

COMMISSIONER'S DECISION

REISSUE: New Claims for Unclaimed Parts of the Real Invention

Even though the new claims may necessarily rely on limitations to clear the prior art different from those of the original patent claims retained on reissue, the original patent is defective and inoperative for having failed to claim as much as was really invented. The new claims stand on their own merit independent of the presence of the original claims, and the fact that the claims might be construed as covering different subject matters does not vitiate the validity of any such claim under the provision of S. 38(1); the Commissioner having been given no authority under S. 50(3) to require additional applications.

FINAL ACTION: Reversed.

This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated March 29, 1972 on application 060,764. This application was filed in the name of Lubomyr O. Hewko and refers to "Accessory Drive Mechanism." The Patent Appeal Board conducted a hearing on November 8, 1972, Messrs. G.F. Henderson and G.E. Fish represented the applicant.

In the prosecution terminated by the Final Action the examiner refused the reissue application on the grounds that:

- (a) The reissue application contains claims directed to a different invention than that of original patent 771,386.
- (b) The applicant has failed to show that he intended to claim the subject matter now set forth in reissue claims 5-10.

The Final Action stated in part:

The first ground for rejection is based on the fact that a reissued patent must issue for the same invention which the patentee has described and claimed in the original patent. For this application to be considered as directed to the same invention, all the claims must contain the essential limitations which were considered necessary to impart patentability to the broadest claim, claim 4, of the original patent, which is also the broadest claim presented in this reissue application.

Claims 1 and 5-10 inclusive as they presently stand do not include the essential distinguishing features of claim 4 of the patent and are therefore directed to a different invention than that for which the patent issued.

The second ground for rejection is based on the fact that applicant had claimed in an original claim of the application a planet carrier having spaced journal bearing surfaces forming a hydrodynamic journal bearing and then in amending the claims cancelled all reference to such a specific bearing, in fact, cancelled all reference to any bearing surface in the carrier. A reissue patent is not for the purpose of reinserting and amplifying subject matter which was cancelled during prosecution of the original patent. An act of judgement deliberately performed in the parent case is binding and cannot be corrected by reissue. This act of judgement clearly negates all intent to claim the subject matter in question.

In summary it is held that this application for reissue still contains new claims not directed to the same invention as the original patent and that applicant did not intend to claim the subject matter of the new claims since this subject matter closely relates to subject matter deliberately cancelled in a claim during prosecution of the original patent. The tenor of section 50 of the patent act decisively negates any intention to make provision for relief in either of these cases and therefore this application for reissue cannot be considered as acceptable.

The applicant's response, of June 28, 1972 to the Final Action, stated in part:

It is submitted that the Examiner's rejection on this ground, and his reasons therefor, are completely improper in law. The Examiner has stated that, for the application to be considered as directed to the same invention, all of the claims must contain the limitations in the broadest claim of the original patent.

It is respectfully pointed out that this statement of the Examiner is completely contrary to the holding of the Supreme Court of Canada in Curlmaster Manufacturing Co. Limited vs. Atlas Brush Limited, 52 CPR 51. At page 63-64 of the report, Claim 1 of the reissue application in that case is reproduced. It will be obvious that this claim does not contain the limitation that the fibers be in two groups of unequal length, although this limitation was a part of all claims of the parent application, as can be seen from page 57 of the report. Despite this, the Supreme Court of Canada held that the reissue application was proper, and that the reissue patent granted therefrom was valid. In view of this holding, the statements of the Examiner that the claims now sought must contain all of the limitations which were essential to impart patentability to Claim 4 of the original patent must clearly be in error.

The Examiner's position appears to be that the Applicant, by cancelling Claim 3 of the original application, made an "act of judgment" which is now binding upon him and prevents him from asserting the subject matter of Claims 5-10. This contention is clearly incorrect on the facts. A consideration of Claim 3, of the original application, which was cancelled on February 9, 1967, shows that this claim did not assert the particular features which are now being relied upon for patentability. The only reference to the subject matter which is now being asserted in Claims 5-10 is "spaced journal bearing surfaces in said planet carrier forming a hydrodynamic journal bearing". In narrowing the claims to overcome the cited Canadian reference, and the art cited against the corresponding United States application, Applicant inadvertently neglected to claim in his revised claims the subject matter relating to the hydrodynamic bearing in Claim 3. However, the existence of Claim 3 clearly shows that the Applicant did intend to claim this subject matter, and the uncontroverted statements in the petition show that the failure to claim this in the revised claims was due to the inadvertence, accident, or mistake during prosecution of the application by the Applicant's patent attorneys. The subject matter of claims 5-10 of the present application is clearly not suggested by the art of record in the file of the original patent 771,386.

It is submitted that, while the cancellation of Claim 3 might be an act of judgment which would prevent the Applicant from asserting a claim of the scope of Claim 3 of the original application in the present proceedings, it can in no way prevent the Applicant from asserting a claim of narrower scope, which was not asserted in the original application, and which is directed to subject matter which was not rejected on art. There is no support in law for the position of the Examiner, and the position is clearly inequitable. In the present circumstances, the Applicant comes within the terms of the reissue statute in that he has claimed through accident or inadvertence or mistake, less than he had a right to claim in view of the state of the art. The applicant accordingly seeks to reissue his patent, to obtain the protection to which he is entitled.

The applicant in his petition stated:

- (1) THAT Your Petitioner is the patentee of Patent No. 771,386 granted on the 14th day of November 1967 for an invention entitled "Accessory Drive Mechanism".
- (2) THAT the said Patent is deemed defective and inoperative by reason of insufficient description and/or specification and by reason of the inventor having claimed less than he had a right to claim as new.
- (3) THAT the respects in which the said Patent is deemed defective and inoperative are as follows:
 - (3a) THAT the specification is deficient in its omission to adequately claim the arrangement and construction of the Figure 5 embodiment,

as amended to correct an inadvertent error appearing therein;

- (3b) THAT the said Patent does not include claims of the scope of claims 5 through 10 which are drawn to the structure illustrated in Figure 5; and
- (3c) THAT claims 1 through 4 of said Patent are restricted to structural details which are not necessarily required in the practice of the invention, and through such undue limitation, fail to provide the coverage to which Your Petitioner is entitled.
- (4) THAT the insufficiency arose without any fraudulent or deceptive intention on the part of Your Petitioner, or the inventor, or on the part of his attorneys who inadvertently erred in the preparation of the application for said Patent and in the prosecution of said Patent application to allowance, and, through inadvertence, the error was not discovered by the inventor, who is inexperienced in patent law and in patent prosecution and did not discover said omissions in the course of such preparation and/or prosecution.
- (5) 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 the first day of June, 1969, in the course of a review of the said Patent and its claims.

Claims 1-4 are substantially the same claims which issued to patent from the original application. Claim 4, a representative claim, reads:

An accessory drive for driving the accessories of an engine driven vehicle comprising a support housing, a support sleeve fixed to said housing, an engine driven planet carrier, a planet roller driven by said carrier, a reaction sun supported on said support sleeve, a bearing between said carrier and support sleeve, a ring, said planet roller being in friction contact with said sun and ring, a final power delivery shaft connected to drive an engine accessory and having one end extending into said support sleeve, and means for supporting said one end of said final power delivery shaft and for driving said power delivery shaft comprising a connection between said ring and power delivery shaft, said planet roller being effective to drive said ring and to support said ring and connection to thereby support said one end of said power delivery shaft.

Claims 5 to 10 have been added in this reissue application. Claim 5 reads:

In a power transmitting mechanism, a housing reaction member, a power input member, a power output member, planet carrier means rotatably mounted in said housing member and connected to one of said members for transmitting torque, a plurality of equally spaced axial notches formed in said carrier having spaced parallel planar bearing surfaces facing each other, a pair of oppositely disposed bearing inserts in each of said notches and each bearing insert having a flat bearing surface in bearing contact with one of said planar bearing surfaces and a concave substantially spherical surface formed on the side opposite said flat bearing surfaces to provide two facing spherical surfaces in each notch, a planet ball mounted between the

facing concave spherical surfaces of each of said pairs of bearing inserts and extending beyond opposed sides of said carrier, the concave spherical surface of each of said inserts having a larger radius than the radius of each of said planet balls providing a wedged opening between the ball and each of said concave spherical surfaces whereby lubricant in said wedged openings tends to lift said planet balls for full hydro-dynamic spherical bearing lubrication, first ring means connected to another of said members for transmitting torque and in friction-drive contact with said ball, second ring means connected to a third of said members for transmitting torque and in friction-drive contact with said ball, and said first and second ring means axially and radially positioning said ball and including means to load said first and second ring means into torque-transmitting friction contact with said ball.

Of the many cases dealing with the present situation involving reissue, one may conveniently refer to the decision of the SCC in Curlmaster v. Atlas (1967) SCR 514 at 527 which gives the state of the law as it affects the determination of this case: (emphasis added by underlining)

The learned trial judge relied upon the statement of Maclean J., as to the purpose of s. 50, in Northern Electric Company Ltd. v. Photo Sound Corporation (1936) Ex. C.R. 75 at 89:

...the purpose of a reissue is to amend an imperfect patent, defects of statement or drawings, and not subject matter, so that it may disclose and protect the patentable subject matter which it was the purpose of that patent to secure to its inventor. Therefore the reissue patent must be confined to the invention which the patentee attempted to describe and claim in his original specification, but which owing to "inadvertence, error or mistake," he failed to do perfectly; he is not to be granted a new patent but an amended patent. An intolerable situation would be created if anything else were permissible. It logically follows of course, that no patent is "defective or inoperative" within the meaning of the Act, by reason of its failure to describe and claim subject matter outside the limits of that invention, as conceived or perceived by the inventor, at the time of his invention.

He also referred to the reason of Duff C.J., in the same case, (1936) SCR 649 at 651:

First of all, the invention described in the amended description or specification and protected by the new patent must be the same invention as that to which the original patent related.

and at page 652:

The statute does not contemplate a case in which an inventor has failed to claim protection in respect of something he has invented but failed to describe or specify adequately because he did not know or believe that what he had done constituted invention in the sense of the patent law and, consequently, had no intention of describing or specifying or claiming it in his original patent. The tenor of the section decisively negatives any intention to make provision for relief in such a case.

Section 50 of the Patent Act was recently considered in this Court in Farbwerke Hoechst Aktiengesellschaft v. The Commissioner of Patents, (1966) S.C.R. 604. In that case reference was made to the judgement of the Supreme Court of the United States in Mahn v. Harwood, (1884) 112 U.S. 354 at 363, which defined the purpose of the American provision as to reissue as being "to provide that kind of relief which courts of equity have always given in cases of clear accident and mistake in the drawing up of written instruments."

Also referred to in the same case at page 530 is the decision in Leonard v. The Commissioner of Patents, (1913) Ex. C.R. 351 in which Cassels J. stated at page 360:

Where a specific device or combination is claimed, the non-claim of other devices or combinations apparent on the face of the specification is, in law, so far as the patentee is concerned, a dedication of them to the public and will be so enforced, unless he with all due diligence surrenders his patent for reissue, and proves that his omission to claim them arose wholly from inadvertence, accident or mistake.

It is quite clear by a long series of decisions, that the words "by reason of insufficient description or specification" cover the claim in the patent as part of the specification.

It is also settled that the original patent may be perfectly good upon its face, but that nevertheless it may come within the terms of this provision and be held defective or inoperative by reason of insufficient description or specification, if it appears that the patentee had set out in the specification his invention but through mistake had not made a claim for it.

It is therefore possible that the conditions of a valid reissue may be satisfied even though no claim was made for the real invention in the original patent, as recently affirmed in the unreported decision in, Burton Parsons Chemical Inc. v. Hewlett-Packard (Canada) Ltd. Case, handed down by the Federal Court of the Canada trial Division on

May 31, 1972 - Ref. No. T-390-71 in which Mr. Justice Noel stated at page 42:

...the court merely considers whether a patentable invention is present, although not necessarily described or even claimed because the statement of invention at the beginning of the original patent in Curl-Master did not even mention the feature which the Court later found to be the invention on which the reissue patent could be supported. (emphasis added)

Considering the present case the ground of rejection, that "The applicant has failed to show that he intended to claim the subject matter now set forth in reissue claims 5-10", appears to have been based on a lack of appreciation of the specification of the original application as well as the application for reissue in the determination of what the real invention is and was intended to have been secured by the patent. It must be understood, however, that reissue is not possible where an inventor could not have intended to claim in the original patent what is claimed in a reissue or where there is evidence of fraudulent intent.

During the prosecution of the original application the applicant withdrew all of the original claims, of which claim 3 contained a broad statement "...spaced journal bearing surfaces in said planet carrier forming a hydro-dynamic journal bearing ..." related to figure 5 of the drawings. The applicant stated, and as noted in the petition, that there was an error in figure 5 of the original drawings in that the inserts (59) should have been shown with cross-hatch marks to agree with the disclosure wherein the part (60) refers to a spherical surface and not a cylindrical surface. On this point the original disclosure reads:

In figure 5, carrier 23 is shown as having notches 58 formed therein and adapted to receive bearing inserts 59. Inserts 59 are provided with spherical surfaces 60 which conform more closely to the other spherical surface of the ball planets 24 and produce better hydrodynamic load capacity. Here a spherical partial hydrodynamic bearing is generated by machining a spherical seat 60 inside the insert 59. As indicated by the arrows, the radius of the seat is larger than the radius of the ball planet. This geometry generates a wedge action between the ball planet and the seat 60.

Therefore, the mistake made in figure 5 of the drawing is accepted as a contributing factor to a misunderstanding of the real invention consistent with the failure to obtain claims covering the structure of figure 5 of the original application. Thus, by the new claims directed to new figure 5 the applicant seeks broader coverage of his invention in the reissue than in the patent. However, as settled by the cited court cases (supra), notwithstanding the public's right to unclaimed subject matter, a patentee is permitted to surrender his patent and remove his apparent dedication to the public provided the carefully defined conditions for reissue are satisfied.

As stated in the examiner's brief, and the Patent Appeal Board agrees, the new claims 5-10 sought by reissue are more restricted than the original claims cancelled; thus there is no question of recovering subject matter deliberately abandoned by the deletion of claims in the face of an objection, as by seeking claims of the same or broader scope than in the original cancelled claims. Furthermore, of equal importance it is agreed that the new claims also avoid the prior art.

The other ground of rejection, that "The reissue application contains claims directed to a different invention", appears to be based on an interpretation of Section 60 of the Patent Rules combined with Section 38 of the Patent Act. In the opinion of the Board such an interpretation of Section 60 of the Rules as an interpretation of Section 50 of the Patent Act could deprive an applicant of his statutory right of claiming what he had a right to claim as new but which he failed to secure by his original patent. This, nonetheless, is to be distinguished from the situation where there has been no insufficiency of claiming as when an applicant cancels claims in the face of a requirement for division and then attempts by reissue to obtain the claims for such other invention for which a divisional should be secured in

accordance with Section 38(2) of the Patent Act.

Hence, the real question is whether the new claims 5 to 10 are clearly for a different and unrelated invention as some thing or combination which was not part of the invention actually made, described and intended to have been secured by the original. It is not enough, however, that the subject matter of the new claims might have been claimed in the original patent because it was suggested or indicated in the specification; it must constitute parts or portions of the invention which were intended, or sought to be covered or secured by the original patent and not merely surplusage or abandoned material (In Re Northern Electric, supra). It is clear from the statements of the courts in the cases cited (supra) that an amended patent must be for the same invention as that to which the original patent related, and that a reissue contemplates new claims for unclaimed parts of the real invention.

In addition, the contention that the claims are "not for the same invention" because of the different limitations specified in the patented claims and the new claims, appears to have overlooked the provisions of Section 38(1) of the Patent Act, in that the fact that they might not be for the same invention could not vitiate the validity of any of the claims if the patent appears before the court for adjudication. The fact that the patented claims 1 to 4 and the new claims 5 to 10 combine a number of the same elements is itself evidence of the interrelationship of the subject matters of both sets of claims.


Moreover, it seems clear that the presence or absence of the patented claims in the reissue, or even the invalidity of the patent claims, should not vitiate the validity of obtaining such new claims on reissue. Support for this view is found in the SCC's decision In Re Curlmaster (supra) wherein a patented claim was deemed invalid in view of prior art and a new claim was obtained on reissue for the real invention, although the new claim was substantially for a different subject matter

from that of an invalid patent claim, this did not prevent the court from holding that the provisions of Section 50(1) concerning the same invention has been satisfied.

The original patent, while operative as to the patented claims presently maintained as claims 1 to 4, is inoperative and defective within the conditions specified in Section 50(1) of the Patent Act for having failed to claim as much as was really invented and intended to be claimed, as that defined by new claims 5 to 10 which relate to the subject matter of figure 5.

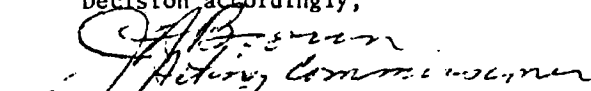
In these circumstances, therefore, the Board is satisfied that the subject matter of the new claims is not outside the limits of the invention which the patentee attempted to describe and claim in his original specification and failed to do so perfectly, and that a review of the case demonstrates that there is sufficient evidence to conclude that the statutory provision for same invention has been respected.

The Board recommends that the Final Action, refusing the reissue application, be withdrawn.


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 16 day of February, 1973.

Agent for Applicant

Messrs. Gowling, MacTavish,
Osborne & Henderson.