

## COMMISSIONER'S DECISION

**REISSUE:** Lack of intention to obtain broader claims. Policy statement that an applicant must have intended to claim in the original what he claims in a reissue has been modified since the Final Action. While the new claims are broader than the patented claims, they are narrower than any cancelled claim, in that the patent failed to obtain the protection for the real invention to which the patentee was entitled, and attempted but failed to claim in the original patent.

**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 April 26, 1972 on application 100,628. This application was filed in the name of Arthur J. Daugherty and refers to "Photographic Printing Apparatus For Making Plural Assorted-Sized Prints Simultaneously".

In the prosecution terminated by the Final Action the examiner rejected the reissue application based on claims 5-8 inclusive for lack of intention to obtain broader claim coverage.

The petition reads as follows:

- (1) THAT your petitioner is the patentee of Canadian Patent Number 812,516 granted on the 13th day of May, 1969 for an invention entitled "Photographic Printing Apparatus for Making Plural Assorted-Sized Prints Simultaneously".
- (2) THAT the patent is deemed defective or inoperative by reason of insufficient description or specification and by reason of the patentee having claimed less than he had a right to claim as new.
- (3) THAT the respects in which the patent is deemed defective are as follows:

In the description of the patent it has not been made clear that the essence of the invention is the provision of a photographic printing apparatus including two lenses, each of which projects an image of a different size onto the print paper. Accordingly the apparatus simultaneously produces from each single frame of an exposed roll of film at least two prints of different sizes. The description does not state clearly that although the most efficient use of paper is obtained by producing one large print and two small prints simultaneously the invention resides in printing two different sizes simultaneously. Thus only two lenses are required to carry out the principle of the invention. While the patent mentions that "multiple images of at least two sizes are being projected simultaneously" it is felt that a clear statement of the invention is required.

Claim 1 of the patent which claims the idea of having a plurality of first objective lenses of a first focal length and at least one second objective lens of a second focal length is deemed to be too restricted because Patentee's apparatus could be made with just two objective lenses of different focal lengths.

Furthermore, claim 1 is deemed to be unnecessarily restricted by the recitation of specific means for focusing the lenses. In an Official Action dated July 20, 1967 it was argued by the Examiner that the original claim 1 was anticipated by Canadian Patent Nos. 275,660, 358,064, 361,364 which disclose multiple lens systems. At that time it would have been desirable to include means for focusing the lenses in Claim 1 in order to distinguish over the above-noted prior patents which showed color filter lenses but claim 1 was not restricted. However, a subsequent Official Action dated May 24, 1968 resulted in the unnecessary restriction of the claim 1 which appears in the patent. In the response dated September 30, 1968 it was pointed out that in the additional reference cited, United States Patent No. 3,212,396 to Schwardt, none of the lenses are individually adjustable to allow for corrections in varying focal length between lenses. Instead, a very cumbersome external adjustment is provided by mounting brackets at different heights at the sides of each unit so as to permit the distance between the negative and a dichroic beam splitter to be varied.

Accordingly, it would have been possible to recite broad means for focusing the lenses so as to overcome the individual prior patents rather than unduly restricting the claim 1 now appearing in the patent so as to overcome a combination of the cited references.

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

- (4) THAT the application which resulted in the above-noted patent corresponds to a United States patent application prepared by applicant's United States patent attorney. Mr. Martin Farber, Vice President of the Film Corporation of America was chosen by the company to look after the patent matters and being relatively unaware of the procedure by which patents are obtained relied wholly on his U.S. counsel and did not review any paper relating to the Canadian patent. Although Mr. Farber made a cursory review of all covering letters concerning the Official Actions of July 20, 1967, May 24, 1968 and the responses thereto, he did not understand the changes made in the claims in the patent application. Furthermore, Mr. Farber was not consulted regarding the form of claims to be submitted in response to the Official Action dated May 24, 1968. Within approximately one month of receiving a copy of the new claims 1 to 4, the application proceeded to allowance. Mr. Farber was not advised that broader claims might be obtained in Canada either before or after allowance due to differences in Canadian and U.S. patent law.

On reviewing the corresponding United States patent it was observed that the claims of the U.S. patent were unnecessarily restricted. On making this discovery the above-noted Canadian patent was also reviewed and an examination of the claims and cited references led to the conclusion that applicant had inadvertently claimed less than he had a right to claim.

In the Final Action the examiner stated in part:

Paragraph (b) relating to lack of intention to obtain broader claim coverage is maintained as the ground for rejection of this Re-issue application. The allowance of this Re-issue application, based on claims 5 to 8 inclusive, is therefore refused.

The Re-issue of a patent is not permitted for the reason of reasserting claims of similar scope to claims deliberately cancelled during prosecution of the original patent, in order to remedy poor judgement on the part of the applicant in deciding what to claim as his invention.

No specific evidence can be seen in respect of applicant's exhibits "A" and "B" (supporting this Re-issue application) relating to intention on the part of the applicant to obtain different claims from those appearing in patent 812,516. At most, applicant appears to be relying on the generalised proposition that any applicant intends to obtain the broadest claims that would be valid.

The applicant's response of August 22, 1972 read in part:

Briefly stated, Applicant wishes to obtain reissuance of the basic patent by adding new Claims 5 to 8. These claims are of a scope never before presented in the original application and are substantially more limited than the claims originally presented in the basic application, although somewhat broader than the claims finally allowed and issued i.e. claims 1-4. For instance, (a) claim 1 calls for "a plurality of first objective lenses ...." whereas claim 5 specifies "first" and "second" lenses; (b) claim 5 specifies the relative image size produced by the "first" and "second" lenses, respectively, whereas claim 1 makes no mention of image size. Thus, in each of these respects, claim 5 (and its dependent claims) is narrower than claim 1.

Among other differences, claim 1 specifies (i) that the tubular member has an externally threaded end, there being no similar recitation in Claim 5; (ii) that a "tubular adapter" is provided as well as "means on said adapter to lock said tubular member axially with respect thereto", there being no similar recitation in claim 5. Thus, in these particulars, claim 5 is broadier than claim 1 and calls for a different combination of elements.

It is again repeated that claims 1-4 allowed in the basic application are directed to the embodiment shown in Figures 6-8 of the drawings. The embodiment shown in Figures 1-5 is the apparatus which is in commercial use. This apparatus is not covered by claims 1-4. Purely as an example, claim 1 calls for "partition webs integrally formed within said tubular member and longitudinally compartmentalizing objective lenses of different focal lengths from each other"; this feature can be clearly seen in Figures 6-8. However, the embodiment shown in Figures 1-5 does not possess such webs.

As has already been stated Mr. Farber is no skilled patent agent and wholly relied upon his U.S. attorney to draft, prosecute and obtain allowance of claims covering the invention set forth in the basic application and he mistakenly believed that the allowed claims i.e. claims 1-4 covered the commercial embodiment of the invention. Obviously as a business man, if not as a patent expert, Mr. Farber would hardly have acquiesced to the allowance of a mere four claims had he known that these failed to cover the commercial embodiment of the invention.

Having studied the application the Board finds that the ground of rejection, "Claims 5-8 are refused for lack of intent to obtain broader claim coverage", is based on a strict interpretation of Office policy that: "... the applicant must have intended to claim in the original patent what he now claims in the reissue." However, the policy on this matter has been modified in the sense that any evidence of lack of intent on the part of an applicant to claim in the original patent what is being claimed in a reissue, or any evidence of fraudulent intent, is fatal to the reissue. The original specification and its prosecution aids in the determination of what an applicant intended to secure by his patent.

Of interest is the recent unreported, Burton Parsons Chemical Inc. v. Hewlett-Packard (Canada) Ltd. case, handed down by the Federal Court of Canada Trial Division on May 31, 1972, - Ref. No. T-390-71. At page 43, Mr. Justice Noel stated:

... it may, I believe be said that if an invention is disclosed initially, but improperly described and claimed in the reissue (sic), this is sufficient to sustain a reissue providing, of course, that the other requirements of the Act are complied with. (emphasis added)

Also, of interest to the present case, the court in Northern Electric Co. Ltd. v. Photo Sound Corporation (1936) SCR 649 held that:

... 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 so properly .... (emphasis added)

This statement was also cited by Martland J. of the Supreme Court of Canada in Curl-Master Mfg. Co. Ltd. v. Atlas Brush Limited (1967) SCR 527.

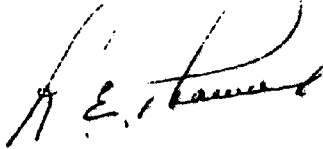
During prosecution of the original application the applicant cancelled claims 1-4 as filed, and the reason as stated by the applicant was, "... to distinguish applicant's invention over the references cited ...." The application was then allowed and passed to issue.

It is noted that the applicant is attempting to obtain broader coverage in the reissue than in the patent. However, there is a balance of interest between the public's right to abandoned subject matter and the potential loss of a patentee's valuable property rights through erroneous claiming. In striking this balance, a patentee is given preference and is permitted to eradicate his ostensible abandonment, provided certain carefully defined conditions are satisfied. One of these conditions is that the recapture of the subject matter abandoned by the deletion of a claim in the face of a specific rejection during the prosecution of the original application is not permitted.

In the present situation the examiner's brief to the Patent Appeal Board has established that claims 5-8 sought by reissue are new claims more restricted than the original claims cancelled. But, it is also well settled that an applicant is entitled to make his claims to the real invention disclosed as broad as the prior art will allow, and in the present situation it has also been established that claims 5-8 avoid the prior art. It then follows, that the original patent failed to obtain proper protection for the invention disclosed, but which he attempted to do by the original claims cancelled, and that by the same token no attempt is being made to recapture abandoned subject matter of the same or broader scope than in the original claims cancelled. Moreover, the public had no basis on which to assume that the additional subject matter covered by new claims 5-8 was abandoned.

On this basis, the Board is satisfied that the applicant has, by inadvertence, accident, or mistake improperly claimed the actual invention which he had a right to claim as new in his original patent. Therefore, it is held that the conditions of Section 50 of the Patent Act have been complied with, and the present application should be allowed to proceed to patent.

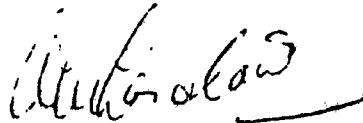
Therefore, the Board recommends that the Final Action be withdrawn.



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.

Decision accordingly,



A. M. Laidlaw,  
Commissioner of Patents.

Dated at Ottawa, Ontario,  
this 27<sup>th</sup> day of November, 1972.

Agent for Applicant

Moffat & Butler