

COMMISSIONER'S DECISION

INDEFINITE CLAIMS - Section 36(2): Means by functional clause.

The claims held not to embrace all possible means without qualification so as to, in effect, restate the problem. Once the best mode of giving effect to a new idea or principle has been described, the ambit of the claims may protect against all modes by which the new idea can be given effect.

FINAL ACTION: Reversed

The decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated June 1, 1972 on application 044,570.

This application was filed in the name of Donald E. Schmitt et al and refers to "Plural Successively Operable Check Controlled Slides".

In the prosecution terminated by the Final Action the examiner rejected claim 21 as being contrary to Section 36(2) of the Patent Act in that it is indefinite, and for lacking support in the disclosure.

Claim 21 reads:

In a coin chute, the combination of, a base, first and second slides each adapted to hold a coin and each mounted for in and out sliding on said base between coin-inserting and coin-depositing positions, and means on said base for preventing movement of said second slide to its coin-depositing position until said first slide has been moved to its coin-depositing position a preselected number of times.

In the Final Action the examiner stated in part:

Reference Applied

United States Patent
1,736,710 Nov. 19, 1929 Hulin

The Hulin patent teaches a coin activated device utilizing a base and first and second slides each adapted to hold a coin and each mounted for in and out sliding on the base between coin-inserting and coin-depositing positions.

Claim 21 is indefinite in that it merely recites a desired mode of operation to be achieved with a pair of coin slides and does not specify an inventive structure which will produce the result.

The claim sets forth the invention in terms of means with a statement of function, namely "means on said base for preventing movement of said second slide to its coin-depositing position until said first slide has been moved to its coin-depositing position a preselected

number of times". The statement of means plus function is what distinguishes the claim from the prior art, namely the Hulin patent. This statement is so broad that it embraces all possible means, without qualification for solving the problem facing the inventor and is in effect a restatement of the problem.

Claim 21 is further rejected as not being supported by the disclosure. The applicant has not disclosed a unitary means which by itself will function as claimed. As defined in the disclosure in the last paragraph on page 7 the things to carry out the invention include retainer 45 to prevent the second slide from moving to its coin-depositing position and a counter 46 on the base to detect inward movement of the first slide and disable the retainer after the first slide has been moved inwardly a preselected number of times. These are the minimum necessary things to prevent movement of the second slide and also determine when it may be released as a result of predetermined movement of the first slide. In order to do this both a retainer means and a co-operating counter means must be included.

The applicant in his response of August 11, 1972 stated in part:

The Examiner has indicated that claims 1 to 20 are allowable but has rejected claim 21 as being contrary to Section 36(2) of the Patent Act and furthermore that the claim is not supported by the disclosure. It is respectfully submitted that claim 21 is not open to the objections stated by the Examiner. It is applicants position that there is no basis in fact or in law for the Examiner's allegation that claim 21 indefinite because it differs from the prior art only by a statement of means plus function at the point of invention. It still appears to applicant that the Examiner considers only the "means for preventing movement of said second slide to its coin depositing position until said first slide has been moved to its coin depositing position a preselected number of times" as being the point of the invention. This is not the case. Applicant has developed a entirely new combination of integers, each of which has been defined in appropriate fashion, and which together make up the whole point of the invention. While it may be true that the Hulin reference shows certain of the elements present in applicant's device, there is nothing in the Hulin device which would suggest to a person skilled in the art that applicants entire device could be produced by multiplication of the relatively crude devices shown in the reference. It is again submitted that the courts have long ruled a combination claim can consist of a series of means clauses to define an operative combination of integers and that a valid combination claim does not necessarily contain any structural clauses such as are being required by the Examiner. Applicant therefore submits that in a combination claim he is entitled to mention such structural elements as appear necessary and to define other elements in terms of means clauses. It is the combination which counts and not any one particular means or structural clause.

The Examiner's further objection that claim 21 is not supported by the disclosure is also respectfully traversed. It is respectfully submitted that applicant is entitled, in the absence of any pertinent prior art to the entire combination, to claim his inventive combination in broad terms. It is not seen that the reference relied upon by the Examiner teaches a device which in combination includes means for preventing movement of the second slide in combination with the other integers such as would necessitate applicant to restrict the

claim to any particular limitation. In the absence of references to show movement preventing means in combination with a first and second slide in a coin chute it is believed that applicant is entitled to claim the combination in broad general terms and the Commissioner is respectfully requested to reverse the Examiner's position thereon.

This application relates to a coin activated device wherein a pair of coin receiving slides mounted for in and out movement between coin-receiving and coin-depositing positions, each adapted to receive a coin of a different denomination which functionally interact in a particular way through means including a retainer to prevent movement of a quarter receiving slide and a counter which is selectively set by the proprietor so that a nickel receiving slide must be activated a preselected number of times before the retainer is released allowing the quarter slide to be actuated, subsequently allowing the article to be dispensed since the required amount of money has been deposited in the device.

The reference to Hulin discloses a base on which is mounted two coin slides mounted for independent in and out movement on the base between coin-inserting and coin-depositing positions.

Of significance in the present determination is the consideration of the Court, Cluett Peabody & Co. Inc. v. Dominion Textiles Co. Ltd. (1938) Ex.CR. 47 at 79 wherein Maclean J. stated:

It has been well and concisely stated in the text book, Terrell on Patents, that inventions may be divided roughly into two classes in respect to subject-matter. First, there is that kind of invention which consists in the discovery of a method of application of a new principle-here what has been invented is in effect the new principle, and, generally speaking, the Court will regard jealously any other method embodying that principle, for the patentee was not bound to describe every method by which his invention could be carried into effect. Second, there is that kind of invention which consists in some particular new method of applying a well known principle, and in this case the use of other methods is not contemplated by the patentee, and should not be included within the ambit of his claim. That describes an accepted doctrine in patent law....A patent for carrying a principle which is new into effect protects the grantee against all other modes of carrying that principle into effect. (emphasis added).

The new principle referred to in the above Court case related to a method of treating fabric to prevent shrinkage. The Judge also equates "idea" with "principle" when he stated at page 80: "This case is a good

illustration of how readily the competent mechanical engineer, once understanding the principle of an invention, may produce other means of carrying the same idea or principle into effect."

Considerable argument has been presented with respect to the use of "means clauses" in a claim. The use of "a means qualified by a statement of function" in a claim is not objectionable in itself. While a patentee may be entitled to protection for all modes particularly adapted for carrying out the means, it is not sufficient to merely restate a problem or desired result without any qualification of the new idea or principle given effect by the means. Section 36(1) of the Patent Act requires disclosure of one embodiment only and the best mode which is contemplated by the inventor for the practical application of the new idea or principle. Since this has been done in the present application, there is no basis for the objection that the claim is not supported by the disclosure whether or not a "means" embraces one or a plurality of elements or means as necessary to perform a clearly stated function. Notwithstanding, "a means qualified by a statement of function" must be fairly expressed and even though a claim need not define structure it must not be indefinite or ambiguous.

As in the present case, coin machines are designed to operate to deliver goods when the correct amount of money has been inserted. Since the prior art does not teach any form of interaction between coin receiving slides to prevent one from movement until the other has been moved a predetermined number of times, an invention appears to have been made in such new idea or principle, and the new combination giving effect to that idea or principle. Thus, in accordance with the criteria enunciated in Cluett Peabody v Dominion Textiles Ltd., supra, the applicant is entitled to a patent that protects against all other modes particularly adapted for carrying his new idea or principle into effect.

The examiners rejection under Section 36(2) stated that: "Claim 21 is indefinite in that it merely recites a desired mode of operation to be

achieved with a pair of coin slides and does not specify an inventive structure which will produce the result," and "The statement of means plus function is what distinguishes the claim from the prior art, namely the Hulin patent. This statement is so broad that it embraces all possible means, without qualification for solving the problem facing the inventor and is in effect a restatement of the problem".

First, it is not necessary in the present situation that the applicant avoid the prior art by "inventive structure", for he may avoid the prior art with a new combination with such means qualifying the functional interaction of the two slides being the only difference from the prior art.

It is settled law that the new idea or principle of an end is patentable even though the new means to achieve that end may be very obvious once the suggestion of the end has been understood, in this case a new idea of the operation of the slides has been made. The Board is satisfied that the claim is not designed to embrace all possible means without qualification so as to merely restate the problem for the means giving effect to the new idea has been qualified by stating: "...for preventing movement of said second slide to its coin-depositing position until said first slide has been moved to its coin-depositing position a preselected number of times".

Whether such statement is accurate in its definition of the required function interaction of the slides by the means on said base is quite a different matter which cannot at the moment be decided by the Board since the question was not raised by the examiner. It does, however, appear that the claim fails to state the functional interaction of the means and the slides as a result of the preselected movement of the first slide. For example (as set out in claim 18), is it not the function of the means to prevent movement of the second slide from its coin-receiving position until a preselected number

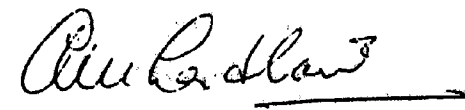
of movements of the first slide, from its coin-receiving position to its coin-depositing position, operates the means to permit movement of the second slide to its coin-depositing position?

The Board recommends that the Final Action, refusing claim 21 under Section 36(2) of the Patent Act for the reasons stated, be withdrawn.


J.F. Hughes
Assistant 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 4th day of April, 1973

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