

COMMISSIONER'S DECISION

REDUNDANT CLAIMS: Rule 43 and Section 38.

Claims for a new combination and for that combination with added features are neither redundant nor directed to different inventions. Only one inventive step is required of each new combination claimed; and the applicant is entitled to claim his invention in terms of those things or combinations which he regards as new and in which he claims an exclusive property.

FINAL ACTION: Reversed

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This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated August 9, 1972 on application 008,653. This application was filed in the names of James H. Case and Neil C. Stewart and refers to "Digital Computing and Information Processing Machine and System".

In the prosecution terminated by the Final Action the examiner refused to allow the application on the grounds that Section 43 of the Patent Rules or alternatively Section 38 of the Patent Act have not been complied with.

In this action the examiner stated in part:

All the claims appear to be allowable over the art of record.

Claims 4 to 6 are held to be directed to the structure of an array of cells of word organized type. Such a structure forms a sub-combination of a digital information processing machine as referred to in the preamble to claim 4. Thus, the digital information processing machine forms the immediate environment of the cell array. It is the examiner's contention that the addition of either a digital storing and transferring machine or of a second machine of the type defined in claim 4, to the array defined in claim 4 does not produce a result or effect which is not the sum of the known characteristics of the parts or the obvious result to be expected from their known characteristics. Furthermore the addition of such machines goes beyond the immediate environment in which the cell array would normally be found.

In view of the above, it is clear that claim 11 is not patentably different from claim 4, claim 12 is not patentably different from claim 11, and claim 13 is not patentably different from claims 4 to 6. In view of Rule 43 of the Patent Rules applicant is required to elect which of claims 4 to 6 or 11 to 13 he desires to have allowed and to cancel the others.

From applicant's arguments that claims 11 to 13 add new features to claims 4 to 6 respectively to form new combinations of features it appears that applicant is arguing that the subject matter of claims 11 to 13 is inventive over that of claims 4 to 6. If applicant wishes to pursue this line of argument he is required to restrict his claims to a single invention.

The applicant in his response to the Final Action, dated November 7, 1972 stated in part:

From basic principles, the objective of asserting each of claims 11 through 13 is to provide a claim which is narrower than claim 4 by the addition of some feature to provide a different combination of features.

It has always been accepted by the Patent Office that, if a claim is found to be allowable from the aspect of novelty, then a dependent claim adding a further feature must also be allowable (at least from the point of view of novelty), it being self-evident that if the combination of (a) through (f) is novel, then the combination (a) through (g), formed by adding another feature, must also be novel.

As regards the remarks that these claims 11 through 13 define features beyond the immediate environment of the machine defined in Claim 4, even if this were true, its importance is not seen.

Claims 11 through 13 are each dependent directly or indirectly on one of the presumably allowable claims, and it cannot be seen how, by adding further features, one can possibly turn a patentable combination into an unpatentable combination.

This application relates to an array of cells of word organized type which is used in association with a digital processing machine. The claims 1, 4, 11, 12 and 13 read as follows:

Claim 1

A digital information processing machine comprising an array of cells of word organized type arranged for operation in parallel with each other, each cell having means for exchanging information with neighboring cells in a region surrounding the cell and at least two cells of the array having respective surrounding regions which have no cells in common, and power and clock pulse bus lines connected to each cell of the array for supply of external power and clock pulses at such a rate and in such a manner that consecutive pulses are separated from each other far enough in space and time so that the surrounding region of any cell within the array contains at most one power and clock pulse at any given time.

Claim 4

A digital information processing machine comprising an array of cells of word organized type arranged for independent operation in parallel with each other, each cell having means for addressing all of the cells within a region surrounding the cell limited in extent by bit length of an instruction word, at least two cells of the array having respective surrounding regions which have no cells in common, means for transferring information between any cell in the array and other cells with the region surrounding the cell, and means for deactivating the cells of the array in order to stop their execution of the instructions, and power and clock bus lines connected to each cell of the array for supply of external power and clock pulses at such a rate and in such a manner that consecutive pulses are separated from each other far enough in space and time so that the surrounding region of any cell will contain at most one such pulse at any given time.

Claim 11

A machine as claimed in claim 4 having functionally connected to a cell thereof at least one digital storing and transferring machine.

Claim 12

A machine as claimed in claim 11 in which the digital storing and transferring machine is a machine as claimed in claim 1.

Claim 13

A digital computing and information processing system comprising at least two machines as claimed in any one of claims 4 to 6 and means for transferring information between at least one cell of one of the machines and at least one cell of at least one other of the machines.

The first question to be decided is whether claims 11 to 13 are objectionable under Section 43 of the Patent Rules, keeping in mind that according to the examiner all the claims of the application appear to be allowable over the cited art.

This section reads:

No more claims shall be allowed than are necessary adequately to protect the invention disclosed, and if two or more claims differ so slightly that the several claims could not be allowed in separate patents the applicant may be required to elect which of such claims he desires to have allowed and cancel the others.

The intent of this section is to limit an undue multiplicity of claims in an application; situations where there is no significant distinguishing feature but merely variations of language without any variation of the scope of the claims.

In claim 11, a digital storing and transferring machine has been added to claim 4; in claim 12, a specific digital storing machine as claimed in claim 1 has been added to claim 11. Claim 13 is directed to a digital computing and information processing system comprising at least two machines of the type as defined in claims 4 to 6.

Of interest in the determination of this case is the consideration of the court in Hercules Inc. v Diamond Shamrock Corp. (1970) 62 CPR 43, wherein Jackett P. of the Exchequer Court stated at page 61:

Having thus described his "invention" or discovery in words that would enable his colleagues in his particular branch of learning or of the art to make use of it, the inventor is faced with the requirement in S. 36(2) that he shall state in "explicit" terms the things or combinations in which he claims an exclusive property.... If he frames his claim so that it does not cover the whole of what he discovered, others will be able to take advantage of his disclosure without infringing the monopoly that he seeks. This problem certainly puts an inventor and his advisors in a position where they must be very careful to establish precisely what he did and did not invent, or it would do so if the permissiveness of S. 38 did not allow the Commissioner an implied discretion to permit inventors to "claim" in effect in the alternative. With the Commissioner's acquiescence, what happens, in at least some cases, is that, in the first instance, a claim is made in the widest terms possible for the subject matter described in the specification and then, by what seems to be an infinite variety of changes in the terms of the first claim, the inventor makes additional claims by which the invention is variously described by adding additional limiting factors not included in the initial claim. (emphasis added)

Accordingly, the Board is satisfied that limiting features have been added in claims 11, 12 and 13 and the addition of such features to a new combination, forms additional new combinations to which applicant is clearly entitled under Section 36(2) of the Patent Act.

The Board is therefore satisfied that the rejection of claims 11 to 13 under Section 43 of the Patent Rules is not justified.

The second ground of rejection, that alternatively Section 38 of the Patent Act is not satisfied, appears to be an interpretation by the examiner of the statements of the applicant that claims 11 to 13 add features to claims 4 to 6, to form new combinations, in view of which the examiner requires restriction of the claims to a single invention.

The examiner appears to have misconstrued the foregoing statement of the applicant to imply that a further inventive step must be proven to establish the patentability of the new combination with an added feature. Only one inventive step is required of a new and patentable combination. While additional features such as; a digital storing and transferring machine, and a digital computing and information processing system, have been added to the already allowable claims, the requirement has been met that the added claims state distinctly and in explicit terms the things or combinations that the applicant regards as new.

In the circumstance, therefore, the Board is also satisfied that the rejection under Section 38 of the Patent Act is not justified.

The Board recommends that the grounds of rejection should be withdrawn for the reasons stated herein.

  
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 handwritten signature in dark ink, appearing to read 'A.M. Laidlaw', with a long horizontal flourish extending to the right.

A.M. Laidlaw  
Commissioner of Patents

Dated at Ottawa, Ontario  
this 18<sup>th</sup> day of April, 1973

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