

COMMISSIONER'S DECISION

SUFFICIENCY; NEW MATTER: Section 36(1) and Rule 52

There is a vital difference between imperfections of draftsmanship and non-compliance with the statutory requirement of Section 36(1), and a specification is not insufficient if a competent person may have to make trials or experiments by following the teaching of the specification, or by applying common knowledge or skill. The amended definition of the invention is reasonably to be inferred by such competent person and the specification as filed was not insufficient in the statutory sense.

FINAL ACTION: Overruled.

This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated August 23, 1972 on application 047,327. This application was filed in the name of Thomas A. Pilgrim et al and refers to "Plastering Compositions".

In the prosecution terminated by the Final Action the examiner rejected an amendment to the application on the ground that it added new subject matter contrary to Section 52 of the Patent Rules.

In this action the examiner stated in part:

The rejection of this amended application is maintained and the reasons for such rejection are as follows:-

- (1) Amended page 3 (second paragraph) and page 6 (last two paragraphs) add new subject matter which was not part of the invention disclosed in the specification as originally filed on March 31, 1969.
- (2) Amended claims 2 to 5 define new subject matter for which no adequate support was provided in the specification as originally filed on March 31, 1969.

This application as filed on March 31, 1969 clearly described the ambit of the plastering compositions suitable for application to backgrounds of high absorbency to include from 50 to 95% calcium sulphate hemi-hydrate plaster having a dry specific surface in the range 2,500 to 5,000 sq. cm. per gram and a dispersion factor of at least 4.6. The applicant is referred to page 3 lines 7 to 11 and claims 1 to 3 of the specification as originally filed. The amendments of June 26, 1969 completely change the scope of the plastering compositions as contemplated in the specification as originally filed because they define the use of a calcium sulphate hemi-hydrate plaster wherein the product of the dry specific surface and the dispersion factor is at least 13,800 sq. cm. per gram. Since the originally filed specification failed to state that (1) a dispersion factor of less than 4.6 can apply to plaster having a dry specific surface above 3,000 sq. cm. per gm. and (2) a dispersion factor of 4.6 does not apply to plaster having a dry specific surface below 3,000 sq. cm. per gm., it has been determined

that this new subject matter cannot be reasonably inferred from the specification as filed on March 31, 1969.

In the response of November 23, 1972 the applicant stated in part:

The applicant makes the following general submissions:

1. The amendment of the application as proposed by the applicant is completely consistent with the applicant's duty to the public and pursuant to the applicant's duty as defined in Section 36 of the Patent Act.
2. Properly construed, Rule 52 is not applicable to a situation in which there is no change in the invention made by the inventor but merely a change in the definition of that invention by the applicant's patent agent.
3. The jurisprudence on reissue patents is persuasive in considering what constitutes new matter within the meaning of Rule 52.
4. The proposed amendments do not violate even the narrow interpretation of Rule 52 advanced by the Examiner.

In defining the invention it was decided in discussion between the inventor and his British patent agent, that the degree of breakdown in water was of outstanding importance and it was agreed that this quality should be indicated by "dispersion factor" defined as in the present specification. The patent agent asked for a range of particle sizes for the plaster actually taken in the dry composition, and this was supplied. The patent agent at this stage had not appreciated the fact that, not only was there a range of particle sizes in the dry material which would give easy mixing but also that the requirement of high water retention could be ascribed to a particle size falling below a given limit (or when expressed as specific surface falling above a particular limit).

To define "dispersion factor" it was necessary to describe a test in the specification, and to demonstrate the invention a series of trials was described using the typical starting material of 3,000 cms per gram per specific surface. The results of these experiments showed the critical nature of the 4.6 limit of dispersion factor. The inventor was aware that the 4.6 limit only applied to a specific surface of 3,000 and wrote to the patent agent suggesting that this should be made clear.

Unfortunately, the patent agent did not appreciate the full significance of this observation but feared that a reference to 3,000 specific surface in the definition of dispersion factor would make it impossible to apply the claim to plasters of other initial specific surface values, and so perhaps deny protection to the wider range of starting materials. In his reply to the inventor, the patent agent merely observed that he would prefer to keep the broad range of starting materials and hope that the value quoted for the dispersion factor would not be too far out over the whole range. In other words, the patent agent did not appreciate that there was a critical lower limit for the wet dispersed surface area of the plaster.

Section 36 is explicit in its terms "The applicant shall in the specification correctly and fully describe the invention and its operation or use as contemplated by the inventor". For the Examiner to reject the

explanation of the interrelationship between the dry specific surface range of available plasters and the dispersion factor essential to proper employment of the invention is to deny the public the information to which the public is entitled in connection with the best use of the invention as contemplated by the inventor. It is inconceivable that any rule under the Patent Act should be so construed as to deprive the public of the benefit of a clear and lucid explanation of the invention. The section further provides that the applicant shall "particularly indicate and distinctly claim the part, improvement, or combination which he claims as his invention". The section goes on to say that "the specification shall end with a claim or claims stating distinctly and in explicit terms the things or combinations that the applicant regards as new and in which he claims an exclusive property or privilege". There is both a public and private interest in ascertaining the correct scope of monopoly to be accorded an invention. The amendments that have been presented in this application are consistent with claiming that invention which in fact was made and a specific example of which was originally presented as part of the disclosure.

It is inconceivable that an applicant should be able to do by reissue what he is prevented from doing while the application is pending. Amendment of the pending application must be allowed consistent with the overriding considerations of Section 36. It is quite appropriate for Section 36, in conjunction with Section 28, to be read as applicable to the originally created invention and not to some later improvement or addition made by the inventor. For that reason, Rule 52 is proper insofar as it prevents the filing of what are tantamount to a series of continuation-in-part applications, to borrow a term from United States practice. However, the function of Rule 52 surely cannot be to deprive the applicant from an opportunity to properly present his invention. Where the legislature has set out a specific remedial provision in Section 50 to permit the inventor to properly describe and claim his invention as made even though the patent has already been granted, it must be apparent that Section 36 read with Section 32 implicitly authorizes the applicant to make comparable amendments to the application while it is still pending. It should be apparent from the foregoing recital of facts that there would be absolutely no difficulty in obtaining reissue of the present application had it issued to patent in its originally filed form. Accordingly, it is in the applicant's submission inconceivable that Rule 52 could be applied to preclude the applicant from doing by way of amendment during prosecution what the applicant is permitted to do by the very exceptional reissue proceedings following grant of a patent.

This invention relates to plastering composition for application to backgrounds of high absorbency. While claim 1 was found by the examiner to be allowable, claims 2 and 3 under rejection read as follows:

A plastering composition comprising by weight of the dry composition from 50 to 95% calcium sulphate hemi-hydrate plaster having its product of dry specific surface and dispersion factor (as hereinbefore defined) of at least the product 13,800 sq. cm. per gram; from 0 to 4% hydrate lime, 0 to 45% ground calcium carbonate and 0.05 to 0.5% cellulose ether.

A composition according to claim 2, wherein the calcium sulphate hemi-hydrate plaster has a dry specific surface in the range 2,500 to 5,000 sq. cm. per gram.

At the outset it is noted that the examiner in making the rejection did not have the benefit of the contents of an affidavit signed by G.P. Campbell, which was submitted to the Board on January 4, 1973. The contents of this affidavit will be considered latter in this decision.

This invention deals with the problem of rapid loss of water from the usual plastering composition into the background which causes the plaster to be weak. Previously the introduction of a small amount of cellulose ether into the plaster composition substantially reduces the loss of water, but at the same time renders the composition difficult to wet out and mix with water.

The applicant has solved the problem by using a calcium sulphate hemi-hydrate plaster prepared by appropriate calcination from certain gypsum rocks which on wetting disperse readily with a large increase in dry specific surface (that is a substantial reduction in particle size). The original specification stated that the calcium sulphate hemi-hydrate plasters have a dry specific surface in the range of 2500 to 5000 sq. cm. per gram and a dispersion factor on wetting as defined in the disclosure of at least 4.6, which was reflected in the original claims. But in all of the examples disclosed, a hemi-hydrate plaster having an initial dry specific surface of 3,000 sq. cm. per gram was used for which the dispersion factor on wetting of 4.6 was found essential for satisfactory results.

In the amendment of June 26, 1969, the disclosure was amended to state that the dispersion factor of 4.6 applied to 3000 sq. cm. per gram and did not apply over the whole range of dry specific surfaces. The applicant stated that what is important is that the hemi-hydrate plaster must have a dry specific surface after wetting (dispersion factor times the dry specific surface before wetting) of at least 13,800 sq. cm. per gram. The applicant also stated that he was aware and the tests show that the 4.6 limit applied only to a specific surface of 3000 sq. cm. per gram, and that he wrote to the agent suggesting that this should be made clear. New claims were also filed containing this definition of the essential nature of the invention.

Of interest in the determination of this case is the consideration of the Court in Minerals Separation v. Noranda Mines Ltd., (1947) Ex.CR. 306, wherein Thorson P. stated at page 319:

When it is said that a specification should be so written that after the period of monopoly has expired the public will be able with only the specification to put the invention to the same successful use as the inventor himself could do, it must be remembered that the public means persons skilled in the art to which the invention relates, for a patent specification is addressed to such persons.

And at page 319 he also stated:

There is no doubt that the specification is not well drawn, but there is a vital difference between imperfections of draftsmanship and non-compliance with statutory requirements. (Emphasis added).

Thus the issues appear, first as to whether the application as filed has complied with the statutory requirements of Section 36 of the Patent Act keeping in mind the instruction that there is a vital difference between imperfections of draftsmanship and non-compliance with the statutory requirements, and second as to whether the amended definition of the dry specific surface of the plaster after wetting is admissible under Section 52 of the Patent Rules as matter reasonably to be inferred by persons to whom the specification is addressed.

Of the numerous decisions that may be cited, the statement of Thorson P. in Ernest Scragg v. Leeson (1964) Ex.CR. 649 at 747 appears apt for the present circumstances:

It is settled law that a patent specification is not insufficient by reason of the fact that a competent workman of ordinary skill in the art to which the invention relates may have to make trials or experiments which are not themselves inventions and the competent workman can accomplish the desired result by following the teaching of the specification. The specification is sufficient if it enables him to put the invention into practice and sufficient directions are given to him to enable him to know what trials or experiments he may have to make and how to make them.

In addition, Section 36(1) makes it clear, and it is settled in law, that an applicant is under no obligation to describe more than a single preferred embodiment, which embodiment may be an exemplification of an invention of wider scope that can be claimed. The specification as originally filed describes on pages 2 and 3 the test procedure to follow to assure the

advantages of the invention and its contribution to existing knowledge, and page 4 of the specification reads: "In putting the invention into practice, available plasters must be examined to establish whether they disperse in water to the extent necessary to achieve the advantages of the invention. This can be done by employing the test procedure just described."

The Board is therefore satisfied that sufficient directions are given in the original specification to enable a competent person or expert in the art of plasters to carry out the teaching of the specification and tests described so as to enable him to put the invention to full use; thus Section 36 of the Patent Act is satisfied.

The Board finds that the rejected amendment is nothing more than an amended definition of the dry specific surface of the plaster after wetting in terms of the dispersion factor times the dry specific surface before wetting of at least 13,800 sq. cm. per gram, and does not change the nature of the invention so defined but places emphasis on the lower critical limit of 13,800 sq. cm. per gram rather than the dispersion factor of 4.6.

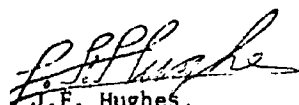
Moreover, there appears no reason to doubt the statement of Mr. G.P. Campbell in his affidavit that: "For some unexplained reason the illogicality, and indeed error, of associating the entire range of initial particle size with a single limiting value of "dispersion factor" must have been overlooked in drafting the original broad claim." Further "I think it entirely reasonable and acceptable that the claim should be brought into line with what to me as a plaster chemist of some experience is clearly the teaching of the specification as a whole on the essential nature of the invention." (Mr. Campbell, a Scientist with BPB Industries (Research and Development) has been for eight years concerned with the chemistry and properties of gypsum and dehydrated properties of gypsum).

The Board is therefore satisfied that no newly discovered subject matter has been added and that the amendment under rejection is admissible as matter reasonable to be inferred by a competent person in the plaster art having before him the teachings of the original specification and the prior knowledge and skill such addressee of the specification possesses.

Having arrived at the forgoing conclusions for the reasons stated, no discussion is necessary by the Board with respect to the argument advanced by the applicant on the basis of Section 50 of the Patent Act.

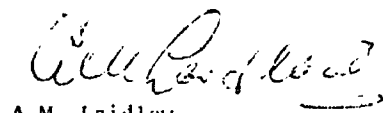
The Board suggests that some attention should have been given to the scope of claim 1 to which no objection has been made, in that the range of initial dry specific surface of up to 5000 sq. cm. per gram may be beyond the scope of the specific embodiment intended to be covered by the claim. Also, claim 2 appears incomplete without reference to the subject matter of claim 3.

The Board therefore recommends that the Final Action refusing the amendment 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 27th day of March, 1973.

Agent for Applicant

Fetherstonhaugh & Co., Ottawa.