COMMISSIONER'S DECISION

STATUTORY SUBJECT MATTER - S. 2: Testing and Developing The Capacity of Human Lungs

Following the principles of the S.C.C. in Tennessee Eastman v. Commissioner, the process for measuring and increasing the capacity of air sacs of human lungs lies in the field of practical application, and is not related to medical treatment in the strict sense or in the use of a medicine. The process has utility in the sense that the process is controllable by the means disclosed. The rejection was on the basis that the process performs on a non-industrial product, that it is essentially non-economic, and that it is dependent on professional skills.

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 17, 1972 on application 016,962. This application was filed on April 8, 1968 in the name of Edward Fitz and refers to "A Device For Developing The Lungs". As stated by the applicant in the specification, "This application refers to a device and method for increasing the capacity and strength of lungs. More particularly, this invention relates to a device and method for exercising the lungs and improving the capacity thereof."

In the prosecution terminated by the Final Action the examiner rejected claims 7 and 8 in that they are directed to subject matter not allowable under Section 2 of the Patent Act. Claims 7 and 8 read:

> 7. A method for measuring the increase in capacity and strength of air sacs in human lungs comprising the steps of: collecting air expelled therefrom against an opposing force measuring the amount of air collected, recording the amount and repeating each of the foregoing steps.
>
> 8. A method in accordance with claim 7 including the steps of varying the opposing force after each repetition of the method.

In the Final Action the examiner stated in part:

> Claims 7 and 8 are directed to a diagnostic method for use on a living body, i.e., to diagnose the capacity and strength of the lungs, and as such, even though the wording of the claims calls for "measuring the increase", the method would also indicate any "decrease" and thus in effect the method tests or diagnoses the condition of the lungs in terms of capacity and strength.

> Although the present method of measuring the increase in capacity and strength of the lungs in a human body may be new, useful, and unobvious, it is however, not susceptible of industrial application. The method here, which is performed on a non-industrial product i.e., on lungs in a human body, is rather conceived as being essentially non-economic as it does not produce a result in any way associated with trade, commerce or industry in the sense that those expressions have been used in court decisions on patent applications directed to methods dependent on professional skill. (See Lawson vs. Commissioner of Patents, or Tennessee Eastman Co. vs. Commissioner of Patents); the matter contained by the said method claims is also contrary to the spirit of the expression "working in a commercial scale", referred to in the Patent Act.

The applicant, in his response to the Final Action dated January 25, 1973, stated in part:

> The Examiner's rejection is based on the argument that even though the method may be new, useful and unobvious, it is performed on a non-industrial product. This argument is evidently based on the British line of cases which are based on an interpretation of the British Statute to require a vendable product. The Examiner has referred to the Lawson and Tennessee Eastman cases, which might be taken as implying that the principles of the British Statute are applicable in Canada. Since then, however, the Supreme Court of Canada has rendered its Judgment in Tennessee Eastman Company et al vs. Commissioner of Patents. The reasoning of the Supreme Court makes it clear (at page 8) that a method of surgical treatment involving the use of a substance is not patentable, as otherwise there would be an easy way out of the restriction as to the patentability of substances under Section 41(1) of the Patent Act. This ground of decision is obviously inapplicable to the present case, as applicant is not trying to obtain protection for a medicinal substance. Also on page 8 of the Tennessee Eastman case the Court makes it clear that decisions dealing with the patentability of inventions under the United Kingdom Act are not entitled to the weight attributed to them by various authors in view of the substantial differences between the British and Canadian Statutes. Therefore as the Examiner's objection with respect to the requirement of an industrial product is based on the line of cases which interpret the term "manufacture" in the British Statute, it is submitted that the entire matter should be reconsidered. It is clear from the decision of the Supreme Court that the claims should not be rejected unless some basis for rejection can be found in the Canadian Statute rather than the British Statute. We know of no requirement in the Canadian Statute that the method result in the production of a vendable product.

At the outset the Board observes that at the time the Final Action conformed with Patent Office guidelines relating to the patentability of inventions involving processes of testing related to the human body, as distinct from processes for testing other natural products, or industrial products and of materials used in the manufacture of such products.

The examiner advanced the argument that the claims are directed to a diagnostic method that is performed on a non-industrial product, and that the method is essentially non-economic and does not produce a result in any way associated with trade, commerce or industry in the sense that those expressions have been used in court decisions on patent applications directed to methods dependent on professional skill.

The basic issue is therefore whether the subject matter of the process as claimed in claims 7 and 8 constitutes a "useful art or process" (as distinct from a fine art such as that in which novelty lies solely in the exercise of professional skills, or that having intellectual meaning or aesthetic appeal alone), within the meaning of Section 2 of the Patent Act, and in the case of claims for methods of testing the established criteria of utility is usually critical in determining that issue.

Section 2 of the Patent Act reads in part:

> "Invention" means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter.

The prerequisite of utility of a "useful art or process" within the meaning of Section 2, may be conveniently stated, inter alia as to: whether the subject matter is controllable and reproducible by the means disclosed so that the desired result inevitably follows whenever

it is worked, and whether the subject matter has utility in the field of practical application (as that in relation to trade, commerce or industry) which is beneficial to the public.

Of interest in the interpretation of Section 2 of the Patent Act is the Supreme Court decision in Tennessee Eastman v. Commissioner of Patents dated December 19, 1972 (unreported) which concerned claims directed to a method of surgical bonding of body tissues of human beings; and in which the court held that the process then under consideration of applying a medicine to a human being, "... is clearly in the field of practical application," as opposed to a mere scientific principle or abstract theorem excluded by Section 28(3) of the Patent Act.

As previously noted the examiner raised the objection that: "Claims 7 and 8 are directed to a diagnostic method for use on a living body...." However, it appears that the process refers to "measurements" and any diagnosis of the results does not form part of the process. Accordingly, achieving the desired result of the process does not depend on professional skills.

In the S.C.C.'s decision Tennessee Eastman v. Commissioner, supra. it was held that patents for medical treatment per se must be excluded under the Patent Act in that the use of a medical substance cannot be claimed by a process apart from the process of producing it, otherwise there would be an easy way out of the restriction as to the patentability of substances under Section 41(1) of the Patent Act. However, the present claims do not fall within this prohibition, and distinguish factually from the claims then under consideration in that no step of using a medical substance is set out in the claims.

The examiner also raised the objection that the method was related to a non-industrial product. It is settled law, however, that the

end result of a test process is not necessarily a physical product and may be tangible information only. It is also settled law that if the invention is the means and not the end, the inventor is entitled to a patent on the means, vide, J. Wyburn Lawson v. The Commissioner of Patents (1970) 62 CPR 101 at 110.

Of interest with respect to a non-industrial product is the reference of the S.C.C. in Tennessee Eastman v. Commissioner, supra, Re Schering A.G.'s Application (1971) RPC 337, a case dealing with a method of contraception, citing the conclusion of the Patent Appeal Tribunal at page 345 as follows:

> Although, however, on a full consideration of the matter it seems that patents for medical treatment in the strict sense must be excluded under the present Act, the claims the subject of the application do not appear to fall within this prohibition and, on the law as it stands today, they should at least at this stage in our judgement, be allowed to proceed.... (Emphasis added by the Court)

The Board is therefore satisfied; (a) that the subject matter lies in the field of a "useful art" and that the claims do not relate to medical treatment in the strict sense or in the use of a medical substance, (b) that since no professional judgement or manual expertise is involved in working the process, the subject matter is controllable and reproducible by the means disclosed so that the desired result inevitably follows whenever it is worked, and (c) that the subject matter has utility in the field of practical application which can be beneficial to the public.

Notwithstanding the above, the Board notes that the examiner made no determination of the subject matter of claims 7 and 8 in view of prior art. It appears that consideration should also be given the specification with respect to Section 36 and Section 38(2) of the Patent Act.

In the circumstances, therefore, the Board is satisfied that the Commissioner ought not to refuse claims 7 and 8 on the grounds that the subject matter falls outside the statutory requirements of Section 2 of the Patent Act and recommends that the Final Action refusing claims 7 and 8 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 in Hull, Quebec,
this 28th day of August, 1973.

Agent for Applicant

Gowling, MacTavish, Osborne & Henderson,
Ottawa.