

COMMISSIONER'S DECISION

DIVISIONAL STATUS: Failure to Comply with Sections 38(2)
and 36(1)

There could be no second invention on which to base the divisional distinct from the process described and claimed in the original specification patented; the divisional claims defining the apparatus generally described and schematically illustrated comprising known means to carry out the respective steps of the patented process; asserted by the applicant to be sufficient enabling a person skilled in the art to use the invention of the process. Claims in a second patent for such apparatus, unavoidably infringed by using the process already patented, would extend the monopoly already granted.

FINAL ACTION: Affirmed.

This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated February 22, 1972 on application 055,271. This application was filed on June 24, 1969 in the name of Neophytos Ganiaris and refers to "Concentration of Tea". The Patent Appeal Board conducted a Hearing on June 20, 1973, Mr. H. O'Gorman represented the applicant.

In the prosecution terminated by the Final Action the examiner refused the application on the grounds, (a) that the divisional application is not proper under Section 38(2) of the Patent Act, and (b) that the application is rejected in failing to meet the requirements of Section 36(1).

In this action the examiner stated in part:

On June 23, 1969 apparatus claims were added to 994,721 to serve as a basis for this divisional application which was filed on June 24, 1969. The apparatus claims inserted in parent application 994,721 for divisional purposes were cancelled voluntarily on June 27, 1969, before any action could be taken by the examiner to determine whether or not such claims were adequately supported by the original disclosure in that Section 38(2) specifies that the parent application must also describe as well as claim any invention which is made the subject of a divisional application.

...

It is well established by case law that the disclosure must describe the invention and its operation correctly and fully; so that when the patent expires those skilled in the art will be able, having only the specification, to make use of the invention. Applying this to the parent application which issued to patent on July 7, 1970 and in consideration of applicant's statement as mentioned above, any one skilled

in the art could assemble the system as claimed. Therefore, it is held that the process claims and the process dependent product claims in the patent already granted, represents the full extent of the protection to which applicant is entitled. To allow the system claims of the present application would do nothing more than extend monopoly for the invention already patented and would have the effect of restraining its free use to the public for an extended period should a patent be allowed to issue from this application. Shortly stated, applicant is entitled to only one patent for one invention.

The application is also rejected in failing to meet the requirements of Section 36(1). Section 36(1) reads in part "...The applicant shall... fully describe...shall particularly indicate and distinctly claim the part, improvement or combination which he claims as his invention". (underlining added). There was no indication whatsoever of the system of apparatus as claimed forming any part of the invention, or a second invention, in the original application and reference to this is set out in the second paragraph of the previous Action.

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

The Examiner rejects the application as failing to meet the requirements of Section 36(1), in the following language (see final action, page 2, paragraph 3):-

"Section 36(1) reads in part "...The applicant shall... fully describe...shall particularly indicate and distinctly claim the part, improvement or combination which he claims as his invention". (underlining added). There was no indication whatsoever of the system of apparatus as claimed forming any part of the invention, or a second invention, in the original application and reference to this is set out in the second paragraph of the previous Action."

In commenting on the above quoted language, it must first be observed that the subject application and it's parent application No. 994,721, although related through the divisional status of the present application, must in other respects be treated as distinct applications. In a situation where the disclosure of a parent application does not describe the invention claimed in the divisional application, the latter application is objectionable. However the objection does not arise under Section 36(1), but may appear as an objection to the divisional status of the divisional application under Section 38(2), or otherwise.

...

In paragraphs 3 and 4 of the office action of June 9th, 1971, reference is made to the relationship between the subject application and it's parent application No. 994,721. Mention is made of the requirements of Section 38(2) of the Patent Act, but that office action raises no specific objection under Section 38(2) of the Patent Act.

Notwithstanding the lack of a formal rejection under Section 38(2) of the Patent Act, the applicant asserts that the subject application is in full compliance with that Section. Section 38(2) of the Patent Act provides that the applicant may file a divisional application "where an application describes and claims more than one invention". Thus to comply with Section 38(2) the Parent Application is merely required to describe and claim the invention which is to be claimed in the divisional application. That Parent Application 994,721 claimed the invention set forth in the claims of the subject application is not in question. That the Parent Application describes the invention claimed in the divisional application will be evident from a comparison of the claims of the subject application with the disclosure of Parent Application 994,721. Such a comparison reveals that each and every integer of the claims of the subject application appears in the disclosure of the originally filed application.

It should be noted that the language used in Section 38(2) of the Patent Act is "describes and claims": the word "describes" is in no way qualified, and it is respectfully submitted that there is not the slightest basis in the wording of the Statute to support the assertion, which is apparently made by the Examiner in the final action, that the Parent Application should particularly indicate the divisionally claimed subject matter as an invention. It may be conceded that Parent Application 994,721 as originally filed was generally concerned mainly with a process and that the objects of the invention as set forth in that application related to a process only. However these circumstances most certainly do not preclude the applicant from gaining allowance of claims directed to an apparatus. In setting forth in the original disclosure of application 994,721 the means of putting into effect the claimed process, the applicant described a system of apparatus for carrying out the process. The system of apparatus therein described lends full support to the claims of the subject divisional application, and accordingly since the requirements of Section 38(2) are fully met, the divisional status of the subject application is entirely proper.

...

... Upon the expiry of the patent which has been granted on the parent application 994,721, the public at large will be at liberty to practice the process claimed in that patent. However in practicing that process, the public will not be at liberty to infringe with impunity the claims of any other Canadian patent, including any patent which may issue on the subject application. This does not mean that the public will be unable to practice the process claimed in the expired patent, but on the contrary only means that the public will be prevented from practicing that process utilizing the specific system of apparatus claimed in the subject application, should the subject application issue to patent. Accordingly therefore, no question of double patenting arises.

This application relates to an apparatus for freeze concentrating an aqueous tea solution. Claim 1 reads:

Apparatus for freeze concentrating an aqueous tea solution comprising

(a) a cooler adapted to cool said solution to form a precipitate therein;

(b) means for extracting precipitate from said solution and delivering said precipitate to a first tank;

(c) means for delivering a supply of water to said first tank and mixing means for mixing said precipitate in said water;

(d) means for delivering solution cleared of precipitate from said extracting means to a crystallizer, means in said crystallizer for cooling said cleared solution to form a mixture of ice and more concentrated solution;

(e) means for delivering said mixture to an ice-removal means operative to separate ice from said more concentrated solution;

(f) means for delivering more concentrated solution to a second tank, means for delivering water containing precipitate from said first tank to said second tank, mixing means in said second tank for mixing the contents thereof to form a concentrated tea solution having dissolved therein precipitate removed in said extracting means.

Also of interest is claim 1 of the parent application (now patent 846,128 dated July 7, 1970) which reads:

In the process of concentrating liquid tea solution, the steps of

(a) cooling a tea solution below 75°F to form a precipitate in the liquid tea solution;

(b) separating the precipitate from the liquid tea solution;

(c) further cooling the tea solution to form a more concentrated liquid tea solution having ice therein;

(d) separating the ice from the concentrated liquid tea solution; and thereafter

(e) combining the separated precipitate of step (b) with the concentrated liquid tea solution.

As previously noted the examiner refused the application on the grounds that Section 38(2) and Section 36(1) of the Patent Act have not been satisfied.

Section 38(2) reads in part: "When an application describes and claims more than one invention the applicant may ... limit his claims to one invention...." The original application (now patent 846,128 dated July 7, 1970) dealt only with a description of the process, and page 1 of that disclosure reads in part: "Thus, this invention provides a process for the freeze concentration of tea solution in which there is no loss of flavor in the concentrated tea solution," and "The figure is a schematic representation of apparatus which may be used to practice this invention." (underlining added) The original claims were directed to a process only and it would appear from the specification of the original application that the applicant did not envisage "the apparatus" as being a second invention or even as an aspect of the invention for which the original application was made.

The applicant has emphasized, especially at the Hearing, that the general description of the elements of the claimed system of apparatus are well known in the art, and would at the time of filing have been fully sufficient to enable any person skilled in the art to use the invention. Surely this holding by the applicant coupled with the statement in the original application regarding the "schematic representation of apparatus" indicates that the skilled person in the art, could set up the apparatus to carry out the process from the teachings of the original application as filed, and there appears to be no second invention on which to base claims which can be the subject matter of a divisional application as approved by Section 38(2) of the Patent Act.

With respect to the second ground of objection under Section 36(1), this section reads in part: "The applicant shall ... fully describe... shall particularly indicate and distinctly claim the part, improvement or combination which he claims as his invention."(Underlining added).


On this point the applicant argued that: "In a situation where the disclosure of a parent application does not describe the invention

claimed in the divisional, the latter application is objectionable. However, the objection does not arise under Section 36(1)...." While Section 38 of the Patent Act reads: "When an application describes and claims more than one invention...", it is well settled that no "newly discovered matter" may be added to any application, and in line with this any invention appearing in a divisional application must be fully described in the original application as filed. That is, the two Sections cannot be treated in isolation when considering parent and divisional applications.


Of interest is the decision of the Court in, Riddell v Patrick Harrison and Company Ltd. (1956-60) Ex.C.R. 213 at which held that: "...it is a basic rule of Patent law that an invention cannot be validly claimed unless it has been described in the specification in the manner required by law. The legal requirement has been made statutory by Section 36(1) of the Patent Act...." The circumstances in this application is analogous to the case referred to above, except in that case the apparatus was properly described as an invention, but not the process and the process claim was held invalid. The Board therefore finds that there was no indication whatsoever of the "apparatus" as now claimed forming any part of the invention, or a second invention, in the original application.

The applicant has also advanced the argument that upon the expiry of the process patent, the public will only be prevented from the carrying out of the process utilizing the "specific" apparatus claimed herein. It is not seen, however, how or where the system can in any way be accurately termed "specific" since the applicant has broadly claimed all means for carrying out the steps in the process, and as such anyone practicing the process claimed in the parent application would, it is held, clearly infringe the apparatus claimed herein. To allow claims to the apparatus which is only the inherent use of known apparatus to carry out the process would do nothing more than extend the monopoly for the invention already patented under the process in Canadian patent 846,128 dated July 7, 1970.

The Board is therefore satisfied that, under the circumstances, the applicant is not entitled to claims to the apparatus under Section 36(1) and Section 38(2) of the Patent Act, for it is clear that the description with respect to any apparatus is so brief and in such broad terms as to merely describe and support claims to a process.


J.F. Hughes
Assistant Chairman,
Patent Appeal Board.

I concur with the findings of the Patent Appeal Board and refuse to grant a patent on the subject matter of this application. The applicant has six months in which to appeal this decision in accordance with Section 44 of the Patent Act.
Decision accordingly,


A.M. Laidlaw,
Commissioner of Patents

Dated and signed this
6th day of September, 1973.

Agent for Applicant

Smart & Biggar,
Ottawa.