

COMMISSIONER'S DECISION

CLAIM REDUNDANCY-RULE 43: Product Uses of New Composition.

Claims for a new process and for the compositions produced by the process allowed. Claims for the articles composed of the new composition having alleged advantages over such articles previously made of known materials, refused on the grounds inter alia of redundancy (R. 43), ambiguity (S. 36), division (S. 38), and for being "exhausted" combinations; traversing applicants argument that such claims are necessary for adequate protection under R. 43, unvitiated by invalidation of the composition claims pursuant to proceedings permitted by S. 46, should the 'prima facie' novelty of the composition but not its presently disclosed utility be found to lack novelty.

FINAL ACTION: Affirmed.

This decision deals with a request for review by the Commissioner of Patents of an Examiner's Final Action on application 131,656 (Class 402-318). The application was filed on January 4, 1972 for Thomas H. Shepherd and Francis E. Gould and assigned to the National Patent Development Corporation of Delaware. The invention is for "Hydrophilic Polymers, Articles and Methods of Making Same." At a Hearing held by the Patent Appeal Board to consider the rejection Mr. Ian Brameld represented the applicant.

The application relates to new hydrophilic polymers and processes for making them. The polymer is useful as a carrier for medically-active substances and for natural or synthetic flavours. No objection was taken to the first 12 claims, in which the new polymers and processes were claimed. The subsequent claims 13 to 31, however, were directed to various applications to which the new polymers may be put, such as surgical sutures, lenses, windshield coatings, denture linings, flavouring compositions and pharmaceutical agents, and were rejected. In his response to the final action the applicant proposes to reduce the number of claims from 31 to 23 by eliminating claims to some forms. It is with such amendments in mind that the Board makes its recommendations.

The Board also has before it a companion application 131655, assigned to the same applicant, which was considered at the same hearing. It will be the subject of a separate recommendation, although it raises essentially the same issues. In it the applicant has included claims directed to such additional forms as intra-uterine devices, blood vessel substitutes, heart valves, diaphragms, flavourings, medicinal compositions, filters, lenses, boat hulls, and mouth guards. Whatever conclusions are reached in one of these applications must have a reciprocal effect upon the other, and should be made with that consideration in mind.

In the prosecution terminated by the Final Action the examiner refused claims 13 to 31 (cf proposed claims 13 to 21 and 23) as being unnecessary for the protection of the composition, and redundant under Section 43 of the Patent Rules.

The examiner gave the following reasons for rejection (as extracted from the Final Action):

The rejection of claims 13-31 is maintained and the reason for such rejection is that these claims are unnecessary for the protection of the composition in view of claims 1-12. Claims 13-31 are therefore redundant under Rule 43 of the Patent Rules.

In paragraph 2 of (his response) applicant sought to draw a distinction between claims 1-12, directed to compositions, and claims 13-31, directed to commercial uses of these compositions. No such distinction can be drawn within the terms of the Patent Act. Indeed it is a requirement for every claim that what is being claimed has utility in trade and commerce. The allowance of claims 1-12 will be predicated on, among other considerations, utility. The importance of that utility is a question of circumstance and does not affect the patentability of these claims once utility is established. The claims to the compositions (claims 1-12) secure protection for use of the compositions. Therefore it is not necessary under the Patent Act to seek to gain further protection by more claims for "important commercial uses."

With respect to the third paragraph of applicant's response there is, a priori, a presumption of validity on issuance of a patent. Proceedings after issue cannot be anticipated by this office in advance of allowance of an application.

Therefore the argument presented by applicant that claims 13-31 should be allowed on the ground that claims 1-12 may in the future be found to be invalid is not considered sufficient reason for allowing claims 13-31.

The applicant in his response dated September 19, 1973 stated

(in part):

It is applicants' position that all of the claims presented do possess the necessary utility to qualify for patentability, and applicants' argument is not primarily based on the possibility that claims to the compositions, as opposed to the claims directed to certain commercial uses of such compositions (i.e. claims directed to compositions in certain commercially attractive forms) might not be held to possess sufficient utility to qualify for protection under the provisions of Section 2 of the Patent Act. There seems however to be some sort of assumption on the part of the Examiner that the claims to the "commercial uses" extend the scope of the monopoly, because in the last sentence of paragraph 3 of the action the Examiner refers to the applicant seeking "to gain further protection by more claims for 'important commercial uses' ". In order to dispose of this possibly preliminary point, applicants wish merely to point out that the claims to "important commercial uses" are in every case dependent upon preceding claims and therefore directly or indirectly from the composition claims which the Examiner considers allowable.

...

Regardless of the significance of this presumption of validity, it has, for at least the major part of this century, been the practice for patent draftsmen to include a number of claims of decreasing scope in patent applications and it may also be pointed out that it has been the practice of the Patent Office to allow such claims. If any great reliance could be placed on a presumption of validity, it would presumably apply just as much to the broad claims as to the narrow, and an applicant who has a valid broad claim hardly needs the protection of a narrower dependent claim. Thus the Examiner's argument would lead to the conclusion that the most one would need in an application such as the present one is a single broad composition claim and a single broad process or method claim. Both the drafting and issue of patents with such limited claims are the exception rather than the rule, not only in this country but also in other countries having comparable patent legislation and a comparable system of jurisprudence. Thus a series of graduated claims of reducing scope is the normal practice not only in this country but also in the United States and Great Britain. The reasons for putting in such a graduated series of claims are clear: an applicant fears that for one reason or another his broader claims may at a later date be found to be invalid and he

argues that the chances of a narrower claim directed to preferred embodiments of his invention being held invalid are generally a good deal less than the chances of the broader claims being held invalid. An applicant does not ask that the Patent Office consider all these matters in detail but only to accept the fact that, unfortunately for the patentee, patents do sometimes become involved in litigation and claims in such circumstances often are held invalid.

...

Apart from this however, it is easy to conceive of situations in which a composition of matter has previously become known for a totally different purpose, in which circumstances a later claim to a particular use such as a particular device made from the polymer, might well be not only novel but also unobvious. Applicants feel entitled to insert a reasonable number of claims to protect themselves against such a contingency, and believe that it was not the intention of Rule 43 to deny an applicant a reasonable number of claims which differ in scope from each other and which might be necessary for the adequate protection of the invention. Rather applicants believe that Rule 43 is intended to prevent an applicant putting forward claims which, while differing slightly in wording, are nevertheless of essentially the same scope, a practice which was at one time not uncommon in specifications originating from the United States. It is believed that the claims retained in the present application are all of differing scope and should not properly be rejected on the provisions of Rule 43.

This rejection raises the important issue of how far an applicant may go in claiming to protect his invention. Specifically we are concerned here with whether an applicant having invented a new process to prepare a new composition of matter, and having claimed that process and composition, may also advance claims which bring in various devices in which the invention may be utilized. Mr. Brameld has urged that the applicant is entitled to a number of claims of decreasing scope. With this there is no disagreement. The examiner, for example, has made no objection to 12 claims in which the process and polymer are defined in varying scope. It was also urged that the applicant is entitled to a "reasonable number" of claims to protect himself against the contingency that the composition of matter claims are subsequently found to be known for a different purpose, "in which circumstance a later claim to a particular device

made from the polymer, might well be not only novel but also unobvious." In his view Rule 43 was not intended to prevent such claims, but only claims which while differing slightly in wording are nevertheless of essentially the same scope.

The examiner's rejection is based principally upon Section 43 of the Patent Rules, which 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 to cancel the others.

Undue multiplicity of claims in an application was discussed by the Exchequer Court in Schweyer Electric & Mfg. Co. v New York Central Railroad Co. (1934) Ex. C.R. At page 35 Maclean J. stated:

I can hardly refrain also from commenting upon the practice which has unfortunately grown up in Canada of inserting in the patent specification an unnecessary number of claims, and this is exemplified in the fact that the claims in patent in suit number one hundred and twenty-one, which I am quite satisfied was altogether unnecessary in order to state what it was Schweyer claimed to have invented, and to state the claims in such numbers was not, in my opinion, to state them distinctly as required by the Patent Act. But I have not Schweyer particularly in mind. The practice of multiplying claims unnecessarily is becoming too common in this jurisdiction and some way should be found of preventing this. If one has really invented something, he should know what it is, and it should not take many words to state in clear language what it is he claims to have invented. Terrell in his excellent work on Patents, discussing this very matter, remarks:

It must be remembered that the object of the claim is to give a perfectly clear statement of the invention claimed. Of late years a superstition has arisen that a patent is more valid and has a greater hold over infringement if every possible permutation and combination of the elements entering into the invention is separately claimed...such prolixity does not help a Court which, whether in considering subject-matter, novelty or infringement, invariably seeks to obtain an answer to the broad question, "What has this man invented?"

That, I think, would be a perfectly fair and just comment to make in respect of the claims in many patents issued in Canada, and it is quite correct to say that it is a pure

superstition to think that a patent is more valid because every possible permutation and combination of the elements entering into the invention is separately claimed. In England, this point came before both law officers of the Crown on the interpretation of rule 4 of the English Patent Rules, 1905 (rule 14, 1920), in the case of J.S. Bancroft's Application (1905) 23 R.P.C., p. 89. The English Patent Rule requires that the claims be stated in clear and distinct terms. The Attorney General pointed out that certain kinds of inventions might be such as to justify a large number of claims. He stated:

So long as the statement of each claim is in itself clear and succinct, and so long as there is an absence of repetition in the separate claims, we do not think that there is necessarily any infringement of this rule...But in the present case we think that the decision of the Chief Examiner was right ... An attempt is made to deal with every possible contingency

...

On page 36 Maclean J. continued:

... If the provisions of the Patent Act are not in terms sufficiently clear to enable the Patent Office to prevent a useless and confusing multiplicity of claims, I would very respectfully suggest to the Commissioner of Patents that he urge that the Patent Act be so amended as to bestow ample power upon the Patent Office to curtail the abuse to which I refer...

In our view it was in response to such concerns and to prevent such abuses that Section 43 of the Patent Rules came into existence.

More recently Jacket, P. has addressed himself to multiple claiming in Hercules Inc. v Diamond Shamrock (1970) Ex. C.R. 574. We quote from page 596:

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. This is the point at which he must put forward the legal definition of the monopoly that he is seeking. 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.

In Ridell v Patrick Harrison & Co. Ltd. 1956-60 Ex. C.R. 213

at 253 the former president of the Exchequer Court stated:

Having made the invention he (the inventor) was entitled to define it in the claims in such a way as to protect himself in enjoyment of the monopoly of his invention. He was in a sense, the master of his claims, within the breadth of his invention, and entitled to draft them "in words wide enough to secure the protection desired...."

However there are other decisions which suggest there are also limitations upon how far an applicant may go in claiming. While the circumstances in which those limitations were applied do not necessarily correspond to those before us here, such decisions do indicate what principles should be followed.

In Rohm and Haas v. Commissioner of Patents, 1959 Ex. C.R. 153, for example, Mr. Justice Cameron considered Rule 43 (at that time Rule 53).

In refusing certain process claims the court observed at p. 172:

In my opinion, also, there is no necessity under our Act for granting a patent for claims such as claims 10 to 13. A patentee is entitled to every use of which his invention is susceptible. To the extent that the assignor of the applicant has invented the compounds for which the patents have been issued, the applicant has full protection for such patents.

In Gilbert v Sandoz 64 CPR (1971) 14 at 35, Mr. Justice Thurlow found certain claims (10 & 11) for pharmaceutical composition invalid "since no invention of pharmaceutical compositions was made, as distinct from the invention of thioridazine itself which is fully claimed in claims 1 to 9." In elaboration he held claims 10 & 11 invalid because "claims 1 to 9 represent the full extent of the protection to which the defendant is entitled in respect of that invention and because in the context of all the claims they (10 & 11) tend to go further than the protection to which the defendant is entitled, as defined in Section 46 of the Patent Act, in respect of the invention of thioridazine and to monopolize, independently of the other claims, compositions containing thioridazine, and thus to restrict the use of thioridazine i

particular way even by one into whose possession it may lawfully come whether by express or implied license." The Supreme Court (8 C.P.R. (2d) 1973, 210 at 212) did not disturb that finding.

In Hoffmann - La Roche v Commissioner of Patents 1954 Ex. C.R. 52 the applicant wished to claim certain known aldehydes restricted to a new process for their manufacture. The Court, in considering a submission that "an invention may be claimed under different aspects" concluded (at p.58):

....a dependent product claim is not necessary to protect the applicant's invention for he is entitled to the same protection for his process without a process-dependent product claim as he would get with one. He is entitled only to protection for his process for that is all he invented. Consequently the applicant falls within the ambit of Rule 53 (now 43) of the Patent Rules [the rule was then quoted] . In my opinion, the Commissioner might well have justified his decision under the first part of this Rule....

On appeal the Supreme Court agreed with the judgement of the President of the Exchequer Court (1955 S.C.R. 414).

Reference may also be made to the findings of the Supreme Court in Commissioner of Patents v. Farbwerke Hoechst, 1964 S.C.R. 49. In that case the applicant had been granted a patent in a divisional application to a process and product, and sought a further patent to the product diluted with a carrier. After holding this to be impermissible because the applicant was in this fashion attempting to obtain two patents for exactly the same invention, the court added (at p.53):

Further, the respondent has already received patent protection to the full extent allowed by law. Invention may be in a new, useful and inventive process for producing a new medicinal substance, and the respondent has already obtained patents for such inventive processes and for the new product as produced by such processes. The process claims and process dependent product claims in those patents represent the full extent of the protection to which the respondent is entitled. (emphasis added)

See also Sirdar Rubber v Wallington, XXII KFC (1905), 257 at 266, where we find:

Where the only invention is in the form of one part of an article or machine, which part is separately claimed as an invention, the scope of the Patent cannot be enlarged by claiming that part in every combination in which it can be used, however obvious.

It may also be asked whether the rejected claims relate to what is generally known as an "exhausted combination", and as such should be considered as failing to define the invention as required by Section 36(2). In Baldwin International Radio Co. of Canada v Western Electric Co. Incorporated (1934) SCR 94 at 104, Rinfret J. relied on the following quotations from earlier British decisions:

The combination is the novelty, and to sufficiently describe the combination is sufficient to describe the novelty; but if the combination is not new, which is the case first put by Lord Selborne in Moore v. Bennett (1884) 1 R.P.C. 120, so that there cannot be a valid patent for a combination, then even though the patentee misdescribes it as a new combination which by hypothesis it is not, the novelty must be in the subordinate integer. Foxwell v. Bostock (1864) 4 DeG. J & S 208 then applies. To describe it as a new combination is, in such a case, to misdescribe it. The invention in such a case is the improvement upon a particular part of an old combination, and the part must be identified by the patentee.

and

...If, indeed, it were left open on the specification to the patentee to claim, not merely the combination of all the parts as a whole, but also certain subordinate or subsidiary parts of the combination, on the ground that such subordinate and subsidiary parts are new and material, as it was held a patentee might do in Lister v. Leather (1858) 8 El. & Bl. 1004, then it might be unnecessary to see that the patentee had carefully distinguished those subordinate or subsidiary parts, and had not left it in dubio what claim to parts, in addition to the claim for combination, he meant to assert.

With respect to the invention now before us, it is well known to use polymers and resins for denture linings, as lenses, to coat boat hulls, as filters, for medicinal devices, and the like. The examiner has not cited instances of such uses, but it is referred to, in part, on page 1 of the disclosure, where the prior art is discussed.

From the jurisprudence referred to above, from Rule 43, and from Section 36(2), which is the legislative progenitor of the Rule, it is apparent that an applicant is entitled to a reasonable number of claims of decreasing scope to define his invention. It is equally clear he

should not go beyond the invention, nor phrase the claims so as to obscure the invention or introduce ambiguity in identifying the invention. He may not extend the scope of his patent beyond his actual invention. He may not multiply his claims by presenting alleged combinations which distinguish from the real invention only by including elements which are old in the art, and perform no new function. He may not include in the claims unnecessary old elements which might mislead the public as to the true scope of the invention. His claims must particularly point out and distinctly claim the invention.

While we do not consider that the number of claims in this case is ipso facto excessive, we do believe that the claims which were refused fail for the other reasons to which we have referred. In our view claims 1-12 represent the type of variable claiming which the courts have considered legitimate.

The applicant has urged us to permit claims to secondary subject matters on the postulation that what is covered by his main claims may not be inventive, in which event the secondary subject matters could be considered as separate inventions from the primary subject matter, and afford him protection for such different inventions. If there is any validity in such an assumption, there is separate invention between the two groups of subject matter irrespective of whether the primary matter is valid or not, and the secondary matter should be in independent applications to satisfy Section 38. It is incumbent upon the applicant to determine what is the invention he wishes to claim in this application, and to restrict his claims to it. The logic of this view is corroborated by a recent decision of the West German Supreme Court in Ex parte Farbenfabriken Bayer, June 27, 1972, as reported in the International Review of Industrial Property and Copyright Law, vol. 4

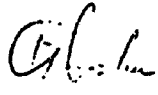
at p. 419. It concluded that where an applicant claimed a new dye, the process of making it, and the process of using it further claims to dyed paper, printing pastes, inked pads, felt crayons, shoe polish, and ball point pens containing the dye contravened the principle of unity of invention.

We also consider that claims such as proposed claims 13, 14, 16, 18 and others introduce needless ambiguity into what is being claimed. Claim 13 for example reads:

13. A hydrophilic polymer powder as claimed in claim 12 wherein the polymer includes a medicinally active substance as a component thereof, coated on a surgical suture.

The reader is left in some uncertainty as to whether the claim is for a suture or for a hydrophilic powder. If only the powder is covered by the claim it is redundant in view of claim 12 upon which it depends; it merely indicates the environment in which the polymer of claim 12 is used. Such claims do not distinctly specify the protection desired. We feel they are open to the criticism voiced in Natural Colour Kinematograph v Bioschemes 32 R.P.C. 256 at 266 against claims being drafted so as to be very wide upon one interpretation so as to catch infringers within their net, but open to narrower interpretations so as to limit them to safe dimensions if attacked in court.

For the reasons indicated we recommend that the rejection of claims 13 to 31 (or 13 to 23 of the proposed claim) be confirmed.



Gordon A. Asher,
Chairman,
Patent Appeal Board.

I concur with the findings of the Patent Appeal Board and refuse claims 13 to 31, and proposed claims 13 to 23. The applicant has six months within which to appeal this decision under the provisions of Section 44 of the Patent Act.

Decision accordingly,

A handwritten signature in cursive script, appearing to read "A.M. Laidlaw", written in black ink. The signature is positioned above a horizontal line that serves as a separator between the signature and the printed name below.

A.M. Laidlaw,
Commissioner of Patents.

Dated at Hull, Quebec
this 27th day of
January, 1975.

Agent for Applicant

Smart & Biggar,
Ottawa, Ontario.