

COMMISSIONER'S DECISION

Rule 44(3): Bone fide response - Electrical Harness

The issue was whether the applicant had made a bone fide response to an examiner's action.

The manner in which the applicant conducted some areas of the prosecution is not beyond reproach. On the other hand there were also some ambiguities in the earlier prosecution by the Office, sufficient that honest misunderstandings may have occurred. The response was accepted.

Rejection: Reversed

The Patent Review Board has considered your letter dated September 15, 1975 in which you argue against the holding that there has not been a bona fide response within the meaning of Section 44(3) of the Patent Rules.

The application 100,575 (class 339-28) was filed on December 14, 1970, in the name of L.S. Finkelstein, and is entitled "Electrical Harness with Moulded Sockets." The application was involved in conflict proceedings with another applicant, during which conflict claims C1 to C19 were lost to this applicant. Following the conflict proceedings the applicant cancelled all the claims on file on March 6, 1975. He then submitted new claims 1 to 3. On April 2, 1975, the examiner refused these claims as lacking patentable subject matter. On June 26, 1975 the applicant indicated he wished to cancel the new claims 1 to 3, and substitute fresh claims 1 to 10 (which have not been entered).

The examiner was of the opinion that the latest response was improper, and that the submission of claims 1-10 was not a bona fide attempt to comply with the requirements of Section 44(3) of the Patent Rules. His reasons were that claims 1 to 10 are for subject matter that is either already covered by the applicants' issued patent, or was subject matter which was lost to him during conflict proceedings. The Patent Appeal Board gave the applicant until September 8, 1975 to present written arguments against the examiner's opinion or to request a hearing to persuade the Board that it should not conclude that the application is abandoned.

The applicant submitted his arguments to the Board in writing in the above-mentioned letter of September 5, 1975. We will now review these arguments in order to determine whether or not the applicant contravened Section 44(3) of the Patent Rules.

The applicant argues that "claims 1 to 10 which were submitted with applicant's amendment of June 26, 1975 correspond to claims 12 to 21 as originally on file in this application." Claims 1 to 6 are method claims, while claims 7 to 10 are directed to apparatus. The apparatus claims were cancelled following an earlier request for division. They are resubmitted in this application at this time now that claims C1 to C19 have been deleted.

We observe that method claims 1, 2, 3, 5 and 6 submitted with the letter of amendment of June 26, 1975, are identical with claims 12, 13, 14, 16, and 17 which were cancelled by the applicant by his letter of March 6, 1975 in response to the Office Action of September 10, 1974, which action followed the conflict proceedings.

In that action, September 10, 1974, it was stated that:

Claim 10 is rejected as not patentable in view of the lost conflict matter.

Claims 2, 4, 6, 12, 13, 14, 16 and 17 are identical with claims 4, 6, 1, 7, 8, 9, 10 and 11 respectively, allowed in the Divisional Application Number 164,182 now Canadian Patent 945,648 issued on April 16, 1974. The Applicant is required to remove the overlap.

We find, however, that claims 12, 13, 14, 16 and 17, which are proposed new claims 1 to 3, 5 and 6, are not identical with claims 7, 8, 9, 10 and 11 of the Canadian patent 945,648. The proposed claims are broader in scope in that they do not recite: "... positioning at least one pin in a position where it will form a ventilating hold through a base of said socket."

Furthermore in the conflict report dated August 9, 1971, claim 10 was indicated to be non-patentably different from the conflict subject matter, whereas claims 12, 13, 14, 16 and 17 (proposed claims 1 to 3, 5 and 6) were not so designated.

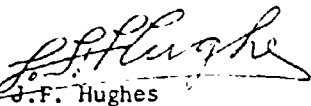
While it is true that the applicant cancelled proposed claims 1 to 6 without argument in his action of June 26, 1975, it is quite possible that he was misled, as noted above, by the Office in the action of September 10, 1974. On the other hand, apparatus claims 7 to 10 have not been considered by the examiner for patentable subject matter.

In summary, the proposed method claims 1 to 3, 5 and 6 were, in effect, designated as patentably different claims from the subject matter of the conflict claims; they are not, as stated by the examiner, identical with the claims in applicant's patent 945648. Furthermore apparatus claims 7 to 10, which were cancelled on a requirement for division, have not been examined for patentable subject matter.

In our view the manner in which the applicant conducted some areas of the prosecution is not beyond reproach. On the other hand there were also some ambiguities in the earlier prosecution, sufficient, we think, that honest misunderstandings may have occurred. In such circumstances we are satisfied that the application should not be held abandoned.

It should be noted that the Board is not assessing the patentability of the claims in question. That is a determination which still remains for the examiner.

The Board recommends that the proposed claims should be entered and examined.



J.F. Hughes
Assistant Chairman
Patent Appeal Board

I concur with the recommendation of the Patent Appeal Board and return the application to the examiner for resumption of prosecution.



J.A. Brown
Acting Commissioner of Patents

Dated at Hull, Quebec
this 7th. day of
November, 1975

Agent for Applicant