

COMMISSIONER'S DECISION

OBVIOUSNESS: Instrument for altering garment patterns

The application, which relates to a transparent template with calibrated scales thereon for use in making or altering patterns and wearing apparel, was refused for failing to define a patentable advance in the art over the references cited.

Final Action: Affirmed.

This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated April 15, 1975, on application 130,584 (Class 33-2). The application was filed on December 20, 1971, in the name of Leona R. Impastato, and is entitled "Instrument For Altering Garment Patterns."

The application relates to an instrument for use in making or altering patterns and wearing apparel. It comprises a transparent template with calibrated scales on the edges thereof. The configuration of the member resembles the letter "J" and is shown in the drawing on page 4.

In the Final Action the examiner refused the application for lack of patentable subject matter over the following patents:

Canadian:

120,681	Sept. 21, 1909	Valentine
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United States:

709,776	Sept. 23, 1902	Kelley
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A second rejection was also made on the grounds that the present device merely brings together a number of previously known instruments with a view to increasing convenience in making alterations by saving time and effort.

In that action the examiner stated (in part):

...

Applicant points out a further distinguishing feature of the present instrument as being the calibrated scale extending along edge 4 including a portion of the head. However, the Kelley patent clearly shows a scale beginning at the top

of the blade and extending along the edge A including a portion of head or arm portion B.

Additionally, applicant stresses the importance of parallel lines 7 and the manner in which they cooperate with straight-edge 2. It is agreed that the cited patents do not show this well-known drafting concept of providing parallel reference lines in reference to which straight parallel lines may be drawn. It must be pointed out that the parallel lines 7 cooperate with straight-edge 7 only and that if this were the point of invention of the present device it would not be necessary to claim anything more than the straight-edge and the parallel lines on a transparent backing. However, applicant has not presented in the disclosure any evidence that patent protection is being sought for the provision of parallel lines on a transparent backing in association with a straight-edge. While this feature, as well as the provision of hole 9, is not shown in the cited prior art, it is not in itself a patentable feature, and furthermore, it does not cooperate in an unexpected manner with other trivial features, such as hole 9 which again is not shown in the cited art, to produce any new and unexpected result. Also, the provision of a number of trivial features such as the parallel lines 7, and the hole 9, each of which is individually unpatentable because each fails to cooperate in an unexpected manner with associated elements, do not cumulatively produce a patentable result.

The previous rejections cited both the Kelley and Valentine patents. However, they were both cited for the same reasons and for this reason only one of them, the Kelley patent, has been mentioned in this Final Action.

It is noted that the Kelley patent fails to show certain features, in addition to those mentioned above with reference to applicant's arguments, which differ from the Kelley patent. These features relate to the disclosed fourth section of the instrument which extends back toward the straight-edge portion and a fifth section which is reversely curved and merges tangentially into the fourth and straight edge portions. While it is conceded that these portions are not specifically shown in any one prior art reference, it is held that these portions have no new and unexpected use, that they fail to cooperate with associated elements in any new and unexpected manner, and that their novelty (not patentability) results from mere design considerations. This view is supported by applicant's disclosure where no mention is made of the unexpected results obtained by the provision of said portions, or is there any specific mention of the use of their particular use among the illustrations of Figures 2 to 11. Figure 2 demonstrates the use of the straight-edge while Figures 3 to 11 illustrate the use of the curve portion 4a up to about the point shown at 4b in Figure 1. It is therefore held that those features which distinguish the present device from the patent to Kelley relate to matters of mere design which are not patentable.

In his response dated July 15, 1975 to the Final Action the applicant argues that:

1. the same references were cited during the prosecution of the United States application, but a patent issued;
2. the shape is different from any prior art device;

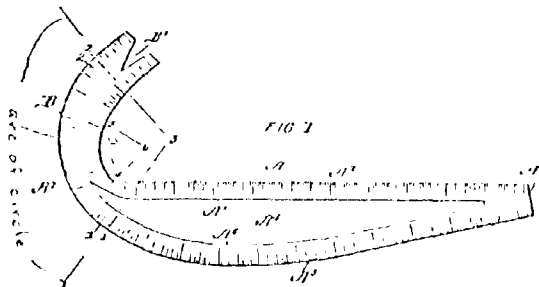
3. the prior art does not show a calibrated scale, nor lines parallel to the straight edge, nor a hole acting as a center of an accurate edge of the head portion;
4. the present device carries out more functions than the prior art devices of Valentine or Kelley; and
5. increased convenience and saving of time and effort result from use of the present device.

In that response the applicant also stated (in part):

...

There seems to be no dispute between the Examiner and the applicant as to the fact that applicant's device as claimed is different from the cited Kelley and Valentine devices but the Examiner considers such differences to be attributable to "mere differences in design" and therefore not patentable (page 2, lines 13-14 of Final Action) and that "their novelty (not patentability) results from mere design considerations" (page 3, lines 16-17 of Final Action) and again, that they "relate to matters of mere design which are not patentable" (page 3, line 26 of Final Action). From this it would appear that the Examiner feels that applicant should be seeking protection under the Industrial Design Act rather than the Patent Act; in other words, that there are mere differences in shape or ornamentation but not of function between applicant's device and the prior devices. This, however, completely contradicts the statement made by the Examiner at the top of page 2 of his Official Action of March 25, 1974, namely "it is agreed that the present instrument carries out more functions than (sic) can be carried out using either Valentine's pattern drafting device or the drafting rule shown in the patent to Kelley". The Examiner cannot have it both ways. Applicant's device is different from and can carry out more useful functions than the prior art, as admitted by the Examiner, and it clearly, therefore, lies in the field of patentable invention rather than registrable design. The additional functions arise from the features claimed by applicant and these cannot, therefore, be "mere differences in design".

The Kelley citation relates to a drafting instrument. The object is to provide "an instrument by means of which a multiplicity of different figures - plain, curvilinear and mixtilinear - can be quickly and easily constructed." Figure 1, shown below, is considered to be illustrative of the Kelley invention.

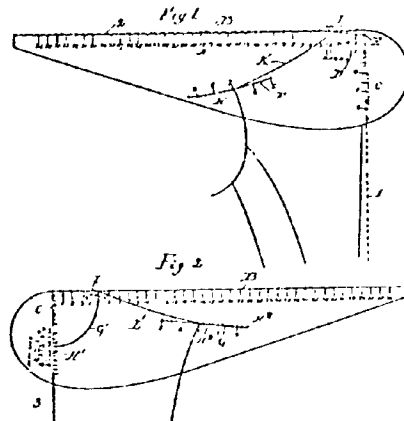


Claim 1 of the Kelley patent reads as follows:

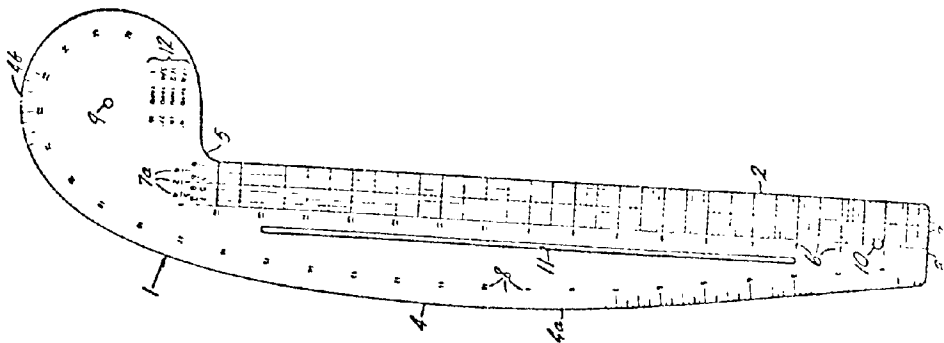
A device of the kind described, comprising a body portion and a curved arm, the end of said arm being bifurcated, one edge of the body portion being a straight edge, the other edge being a constantly-varying curve, one edge of the curved arm containing a long arc of a circle, the other edge of the curved portion containing a short arc of a circle, said short arc intersecting the straight edge of the body portion, substantially as described.

The Valentine citation relates to an instrument for drafting garment patterns.

This instrument is best depicted by Figures 1 and 2, shown below, of the patent.



This application relates to an instrument for use in making or altering wearing apparel. The instrument is made of transparent material and has a configuration which resembles the letter "J". Figure 1 of the application, shown below, is considered to be illustrative of the alleged invention.



Claim 1 of the application reads as follows:

An instrument for altering garment patterns and making garment changes comprising transparent sheet material having an elongate straight edge portion, a relatively short end edge portion at one end of said straight edge portion and perpendicular to said

straight edge portion, a curved edge portion comprising successively a first section starting at said end edge portion, diverging gradually from said straight edge portion for a portion of its length and then converging toward said straight portion, a second section of progressively increasing curvature, crossing to the opposite side of a projection of said straight edge portion, a third section disposed on said opposite side of said straight edge portion projection and substantially concentric to a center offset from said straight edge portion projection, means defining a small circular hole at approximately the center of curvature of said third section of said curved edge portion, a fourth section extending back toward said straight edge portion and a fifth section which is reversely curved and merges tangentially into said fourth section and said straight edge portion, said straight edge portion, end edge portion and said first section of said curved edge portion defining a blade portion of said instrument and said second, third, fourth and fifth sections defining a head portion at the opposite end of said straight edge portion from said short end edge portion, said blade portion lying at one side of said straight edge portion and said head portion extending to the opposite side of said straight edge portion, said first section of gradual curvature constituting a hip curve with a length corresponding approximately to the length of said straight edge portion and merging into said second section of greatly increased curvature constituting an armhole curve, means defining a calibrated scale extending along said curved edge portion throughout said first section and at least part of said second section beyond the point at which said curved edge portion crosses the projection of said straight edge portion, means defining a calibrated scale extending along said straight edge portion throughout substantially its whole length and means defining uniform spaced lines parallel to the edge of said straight edge portion, said lines extending from said short end edge portion substantially the whole length of said blade portion.

We observe that the claims are directed to the "structure or shape of the instrument," but not to the method of making it. The novelty and subject matter, if any, must therefore be associated with the idea itself of a one-piece instrument for altering garments. It is well established, of course, that invention may reside in a new idea, or in a new means for carrying an idea into effect, or in a combination of the two.

Some generalized ideas or desiderata are, nonetheless, inherently unpatentable. Examples of such ideas are automatic operation, convenient arrangement of one's work or an increase of efficiency. In our opinion, the suggestion of combining a number of things in one piece normally comes within the field of such unpatentable generalized ideas. In the well known "Sausage Machine" case (Williams v. Nyc, 7 R.P.C. 62), it was held that there is no invention in

doing in one machine what was previously done in two. Similarly in Carter v. Leyson, 19 R.P.C. 473 it was held that a socket with fangs made in one piece was not subject matter when it had been known to make them separately. In a more recent case, Casceloid Limited v. Milex Star Engineering Company Ltd. (1953) 70 R.P.C. 28, it was held that dolls' eyes made in one piece were not patentable subject matter, even though the claim included further limitations as to materials (plastic) and the manner of performance (injection moulding), with advantages claimed for each aspect.

Further to this point, in Doctors v. Warshawer & Son Ltd. (1934) 51 R.P.C. 385, at page 391, Farwell J. said: "But what is said is that the combination of making the hinge and the slotted stay in one piece was something which required invention; and in support of that it is said that for a great many years nobody ever thought of doing this, until it was done by the Plaintiff ... I think this is nothing more than a combination of perfectly well-known devices, and not a combination which required any invention at all."

In Newsom v. Mann, 7 R.P.C. 307, it was held that the claims were really for the mere casting together of things well known and were not subject matter.

The applicant points out that the prior art does not show a calibrated scale. The Kelley disclosure, however, at column 2, line 28 reads: "One or both sides of the rule may be provided with scales or graduations as preferred."

The applicant stresses the importance of parallel lines 7 and the manner in which they cooperate with straight edge 2. Although not quite the same the Kelley patent does show parallel edges A2 and A5.

The applicant states that there is no disclosure of a hole corresponding to hole 9 of the present device. The provision of hole 9, however, is held to be for a purpose which is well known in the art; that is, to provide a center about which a circle or portion of a circle may be drawn. The disclosure of Kelley, column 2, line 32 reads: "... owing to the peculiar arrangement of the straight and curved edges which form considerable portions of circles

I am able to produce a great variety of different designs and patterns."

Furthermore, the instant disclosure merely points out the provisions of hole 9 without any indication that it has a function in a patentable combination.

The applicant argues that the shape of his device is different from any prior art device. While this may be true we must keep in mind that articles of special shape may only be patentable where the shape has some function or purpose producing a new and useful result in an inventive manner. The prior art devices, as illustrated by the Kelley and Valentine patents, are similar in many respects to the applicant's device. The changes in shape between applicant's device and those of the prior patents do not singly or cumulatively produce a combination which operates substantially different from the individual devices, which the applicant states existed before the present device was conceived. In other words, no new or useful result, in the sense of patent law, was achieved by bringing together the prior art devices, as each part of the present device performs substantially the same function and has the same purpose as a separate prior art device known to the applicant.

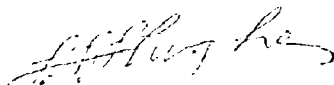
We agree that increased convenience may result from putting in one device what previously existed in a plurality of devices. Increased convenience, however, usually flows from an idea lacking in patentable merit. On this point we refer to Drysdale and Sidney Smith & Blyth Limited v. Davey Paxmon & Company (1939), 55 R.P.C. 95 at page 113, where Luxmoore J., said: "An attempt has been made to displace the argument that the invention lacked subject matter by setting up a number of advantages which were alleged to result from the user of the device; but if no ingenuity is involved in the application of the idea, no amount of proof of its practical utility can save it from being invalid from want of subject matter."

The comments of the court, in Lowé Martin Co. Ltd. v Office Specialty Manufacturing Co. Ltd. (1930) Ex. C.R. 181, are pertinent: "The mere carrying

forward of the original thought, a change only in form, proportion or degree, doing the same thing in the same way, by substantially the same means, with better results is not such an invention as will sustain a patent" (page 187 line 9), and "It is always necessary to consider the rights of the general public to avoid monopolies on such simple devices as would occur to anyone familiar with the art."

We are satisfied that the application is not directed to a patentable advance in the art. The applicant has achieved a result with a change in form only, producing a result, by substantially the same means, as is taught or inherent in the prior art.

We recommend that the decision in the Final Action to refuse the application be affirmed.



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

I am in agreement with the recommendations of the Patent Appeal Board. Accordingly, I refuse to grant a patent on this application. The applicant has six months within which to appeal this decision under the provision of Section 44 of the Patent Act.



J.H.A. Gariépy,
Commissioner of Patents.

Dated at Hull, Quebec

this 26th. day of April, 1976

Agent for Applicant

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