

COMMISSIONER'S DECISION

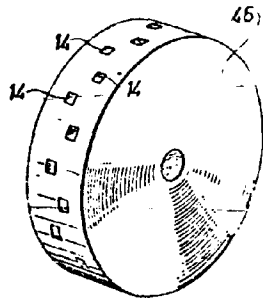
OBVIOUSNESS: Roll of Closure Tabs for Milk Containers

A continuous roll of web material is used in a machine for the construction of tetrahedron shaped containers for milk and other fluids. A repeated pattern of stamped holes, which are covered by tabs, are arranged in a predetermined staggered relationship on the web. The prior art did not teach the same concept.

Rejection: Reversed.

This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated May 22, 1975, on application 131,930 (Class 229-13). The application was filed on January 7, 1972, in the name of William O. Young, Jr. and is entitled "Pull Tab Paper." The Patent Appeal Board conducted a Hearing on September 15, at which Messrs. N.S. Hewitt and A. Messulam represented the applicant.

The application relates to the preparation of a continuous length of web material to be used in the construction of containers for liquid filling goods, for instance tetrahedron containers. Figure 20, shown below, is illustrative of the alleged invention:

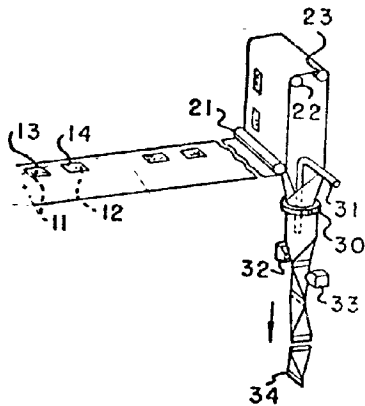


In the Final Action the examiner refused the claims as "lacking invention over the disclosure of Mobley, when combined with the common general knowledge of the staggering of closure facilities in the roll making art, as evidenced by Paxton." The examiner also cited Canadian Patent 437,800 - Nov. 5, 1946 to show that a roll with adjacent rows of articles on a web is common knowledge. In that action the examiner stated (in part):

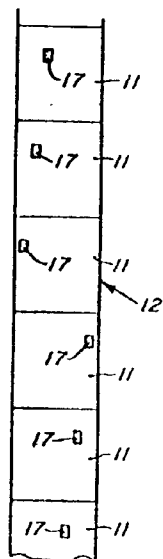
Should it be necessary for the machine which receives a feed from such a roll to receive a staggered arrangement of web material then it is held to be but expected skill to so provide a staggered roll. To stagger the holes simply to have a staggered arrangement is a mere matter of choice.

It is clear from the above art, particularly Paxton that to provide a uniform diameter roll one should locate the attached members uniformly across the web width. This is all applicant does.

The Mobley patent discloses a web of sheet material having spaced openings with pull tabs heat sealed over the openings. That invention is illustrated by the following drawing showing part of Figure 1:



The Paxton patent discloses the basic idea that closure facilities on a web of material must be in staggered relationship to each other in order to distribute the thickness of the closure facilities uniformly when the material is rolled up. Figure 2, shown below (in part), is illustrative of that invention:



In the response (dated Oct. 21, 1975) to the Final Action the applicant states that the concept of the invention is to separate the perforating and pull tab applying operations from the filling operation so that the filling speed is not retarded by the speed of the perforating-pull tab applying operations.

In doing this it is necessary to make a roll of packaging material which has openings therein which are covered by a pull tab for access to the interior of the package. This roll can then be transported for use in a filling machine. In that action the applicant also stated (in part):

In particular, without the separation of the machine of Mobley into two separate machines as in the present invention, the roll of the present invention does not occur. Thus, the packaging material as claimed in claims 1 to 3 of this application is predicated upon the concept of the separation of the two machines, and it is submitted that in the absence of the disclosure of the concept of the two machines in the prior art, there can be no disclosure or teaching of the roll of the present invention. Thus, the roll of the present invention, i.e. the packaging material is the product of the machine forming the holes and tabs in the sheet material which is withdrawn from the machine and is subsequently used as a roll for feeding a machine for forming the packages. It is respectfully submitted therefore that a person skilled in the art reading Mobley would have no reason to wish to modify Mobley so that the holes 11 and 12 covered by the tabs 13 and 14 are staggered in their relationship along two middle and in relation to the longitudinal direction of the sheet material parallel lines, i.e. that such openings and tabs are alternately located on one side of the center line the same distance, each of the openings being spaced the same longitudinal distance from each other with tabs sealed over the openings. There would be no advantage in Mobley in doing this and in fact, there would be substantial disadvantages in that the machine of Mobley would have to be substantially modified to achieve this both with respect to the mechanism for packaging the holes and covering the holes with the tabs of the mechanism for turning the sheet material into sealed packages. It is only when it is desired to roll the sheet material from the packaging and tab closing mechanism into a roll before it is used to form packages in a packaging machine that the critical features of the present invention become important. As neither Mobley nor Paxton teaches such a separation into two machines, then it is respectfully submitted that it would not be obvious to a person skilled in the art to modify Mobley and in fact, a person skilled in the art on being instructed to modify Mobley so as to stagger the holes 11 and 12 as suggested by the Examiner would refuse to accept such instructions as clearly such a modification of Mobley could only lead to complications and an unworkable apparatus.

The question to be considered is whether or not the applicant has made a patentable advance in the art. We will now consider the disclosure and claims. Claim 1 reads as follows:

A circular, cylindrical supply roll containing a web of packaging material, said web being provided with a repeated pattern of stamped holes, which holes are covered by pull tabs attached to the web around said holes, said pull tabs covering said holes being arranged in a staggered or zig-zag relationship along two mutually and in relation to the longitudinal direction of the web parallel lines.

We note that the applicant has a copending application (131,929) of even date which is directed to the method and apparatus for producing the packaging material as described in this application. We are mindful therefore that this decision may have some bearing on the outcome of that application.

We have considered with care the able arguments of Messrs. Hewitt and Messulam which were presented at the hearing.

In the present circumstances we find it understandable that at first blush the alleged invention may appear unsophisticated. We believe however, that this may be a situation where an idea or concept may be at least partly at the heart of the invention. The solution to the question which we must consider in these circumstances is not however, without its difficulties.

At the hearing the applicant stated that the present invention is predicated on two inventive steps: the concept of the separation of his machine into two machines operating independently; and the specific roll adapted for the new machine to carry out that concept. It is related, as we see it, to a realization of the lack of efficiency in production in the prior art machines; to an idea or concept and a novel practical application in the solution to this problem.

It is well established that the inventive step - the merit, may be in the idea or concept. In other words the merit of an invention may be in the recognition of the existence of a problem, or in clearly realizing some particular useful end to be obtained. It is also well established that the recognition of the concept may well merit patent protection even though the means of realizing the concept are straightforward given the concept.

A leading case on the matter of the "recognition of the idea or concept" is Hickton's Patent Syndicate v. Patents and Machine Improvements Company Ltd. (1909) 26 R.P.C. 339. At page 347, Fletcher Moulton L.J. set forth the applicable law as follows:

The learned Judge says: 'An idea may be new and original and very meritorious, but unless there is some invention necessary for putting the idea into practice it is not patentable.' With the greatest respect for the learned Judge, that, in my opinion, is quite contrary to the principles of patent law, and would deprive of their reward a very large number of meritorious inventions that have been made. I may say that this dictum is to the best of my knowledge supported by no case, and no case has been quoted to us which would justify it.... To say that the conception may be meritorious and may involve invention and may be new and original, and simply because when you have once got the idea it is easy to carry it out, that that deprives it of the title of being a new invention according to our patent law, is, I think, an extremely dangerous principle and justified neither by reason, nor authority.

...

In my opinion, invention may lie in the idea, and it may lie in the way in which it is carried out, and it may lie in the combination of the two.

Lindley, L.J. stated in the case of Fawcett v. Homan (1896) 13 R.P.C. 398 at 405:

The merit of an invention very often consists in clearly realising some particular useful end to be attained, or, to use Dr. Hopkinson's language, 'in apprehending a desideratum'. If an inventor does this, and also shows how to attain the desired effect by some new contrivance, his invention is patentable....

These doctrines have been acknowledged to form part of the Canadian jurisprudence. For example, consider the following language of Rinfret J. in Electrolier Manufacturing Co. Ltd. v. Dominion Manufacturers Ltd. (1934)

S.C.R. 436 at 442:

The merit of Pahlow's patent is not so much in the means of carrying out the idea as in conceiving the idea itself (Fawcett v. Homan), supra...

This case, in our view, also comes within the interdiction expressed by McLean J. in Merco Nordstrom Valve Co. v. Cromer (1942) Ex. C.R. 138 at 155:

It has been authoritatively stated that the art of combining two or more parts, whether they be new or old, or partly new and partly old, so as to obtain a new result, or a known result in a better, cheaper, or more expeditious manner, is valid subject-matter if there is sufficient evidence of presumption of thought, design, or skillful ingenuity in the invention and novelty in the combination. (emphasis added)

We agree with the applicant that the cited art does not disclose "the concept of the separation of his single machine into two machines operating independently." It was also made clear at the hearing that "all sorts of problems" were encountered in the solution to the "slow production problem" over and above "the recognition of the existence of such a problem." It was also made clear at the hearing that the total production using the "new supply roll" is "much more efficient" and that the speed of production was increased "very substantially."

There was considerable discussion as to the inventiveness of the staggered relationship of the tabs and the stability of the roll. We agree that the cited art may be pertinent to some features of the invention. We are not persuaded however, that it teaches or renders the "total concept" obvious. We must remember, as previously mentioned, that in testing the question of invention, one must not simply question the novelty and obviousness of the means for realizing the invention, but also of the concepts underlying the invention; if the concept and desiderata are new and possessing a degree of ingenuity,

then that is sufficient to support a patent. It is clear that the applicant has produced a new combination to produce essentially a known result in a better, cheaper or more expeditious manner (vide: Nordstrom v Comer, supra). We deem it apposite to quote here the warning sounded by Fletcher Moulton L.J. in British Westinghouse Electric and Manufacturing Co. Ltd. v Braulik (1910), 27 R.P.C. 209, where he observed:

I confess that I view with suspicion arguments to the effect that a new combination, bringing with it new and important consequences in the shape of practical machines, is not an invention, because, when it has once been established, it is easy to show how it might be arrived at by starting from something known, and taking a series of apparently easy steps....

In view of the evidence before us we are therefore constrained to conclude that there is "ingenuity in the invention" when we consider the "total concept" of the problem, or the recognition of it and the solution thereof.

We turn now to the scope of monopoly covered in the instant claims. Claim 1 will, for convenience, be reproduced again as follows:

A circular, cylindrical supply roll containing a web of packaging material, said web being provided with a repeated pattern of stamped holes, which holes are covered by pull tabs attached to the web around said holes, said pull tabs covering said holes being arranged in a staggered or zig-zag relationship along two mutually and in relation to the longitudinal direction of the web parallel lines.

We are not satisfied that this claim, nor claims 2 and 3, limit the scope of monopoly of the total concept, as discussed above, with sufficient particularity and distinctness. We are mindful that the examiner did not refuse the claims on this ground, nor was it necessary, because they were refused as lacking invention. We suggest they be redefined in the following terms:

A circular, cylindrical supply roll containing an elongated web of packaging material from which tetrahedron shaped packages are to be made, said web being provided with a repeated pattern of stamped holes which provide for dispensing the contents of the formed package, which holes are covered by pull tabs attached to the web around said holes, said applied pull tabs being arranged in a staggered or zig-zag relationship located along two parallel lines each offset the same distance from the longitudinal center line of the web, and wherein said elongated web is rolled into a cylindrical form in which the outside diameters on each side of said roll are substantially equal, the cylindrical roll being suitable for transfer to and use in a machine which forms and fills said packages.

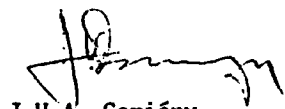
We think it important that the manner in which the pull tabs are arranged on the roll be more particularly described in the claim since, as was stressed by Mr. Hewitt at the hearing, this is a distinctive feature serving to distinguish the applicant's invention from the prior art.

In summary, we are satisfied that the applicant has made a patentable advance in the art. We therefore recommend that the decision to refuse the application be withdrawn. The claims presently on file should be amended as indicated above.



J.F. Hughes  
Assistant Chairman  
Patent Appeal Board

I am in agreement with the findings of the Patent Appeal Board. Accordingly, I direct that the application be returned to the examiner for further prosecution. In the event that the applicant elects to make the amendments called for by the Patent Appeal Board voluntarily it would appear that further prosecution will be unnecessary.



J.H.A. Gariépy  
Commissioner of Patents

Dated at Hull, Quebec  
this 27th. day of September, 1976

Agent for Applicant

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