

COMMISSIONER'S DECISION

Obviousness; Anticipation; Section 36; Commercial Success - LAUNDRY SOFTENERS

The application was for a process to treat laundry in driers with paper sheets coated with conditioning agents such as softeners, deodorants, anti-static agents and the like. The coated sheets, sold under the Trade Mark "Bounce", were also claimed. The applicant argued the product claims were allowable despite the fact that similar products were known for other purposes, because the new use to which the sheets were to be put were included in the claim. This contention was rejected and the product claims refused as anticipated. The rejection of the process claim as being obvious was reversed. There was sufficient ingenuity both in the fundamental concept and in its adaption to the required purpose to grant a patent. weight of commercial success and of the grant of foreign patents as indicators of inventively was discussed. The argument that the Commissioner became functus officio when notice of grant was published in the Patent Office Record, and consequently was obliged to issue a patent, was rejected.

Final Rejection - Modified.

The Patent Appeal Board held a hearing on August 18, 1976, to consider the final rejection of patent applications 049669 and 236450. These had been filed by Conrad J. Gaiser on April 24, 1967 and September 26, 1975, respectively, and assigned to The Proctor & Gamble Company. Both of them are classified in Class 8, subclass 93.11. At the hearing the applicant was represented by Mr. Donald F. Sim, Q.C., and Messrs. Gebhardt, Witt and Hendricks.

The primary purpose of the invention is to treat laundry in clothes driers with chemical conditioning agents, such as laundry softeners, anti-static materials, bacteriocides, fungicides, deodorants, or silicones to assist in ironing. Small sheets of cellulose, paper towels or other flexible substrates are coated or impregnated with the conditioning agents, and then placed with a load of laundry in the drier. Under the conditions of agitation, heat and moisture which develop in the drier, the conditioning agents transfer to the clothing. The substrate may be made in the form of rolls of tear sheets. One tear sheet is placed with each load in the drier. This obviously is a very convenient way to soften clothes and to provide the correct measured amount of agent for each load. It also

avoids the inconveniences and difficulties which occurred in the prior art, where the conditioning agents are added during washing. In that process detergents react with the conditioning agents, and the latter must be added to the washing stage at a particular moment in the washing cycle. This requires additional attention from the operator or the housewife during washing. The new method of conditioning clothes is effective, simple, and commercially successful. The applicant's product is marketed by Proctor and Gamble under the Registered Trade Mark name "Bounce," and by its competitors by their Trade Marks "Cling Free", "Fleecy" and "Caress."

The earlier application is directed to that aspect of the invention where the carrier is impregnated with the conditioner. The later application, which is a division of the first, covers substrates coated with the conditioners. Both the products and the process of using them are claimed. Representative are claim 18 and 1 in application 049,669, which are given below:

Claim 18 A fabric conditioning article comprising a substrate impregnated with a fabric conditioning agent which is removable to a fabric contacting the substrate.

Claim 1 The method of conditioning fabrics which comprises commingling pieces of damp fabric by tumbling said pieces under heat in a laundry dryer together with a substrate impregnated with a transferable conditioning agent, thereby to effect transfer of the conditioning agent to the fabric while being dried.

The reasons for rejecting both applications are the same, and for convenience we may restrict our attention to 049,669. Some claims were refused for obviousness, and others for anticipation. The examiner applied eight prior patents, to wit:

United States Patents

2,542,909	Feb.20,1951	Cl.167-84	DeWet
2,634,229	Apr.7,1953	Cl.167-84	DeWet
2,702,780	Feb.22,1955	Cl.167-84	Lerner
2,846,776	Aug.12,1958	Cl.34-45	Clark
2,851,791	Sep.16,1958	Cl.34-90	Olthuis
2,941,309	June 21,1960	Cl.34-60	Cobb
3,138,533	June 23,1962	Cl.167-84	Heim et al
3,227,614	Jan. 4,1966	Cl.167-84	Scheuer
3,283,357	Nov. 8,1966	Cl.15-506	Decker et al

He then developed his argument in the following terms:

Clark, Olthuis and Cobb disclose methods of conditioning fabrics in laundry dryers. The methods comprise tumbling

the fabrics in the dryer in the presence of conditioning agents, the agents being released so as to be dispersed on the fabrics at a controlled rate. The conditioning agents taught include water, mothproofing compounds and disinfectants.

DeWet, Lerner, Heim et al, Scheuer and Decker et al all teach articles comprising a substrate carrying a certain amount of conditioning agent. The conditioning agents taught include germicides, deodorants, and anti bacterial agents. Some of the conditioning agents exert a softening action on the substrate carrying them. (DeWet United States Patent 2,542,909). The conditioning agents can be removed from the substrates by attrition or by washing out.

Applicant's alleged invention as reflected in the claims and in applicant's arguments is directed to conditioning damp fabrics in a laundry dryer while the fabrics are being dried, comprising commingling with the fabrics a substrate carrying a transferable conditioning agent. Applicant has argued that his process and product claims are patentable in that the prior art fails to show a simultaneous drying and conditioning operation in a laundry dryer and in that all prior art substrates contain far too little conditioning agent to be effective for use in a laundry dryer.

Furthermore applicant maintains that the applied references singly or combined fail to show "the invention" and, in fact, represent an improper mosaic of references.

The examiner can not agree with these contentions and maintains that the realization of applicant's process and product is not unobvious and does not require the exercise of inventive ingenuity.

Fabric conditioning is an old and well known art. It is well known to condition fabrics during the laundering operation by introducing a conditioning agent either into the rinse cycle or a washing machine or onto the dry clothes in a dryer. On given a problem of where clothes can be conditioned, the obvious answer is in the washing machine, or in the dryer. In fact, Clark, Olthuis and Cobb reflect such thinking in their teachings, which are directed to conditioning of clothes in the dryer. Furthermore, it is deemed obvious for a person skilled in the art that, since the conditioning of damp clothes in the washing machine is known, they can also be conditioned in the dryer.

Thus if a person wanted to avoid the disadvantages of detergent-softener interactions, in the washing machine, and having to wait for the rinse cycle of the washing machine, he could search the prior art for means to introduce his conditioner into the dryer. Clark, Olthuis and Cobb teach three different ways of introducing a fabric conditioner into the dryer. DeWet, Lerner, Heim et al, Scheuer and Decker et al teach means of dispensing conditioning agents wherein the conditioners are removed from a substrate either by attrition or by being rinsed out into water. Hence, the use of any of the above taught articles to condition fabrics in the dryer while they are being dried is an obvious use for

these articles.

Applicants conditioning article, which is distinguished from the prior art only by a different use is also deemed obvious. A novel use does not confer patentability on an old product. Some of the conditioning articles taught in the applied references contain conditioning agents which are transferable to clothes if the article is rubbed against the clothes.

It is therefore submitted that the references are pertinent and that a person skilled in the art would draw on their technical content to arrive at a process and a conditioning article specified in the present application. Given a problem to condition clothes, a person skilled in the art would search the prior art for information as to how fabrics have been conditioned in the past, the kind of fabric conditioners that have been used in the past and how those conditioners were stored, packaged and dispensed in the past.

It is admitted that not all the features of applicant's process and article are shown in the prior art. For instance, the references fail to show simultaneous drying and conditioning in the dryer, the use of a flexible, tear-resistant substrate carrying a fabric conditioner in a dryer, the selection of a conditioning agent that is a low melting normally solid substance for use in a dryer, and a flexible substrate carrying 1.0 to 10 gms conditioner per 105 sq. inches of substrate.

However, as it was pointed out above, in view of the prior art, a simultaneous drying and conditioning operation and the use of a flexible substrate carrying a conditioner are deemed obvious. The selection of a particular conditioning agent, be it a softener, a bacteriostat or an antistat, that is suitable for use in a dryer operation, and is a low melting normally solid substance, requires only the use of expected skills when presented with all the known fabric conditioners. Furthermore, it is maintained that the determination of the optimum quantity of conditioning agent for the transferal of an effective amount of conditioner in the dryer falls within the realms of expected skill.

Additional features which can be found in the claims such as the provision of a tear-resistant, resin sized substrate and the provision of a continuous perforated roll of conditioning article for easy dispensation fail to confer patentability on the claims. Resin sizing to stiffen materials is old and well known and the provision of a perforated roll of material is a well known method of dispensing materials.

The claims are therefore rejected for the following reasons:

Claims 1-17 are obvious in view of the applied references.

Claims 18-20, 24-26 are anticipated by DeWet, Lerner,

Heim et al, Scheuer and Decker et al.

Claims 21-23 and 27-30 are obvious in view of DeWet, Lerner, Heim et al, Scheuer and Decker when viewed with the state of the art.

In considering these grounds for rejection, the Board has been assisted by the skilful submissions of both Mr. David Watson, Q.C., whose arguments were in writing, and those of Mr. D. Sim, Q.C. made orally at the Hearing.

We will consider first those claims which were said to be anticipated by DeWet, Lerner, Heim et al, Scheuer and Decker, i.e. claims 18-20 and 24-26, of which claim 18, reproduced earlier, is representative.

Essentially

it covers a substrate impregnated with a conditioning agent. In those terms it is clearly anticipated by the references, and fails to satisfy the requirement for novelty expressed in Section 28 of the Patent Act. Scheuer, for example, describes and claims a paper impregnated with a germicide transferrable to other surfaces. He mentions specifically some of the identical conditioners referred to in the applicant's disclosure. DeWet also describes napkins carrying some of the same conditioners.

The applicant, however, lays stress upon the additional phrases "A fabric conditioning article," and "which is removable to a fabric contacting the substrate," as being important in overcoming that objection. It is his contention that

by labelling an old product by the use to which it is put (provided that use is new), then the product may be claimed. He concedes that under American and even British patent jurisprudence it is not possible to reclaim

an old product or device by relabelling it for a new use, though in those

jurisdictions it might well be possible to patent a new method involving that product, or even a modification of the old product to adapt it to that

new use provided that modification differs in some way from the old product,

and thus is novel. He contends that in Canada, however, the patent law is different; that a product claim, even if old, when relabelled for a new

use is a good claim; and he points to the finding of the Supreme Court of Canada in *Burton Parsons v. Hewlett Packard* (1975) 17 C.P.R. (2d) 97 as supporting that contention. Mr. Sim submitted that at the *Burton Parsons*

appeal, he, as representing Hewlett Packard, had submitted there that the *Burton Parsons* patent covered such old compositions as tomato ketchup,

but the Court had held the claims avoided that anticipation by being relabelled

as to their electrocardiographic use. Whatever might have been said or

concluded by counsel in the heat of argument at that appeal, we believe we must rely on what was actually stated by the respective courts in their written reasons for judgement. They present their reasoned view. When we do so, we must come to a different conclusion than applicant's counsel, for we find that the courts proceeded on the premise that the compositions were new.

In the decision of the Trial Court, which like the Supreme Court found for Burton Parsons, Mr. Justice Noel said (7 C.P.R. (2d) 198 beginning at p. 231):

The defendants then attacked the patent on the basis that one cannot obtain a patent on an old substance for a new use. Assuming that there was a meritorious invention made in the discovery that one can make an electrode cream consisting of an emulsion, a highly ionized salt with or without a buffer, defendants say that the Harry reference, showing a cold cream or skin cream consisting of an aqueous emulsion or an aqueous solution of an emulsified material, a highly ionizable salt, namely, sodium phosphate (although there was disagreement between Mr. Hayes and Dr. Shansky as to whether sodium phosphate was a highly ionizable salt or not) meets all the limitations of the claims and one cannot patent the substance or one cannot get a patent on the old substance for the new use. The Harry reference, according to the defendants, has everything that is within the scope of the claims except that the patentee here says that his is an electrode cream for increasing the productivity between an electrode and the patent and Harry of the Harry reference says his is a skin cream. There is, according to the defendants, authority in the United States and Great Britain to the effect that when that situation obtains, one cannot patent the substance and the patent in such a case must be for the use itself and in the present case, defendants say the use itself is unpatentable. Inventions, according to counsel for the defendants, will not reside where a person has taken a known compound and found a new use for it. He must then claim not the compound but only the process in which it is used. The submission is that one cannot get a patent on placing a new label on an old substance. The claim must be framed for the method. Counsel for the defendants even puts forward that in the present case the patentee cannot get a valid patent even for the new use on the basis that as the use here is for the purpose of monitoring the human body and obtaining a reading, namely testing, such a device is not patentable under the vendible object principle. A patentable process must be, he says, one relating to the manual or the useful arts, not the fine arts and not to professional skills and in Great Britain, under that part of the definition of invention "manner of new manufacture" it has been held that that term does not include a method of testing. It is also submitted that for a process to be patentable, there must be some vendible product

involved and processes for the human body have been consistently rejected. Counsel for the defendants suggests that the claim should have been not for a method of making this product or for the product itself, but for a method of making encephalograms or electrocardiograms consisting of attaching an electrode to the skin of the patient and the improvement being to interpose between the electrode and the patient, the cream. Such a claim, however, would, he says, still be invalid as the method of treatment of the human body has never been patentable because it is not related to a vendible object. Defendants' submission that Harry's compound is similar to plaintiffs' and that the former can be used for the latter, or as an ECG cream is not true. (emphasis added) There is no question that Harry had an emulsifiable material, an ionizable salt, sodium phosphate, a buffer, but the sodium phosphate, the salt, was part of the buffer. It is indeed different from the plaintiffs' product where there is an emulsified material or there is the emulsion plus the salt and plus the buffer. Furthermore, the evidence discloses that sodium phosphate is not a highly ionizable salt and, therefore, will not provide good conductivity which is a necessary requirement for plaintiffs' cream. Although Mr. Hayes attempted in his evidence to say that sodium phosphate was a highly ionized salt, he was obliged to admit in cross-examination that it was the salt of a weak acid with citric acid and not of a strong acid and of a strong base. In para. 15 of his affidavit Mr. Hayes indeed, when describing a buffer solution, states this clearly when he says "a buffer system is usually made up of a salt of a weak acid itself, the selection depending on the desired pH". As a matter of fact, Mr. Hayes, as pointed out by counsel for the plaintiffs, at no time suggests that the sodium phosphate on the Harry emulsion would have any conductivity whatsoever. It therefore appears to me that plaintiff's cream is not just a matter of a new use but a different product or combination which, no doubt, has some similarities to the prior art but it is not, and cannot be the Harry reference (emphasis added) because the latter does not provide good conductivity nor was it used for an electrode cream the latter, of course, being sufficient to dismiss any thought of the Harry reference having anticipated plaintiffs' patent.

The Federal Court of Appeal (10 C.P.R. 2d, 126) found for Hewlett Packard,

reasoning that the claims did not satisfy Section 36 in that they covered

inoperative compositions. It did not question the finding of the lower court that the compositions were not anticipated. In his dissent, Mr. Justice

Mackay looked to the functional qualifications in the claims not to avoid

prior art, but as overcoming the objection as to inoperability. He said, at

p. 149:

I think that these limitations as to the use of the invention

and the limitation as to the materials to be used are an answer to the appellant's submission that among the classifications of the materials referred to there are some that would be dangerous to use on the human skin. The patent does not claim that any emulsion or any highly ionizable salt could be used.

In reversing the Federal Court of Appeal, the Supreme Court (17 CPR 2d, 126)

adopted Mr. Justice Mackay's reasoning. It said, at p. 105:

In the present case, the invention relates to a mixture and a process for making it. This mixture is of no fixed composition. A great many different substances can be used, hundreds if not thousands, said Shansky. The essential is to combine a highly ionizable salt with an aqueous emulsion. As a result of this combination, the wetting action of the emulsion on the skin makes it possible to use the salt in a low concentration (from 1 to 10%). If the patent is to have a practical value, it must cover all the emulsions and salts which can yield the desirable result, namely, all "emulsions with the outer phase or the continuous phase being water" and all salts that are highly ionizable enough to carry an electric current with low resistivity on the skin excluding only such substances as are not compatible with normal human skin. The evidence makes it clear that this was obvious to any person skilled in the art because the characteristics of suitable emulsions and of suitable salts were well known.

Significantly it then added:

Only the combination was new.

We cannot, consequently, accept the submission that Burton Parsons stands

for the proposition that old products may be repatented by giving them a new label to identify the use to which they are to be put.

Mr. Sim did not refer to other jurisprudence to support his contention.

On

the other hand there are some Canadian decisions which suggest, some admit-

tedly obliquely, others more directly, that an old device cannot be repatented without change merely because a new use has been found for it.

We are thinking, for example, of *Somerville Paper Boxes v. Cormier* 1941 Ex. C.R. 49 at pp. 65-68; of *Canadian Raybestos v. Brake Service* 1926 Ex. C.R. 187 at 192 and 1928 S.C.R. 61 at 62; of *Belding Corticelli v. Kaufman* 1935 Ex. C.R. 152 at the bottom of p. 159 and on p. 160 and 1940 S.C.R. 388 at 390; of *Northern Shirt v. Clark* (1917) 17 Ex. C.R. 273; of *Detroit Rubber v. Republic Rubber* 1928 Ex. C.R. 29; of *Tennessee Eastman v. Commissioner of Patents* 1974 S.C.R. 111; and of *Bergeron v. DeKermor* 1927 Ex. C.R. 181. These decisions recognize that a method of using an old device

may be patentable if novel and inventive, but in the Bergeron decision, for example, we find:

A man cannot introduce some variations or improvements, whether patentable or not, into a known apparatus or machine and then claim as his invention the whole apparatus. (p. 187)

and

In view of the prior art, I am of opinion [sic] that not only is there no contrivance or device that is new in the defendant's patent, but that there are no new features in the combination claimed, the same features have been previously shown in other electric heaters. (p. 188)

and

... The claim must be limited to what is new.... (p. 196)
In *Hosiers Ltd. v Penmans*, 1925 Ex. C.R. 92 at 104, it was recognized that:

If a product is known to the trade, its production by a new process or new instruments cannot make it new.

This principle was reaffirmed in *Hoffman-LaRoche v Commissioner of Patents* 1954 Ex. C.R. 52 and 1055 S.C.R. 414. At page 56, the Exchequer Court said:

It is essential to the validity of a claim that the thing should have novelty. This is lacking in claim 14. Aldehyde is admittedly an old product and the submission that when it is prepared according to the appellant's process there is sufficient novelty on which to found a claim for it when so prepared cannot be accepted. The weight of judicial authority in Canada and the United States is against it....
(underlining added)

The Supreme Court (p.417) classified as an "artificial attribution" the suggestion that the product gained novelty by virtue of the new process for preparing it. We think it would be equally artificial, and unacceptable, to hold that the use to which the present product is to be put renders it novel.

As a perusal of the cases cited above demonstrate, the Canadian Courts have not hesitated when considering novelty to rely upon both British and American jurisprudence. The underlined portion of the quotation above from *Hoffman-LaRoche v. Commissioner of Patents* testifies to that proposi-

tion. Indeed it has long been recognized that where there is a correspondence between the patent laws it is quite proper to look to both British and American jurisprudence for instruction, though not for direction, always provided that due weight is given to such differences in the laws as do exist. See, for example *Hunter v Carrick* (1884) 10 O.A.R. 449 at 468; *Curl-Master v Atlas Brush* (1967) S.C.R. 514 at 527 & 530; *Farbwerke Hoechst v Commissioner of Patents* (1966) S.C.R. 606 at 614; *Van Heusen v Took Bros.* 1929 Ex. C.R. 89 at 100; *Leonard v Commissioner of Patents* (1914) 14 Ex.C.R. 351 at 361; *Lawson v Commissioner of Patents* (1970) 62 C.P.R. 107; *Commissioner of Patents v Winthrop Chemical*, 1948 S.C.R. 46; or *Tennessee Eastman v Commissioner of Patents* 62 C.P.R. 11 and 1974 S.C.R. 111.

Consequently in the present circumstances we consider it useful to consider what was said by the U.S. Court of Customs and Patent Appeals in *In Re Thau*, O.G. Sept. 7, 1943, 14, where we find at p.15:

It is our opinion that not only is the weight of authority contrary to appellant's contention, but that it is clearly contrary to the spirit and in our opinion contrary to the letters of the patent laws that patents should be granted for old compositions of matter based upon new uses of such compositions where such uses consist merely in the employment of such compositions.

Similarly in *In re Lawson* 108 U.S.P.Q. 132 we find at 134:

It has been held in the past that where the prior art structure is substantially similar to the structure sought to be patented, even though its function might be different, the similarity in structure alone is sufficient to negative patentability, *In re Griswold*, 33 C.C.P.A. (Patents) 799, 152 F.2d 1014, 68 USPQ 176. It has also been held that where it is obvious that the prior art structure is substantially similar to and would perform the same function as the structure sought to be patented, the latter is unpatentable regardless of whether the prior art patentee intended the structure to be used for the same purpose. *In re George Langford*, 17 C.C.P.A. (Patents) 844, 37 F.2d 753, 4 USPQ 320. The rationale behind the denying of a patent under these circumstances appears to be that there is no invention in perceiving that the product which others had discovered had qualities they failed to detect; more than a new advantage of a product must be discovered in order to claim invention. *General Electric Co. v Jewel Co.*, 326 U.S. 242, 249, 67 USPQ 155, 158 (1945).

That the law in the United Kingdom is the same has been recognized by the applicant, and is confirmed, inter alia, by *Gadd and Mason v The Mayor of*

Manchester (1892) 1X R.P.C. 516; Sharp & Dohme v Boots Pure Drug (1928) XLV R.P.C. 153; Adhesive Dry Mounting v Trapp (1910) 27 R.P.C. 341; and In re L'Air Liquide Societe (1932) 49 R.P.C. 428.

We are satisfied then that the rejection of claims 18, 19, 20, 24, 25 and 26 for anticipation was proper and should be sustained.

Claims 21, 22, 23, 28, 29 and 30 were rejected as being obvious in view of the references. We cannot see that they add anything of a patentable nature to those claims rejected for anticipation, and consequently conclude that they were properly refused (Durable Electric v Renfrew Electric 1928 S.C.R. 8 -and Babcock & Wilcox's Application 1952 R.P.C. 224). Claims 21, 22 & 23 for example, bring in such features as tear lines to permit easy separation, or sizing to stiffen the paper, all features well known in association with paper rolls. Scheuer, for example, at col. 2, lines 26-30 mentions the use of sizing in column 2 commencing at line 27. Lerner mentions subdividing sheets to provide desired quantities of active substances. These alterations are all common expedients in the roll paper art. Claims 28, 29 & 30 are restricted to the presence of softening agents, which feature are not only obvious from the prior art, but even, we believe, directly anticipated, for in DeWet (U.S. 2,542,909), col. 1 at line 53, it is indicated that many of the quaternary ammonium compounds are fabric softeners. The Heim et al citation mentions not only the fabric softening qualities of these materials (col. 2, line 33), but also their potentiality for transferral from a substrate onto fabrics contact-ing the substrate (col. 2, beginning at line 70). The compounds mentioned in claim 30 may be found in the Scheuer patent. Consequently the art which anticipates claims 18-20 and 24-26 also anticipates 28-30.

Of the product claims then, only 27 is left. We will consider it below.

The process claimed was not, it would appear, anticipated. The examiner refused it on the proposition that it was obvious. When we turn to the prior art on which he relied in support of that proposition, we find firstly that conditioning

of clothes in the washer was known, but with the attendant disadvantages and problems discussed in the disclosure. Secondly that spraying of clothes in driers with water and other liquids were also known. Additionally known, as has been previously indicated, are paper towels impregnated with germicidal agents and the like, which towels are used to spread the agents where needed by wiping. What was not known, however, was to condition clothes in driers with towels impregnated with solid conditioners. With the advantage of hindsight, it may seem but a short and simple step to put that all together and come up with what this inventor has done in this case, and we can appreciate why the examiner made that leap. We, however, have not been so intimately involved with the prior prosecution as was the examiner, and from the advantage point where we stand have not been able to leap so far.

The applicant has stated both in his written and oral arguments that the prior art references are "exceedingly remote" from the invention claimed here. We would not put it quite so strongly. Nevertheless important differences are apparent when we look at claim 1 (supra). The manner in which the prior art driers were used according to the record involved the use of liquids, not solids. They were operated with the heat turned off. They did not involve commingling damp fabrics with solid substrates impregnated with solid conditioning agents transferable from the substrate to the clothes.

Other differences are added in the subsidiary process claims, such as the amount of conditioning agent on the substrate, the use of antistatic agents, the presence of resin stiffening agents, etc.

We have been impressed by the fact that none of the references suggest the conditioning of fabrics in a laundry drier using a substrate carrying a conditioning agent, which is the fundamental concept in this invention. The idea of, the particular problems in moving from conditioning in a washer to conditioning in a drier, and the particular means for making that change were not conceived of previously.

The fallacy in ex post facto analysis has been expressed by Fletcher Moulton in *British Westinghouse v Braulik* (1910) 27 R.P.C. 209 at p.230, where he said:

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 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. This ex post facto analysis of inventions is unfair to the inventors, and in my opinion is not counteracted by English Patent Law.

In a Canadian case, *Preformed Line Products et al v. Payer*, Fed. Ct. C, November 5, 1975, it was put succinctly at p. 7:

...great care must be taken in examining an invention ex post facto to determine when there is that element of inventiveness required, for a very great number of extremely useful and truly ingenious inventions often appear to be perfectly obvious and devoid of originality when examined after they have been invented.

Mr. Sim himself cited somewhat fancifully an appropriate quotation from Milton,
- *Paradise Lost*, Book VI at line 498:

Th'invention all admir'd, and each, how hee
To be th'inventor miss'd, so easie it seemd
Once found, which yet unfound most would have thought
Impossible.

At the hearing reference was made to certain external evidence of ingenuity, and in particular to the extensive commercial success enjoyed by the invention. Since its introduction to the market in 1975, there have been over one billion individual applications of the invention in North America. Licences have been taken out by Merck-Calgon and Tenneco, and several competitors subsequently rushed to market their own imitations, though none of them, apparently, had practised the invention previously. We are aware, of course, of the danger in standing too firmly upon the quicksand of "commercial success" (cf. *Niagara Wire Weaving v Johnson Wire* 1940 S.C.R. 700 or *Bergeon v DeKermor* 1927 Ex. C.R. (8)). However in *The King v American Optical*, 1950 Ex. C.R. 344 at 371, and in other cases,

it was concluded that under appropriate circumstances commercial success, though not sufficient in itself to establish inventive ingenuity, may yet be an indicator of ingenuity. From them we conclude that where there is doubt as to the presence of invention, commercial success may add weight to an applicant's case (General Tire v Firestone 1972 R.P.C. 457 at 503.) In the present case we believe the tremendous and sudden commercial success of the invention may be taken as an indicator of ingenuity.

As another external indicator of invention the applicant pointed to the issuance of the corresponding United States patents (3,442,692 May 6, 1969 and 3,895,128 July 15, 1975) and the acceptance of the corresponding German Application P19 55 803.1-43. The frailty of such evidence is well recognized, and Mr. Sim was not prepared to lean too heavily upon it. For whatever it may be worth, we have taken note of it. We also note that the German claims are restricted to a process where there is the added limitation that the substrate is a paper or textile material, and that the product claim was unacceptable. The earlier United States patent is limited to eight process claims comparable to claims 1-9 of the Canadian application. The later United States patent contains product claims extremely circumscribed in scope, and much more restricted than those we have already concluded are unacceptable in Canada.

Having weighed all these arguments, we have come to the conclusion that the rejection of claims 1 to 17 inclusive should be withdrawn.

We turn finally to claim 27, which reads as follows:

27. An article as in claim 18 in which the substrate is a dry paper sheet impregnated with an amount of agent of about 1.0 to 10 grams per 105 square inches.

In doing so we think it important to keep in mind that where there is invention in conceiving an idea of what is desired, there need be no further invention in constructing a device adapted to carry out that idea. Nevertheless that device may be patentable if novel.

In *Reliable Plastics v Louis Marx* 17 F.P.C. 184 at 198, for example, we find:

The fact that it was easy to put the idea into practice and that all that was needed to do so was to apply well known techniques to well known substances does not prevent the embodiment of an idea from patentability if the idea itself involved the exercise of inventive ingenuity.

Similarly in *The King v Uhlemann Optical* 1950 Ex. C.R. 142 at 162 (Affirmed 1952 - 1 S.C.R. 143):

The fact that it was easy to connect the temple arm at the point where Uhlemann did once the idea of doing so had been thought of is thus no evidence of lack of invention. There is support of this in *Hickton's Patent Syndicate v. Patents and Machine Improvements Company Ltd.* (1909), 26 R.P.C. 339. There the Court of Appeal reversed the judgment of Swinfen-Eady J., who had held the patent invalid, and Fletcher Moulton L.J., at p. 347, made the following comments with regard to the views expressed by the trial judge:

"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. But let me give an example. Probably the most celebrated Patent in the history of our law is that of Bolton and Watt, which had the unique distinction of being renewed for the whole fourteen years. The particular invention there was the condensation of the steam, not in the cylinder itself, but in a separate vessel. That conception occurred to Watt and it was for that that his Patent was granted, and out of that grew the steam engine. Now can it be suggested that it required any invention whatever to carry out that idea when once you had got it? It could be done in a thousand ways and by any competent engineer, but the invention was in the idea, and when he had once got that idea, the carrying out of it was perfectly easy. 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."

We refer also to *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 desider-
atum'. If an inventor does this, and also shows how to attain the desired effect by some new contrivance, his invention is patentable....(underlining added)

to Electrolier Manufacturing v Dominion Manufacturers 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....

and to Merco Nordstrom v Comer 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)

Invention may, therefore, be present notwithstanding the fact that there was no difficulty in putting the idea into effect once it had been conceived.

In so far as claim 27 is concerned, it is on the evidence before us novel.

It includes some elements particularly designed to carry out the inventive concept, and in that respect goes beyond what has been done in the other product claims. We consequently are of the opinion that it should not be rejected on either the ground of anticipation or obviousness. We are doubtful that it includes all the elements necessary for its new purpose, and is stated with sufficient distinction and explicitness to satisfy Section 36(2) of the Patent Act. See

Northern Shirt v Clark supra at p.285. There is not included, for example, any indication of the softening temperature of the conditioning agent. Section 36 was not applied by the examiner because of the other grounds on which he based his refusal, nor did the applicant have the opportunity to argue it.

Consequently we recommend that the claim be remanded to the examiner to consider that question. We are, in any event, satisfied that the claims appearing

in U.S. Patent 3,895,128 would satisfy this requirement, and would advise they

be accepted if the applicant wished to substitute them for claim 27.

At the Hearing Mr. Sim referred to the lengthy and chequered course of the prior prosecution of this application, including as it did an earlier final rejection on the ground that the claims were too broad for the disclosure, a notice of allowance, a withdrawal from allowance because of possible conflict, said withdrawal occurring too late to avoid publication of notice of grant in the Patent Office Record of Nov. 4, 1975, and eventually the final rejection for different reasons than those made previously. Needless to say such developments would be frustrating and disheartening to applicants. To such extent as they might be avoidable, they are especially regrettable. In our view, however, the prior history of an application should not deter an examiner from withdrawing an application from allowance, nor from making a final rejection when after due deliberation he has concluded that an application should not proceed to grant. In the present circumstances we ourselves have concluded that the latest rejection was at least in part justified. The responsibility that Section 37 of the Patent Act imposes upon an examiner required him not only to encourage inventors and inventive progress by granting patents where justified, but also to protect the public interest by rejecting applications (and claims) which do not warrant patenting, since to do so would unduly impede industrial effort (cf. *Crossley Radio v. C.G.E.* 1936 S.C.R. 551, *Niagara Wire v Johnson* 1939 Ex. C.R. 273 and *Lowe Martin v. Office Specials* 1930 Ex. C.R. 181).

In making his comments about the prosecution, Mr. Sim suggested that when the patent had been allowed previously, or at least once notice of the grant had been published, the Commissioner became *functus officio* with respect to the application, that he could not withdraw it from allowance, and the only proper remedy now is to reallow the application at once. Section 75(1) of the Patent Regulations does, of course, state that the Commissioner may withdraw a notice of allowance "either before or after the payment of the final fee." The regulation puts no limitation to such withdrawal because of publication of notices of grant. In this instance delivery of the patent had not been made, the applicant never received a patent nor was one

dispatched to him, and the notice of withdrawal was made before the notice of grant was published. Subsection (2) of Section 4 of the Patent Act states what are to be the duties of the Commissioner. They include "all acts and things requisite for the granting and issuing of patents" (underlining added). These duties obviously include sealing the patent, signing it, delivery to the patentee, or at the least placing it in the mail for delivery to the patentee, and all the other steps specified in Sections 13 and 47 of the Act. Until those steps had been completed it can hardly be said that the Commissioner had discharged his duties. The patentee had not obtained a patent as called for in Section 28.

We know of no Canadian patent cases indicating when the Commissioner does in fact become functus officio, nor did Mr. Sim refer to any. However in

In Re Jamieson Construction Co. Ltd. and City of Edmonton, (1930) 3 Western Weekly Reports, 23, the Supreme Court of Alberta came to the conclusion that a public official (in that case an arbitrator) was not functus officio until all his duties had been discharged. To quote:

An arbitrator is not functus officio until his award is actually made, and the power given to the arbitrator and the Court under sec. 15 may be exercised "at any stage of the proceedings" which means at any stage before the proceedings have come to an end by a completed award.

We believe the same principles would apply to the Commissioner of Patents, and he could not be considered functus officio until he had completed all his duties in issuing a patent.

Reference was also made to the harm done to the applicant's interest by virtue of the notice in the Record. It was suggested by Mr. Sim that such notice led to the filing of a protest leading to this final rejection. Previously, however, the Acting Commissioner of Patents was informed by an agent of the applicant that the alleged protester had been forwarded a copy of the application by the applicant himself before November 4, 1975. That being so, the notice can not be said to have caused the harm alleged to it. The Notice gave very little technical information about the invention, and nothing, of course, comparable to what was already available in the United States patent, 3442692, of May 6, 1964, the Belgian patent, 741922

of January 30, 1970, and U.S. Patent 3895128 of July 15, 1975. The Canadian specification was not made available to public inspection at the Patent Office, and consequently Section 10 of the Act does not come into consideration.

All this is not to suggest, of course, that it is any way desirable for notices of grant to appear when a patent has been withdrawn, nor that every effort should not be made to prevent them, but in the course of processing thousands of patents a year, some mishaps do unfortunately occur.

We turn now to the companion application 236450. It raises the same issues as those we have just considered, and we reach the same conclusions, mutatis mutandi, with respect to it. Related to it, however, there is an additional question.

The examiner has required the applicant to proceed with only one application because he considered that there is only one invention present. At the hearing Mr. Sim agreed that this was so, and we are likewise persuaded that there is no inventive difference between claims directed to carriers coated with conditioning agents, and those where the carrier is impregnated with the agent. When coating occurs, perforce some impregnation will take place, and the process of impregnation will likewise result in some coating. The artificial division between these two aspects of the invention developed during the earlier prosecution in an attempt to avoid conflict with other applicants. We recommend that the applicant should now proceed with only one application. The subject matter we have found allowable in application 236450 should be claimed in the same application as the subject matter found allowable in 049669, and only one proceed to grant. He is entitled to claim broadly substrates carrying (whether by impregnation or coating) conditioning agents.

It should be noted by the examiner that this application was placed under special order on July 30, 1976, and further prosecution should proceed as expeditiously as possible.

Gordon Asher
Chairman
Patent Appeal Board

I have considered the report and recommendation of the Patent Appeal

Board, and the other documents relating to this case. I have reached the same conclusions as those which the Board came to. In application 049669 I refuse claims 18-26 and 28 to 30. The rejection of claims 1-17 is withdrawn. The rejection of claim 27 for obviousness is also withdrawn and I remand the claim to the examiner to make the assessment called for by the Board. I also direct that subject matter now claimed in applications

049669 and 236450 which has been found allowable be consolidated into one application. If the applicant wishes to appeal my decision under Section 44

of the Patent Act he has six months to do so. Otherwise the amendments and

deletions required by the Board are to be made within that same time period.

J.H.A. Gari,py
Commissioner of Patents

Dated at Hull, Quebec
this 14th.day of October, 1976

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