

COMMISSIONER'S DECISION

DIVISION: Apparatus and method for manufacturing flexible tubing.

This is a divisional of application 072,053. The issue was whether an apparatus could be considered to have been claimed in a prior application which had claimed only the method of using the apparatus. The Board decided that the same subject matter had under the particular circumstances been claimed in the parent, and provided certain amendments were made the application should proceed.

Final Rejection: Reversed.

This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated April 10, 1975, on application 167,447 (Class 271-9). The application was filed on March 29, 1973, in the name of Algimantas P. Urbutis et al, and is entitled "Shirred Casing Article, Method And Apparatus For Making Same." The Patent Appeal Board conducted a Hearing on September 8, 1976, at which Mr. A.P. Bull represented the applicant.

The invention relates to the art of shirring flexible tubular material. More particularly, it relates to an apparatus and method for manufacturing flexible tubing shirred and compressed into self-sustaining hollow sticks that are useful as sausage casings. This application is a divisional of application 072,053, which divisional issued to patent 927,417 on May 29, 1973 with claims directed to an apparatus only. It is also pointed out that divisional application 072,053, supra, is in turn a divisional of application 935,456 which issued to patent 884,816 on November 2, 1971. That patent contains claims directed to an apparatus and a method relating to shirred tubing.

In the Final Action the examiner refused the "divisional status" of this application. The reason for such rejection is that the subject matter of method claims 4-10 was not claimed in the parent application 072,053. He also stated that the apparatus defined in claim 1 "is not especially adapted" to carry out the method in either claims 4, 9 or 10. He also stated (in part):

Throughout the lengthy prosecution the office has maintained the position that the instant application was not entitled to a Divisional Status as it contained claims to a subject matter which was not claimed in its parent application No. 072053.

In his first response dated August 21, 1973 the applicant concurred with the office's requirement by cancelling the offending claims in order to overcome the issue of granting the Divisional Status, however, in the ensued prosecution he re-submitted cancelled claims arguing (in his responses of May 3, 1974 and September 19, 1974) that these method claims are but a further aspect of the invention defined in the apparatus claims and as such should be accorded a Divisional Status notwithstanding the fact that the subject matter of these claims was not claimed in the parent application.

The applicant himself has conceded that claims 4-10 were never entered in the parent application No. 072053 although they were present in application No. 935456, arguing further that his understanding of this requirement at the time of co-pendency of application No. 072053 and the present application was that it was not necessary to include these claims in the parent application No. 072053.

Considering now applicant's remarks it is evident that the subject matter of claims 4-10 was not claimed in the parent application No. 072053, the fact of applicant's erroneous understanding of the requirement for such a claiming is of course irrelevant.

Further, the applicant's contention that the method claims 4-10 correspond to the apparatus claims and are therefore only a different aspect of the same invention can not be entertained.

The issue of unity of invention involving an apparatus and a method is governed by Rules 59 and 60. Rule 59 imposes the condition that an apparatus must be especially adapted to carry out the method claimed in order to fall within the permissive extent of the Rule to not regard the two types of claims as being directed to more than one invention.

The applicant responded to the Final Action on July 7, 1975, and on April 27,

1976. We quote from the response of April 27, 1975 (in part):

While applicants will readily consider that claims 4 to 10 (which correspond to method claims 7 to 10 in this application as filed) do not appear as such in the corresponding parent application Serial No. 072,053, they cannot agree that this is necessary to satisfy the requirements of Section 38(2) of the Patent Act. Thus while the Examiner is taking the position that method claims 4 to 10 or their equivalent must have appeared in application Serial No. 072,053 at some time before it was allowed, the requirements of Section 38(2) of the Patent Act provide no basis for such a restrictive view. Section 38(2) of the Patent Act reads in its entirety as follows:

"Where an application describes and claims more than one invention the applicant may, and on the direction of the Commissioner to that effect shall, limit his claims to one invention only, and the invention or inventions defined in the other claims may be made the subject of one or more divisional application, if such divisional applications are filed before the issue of a patent on the original application; but if the original application becomes abandoned or forfeited, the time for filing divisional applications terminates with the expiration of the time for reinstating or restoring or reviving the original application under this Act or the rules made thereunder." (underlining added).

If we consider the underlined portion only, it is clear that provided the present divisional application is directed to a single invention which has been defined in the other claims then the requirements of this Section of the Patent Act are satisfied. This is the view that applicants have consistently adopted in their various submissions to the Patent Office since the objection to divisional status due to the presence of the method claims was originally raised. It therefore appears that one of the major criteria to be met by the claims of a divisional application is that they relate to a single invention. If they do, then automatically the provisions of Section 38(2) of the Patent Act are met because the invention embraced by all the claims has been defined in the claims of the corresponding parent application. Applicants consider therefore that it would be most expedient to establish first to the Patent Appeal Board's satisfaction that there is no doubt that all of the present claims are directed to a single invention which has been defined in one or more claims previously present in application 072,053 as required by Section 38(2) of the Patent Act and hence the present application is properly entitled to the divisional status claimed. If this is done then whether or not claims 4 to 10 were ever present as such in application No. 072,053 is irrelevant as if it is true that the apparatus of claims 1 to 3 is especially adapted to carry out the method of claims 4 to 10 then claim 1 is a claim broader in scope than any other so as to satisfy Rule 60 of the Patent Rules and the present application is one "that describes and claims an apparatus especially adapted to carry out the process" as required by Rule 59. In such circumstances the apparatus and method claims merely represent different aspects of the same invention which applicants are appropriately entitled to claim in a single application as established by the Supreme Court of Canada in Baldwin International v. Western Electric 1934 S.C.R. 94.

The applicant also referred to the Libby-Owens-Ford v. Ford (S.C.) decision.

We will discuss that decision later.

We have considered with care the able arguments made by Mr. Bull at the Hearing.

What we must determine is whether the invention defined in claims 1-4 was or was not claimed in the parent application. In doing so we turn first to Section 38(2) of the Patent Act which reads (in part):

Where an application describes and claims more than one invention the applicant may, and on the direction of the Commissioner to that effect shall, limit his claims to one invention only, and the invention or inventions defined in the other claim may be the subject of one or more divisional application, if such divisional applications are filed before the issue of a patent or the original application...."  
(emphasis added)

It is clear from this provision that all claims in a divisional application must be for "the invention...defined in the other claims" of the parent application. It is also clear that the "invention" must have been claimed in the parent application.

Relevant to our consideration are the comments of the Supreme Court in Libby-Owens-Ford v. Ford Motor Co. (1970) S.C.R. 833, where Mr. Justice Hall referred to Section 38 to clarify the meaning of the word "invention" as used in Section 58 of the Patent Act. At page 841 he stated:

The established practice of the Patent Office of allowing both apparatus and process claims or process and substance claims in a single patent indicates that process claims are apt to be considered, in a proper case, as being only different aspects of a single invention covering either an apparatus or a substance. With[while]an infringement of either kind of claim will give rise to a right of action, this does not mean that such a patent covers two inventions. Although it is expressly provided that a patent is not rendered void by reason of the fact that it contains more than one invention, this is certainly not to be presumed. In the present case, appellant has in no way shown that the method claims constitute a separate invention distinct from the apparatus claims. (emphasis added)

It is to be observed that Mr. Justice Hall limited his comments to one existing "in a proper case." Our concern should be, then, whether this is a proper case for holding that the method claims are for the same invention as is protected by the apparatus claims, which did appear on the parent application.

When we look at claim 4, for example, we find that it contains all the elements included in claim 1, and no other elements. We find in it the flexible tubing, the mandrel, the means for shirring the tubing, and the annular restraining passage. In short, it is but a restatement of the same subject matter as appears in the apparatus claim. It defines the way in which the apparatus would normally be used, and in all probability

the only way in which it could be used.

We are consequently, brought to the conclusion that this is a "proper case" to hold that the invention of the process claim was claimed in the parent application

The applicant has proposed an amendment to claim 1 to read: "...a mandrel; means for advancing a flexible tubular casing about said mandrel to and through a shirring passage..." We recommend that this amendment be accepted because it ensures that the claim more clearly satisfies Section 36(2) of the Patent Act. Such amended claim 1 would read:

A machine for producing coherent self-sustaining sticks of shirred flexible tubing comprising in combination, a mandrel; means for advancing a flexible tubular casing about said mandrel to and through a shirring passage; means for shirring such tubing on said mandrel; and annular passage means adjacent said shirring means to engage the shirred tubing and compact the same on said mandrel.

It was also agreed at the Hearing that the passage in claim 4 which reads: "wherein a predetermined pattern of pleats is formed in the tubing," should be deleted for lack of full support in the disclosure. Claim 4 would then read:

The method of shirring flexible tubing into a coherent self-sustaining stick which comprises advancing a flexible tubing over a mandrel to and through a shirring passage and then advancing the pleated tubing through an annular restraining passage, subjecting an outer surface of the pleated tubing to a restraining force and compacting said tubing about the mandrel.

We must also determine whether or not this amended claim 4 is but another aspect of the same invention covered by claim 1.

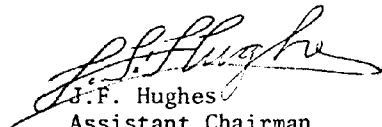
It is our view that the above amendments to claims 1 and 4 overcome the examiner's objection that the apparatus of claim 1 would not carry out the method of claim 4, for they are now of substantially the same scope. These claims are now directed to but two aspects of the same invention.

Claims 5, 6, 7 and 8, which depend on claim 4, add variants which can also be carried out by the apparatus of claim 1. These claims then are also acceptable in the present application.

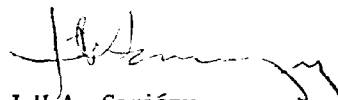
In regard to claims 9 and 10 the applicant stated that "they are prepared to remove these claims from the application if this will assist in placing it in order for allowance." In any event we are satisfied that the apparatus of claim 1 is not especially adapted to carry out the method of claims 9 and 10, because these claims also cover further subject matter beyond that recited in claim 1. Claims 9 and 10 therefore should be refused.

The applicant also submitted a proposed claim 10. This claim in our view, however, should be refused for the same reasons as apply to claims 9 and present 10.

In summary, we recommend that the amendments to claims 1 and 4 be accepted, and that amended claim 4, and claims 5, 6, 7 and 8 be allowed to remain in the present application. We also recommend that instant claims 9 and 10 and proposed claim 10 be refused.

  
J.F. Hughes  
Assistant Chairman  
Patent Appeal Board

I have considered the prosecution and the findings of the Patent Appeal Board. It is my decision that amended claims 1 and 4, and claims 5, 6, 7 and 8 are to be accepted. I refuse however, claims 9 and 10, and proposed claim 10. The applicant has six months in which to make the proposed amendments, and to cancel claims 9 and 10, or to appeal this decision under the provisions of Section 44 of the Patent Act.

  
J.H.A. Gariépy  
Commissioner of Patents

Dated at Hull, Québec  
this 22nd. day of December, 1976

Agent for Applicant

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