

COMMISSIONER'S DECISION

SECTION 36: Claims for Compounds with Carriers

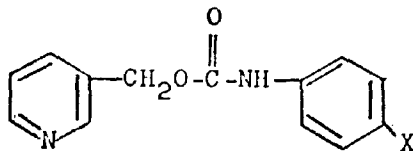
An applicant who has invented and claims a new insecticide, rodenticide or fungicide, may not claim them when mixed with a carrier. Cf. CD's 296,310. The decisions on 464, 465, 466 and 467 are essentially the same.

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The Rohm and Haas Company has filed an application in which it is claiming certain Pyridyl Phenyl-Carbamate Rodenticides. The serial number of the application is 163836 (Class 260/291.1), and the inventors are James E. Ware, et al.

Some of the claims (1-11 and 38-50) which are directed to new chemical compounds and their method of manufacture and use are considered to be allowable. However other claims, 12 to 37, were rejected. In them the applicant is claiming the same compounds as are covered by claims 1-11 in admixture with either unidentified ingredients, or with carriers. Claims 1, 12, 23, 28, 30 and 32 will serve to illustrate what is involved (claim 1 being typical of the allowable claims). We also included an amended claim 12 which the applicant now proposes. We agree that it more clearly defines what the applicant is attempting to claim, and will use it in our subsequent discussion.

1. A compound having the formula:



wherein X is selected from the group consisting of -NO<sub>2</sub>, -CN, -CF<sub>3</sub>, -SR, -SOR, -SO<sub>2</sub>R, and -SO<sub>2</sub>NH<sub>2</sub> wherein R is lower alkyl.

12. A rodenticidal composition comprising a rodenticidally effective amount of a compound in accordance with claim 1 or a mixture thereof.

23. A rodenticidal composition in accordance with claim 12, wherein said composition is in the form of a bait and further comprises an edible carrier.
28. A rodenticidal composition in accordance with claim 23 wherein said edible carrier is selected from whole ground corn, steel cut oats, sugar, molasses, rice, vegetable oil, salt, dehydrated fruit, fish meal, tankage, wheat, paraffin wax and acrylic polymer, and mixtures thereof.
30. A rodenticidal composition in accordance with claim 12 wherein said composition is in the form of a tracking powder.
32. A rodenticidal composition in accordance with claim 30, wherein said compound is present in an amount between about 0.75 and 100 per cent by weight and the remainder is a powdered carrier.

Proposed Claim 12:

12. A rodenticidal composition comprising a rodenticidal composition comprising a rodenticidally effective amount of a compound in accordance with claim 1, or of a mixture thereof, in association with one or more auxiliary substances conventionally used in such a composition.

We need not be concerned with the structure of the compounds themselves, or their chemical properties. Suffice it to say that these new carbamates are useful for exterminating rats and mice.

The examiner rejected the composition claims on the ground that they did not properly define the invention. It was his view that the invention resided in the compounds themselves, which are protected by claims 1-11 and the other allowable claims, and that claims 12 to 37 go beyond what is the invention. In all respects the rejection compares to that considered by this Board previously in the Agripat decision of June 25, 1976, involving patent application 132421, which was published in the Patent Office Record of May 17, 1977, beginning at page xvii. That decision was subsequently taken on appeal to the Federal Court of Canada in Agripat v Commissioner of Patents which affirmed the rejection on December 14, 1977, under Court file No. A-589-76. In an unanimous decision the Court (Coram: Justices Heald, Urie and Ryan) said:

We are all of the opinion that the Farbwerke Hoechst (1964 S.C.R.49), the Sandoz Patents (1974 S.C.R. 1336) and Rohm & Haas (30 C.P.R. 113) cases are indistinguishable on any valid grounds from the case at bar. The Commissioner, correctly, in our view, interpreted and applied the principles established in those cases, insofar as they are relevant to claims 5 to 11 inclusive herein. Accordingly the appeal is dismissed with costs.

There was no subsequent appeal to the Supreme Court.

Despite these developments, on March 8, 1978, the applicant requested that the Appeal Board and the Commissioner review the present rejection and give full reasons for whatever conclusion is reached. Having reviewed the prosecution of this application we are satisfied that the Agripat decision is applicable mutatis mutandis to the matter before us now, and we consequently refer the applicant to the reasons given in Agripat. In deference, however, to the most thorough and exhaustive arguments he has submitted, we will provide some elaboration to the earlier reasons.

As stated by the applicant (letter of February 4, 1977, page 1), the basic issue to be decided is whether a patent application which contains claims to a compound having a specified utility may also contain claims to compositions incorporating said compound with one or more carriers or other auxiliary materials. The examiner refused such claims on the grounds that they did not properly define the invention, relying on the findings in Gilbert v Sandoz (1971) 64 C.P.R. 14, and 1974 S.C.R. 1336 (where it is styled as Gilbert v. Gilcross). In that decision it was stated that claims to a pharmaceutical compound associated with a carrier:

... cannot stand as claims in respect of any inventive step involved in the mixture of a substance with a carrier since there is no invention involved in such a step. Vide Commissioner of Patents v. Farbwerke Hoechst, 41 C.P.R. 9 [1964] S.C.R. 49, 25 Fox Pat. C.99 [quoted from the decision of the Exchequer Court at p. 35, and adopted by the Supreme Court at p. 1339].

The examiner also relied on Rohm & Haas v. Commissioner of Patents (1959 Ex. C.R. 133), and said:

The inventive matter resides in the compounds themselves, there being no further invention in the mixture of the compounds with solid, liquid or liquified gaseous carriers. The addition of these carriers is merely to obtain a suitable mixture for application. There is no interaction between the compounds of the invention and these carriers; and no new and unexpected result in itself is obtained.

The main thrust of applicant's argument is that the reasoning adopted by the jurisprudence cited should not be applied to his invention because it is not a pharmaceutical. He contends that the Court's conclusions were influenced by Section 41, and consequently leaned to the public interest, against that of the patentee. We cannot, however, see that there is any substance to that proposition. The statement of the Court in Gilbert v. Sandoz, for example, is that there is no inventive step involved in the mixture of a substance with a carrier. Logically that objection is applicable to all substances, not just pharmaceuticals. Indeed in the most recent decision (Agripat) the invention was a pesticide, to which Section 41 does not apply. Similarly in the Rohm and Haas case the substance was a fungicide. We do not feel we should be tempted to look behind the clear statements in those decisions, and look for hidden meanings and exceptions, as the applicant invited us to do. Nor do we accept the proposition made "that the Supreme Court of Canada did not fully understand the situation" (response p.9) when it came to its conclusions.

The applicant has said that the Supreme Court contradicted itself ("appear to be in direct contradiction" is the wording used) if one looks at Commissioner of Patents v Farbwerke Hoechst (supra) and then at Sandoz v Gilcross because in one case it said compound plus carrier could not be claimed in separate patents, while in the other it said they cannot be in the same patent. We cannot see the contradiction. In Hoechst it did not say they could be claimed in the same patent when it said they could not be in separate patents. Taking the two decisions together, they stand for the proposition, we suggest, that it is improper to make the two types of claims either in separate patents or in the same patent where the situation is analogous to

that before the Courts, and now before us. Elsewhere in applicants final submission (p. 49) he says:

It is submitted that a person skilled in preparing rodenticides and in making up rodenticidal compositions could readily make an appropriate selection of conventional adjuvant materials to make up the claimed composition, in accordance with the particular type of composition desired.

This clearly demonstrates that there is no inventive step involved in the mixture of that substance with a carrier, and brings the composition claims directly within the interdiction expressed in Gilbert v Gilcross, and quoted previously.

We accept the applicants contention that patentability is not to be assessed against new matter which the applicant himself teaches in his own application, at least in the sense that it is not in itself prior art. We also agree with much of what he says about how claims are to be interpreted. But we cannot concede that he may claim everything in his disclosure, since the claims must define the invention itself, and not go beyond it. Section 36(2) of the Patent Act puts that limitation upon what he may claim. It requires that the inventor distinctly claim the part which is the invention. In B.V.D. v Canadian Celanese (1937) S.C.R. 221 (at 237) for example, claims which went beyond the invention invalidated the patent. Similarly in Bergeon v. DeKermor Electric 1927 Ex. C.R. 181 at 187 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.

The Court in that case also quoted with approval the following passage from Nicholas on Patent Law:

When the invention is for an improvement (as in this case) the patentee must be careful to claim only the improvement and to state clearly and distinctly of what the improvement consists. He cannot take a well known existing machine, and, having made some small improvements, place that before the public and say: "I have made a better machine. There is the sewing machine of so and so; I have improved upon that; that is mine, it is a much better machine than his." He must distinctly state what is, and lay claim only to his improvement. (underlining added)

This important principle of patent law is so long established that we find it stated almost 100 years ago in Moore v. Bennett (1884) 1 R.P.C. 129 at 143:

When a claim is made for a general combination and arrangement of the different parts of a machine, if the Court sees that the combination is not new, but that there is some particular improvement in some particular part, it will not do to claim the whole combination as new, but you must condescend upon that which is improved.

When we turn to the case before us, we find that mixtures of rodenticides with carriers are well known. The applicant has replaced the old rodenticide with a different one, one patentable in its own right. His claim should consequently be limited to that "improvement" over the prior art.

We refer also to Dick v. Ellam's Duplicator Company (1900) 17 R.P.C. 196 at 202, where we find:

.... I do think there is something in the invention, and that the invention might have been patentable if the Patentee had not thrown his net too wide as Patentees constantly do, to catch people who do not infringe the real invention.

and to Eli Lilly v Marzone Chemicals, Gibson J., Fed. Court Trial Div., July 11, 1977, at p. 33:

As the cases say, this statutory provision (Sec. 36-2) directs that an applicant may not make a covetous claim or overclaim.

In American patent law a somewhat similar objection is encountered in rejections based on "old combinations," or as it is also known "exhausted combinations." (cf U.S. Manual of Patent Examining Procedure, Sec. 706.03(j)). There is a considerable body of American patent law holding that when an applicant has improved one element of a combination which may be per se patentable, he is not entitled to claim the improvement in combination with old elements when the elements perform no new function in the claimed combination. See, inter alia, Ex Parte Hall 680 Official Gazette, p. 5; Ex Parte Silverstern 125 U.S. Pat. Quarterly at 238; Ex Parte MacNeil 100 O.G. at 2178; In re Latican 162 O.G. at 340; Ex Parte Mumford 206 O.G. at 873; Ex Parte Griffiths 1898 Decisions of the Commissioner at 233; Ex Parte Arbuckle 291 O.G. at 441 or 1921 Commissioners Decisions at 85; and the Grease Gun case, Bassick v Hollingshead, 298 U.S. 15. Risdale Ellis in his book on Patent Claims, Baker, Voorhis & Co., New York, 1949 said this about it on page 184:

The bar against claims which merely aggregate old elements with the combination forming the real invention is well expressed in the syllabus of Ex parte Griffith, 1898 C.D. 233, which reads:

An applicant after being allowed claims which fully and adequately cover his real invention should not be permitted to needlessly multiply such claims by the inclusion

of known elements which do not cooperate therewith to produce a new result or in any manner add to the patentable novelty of the device.

Most of the leading cases on exhausted combinations in the United States deal with mechanical inventions, but the principles enunciated therein clearly are of general applicability.

The applicant has drawn our attention to In re Bernhart and Fetter (1969) 163 U.S.P.Q. 611 at 618 where the U.S. Court of Customs and Patent Appeals (C.C.P.A.) has questioned the rationale adopted in exhausted combination rejections. However the C.C.P.A. is a lower court, and its remarks run counter to many decisions of the U.S. Supreme Court.

The applicant has argued that the rejected claims do not go beyond the actual invention made since they narrow the scope of the invention and create a lesser monopoly than do the claims to the compound per se. This however is merely a futile question of semantics. It could equally be said that such claims extend the monopoly, since they bring within the scope of the monopoly additional matter (the carriers) which are not part of the allowable claims.

The point is made that where the other elements of a combination form the natural setting for the element improved, the old combination should be patentable, and we are referred to the following passage from Ex parte Woodall, 40 U.S.P.Q. 131:

It seems to us that, inasmuch as appellant's fastener has special utility only when used with a recessed panel (underlining added) such as claimed, it is proper to claim the same in combination, despite the fact that similar organizations have appeared in the prior art. Where an element of an old combination has utility in various relationships and is not of a character which especially adapts it for combined use, it is of course proper to reject on the ground of old combination, but where the element of a combination has utility to its fullest extent only in such combination and no general utility, it is not believed proper to hold that it should not be claimed in the combination where it finds its full usefulness. (emphasis added by applicant).

Our comment on this is that the new compounds do not have special utility only when used with the carriers. As revealed on page 12 of the disclosure:

...there is no upper limit to the amount of compound which may be present in bait. Rats, mice and other rodents accept the compounds of the present invention so well that even when offered free choice between untreated basal ration and a bait consisting entirely of one of the present compounds, they ingest rodenticidally sufficient quantities of the compounds....(underlining added)

There is consequently no room for arguing that the compounds have special utility only when used with the carriers.

In another passage (p. 45 of the Final Response) the applicant has said:

It appears from the tenor of the Official Action (even though the Examiner may not have specifically said so in his report in so many words) that the Examiner considers the compositions of claims 12-37 inclusive as representing something which the applicants have not invented. If this is the Examiner's position, then applicants believe that such a position most definitely is unjustified, and has no valid basis. The Examiner does not have access to, nor possession of, the full records of the applicants' invention; therefore, he is not in a position to assess completely what the applicants have (or have not) invented. The only record the Examiner has before him is the specification of this application.

At the same time, on p. 49, he has put on record the following statement (which we quoted previously) which make it quite clear that the applicant could not have made any invention in mixing the new compounds with carriers:

It is submitted that a person skilled in preparing rodenticides and in making up rodenticidal compositions could readily make an appropriate selection of conventional adjuvant materials to make up the claimed composition, in accordance with the particular type of composition desired. The selection of the appropriate substances conventionally used for such a composition, for any particular requirement, is well within the skill of such a person, and said selection would not require inventive ingenuity on his(her) part. [underlining added]

The Continental Soya v Short Milling case (1942) S.C.R. 187 has been cited as one instance where the Supreme Court approved claims for both a new substance and a composition containing that substance, and that decision, it is said is counter to the holding of the Supreme Court in Gilbert v. Sandoz. We have studied the Continental Soya decision in detail, and do not see that it affords much help to the applicant. Compared to Gilbert, it is an old decision. The Court then did not have before it the same question as was decided in Gilbert. The claims for the bread were for a product of a baking process which in itself was found inventively patentable, whereas in both Gilbert and the present case there is admittedly nothing inventive in mixing the substances with the carriers. The bread in Continental was considered a separate invention from the bleaching enzyme, and the two were issued in separate patents.



In appendix B of his submission of February 4, 1977, the applicant has quoted statements from both the Sandoz decision and Burton Parsons v Hewlett-Packard (1975) 17 C.P.R. (2d) 97 to the effect that patents should not be invalidated on mere technicalities. We agree fully with that philosophy but obviously the objections to the carrier claims in Sandoz were not viewed as "mere technicalities." Similarly in Burton Parsons we find, at p. 97:

In Commissioner of Patents v Farbwerke Hoechst this Court held that the last step in the production of a drug in dosage form was not patentable because there is no invention involved in it.

In any event the refusal of these claims now does not affect the validity of the claims found allowable, and which will afford to the applicant the full protection to which he is entitled.

The issues related to the need for and propriety of multiple claims were considered in detail in the Agripat decision. To those reasons we would merely add two additional references.

The first is Christiani v Rice 1930 S.C.R. 443 at 461 (aff'd 1931-48 R.P.C. 511) which held that a patent cannot be converted into a different invention if the main claims fall. This is relevant to the applicant's argument that if the claims to the new compounds per se fall the applicant could then use the composition claims to protect what, it follows, would then be directed to a different invention from that defined in the main claims. (See also In re May & Baker, 1948 R.P.C. 255 & 67 R.P.C. 23).

The second is Eli Lilly v Marzone Chemicals Fed. Ct. C., Trial Div., July 11, 1977 at 34 (affd. Appeal Div. Fed. C.C., Mar. 7, 1978) which deals with the applicants concerns about "scientific curiosities" invalidating his claims to the compound. As was made clear in the Eli Lilly decision, for a defence of lack of novelty to succeed, references must give an exact description of the invention, and disclose a "practical utility" for the compounds. They may not be (p. 35) paper references, prior patents and publications not really possessing the "reality of use by the public." They must not be "abandoned scrap heaps of dust-covered books which tell of hopes unrealized and flashes of genius

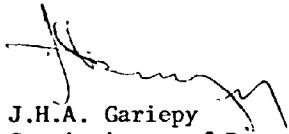
quite unrecognized. We think a disclosure of a "scientific curiosity" would fall in that category.

Having considered all the arguments of the applicant and answered them either here or in the prior Agripat decision, we are satisfied that the applicant is not by law entitled to be granted a patent, and that claims 12-37 inclusive were properly refused.



Gordon A. Asher  
Chairman  
Patent Appeal Board, Canada

I have reviewed the prosecution of this application and the recommendation of the Patent Appeal Board. I am satisfied that the applicant is not by law entitled to claims 12-37, and consequently refuse claims 12 to 37 inclusive. If any appeal is contemplated under Section 44 of the Patent Act, it must be taken within six months.



J.H.A. Gariépy  
Commissioner of Patents

Dated at Hull, Quebec  
this 5th. day of May, 1978

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