

COMMISSIONER'S DECISION

Section 38 and Rule 60

Alloys

The element cobalt is not included in claim 1, but is found in claim 6 as part of the alloy composition. The addition of cobalt does not alter the alloy properties to any extent, and does not constitute another invention.

Final Action: Reversed.

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This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated February 17, 1977, on application 169,228 (Class 75-122). The application was filed on April 10, 1973, in the name of Julius Heuschkel, and is entitled "Alloys For High Creep Applications."

The invention in this application is a ferrous alloy useful for castings for steam turbines.

In the Final Action the examiner rejected some of the claims on the ground that more than one invention is claimed because there is no single claim that can be considered as being broader in scope than any other claim. The basis for such rejection would be Section 38 and Rule 60. The two groups of claims indicated as being for separate inventions are claims 1, 6, 8 and 9 which form one group, and claims 2 to 5 and claim 7 the other.

In response to the Final Action the applicant has made some amendments which overcome some of the objections, but not all of them. The examiner still feels that the additional element Cobalt found in claims 6, 7 and 8 should also be present in claim 1 if the requirements of Rule 60 of the Patent Rules are to be met.

The question to be determined is whether more than one invention is being claimed.

Claims 1 and 6 read as follows:

1. In an apparatus operating under conditions requiring resistance to high creep exceeding load resistance of 1150 ton-hours, said apparatus having casings or fluid conductors, the improvement wherein at least a portion of said casings or fluid conductors include a ferrous alloy having the composition consisting essentially of the following weight percent:

C	-	0.078 to .201
Cu	-	.68 to 2.00
Ni	-	0.0 to 3.67
Mo	-	1.0 to 2.0
V	-	0.0 to 0.85
Si	-	0.0 to 0.53
Cr	-	0.0 to 2.5
Mn	-	0.0 to 0.091
W	-	0.0 to 2.00
Fe	-	Remainder

6. In an apparatus operating under conditions requiring resistance to high creep exceeding load resistance of 1150 ton-hours, said apparatus having casings or fluid conductors, the improvement wherein said casings or fluid conductors contain welds of a ferrous alloy having the composition consisting essentially of the following in weight percent:

C	-	.78 to .201
Mn	-	.032 to .091
Si	-	.04 to .53
Cu	-	.68 to 1.81
Ni	-	.56 to 3.67
Cr	-	.20 to 1.06
Mo	-	1.66 to 1.92
V	-	.41 to .85
W	-	0 to .20
Co	-	.008 to 1.01
Fe	-	Remainder

According to the disclosure the addition of cobalt to the basic alloy mix does not significantly affect the properties of the alloy. Paragraph 2 on page 4 states:

In accordance with this invention a ferrous (iron base) alloy for creep resistance coatings and weld metals is provided which includes the elements carbon, copper, molybdenum, vanadium, chromium, cobalt. The chromium is the least important of the first five elements; the presence of some cobalt is desirable but not essential.

From this it is clear that the addition of Cobalt to the other elements found in amended claim 1 does not effect the alloy's properties to such an extent that it could be considered there is a second invention. In our view Section 38 of the Patent Act is consequently satisfied.

If there had been some important change of properties when Cobalt is added we would not, of course have reached that conclusion. We also believe that if there had been several separate claims in which other additional elements were added to the principle alloy base, there might well have been grounds to object, either on the basis of Rule 43, or under Section 36 for failure to state distinctly in the claim what the real invention is.

We are satisfied that in the present case, however, these claims are not directed to more than one invention, and that such ground of rejection should be withdrawn.



G.A. Asher  
Chairman  
Patent Appeal Board, Canada

Having considered the arguments made in the prosecution of this application, and the recommendation of the Patent Appeal Board, I direct that the rejection made by the examiner should be withdrawn. The application is returned to the examiner for resumption of prosecution.



J.H.A. Gariépy  
Commissioner of Patents

Dated at Hull, Quebec

this 15th. day of May, 1978

Agent for Applicant

McConnell & Fox  
P.O. Box 510  
Hamilton, Ont.