

COMMISSIONER'S DECISION

Indefinite Claims Referring to Drawings: Antibiotic from streptomyces

Two claims had been refused by the examiner as indefinite because they referred to an infrared absorption spectrum shown in the drawings. The office held that since in this case it was difficult to accurately define the invention without reference to the drawings, the reference would be permitted.

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 December 16, 1975, on application 120,508 (Class 195-104). The application was filed on August 13, 1971, in the name of Julius Berger, and is entitled "Antibiotic From Streptomyces ATCC21386." The Patent Appeal Board conducted a Hearing on May 3, 1978, at which Mr. R. Fuller represented the applicant. Also in attendance was Mrs. J. Harding, from the same Firm.

The invention relates to a novel antibiotic designated as antibiotic X-5108, which is produced by a new species of Streptomyces, Streptomyces SP. X-5108. The antibiotic is active against bacteria and produces growth stimulation and increased feed efficiency in poultry.

In the Final Action the examiner refused claims 18 and 19 (present claims 9 and 10) because they "are indefinite." These claims refer to a diagram in the drawings. Other objections made in the Final Action have been overcome by amendment.

On the point of indefiniteness in the Final Action the examiner stated:

Further, claims 18 and 19 are indefinite. Reference to figures of the disclosure is not allowable. It has been the policy of this Office to have spectral data presented in tabular or descriptive form (see, for example, Canadian Patents 942,217 and 942,696).

In his response, dated June 10, 1976, to the Final Action the applicant has, inter alia, this to say:

...

In order to overcome the Examiner's objection in respect of claims 18 and 19 in that reference to figures of the disclosure are not allowable, applicants have included these figures in the claims concerned. They have taken this action because to identify compounds by spectral data identified either in tabular or descriptive form represents only a poor substitute for identifying the compound by reference to spectral diagrams. Thus as has been previously argued by applicants to define a compound by reference to either an infrared absorption spectrum or a nuclear magnetic resonance spectrum is the most satisfactory way of "finger-printing" it. Although applicants have been unable to find any basis for the Examiner's requirement in either the Patent Act or Rules that the claims be completely independent of any document referred to in the disclosure and earlier in the Rules the disclosure is defined as that part of the specification other than the claims, which presumably means that it includes the drawings, nevertheless they have taken the only other step which is available to them and have included the spectral diagrams in the claims themselves.

Applicants take issue however with the Examiner's contention that previous claims 18 and 19 were indefinite as there is no doubt that they clearly refer on the one hand to Figures 1 and 4 and on the other to Figures 2 and 3 and there could be no doubt that these were spectral diagrams clearly identifying the substances concerned. Consequently it is believed that the Examiner's requirement to present the spectral data in tabular or descriptive form as in Canadian Patents 942,217 and 942,696 is unreasonable particularly as this cannot be said to be the policy of the Office as the Patent Office have just as frequently accepted reference to drawings in order to fully identify substances in the same way as has been done in the present case.

...

The only consideration before the Board is whether present claims 9 and 10 should make reference to the drawings. Claim 9 reads:

A novel antibiotic substance effective in inhibiting the growth of gram-positive and gram-negative bacteria designated antibiotic X-5108, which is a yellow amorphous substance characterized as follows: (a) analysis: carbon, 63.63%; hydrogen, 7.81%; nitrogen, 3.48%; oxygen, 25.08%; (by difference); (b) soluble in methanol, ethanol, 1- and 2-propanol, tert.butyl alcohol, ethyl acetate, amyl acetate, butyl acetate and chloroform; (c) a characteristic infrared absorption spectrum as shown in accompanying attached Figure 1; (d) a characteristic nuclear magnetic resonance spectrum as shown in accompanying attached Figure 4; and physiologically acceptable cationic salts thereof whenever prepared by the process of claim 1, 2 or 3.

Section 36(2) of the Patent Act required that the claim or claims are distinct and explicit:

The specification shall end with a claim or claims stating distinctly and in explicit terms the things or combinations that the applicant regards as new and in which he claims an exclusive property or privilege.

It is clear then that a claim must be framed in language that is specific and distinct and admits of no doubt as to its meaning (see B.V.D. Co. Ltd. v Canadian Celanese Ltd. (1936 Ex. C.R. at 139), so that an addressee of the patent will, on a fair reading of the claim, be able to determine whether his proposal will infringe or not. A claim is not, therefore, an added description of the invention, but a limitation of the description of the invention contained in the body of the specification (see Gillette Safety Razor Co. of Canada Ltd. v Pal Blade Corpn. Ltd. [1932] Ex. C.R. 132; [1933] S.C.R. 142).

At the Hearing Mr. Fuller argued that in certain circumstances it is permissible to refer to the drawings, e.g. when it affords a method of "uniquely identifying" a particular compound. He also argued that it is inconsistent with Section 36(1) that the applicant be required to provide only part of the story when claiming, according to the direction of the examiner, the product embodiment of his invention. We tend to agree with the applicant that, under certain circumstances, defining a compound by reference to its infrared absorption spectrum, nuclear magnetic resonance spectrum or ultra violet spectrum is more distinct and explicit than presenting such spectral data in tabular or descriptive form.

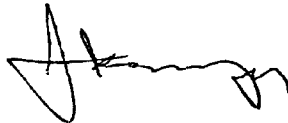
We are satisfied that in the present claims it is difficult to accurately define the product embodiment of the invention in distinct and explicit terms when the spectral data is presented in tabular or descriptive form only. In our view reference may be made to the drawings as indicated in claim 9. We hasten to point out that this does not, under any circumstances, give carte blanche approval to claim by reference to the drawings. The claims should only refer to the drawing in a situation where it is most difficult to define the invention in distinct and explicit terms without reference to the drawings.

We recommend that the decision in the Final Action to refuse claims 9 and 10  
(former claims 18 and 19) be withdrawn.



J.F. Hughes  
Assistant Chairman  
Patent Appeal Board, Canada

I have reviewed the prosecution of this application and agree with the recommend-  
ation of the Patent Appeal Board. Accordingly, I withdraw the objection  
against present claims 9 and 10. The application is returned to the examiner  
for resumption of prosecution.



J.H.A. Gariepy  
Commissioner of Patents

Dated at Hull, Quebec  
this 6th. day of June, 1978

Agent for Applicant

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