

COMMISSIONER'S DECISION

Subject Matter - Section 2 - Speech Training

The applicant sought to patent a text useful in speech therapy, said text to be read by patients to exercise their vocal cords. A claim to Copyright protection had previously been made. It was concluded that the instructional "device" claimed was not patentable. Issues considered were the patentability of schemes or plans, whether the process claims were reproducible, and the distinctions between Copyright protection and patent protection.

Final Rejection: Affirmed.

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On May 31, 1978, the Patent Appeal Board conducted a Hearing to consider the final rejection of application 159,203, Class 35-41. It had been filed on December 18, 1972, by Betty Young Dixon, under the title "Speech Instruction Method." At the Hearing the inventor was represented by Mr. Don Morrow.

The application describes a novel technique to improve the voices of individuals by means of a series of vocal exercises. Original claim 1 illustrates the subject matter rejected by the examiner:

1. A method of speech instruction comprising the following steps:
  - a) inducing a low level diaphragm supported cough accompanied by the sensation of the diaphragm pulling inwardly and downwardly and having an involuntary reflexive outward expansion of the muscles surrounding the diaphragm to develop an unbroken tussive column of air against the larynx;
  - b) enunciating a prescribed series of audible articulation shapes using a coughlike action similar to the induced cough under a) to hook such shapes onto the diaphragm and as a basis for complete diaphragm support of such shapes.

The claims and the application itself were refused on the grounds that they were not directed to proper subject matter within the meaning of Section 2 of the Patent Act.

Since the rejection the applicant has proposed amendments to the disclosure, claims, and title in an attempt to better define the invention. The title now proposed is "Speech Training Apparatus and Method." Of the 52 claims submitted by the applicant, claims 1, 16, 20, 35 and 38 are typical.

1. Material for use in improving human voice production and/or the pronunciation of language comprising a text which includes a series of word group structures, each of which word group structures is characterized by a selected dominant staccato shape present at least once in at least substantially all of the words of the word group structure, no two word group structures having the same dominant staccato shape, each word group structure being divided by first marker means into a plurality of rhythmic word units, the dominant staccato shapes in each word group structure being identified and visually emphasized by second marker means, the word group structures being selected and arranged so as to provide a progressively related sequence of staccato shapes.

16. A method of improving human voice production and/or the pronunciation of language comprising reading aloud the text defined in claim 1, 2 or 3.

20. A method of improving human voice production and/or the pronunciation of language comprising utilizing a text to read aloud a series of word group structures embodied in said text and ranged in a sequential series consisting of word group structures characterized by a dominant holding shape sound and word group structures characterized by a dominant vowel shade sound, each said word group structure being divided into a plurality of word units, said word group structures including means to indicate pauses between said word units, whereby the habitual set of the respiratory/phonatory system as herein defined is varied by causing said system to be subjected to each of said dominant sounds.

35. A method of producing a text for use in improving human voice production and/or the pronunciation of language comprising incorporating in said text:

- a) a predetermined series of progressively related word group structures each of which is characterized by a dominant staccato shape, holding shape or vowel shade, respectively, which in said series have a mechanical effect on the respiratory and phonatory system to vary (sic) the habitual set thereof;
- b) dominant sound indicating means for indicating each dominant shape or shade;
- c) pause indicating means for indicating, in a particular word group structure, locations at which repetition of said word group structure is to be interrupted.

38. A method of improving human voice production and/or the pronunciation of language comprising utilizing a receptive medium to read aloud a series of word group structures recorded on said medium and arranged in a sequential series consisting of word group structures characterized by a dominant staccato shape sound, word group structures characterized by a dominant holding shape sound and word group structures characterized by a dominant vowel shade sound, each said word group structure being divided into a plurality of word units, said word group structures including means to indicate pauses between said word units, whereby the habitual set of the respiratory/phonatory system as herein defined is varied by causing said system to be subjected to each of said dominant sounds.

By such amendments Mr. Morrow explained the applicant was emphasizing that the invention for which protection is sought is less a method of speech instruction than material useful in improving the human voice, such method claims as are now being made being for a method of using the material.

Mr. Morrow also submitted numerous affidavits testifying to the efficacy of the invention in improving the voices of many individuals. In addition, Mr. Morrow both at the Hearing and in his written submissions, has developed a series of ingenious arguments as to why the latest claims should be accepted.

Voice training and speech therapy are of course well known. Mrs. Dixon's improvement to the prior techniques lies in using a series of words, some of which produce staccato sounds to develop the diaphragm. Her claim 1, in its simplest form, is for a page or book of the appropriate words so arranged on the page that when repeated vigorously by the patient they exercise his diaphragm, and improve his voice. The drill can also be put on tape, recordings, or other material. According to the instructions in "Verses for Voice," the instruction booklet embodying the drills, and copyrighted in 1970-71 by Mrs. Dixon, results are affected by fatigue, strain, emotional upset, nerves, physical discomfort, or illness. It is, however, effective in remedying speech problems such as heavy accents, stuttering, nasality, excessive rapidity and mumbling, which problems are caused by tension in the throat and intercostal muscles. This in turn has affected the income of many individuals who have been promoted to more responsible positions, were offered roles in movies, and the like. In one instance a waitress at the Yellowfingers Restaurant in New York City increased her income in tips from "waitressing" by following the exercises. The training so improved her voice that she found it easier to "chit-chat" with customers, make them feel more relaxed and friendly, and consequently more generous. We are, consequently, satisfied that in many instances

the voice drills are effective in voice therapy, and in affecting the economic well being of those who follow them.

In making the rejection the examiner argued that the invention is not susceptible of industrial application, that it is directed to an instructional technique, that it is a series of instructions and drills for a cough technique, all of which are non-patentable. It was also said that the invention depends upon artistic or personal skills, and such fall outside the ambit of Section 2. The examiner contended the invention is not associated with trade, industry or commerce in the normal meaning of those terms, and is essentially non-economic, and that it is not controllable or reproducible since the results differ with the individual treated. To support his holding that the claims are unpatentable, the examiner cited Lawson v. Commissioner of Patents 62 C.P.R. 107.

For the applicant's part, Mr. Morrow has argued that Section 2 permits patents for "any new and useful art, process...", and that the invention is a new and useful art or process. He distinguishes from Lawson (supra) on the ground that:

In the reasons for decision in Lawson v Commissioner of Patents (1970) 62CPR101, it was stated that professional skills are not the subject matter of a patent, with the suggestion that if a surgeon were to devise a method of performing a certain type of operation, he cannot obtain an exclusive property or privilege therein. The unpatentability of such a method can be understood when one considers that it is the mind and the manipulative manual skill of the surgeon himself which is involved in the success of the operation. Nevertheless, articles or apparatus designed for use in the treatment of humans or animals, such as in a surgical operation may be patentable. In the present invention, the instructional method does not depend upon the mental or physical action, i.e. artistic or personal skills, of the teacher or professional deviser of the invention during operation of the method but rather upon the user following a set of instructions and carrying out the laid down procedure according to the defined method. The professional skill of the teacher does not enter into the method once it is in the hands of the user and the user alone is involved in practising the method.

It is noted that the Manual of the Patent Office suggests that a process which depends entirely on artistic or personal skills such as a procedure for exercising and teaching is unpatentable but goes on to indicate that materials and instrumentalities used in such an art may be patentable. Applicant maintains that the claimed method does not depend on the artistic or personal skill of the teacher but depends on the material provided in the form of an instruction for the user to proceed in a certain manner and to carry out certain operations in a specified order to achieve the desired result.

Having considered the Lawson decision, and the exhaustive analysis of Section 2 made by Mr. Justice Kerr in Tennessee Eastman v Commissioner of Patents 62 C.P.R. 117 (affirmed 1974 S.C.R. 111) we are satisfied that the examiner was fully justified in rejecting the claims that were before him. In the Lawson decision (at 109) the following quotations are pertinent:

I take it as well settled that all new and useful arts and manufactures are not necessarily included in s.2(d) of the Act.

In Farbwerke Hoechst Aktiengesellschaft Vormals Meister Lucius & Bruning v. Commissioner of Patents (1962), 39 C.P.R. 105 at p. 124, 22 Fox Pat.C. 141, Thorson, P., took the view that the words contained in the definition of "invention" were to be given their plain and ordinary meaning so that if an "art" or "manufacture" or "improvement" thereof was:

"... new and useful it is an invention within the meaning of the definition and, therefore, patentable under the Act, regardless of whether any inventive ingenuity was involved in it or not, and even if it was merely a workshop improvement or only an obvious advance over the prior art."

On appeal the view of Thorson, P., as above expressed was repudiated by the Supreme Court of Canada, Com'r of Patents v. Farbwerke Hoechst, 41 C.P.R. 9 at p.17, [1964] S.C.R. 49, 25 Fox Pat.C.99, Judson, J., stating:

"...until the question was raised in the reasons delivered in the Exchequer Court no one ever doubted the principle that invention is an essential attribute of patentability."

It is, therefore, clear that words of limitation must be read into s.2(d).

The narrow issue is whether the word "art" in the definition, includes a means of describing the boundaries of a plot of land and whether a piece of land subdivided into lots, the boundaries of which are delineated by curved lines in the shape of a champagne glass constitutes an "art" or "manufacture" within the meaning of that word as included in s.2(d).

An art or operation is an act or series of acts performed by some physical agent upon some physical object and producing in such object some change either of character or of condition. It is abstract in that it is capable of contemplation of the mind. It is concrete in that it consists in the application of physical agents to physical objects and is then apparent to the senses in connection with some tangible object or instrument.

In the earlier development of patent law, it was considered that an invention must be a vendible substance and that unless a new mode of operation created a new substance the invention was not entitled to a patent, but if a new operation created a new substance the patentable invention was the substance and not the operation by which it was produced. This was the confusion of the idea of the end with that of means. However, it is now accepted that if the invention is the means and not the end, the inventor is entitled to a patent on the means.

and: It is obvious from the concluding portion of the above quotation that professional skills are not the subject-matter of a patent. If a surgeon were to devise a method of performing a certain type of operation he cannot obtain an exclusive property or privilege therein. Neither can a barrister who has devised a particular method of cross-examination or advocacy obtain a monopoly thereof so as to require imitators or followers of his methods to obtain a licence from him.

It seems to me that a method of describing and laying out parcels of land in a plan of subdivision of a greater tract of land in the skill of a solicitor and conveyancer and that of a planning consultant and surveyor. It is an art which belongs to the professional field and is not a manual art or skill.

I, therefore, conclude that the method devised by the applicant herein for subdividing land is not an art within the meaning of that word in s.2(d).

and: "Manufacture" connotes the making of something. Thus it is seldom that there can be a process of manufacture unless there is a vendible product of the process. It must accomplish some change in the character or condition of material objects.

and: In rejecting the present application, the Commissioner of Patents concluded, amongst other objections mentioned above, that the subject-matter disclosed in the application was in substance and essence merely a plan for the layout of land. In view of my conclusion that the superimposition of a plan of subdivision on a larger tract of land does not result in a change in the character of the land, it follows that there is merit in the Commissioner's conclusion.

In support of his position the Commissioner referred to "Re Application for a Patent by E.S.P." (1945), 62 R.P.C. 87.

This was a patent application for a patent entitled "Improvements in building constructions" relating to the layout of contiguous houses in a row or terrace. After pointing out the economic advantages [underlining added] of building houses in rows, the specifications then stated the disadvantages that they do not as a rule add to the adornment of a town and they offer but comparatively little privacy, the tenants being exposed to the eyes of neighbours on either side. The object was to eliminate these disadvantages while retaining the advantages of the system of building in rows.

The relevant claim reads as follows:

"A building construction comprising a plurality of contiguous buildings forming an integral block, alternate buildings being set back at front and rear, that is to say one building is set forward relatively to the common centre line of a continuous roof common to all the buildings by the same amount as an adjacent and contiguous building is set back from said common centre line."

The superintending Examiner said:

"It is clear from this claim and from the description and drawings that the alleged invention is, in essence, merely an architect's plan or design for the lay-out of the individual houses in a row of houses. It has never been the practice of this Office to regard such plans or designs as 'matters of new manufacture' within the meaning of Section 93 of the Acts, and to grant patents for them would, in my opinion, be an unfair restraint on the normal use of an architect's designing powers in the exercise of his profession. Mr. Armstrong submitted that the Applicant's lay-out involved a new principle of building construction, but I am unable to accept this view. No novelty is even alleged for the building methods employed in the actual construction, and the individual houses in the row do not differ in any mechanical or constructional sense from other houses. The sole advantages alleged for the lay-out are that it adds to the appearance of the town or district in which the rows of houses are erected and secures greater privacy for the tenants of the individual houses; these are matters which in my opinion belong to the province of the architect rather than the manufacturer."

The reasoning of the superintending Examiner as it applies to the analogous facts in the present application appears to me to be preferable to that adopted by the U.S. Board of Appeals.

It is also instructive to refer to the following extracts from the Tennessee

Eastman case (supra) (62 C.P.R. 117):

The ground on which the Commissioner refused to grant a patent to the applicant was that the method for surgically bonding the surfaces of body tissues as covered by the claims in the said application does not constitute patentable subject matter under subsection (d) of section 2 of the Patent Act, in that it is neither an art, or a process within the meaning of said subsection.

and: Counsel for the respondent submitted, inter alia, that the method has no relation to trade, commerce or industry or to the productive or manual arts, but is rather a surgical method related to the treatment of the human body and, as such, is essentially non-economic and in the realm of the fine arts, and therefore, is not a proper subject for a patent.

and: In a very recent decision dated April 7, 1970, Cattnach, J., said in Lawson v. Com'r of Patents, [62 C.P.R. at pp.109-10]:

"An art or operation is an act or series of acts performed by some physical agent upon some physical object and producing in such object some change either of character or of condition. It is abstract in that, it is capable of contemplation of the mind. It is concrete in that it consists in the application of physical agents to physical objects and is then apparent to the senses in connection with some tangible object or instrument.

"On the assumption that what is being applied for is a patent for a method and that 'method' is synonymous with 'art', I turn to a consideration of whether the alleged invention is an art within the meaning of that word as contained in s.2(d)."

He then quoted the following excerpt from the decision of Dixon, C.J., in National Research Development Corpn's Application [1961] R.P.C. 135 at p.145:

"The point is that a process, to fall within the limits of patentability which the context of the Statute of Monopolies has supplied, must be one that offers some advantage which is material, in the sense that the process belongs to a useful art as distinct from a fine art (see Virginia-Carolina Chemical Corporation's Application [1958] R.P.C. 35 at p.36) - that its value to the country is in the field of economic endeavour. (The exclusion of methods of surgery and other processes for treating the human body may well lie outside the concept of invention because the whole subject is conceived as essentially non-economic: see Maeder v. Busch (1938) 59 C.L.R. 684 at p. 706.)"

and held that the method which he was considering is an art belonging to the professional field and not a manual art, and, therefore, is not an art within the meaning of that word in s.2(d). He held it clear that words of limitation must be read into the section.

and: In Maeder v. Busch (1938), 59 C.L.R. 684, a process for permanent waving of hair on the head was considered by the High Court of Australia. Dixon, J., asked the question "Can the discovery of improvisation of a mere process or method of treating any corporeal part of the human being afford subject matter for a patent?" and in answering it said, at pp. 705-7:

"... To be patentable an invention must relate to an art. Perhaps the widest statement is one of the earliest. In Boulton v. Bull (1795) 2 Bl.&, at p.492: 126 E.R. at p.666), Eyre L.C.J. said:- 'It was admitted in the argument at the Bar, that the word "manufacture" in the statute was of extensive signification, that it applied not only to things made, but to the practice of making, to principles carried into practice in a new manner, to new results of principles carried into practice. Let us pursue this admission. Under things made, we may class, in the first place, new compositions of things, such as manufactures in the most ordinary sense of the word; secondly, all mechanical inventions, whether made to produce old or new effects, for a new piece of mechanism is certainly a thing made. Under the practice of making we may class all new artificial manners of operating with the hand, or with instruments in common use, new processes in any art producing effects useful to the public.' But the ultimate end in view is the production or treatment of, or effect upon, some entity. 'Applications of old things to a new use, accompanied by the exercise of inventive power, are often patentable though there be no production of a new thing. But in every case the invention must refer to and be applicable to a tangible thing. A disembodied idea is not patentable' (Edmunds and Bentwich, Copyright in Designs, 2nd ed. (1908), pp.20,21.)



"In the present case there is nothing to be affected but the hair. The chemical compounds already exist. The use of them, the application of heat and the method of treatment constitute nothing but method, procedure, treatment or process. Can the hair growing upon the human head be regarded as satisfying the condition that the process shall in some way relate to the productive arts? It is part of the human body, and hitherto none of the prosthetic processes by which any of its parts have been treated has been considered subject matter for a patent. Indeed in Re C. & W.'s Application (1914) 31 R.P.C. 235, Lord Buckmaster, as a law officer, held that no patent could be obtained for extracting lead from the human body. In surgery it would not be easy to distinguish as a patentable invention an abdominal operation from face lifting. The application of a process or method of treatment to part of the human body for the purpose of improving its appearance or ameliorating its condition is distinguished from processes which may form the subject of patentable invention in aim and result. The aim is the alteration of some state or condition, feature or attribute belonging temporarily or permanently to a person. The result may be an improvement in his or her physical welfare or an increase in his or her pride of appearance. It is difficult to base any legal distinction on the motive or purpose of the operator or manipulator or on the vocation he pursues. It can hardly matter whether he acts in the exercise of a profession or art or trade or business. The purpose of the patentee and those intended to employ the process may be entirely commercial. The process may be intended for use in ordinary trade or business such as that of hair-dressing, manicure, pedicure. The purpose, on the other hand, may be the relief of suffering by surgical or manipulative means. But the object is not to produce or aid the production of any article of commerce. No substance or thing forming a possible subject of commerce or a contribution to the productive arts is to be brought into existence by means of or with the aid of the process.

and: The same process for permanent waving came soon afterwards before the Court of Appeal of New Zealand in Maeder v. "Ronda" Ladies' Hairdressing Salon and Others, [1943] N.Z.L.R.122, Myers, C.J., and Johnston, J., (Kennedy, J., expressing no opinion) held that a process, to be patentable, must at least have relation in some way to the production of an article of commerce.

and: In my view the method here does not lay in the field of the manual or productive arts nor, when applied to the human body, does it produce a result in relation to trade, commerce or industry or a result that is essentially economic. The adhesive itself may enter into commerce, and the patent for the process, if granted, may also be sold and its use licensed for financial considerations, but it does not follow that the method and its result are related to commerce or are essentially economic in the sense that those expressions have been used in patent case judgments. The method lies essentially in the professional field of surgery and medical treatment of the human body, even although it may be applied at times by persons not in that field. Consequently, it is my conclusion that in the present state of the patent law of Canada and the scope of subject-matter for patent, as indicated by authoritative judgments that I have cited, the method is not an art or process or an improvement of an art or process within the meaning of s.2(d) of the Patent Act. (underlining added)

We ourselves are satisfied that the process in question "does not lay in the field of manual or productive arts." There may well be present some indirect economic advantages, just as the practise of the skill of an architect or of a surgeon has indirect economic advantages both to the surgeon in the form of fees and to the patient whose income benefits from improved health, but as was held in the Tennessee Eastman case, these are not results "related to commerce or ... essentially economic in the sense that those expressions have been used in patent case judgements."

Similarly we believe the method lies essentially in the professional <sup>skill</sup> ~~fields~~ held unpatentable in the same decision. We have noted above that the results achieved are variable, depending upon the individual and the state of his or her health and emotions.

It is said in Mrs. Dixon's own affidavit (para. 6) that "There is no reason why the method cannot be effectively practiced, with the aid of the book, without any personal instruction whatever." In Mr. Fryer's affidavit, however, we find that

[Mrs. Dixon] is particularly concerned because speech work is so delicate and so important for many people. If the concepts embodied in the red book could be stolen and used indiscriminately by untrained people, this very valuable work would suffer irreparable injury.

The affidavits of Belinda Bauer and Joanne Mellia also bring out the importance of the personal guidance and instruction given by Mrs. Dixon in producing effective results. Others refer to her "teaching" and "coaching" expertise. We are consequently satisfied that the training method is in large part dependent upon the professional skills of the instructor.

By virtue of the claims submitted on May 30, Mr. Morrow now proposes to shift emphasis from the method of speech instruction to what is referred to as a "training device," and the method of using it. The device in its simplest form is, as indicated above, a page of text or a booklet of instructions, such as the "Verses for Voice" referred to earlier. These,

he submits, are patentable as a particular means for teaching, and relies upon the decision of the U.K. Patent Appeal Tribunal in Pitman's Application (1967) R.P.C. 646 in support of that contention. He has noted that the Pitman application matured to patent in the United States (3407515, Oct. 29, 1968) and in the United Kingdom. He has also drawn our attention to Mrs. Young's Australian patent 50,297, Dec. 20, 1972 in which method claims similar to those now advanced in Canada were issued. In addition he also provided a transcript of the decision of the U.K. Patent Appeal Tribunal in the Matter of the Application of Betty Young Dixon, May 20th, 1976, refusing Mrs. Dixon's corresponding U.K. application.

In the Pitman case Sir Isaac Pitman claimed an improved method of teaching the pronunciation of language by conveying visually to the reader the correct stressing and inflexion and phases of a text. Claim 1 reads:

A printed sheet or film carrying a word or words in alphabetic writing and in which the conventional format of the printing is modified by employing relatively more visually significant characters for stressed syllables or words, and relatively less visually significant characters for unstressed syllables or words; and the position of individual characters or groups of characters constituting a syllable is varied, relative to the mean axis of the line of writing, according to the nature of the inflection required to be given to the spoken word.

An example of what a sheet would carry is:

Table 2

THERE are FOUR ASPECTS of LEARN<sup>i</sup>ng a FOrEign LANGUAGE. FIRST of ALL, Eve<sup>r</sup>y ONE WANTS to be Able to LIsten to it with UNderSTAND<sup>i</sup>ng and THEN be Able to SPEAK it and be UNderSTOOD. THEN, of COURSE, THEY WANT to be Able to READ it and ALSO to WRITE it.

The application was refused in the U.K. Patent Office on the grounds that what was involved is only an arrangement of words upon the sheet. To quote:

The present objection is based on an old direction of the Law Officers, dating from 1899, and quoted in the judgment in Fishburn's Application (1940) 57 R.P.C. 245 at 246, lines 49 et seq. This reads "Generally speaking, patents can properly be refused in any case in which...the only material is a printed sheet, ticket, coupon, or its equivalent, and the only alleged invention an arrangement of words or the like upon such sheet." From several later precedent cases, it is clear that this rule is subject to certain exceptions, one such, set out in Fishburn's Application itself, at page 247, line 15, being the case in which the real object of a particular arrangement of the words printed upon the sheet "is to serve a mechanical purpose." Instances of the operation of

this exception are found in Cooper's Application (1902) 19 R.P.C. 53, where an application was allowed for a printed sheet in which spaces were left in the printing to facilitate reading when the sheet was folded, and in Fishburn's case, where a ticket had information printed on it in duplicate and so arranged that, when the ticket was divided either transversely or longitudinally each section carried the information. Another instance appears in the American Optical Co.'s Application [1958] R.P.C. 40 at 45. Here an application was allowed for a cinematograph film on which the images were distorted in a particular way. When used with a projector and a functionally related screen, the pictures were seen undistorted. Cases where printed sheets or the equivalent were refused include Johnson's Application (1902) 19 R.P.C. 56, where the alleged invention was a sheet carrying certain printed matter intended to enable a certain system of business correspondence to be carried out, and C's Application (1920) 37 R.P.C. 247, which comprised a musical notation wherein the sharps and flats were contrasted with the natural notes by being printed in colour, shape, size, shade or design.

The Hearing Officer concluded that the newness of the alleged invention lies in so printing the syllables that they convey additional information to what they impart to the reader if printed in a conventional matter. Such additional information he considered entirely intellectual, and he was unable to distinguish Pitman's application from that found in C's Application (supra).

On appeal the Patent Appeal Tribunal reversed, distinguishing from C's Application on the basis that Pitman's sheets possessed a functional purpose when used in conjunction with speaking machines.

Mr. Morrow has argued that Mrs. Dixon's application should be allowed unless the Pitman case can be distinguished from it. We think that distinction can be made. Mrs. Dixon's text does not produce a functional effect in a mechanical device. In our view it does not serve a mechanical purpose. We do not view the vocal apparatus of the human body to be a mechanical device in the patent sense. If we did then all books, whether literary or otherwise, would become patentable in addition to being copyrightable since reading them aloud produce effects upon the human vocal system.

We come next to the decision of Mr. Justice Whitford, May 20, 1976, before the U.K. Patents Appeal Tribunal. In arguing for the appellant, Mr. Jeffs described the alleged invention, and quite properly, we believe, as "...quite a complex treatment in itself. It involves a considerable number of exercises, the cough technique, and so on (transcript of proceedings, p.9, underlining added).

Counsel for the Commissioner maintained it was a scheme or plan. To quote:

Of course it is physical in the sense that the voice when trained by this is a better voice than it was before. So also is a method of training a fast bowler, it makes him a better and faster bowler than before. There have been many other schemes or plans. The concept of a third back in football invented in the 1930s was a scheme or plan, but it would be absurd to suggest that the manager of the football team who invented that could have got a patent for a third back to stop other people using it. There would be two kinds of referee, a judicial referee and the referee on the football field in that case.

The court considered the "liberalizing" approaches taken by the U.K. courts in recent years in re Swift's Application 1962 R.P.C. 37; the National Research Development Corporation case 1961 R.P.C. 134; the Cementation Company Limited's Application 1945, 62 R.P.C. 151; in re Palmer's Application 1970 R.P.C. 598; and Schering A.G.'s Application (1971 R.P.C. 339) (all of which we have ourselves considered in several occasions, - see for example in re IMC Chemicals Application, Patent Office Record, Dec. 20, 1977, p. xiv). The U.K. court rejected the British application, but Mr. Morrow says the U.K. decision dealt with claims similar to the claims rejected by the examiner, and did not consider the new claims now filed. However we note that the Court also considered "whether there was in fact disclosed in the body of the specification a manner of manufacture on which it would be or might be possible to draft a supportable claim." Its conclusions were as follows:

If we come to the sort of claim which I think stands the best chance of success so far as the applicant is concerned, namely, claim 31, what we are going to find claimed is a printed text carrying speech instructing means as claimed, for example, in claim 19. That will be a printed text setting out a plurality of words, each of which deals predominantly with one sound, which you in fact get repeated, a printed text which will tell the student how to provide diaphragm support for the particular

shapes, if I may use the word favoured by the applicant, which he is going to enunciate in sequence and there will be underlining which will draw his attention at any given moment to the particular shape which he ought to be enunciating and there will be markings which will show how the series of words which are being enunciated in sequence can best be divided into rhythmic word groups, though the actual choice at any given time of particular sounds and the actual division into particular rhythmic groups forms no part of the invention as claimed.

I am unable, as I think the Principal Examiner was, to find in a proposal of this kind any suggestion for a representation which can in any way be said to resemble the sort of representation which it was thought proper to support in relation to the claims in Pitman's Application. Fully conscious though I am of the extreme desirability of extending the protection afforded by patents to any field of endeavour in which a man's skill and art can be usefully applied, I think it must stand recognised that there are limits. I refer to the desirability of protecting the useful application of a man's skill and art, because that is a quotation from a very well known case of some antiquity. It must be recalled that it was used in the context of an application which was concerned with what could undoubtedly be described as a purely commercial enterprise.

I think the Principal Examiner has correctly concluded that there is not disclosed in the application before me anything which could properly be protected under our present Act, notwithstanding the liberalisation of the approach to questions of manner of manufacture that has occurred in recent years. The appeal must, accordingly, be dismissed.

Since in the earlier decisions we concluded we should not go so far as the British decisions, we do not think we should outpace them now.

The applicant has referred to a prior decision of the Commissioner in re Eward Fitz, P.O.R. June 4, 1974, p. viii, but we do not find that comparable. It dealt with a measuring method, and so differs from applicants invention.

For his part, the examiner referred to In the Matter of an Application for Patent by C, 1920 R.P.C. 247 in which a new method of notation for writing music for pianos was refused. We have found it helpful.

This case raises certain questions as to whether what may be copyrightable may also be patented, or registered as an industrial design. We perceive each of the enactments protecting different forms of intellectual property as being separate and distinct and that copyrightable material may not be patented. Otherwise the Copyright Act is redundant. This does not mean that the same

idea may not give rise to different embodiments or aspects, some of which may be protected by one piece of legislation, and others by another.

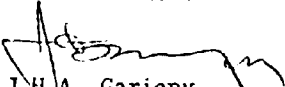
It does mean, however, that exactly the same embodiment cannot be protected by two of these enactments, for once the patent on an embodiment expires, seventeen years after grant - anyone must be free to copy that embodiment. But if that embodiment is also protected by Copyright, the originator could still prevent others from copying the embodiment both during his lifetime and through successors in title, for fifty years thereafter. Yet this is what Mrs. Dixon proposes to do. In this application she seeks patent protection for exactly the same embodiment to which she has already laid claim to copyright protection (see the title page of Verses for Voice, one of the exhibits supplied to us. This double protection for the same thing cannot be provided. We perceive the nature of the claims to be copyrightable, not patentable, and Mrs. Dixon to be estopped from alleging otherwise by her own prior assertion to copyright protection.

We are consequently satisfied that the examiner was correct in rejecting the application, and recommend that his rejection be affirmed. We recognize, of course, the value of Mrs. Dixon's contribution to speech therapy, and in no sense wish to deprecate them. We must also commend Mr. Morrow for both the ingenious and ingenuous manner in which he has represented his client in a most difficult case.



Gordon Asher  
Chairman  
Patent Appeal Board, Canada

Having considered both the prosecution of this application and the recommendations of the Patent Appeal Board, I now reject this application for failing to satisfy the requirements of Section 2 of the Patent Act. I take this action under Section 42 of the Patent Act, and direct the applicant's attention to Section 44 of the Act.



J.H.A. Gariepy  
Commissioner of Patents

Dated at Hull, Quebec  
this 9th. day of August, 1978

Agent for Applicant

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