

COMMISSIONER'S DECISION

SECTION 36: Claims for Compounds with Carriers

The applicant claimed a process to make new compounds, the new compounds themselves, a method of using the compounds, and insecticidal compositions comprising the compounds with carriers. The latter set of claims having been refused in a final rejection, the applicant removed the claims to the compounds, and argued that with their deletion he was entitled to retain the composition claims. It was held that in the present circumstances the composition claims did not properly define the invention. See C.D. 296, 310, 461, 464, 465, 466 and 467.

Rejection: Affirmed

Under Rule 46(5) of the Regulations made under the Patent Act, the owner of patent application 188750, Class 260-315.1, has asked that the prosecution of the application be reviewed by the Commissioner and the Patent Appeal Board. The application was filed on December 31, 1973 by Celamerck GMBH, a German company, the assignee of the inventors, Thomas Klaus et al. The invention relates to Insecticidally and Acaricidally Active compositions.

At the time of the rejection, the application included claims to a method of preparing certain novel imidazolidine compounds, to the new compounds, to a method of applying the new compounds to insect infested areas, and to compositions comprising the compounds mixed with diluents and carriers. There were thus four types of subject matter claimed:

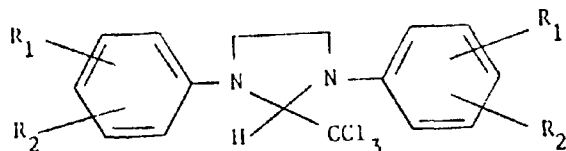
- (1) a process to make the compounds
- (2) the compounds
- (3) a method of using the compounds
- (4) compositions comprising the compounds with carriers

The examiner rejected the composition claims on the ground that they are not inventively different from the claims to the compounds. He relied upon Gilbert v. Sandoz (1971) 64 C.P.R. 14 (Ex. Court) and (1974) S.C.R. 1336 as authority for his rejection.

The applicant requested that consideration of the rejection be delayed pending the outcome of the appeal taken from a Commissioner's decision taken on a similar case, Agripat v Commissioner of Patents, published in the Patent Office Record of May 17, 1977, beginning at page xvii. The appeal to the Federal Court of Canada affirmed the Commissioner's decision on December 14, 1977, under Court file no. A-589-76.

On April 12, 1978, the applicant proposed an amendment in which he proposed to delete the claims to the compounds (which had not been refused), and to retain claims to the composition (which had been refused). He also wishes to maintain claims to the process of preparing the compounds, and to the method of using the compounds (but not the composition). Proposed claims 1, 2 and 3 are typical of the new claims.

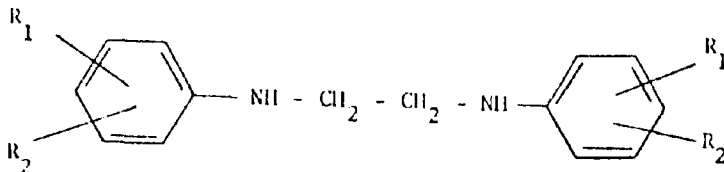
1. An agent which comprises one or more compounds of the formula:



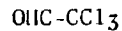
(wherein R_1 and R_2 , which may be the same or different, each represents a hydrogen or halogen atom or a nitro or lower alkyl or alkoxy group in the 3-, 4- or 5-position) or an acid addition salt thereof alone or in admixture with a solid diluent or carrier in the form of a wettable powder, granulate or dusting powder, a liquefied normally gaseous diluent or carrier, a liquid diluent or carrier in the form of emulsifiable concentrate, solution or colloidal dispersion, or one or more known insecticides or acaricides.

2. A method of preventing or inhibiting the growth or proliferation of insects and/or acarids which comprises applying to a site infested with or susceptible to infestation by insects and/or acarids an effective amount of a compound of formula 1 as defined in claim 1 or an acid addition salt thereof.

3. A process for the preparation of compounds of formula I as defined in claim 1, or an acid addition salt thereof, which comprises reacting a compound of the formula



(wherein R₁ and R₂ are as defined in claim 1) with a compound of the formula:



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whereby a compound of formula I is obtained and, if desired, subsequently converting the compound of formula I thus obtained into an acid addition salt thereof.

It should be noted that while claims 2 and 3 refer to claim 1 they bring in only the compounds forming part of claim 1, and not the complete compositions of that claim. They are not for methods and processes for preparing and using the compositions containing carriers to which claim 1 is directed. Put differently claims 2 and 3 refer to only a part of claim 1 for definition, and in no way are they dependent on claim 1. With that explanation in mind we will be referring subsequently to three sets of claims as for

1. A process of preparation of compounds

2. A method of using compounds

and 3. Composition claims

While there had been extensive arguments in the earlier prosecution about the applicability of the Gilbert v Sandoz decision to the claims then on file, all that was said by the applicant about the claims proposed now is:

Thus, in the revised set of claims no separate claims are directed to compositions. It is believed, therefore, that the application is not open to any objection based on the Gilbert vs. Sandoz decision.

In the absence of any elaboration as to why this should be so, we take it as applicant's position that Gilbert-Sandoz stands for the proposition that he may claim either the compound or the composition, but not both. What we must determine, then, is if this is so.

In the Final Action, the Examiner said:

The rejection of claims 1 to 8 and 23 is maintained and the reason for such rejection is that the said claims are directed towards unpatentable subject matter in that they are not inventively different from the composition of matter claims 17 to 22. In the Gilbert vs. Sandoz decision (64 CPR 14) quoted in the Office Action of November 4, 1976 it has been established that claims to compounds when associated with other substances are not inventively different from claims to the compounds themselves and that such claims cannot therefore be allowed in a patent. Thus at page 35 of the Canadian Patent Record [Reporter] reference cited above, it was stated that:

"I find, therefore, that the discovery of the usefulness of thioridazine, and the usefulness of the chemical procedure for producing it represents a patentable invention. On the other hand I am also of the opinion that pharmaceutical compositions consisting of a therapeutically acceptable amount of thioridazine associated with a carrier represent no invention whatsoever save insofar as thioridazine itself is an invention" and further:-

"... and, third, that since an invention of pharmaceutical compositions was made, as distinct from the invention of thioridazine itself which is fully claimed in claims 1 to 9, there is no basis for the presence in the patent of claims 10 and 11 (i.e. the pharmaceutical composition claims).

These last-mentioned claims, as I see it, 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 ...".

The court has thus established the principle, that when a novel compound is claimed, claims to the compound when mixed, or in association with other substances as carriers and/or diluents are not patentable since the inventive concept resides in the compound itself and is fully protected by the claims to the compound itself. It is considered that this principle applies to the claims rejected in this application since the inventive matter resides in the products themselves which are already claimed, there being no further invention in the mixture of the compounds with a carrier. The addition of these carriers and/or additives is merely to obtain a suitable method for application. There is no interaction between the compounds of the invention and these carriers and/or additives and certainly no new and unexpected result in itself is obtained. Claims 1 to 8 and 23 are accordingly rejected.

We take this as being quite clear that the examiner was rejecting the composition claims for failing to define the invention properly, and consequently contravening Section 36. He has not tied his rejection to the presence of the compound claims. He has said that the inventive matter is the compound, and that the composition claims do not properly define the invention.

If we turn to the decision of the Exchequer Court in Gilbert v. Sandoz, supra, at p. 35, we find:

I find, therefore, that the discovery of the usefulness of thioridazine and of the usefulness of the chemical procedure for producing it represents a patentable invention. On the other hand I am also of the opinion that pharmaceutical compositions consisting of a therapeutically acceptable amount of thioridazine associated with a carrier represent no invention whatsoever save in so far as thioridazine itself is an invention.

With respect to the objection that there was no invention the effect of these findings, as I see it, is first, that, no consequences flow from the finding that there was no invention of the class of phenothiazines since the patent contains no claim and purports to give no monopoly of any such class; second, that no consequence adverse to the patentee flows from the finding that there was a patentable invention of thioridazine since in this respect the objection is not sustained and, third, that since no invention of pharmaceutical compositions was made, as distinct from the invention of thioridazine itself which is fully claimed in claims 1 to 9, there is no basis for the presence in the patent of claims 10 and 11.

These last-mentioned claims, as I see it, 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 Comm'r Pat. v. Farbwerke Hoechst A.G., 41 C.P.R. 9, [1964] S.C.R. 49, 25 Fox Pat. C.99. Nor can they stand as claims in respect of the invention of thioridazine itself both because claims 1 to 9 represent the full extent of the protection to which the defendant is entitled in respect of that invention and because in the context of all the claims they tend to go further than the protection to which the defendant is entitled, as defined in s. 46 of the Patent Act, in respect of the invention of thioridazine and to monopolize, independently of the other claims, compositions containing thioridazine, and thus to restrict the use of thioridazine in a particular way even by one into whose possession it may lawfully come whether by express or implied or compulsory licence.

In its own consideration the Supreme Court also held that the composition claims did not define the invention, saying at p. 1339:

I agree with this conclusion of the learned trial judge and this makes it unnecessary to consider the further reasons he advanced against the validity of claims 10 and 11.

We thus take it as evident that the composition claims were refused because they did not define the invention. We find no indication that they were refused because the compound claims were present. The product claims were referred to solely to indicate that they were the ones which properly defined the invention present.

In the Agripat decision referred to above, and affirmed by the Federal Court, it was made quite clear that the objection to the composition claims was predicated upon the fact that they failed to define the invention, since the invention resided in the compounds. The rejection was not based upon

the presence of the compound claims. The following extracts from that decision indicate what we have in mind:

Claims must define the invention itself, and not go beyond it. Section 36(2) of the Patent Act is statutory authority for that statement. It requires that the inventor distinctly claim the part which is the invention. What we must decide is how far an applicant may go in achieving the goal of protecting his invention fully without overstepping the limits of the invention by claiming what is not rightfully his. For to paraphrase what was said by the Supreme Court in B.V.D. v Can. Celanese (1937) S.C.R. 221 at 237, if the claims in fact go beyond the invention, the patent is invalid.

...

In Bergeon v. DeKermor Electric, 1927 Ex. C.R. 181, at 187, Mr. Justice Audette came close to this matter when he said:

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.

He 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)

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

We have also had reference 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.

...

The Canadian Courts have been confronted with a similar issue to that now before us in at least three instances where applicants wished to claim substances mixed with carriers. In Rohm & Haas v. Commissioner of Patents 1959 Ex. C.R. 133, the invention was for fungicidal compositions. Not all the composition claims had been refused, and the principle ground for rejecting those that were rejected was Section 35(2), now 36(2), of the Patent Act. However, Mr. Justice Cameron added the following comment (p. 163):

I am of the opinion however, that where a claim to a compound has been allowed, a claim to a fungicidal composition merely having that compound as an active ingredient is not patentable.

In Rohm & Haas the claims to the compound had already been granted in another patent for a divisional application, though the extract just quoted makes no distinction of that nature, and indicates no limitation to such situations.

In Commissioner of Patents v. Farbwerke Hoechst, 1964 S.C.R. 49 the Commissioner rejected certain claims to a medicinal compound mixed with a carrier. The applicant had filed nine other applications for the medicine when made by nine different processes. In reversing the Exchequer Court, the Supreme Court made the following comments at p. 53:

The fallacy in the reasoning (or the lower court) is in the finding of novelty and inventive ingenuity in this procedure of dilution. It is an unwarrantable extension of the ratio in the Commissioner of Patents v. Ciba, where inventive ingenuity was found in the discovery of the valuable properties of the drug itself.

A person is entitled to a patent for a new, useful and inventive medicinal substance but to dilute that new substance once its medical uses are established does not result in further invention. The diluted and undiluted substance are but two aspects of exactly the same invention. In this case, the addition of an inert carrier which is a common expedient to increase bulk, and so facilitate measurement and administration, is nothing more than dilution and does not result in a further invention over and above that of the medicinal itself. If a patent subsists for the new medicinal substance, a separate patent cannot subsist for that substance merely diluted.

In the case which is before us it is quite evident that the inventive subject matter is the new chemical compounds and the processes relating thereto. It is said on page 3 of the disclosure, last paragraph, that they are the active ingredients, and that mixing them with diluents and carriers is but the conventional manner of using them. The claims on file, e.g. claim 17, are directed to the compounds, and even the method and process claims now proposed are limited to the use or preparation of the compounds - not the composition. Similarly the composition claims themselves, particularly claims 9 to 14, demonstrate where the invention really lies.

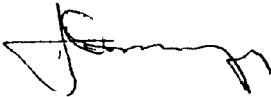
We are consequently fully satisfied that in this instance the composition claims go beyond the invention made, and do not properly define it. We can only view deletion of the compound claims as an artifice and stratagem to mask the real invention and evade Section 36. We believe claims 1 to 8

and 23 were properly refused, and recommend that proposed claim 1 should also be rejected.



Gordon Asher
Chairman
Patent Appeal Board, Canada

I have reviewed the prosecution of this application and considered the recommendation of the Patent Appeal Board. I am satisfied that the applicant is not by law entitled to claims 1 to 8 and 23, and proposed claim 1, and refuse them. They must be removed from the application within six months, or an appeal taken under Section 44.



J.H.A. Gariepy
Commissioner of Patents

Dated at Hull, Quebec
this 29th. day of August, 1978

Agent for Applicant

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