

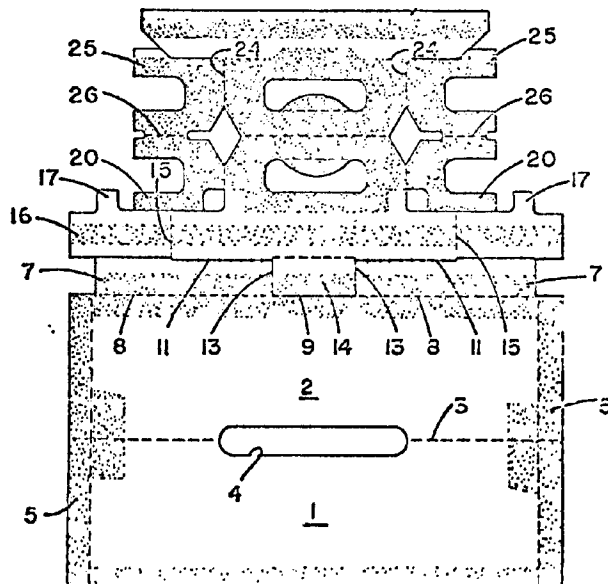
Reissue - No Inadvertence - Beer Carton

Rejection: Affirmed

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The applicant wishes to reissue his earlier patent 940884, granted January 29, 1974, for a cardboard blank used as the interior assembly of beer cartons. The blank comprises two parts, viz. a handle panel and a bottle-divider panel. The handle is normally recessed inside the carton, but can be pulled out when one wishes to carry the carton.

Figure 1 of the application illustrates what is involved.



The bottle-divider panel (1, 2) is shown at the bottom half of the drawing, and the handle panel at the top. The two connecting panels, 7, are separated by a tab 14 which folds up over a part of the handle panel to strengthen it. Tabs 16 also fold over onto the handle panel for reinforcement, as do projections 25-26-20, which serve to strengthen the handle portions themselves. During assembly of the carton the handle panel detaches from the connecting panel at separation line 11, so that the handle can be pulled up to protrude above the carton, and away from the divider panel.

In the reissue application the applicant wishes to broaden the coverage of the claims by changing what he previously termed "connecting panels" to what is now referred to as "at least one connecting panel" (claim 7). In other words, he is now seeking to provide for the situation where tab 14 is not utilized to reinforce the handle panel, or slit at lines 13, but remains part of the connecting panels, so that 7 is one long single panel stretching completely across the blank from one side to the other. The new claims cover blanks both where there is a tab 14 to reinforce the handle, and where there is no tab 14 but only one elongated connecting panel.

The examiner refused the application to reissue for failure to meet the requirements of Section 50 of the Patent Act.

First he has said that the original patent is not defective, at least in the sense that it does not fail to protect what the applicant had originally intended to protect.

Mr. Watson, relying on Curl-Master v Atlas Brush S.C.C., 52 C.P.R. 51, argued, in my view rightly, that a patent need not be defective in the sense of being invalid before it can be reissued, or for failing to define over the prior art, and might well be defective because it fails to protect the full invention which the applicant had a right to claim, always providing, of course, that such defectiveness stemmed from inadvertence,

accident or mistake, which I will come to later. As was said in a passage which Mr. Watson quoted from Curlmaster, at page 54:

The main question on issue on this appeal [Curlmaster] is, therefore, whether there was, in relation to patent 554826, a complete failure to disclose Marchessault's invention, so as to render that patent invalid, as failing to disclose any invention, or whether there was an imperfect description of the appellant's invention, which would render the patent defective, but still capable of correction by reissue, if such imperfection resulted from error or mistake [underlining added].

The examiner has also argued that newly proposed claims 7 and 8 (those broadening the protection to cover "at least one connecting panel") are not supported by the disclosure, and thus are contrary to Rule 25. He has said there is nothing in the disclosure or drawings teaching anything other than a panel in which reinforcing tab 14 is present. In reply, Mr. Watson suggests that there is sufficient evidence to the contrary. He argues that claims 1 and 4 of the patent and the broad statement of the objects of the invention fail to bring in reinforcing tab 14, and consequently the tab is obviously not a material part of the invention. It is only in the other claims that reinforcing tab 14 is specifically included. He also argues that the object of the invention given on the bottom half of page 1 and the first three lines of page 2 do not refer to connecting panels, and it is not until one gets into specific embodiments of the invention that multiple connecting panels and reinforcing tabs are mentioned. The force of his contentions are somewhat blunted, however, by several specific references to a "pair of connecting panels," or to "panels" in the plural, in both claims 1 and 4. That of necessity eliminates the possibility of a single elongated connecting panel, or, to use the wording of claim 7 in the reissue of "one connecting panel integral with ... said primary panels." Furthermore both in the patent and in the application the presence of two connecting panels and reinforcing tab 14 is evident in all the drawings showing that section of the panel.

Considerable reliance has been placed by the applicant upon the decision of the Supreme Court of Canada in Curlmaster v. Atlas Brush, (1968) 52 C.P.R. 51, because in it there had been a failure on the part of the Patent Agent to appreciate that there was an immaterial limitation in the claims. I think, however, that caution should be exercised in extending Curlmaster beyond the rather unique circumstances surrounding that case. The original drawings in Curlmaster did show the embodiments of the invention claimed in the reissue patent, and the feature claimed in the reissue patent as the main invention was included in some of the claims or the original as subsidiary to what was originally thought to be the main invention, and became the subsidiary aspect in the reissue. Further Mr. Justice Martland, in discussing the earlier case of Northern Electric v. Photosound [1936] 4 D.L.R. 637 and 1936 S.C.R. 649 pointed out that the inventor in Northern Electric was "an accomplished physicist, a competent radio engineer and inventor, accustomed to framing specifications, [and] had obtained a patent..." whereas the Curlmaster inventor "was not an engineer, and had had no prior experience in relation to patents." In the present case Mr. Watson was not able to say what are the professional qualifications of the inventor, Mr. Dewhurst, but clearly he had had long experience in designing cartons with several leading carton manufacturers. He has been granted a dozen or more Canadian patents going back to at least 1960, not to mention his foreign patents. The applicant company, the Paul Moore Company Limited, is also thoroughly experienced in these matters. From the letter of July 12, 1973, on the original patent, we note that the company then held about 88 patents, and had filed in Germany, the United States, the United Kingdom, and Canada. Similarly the patent agent, Mr. Moffat, is well versed both technically and legally in this legal specialty. He participated, for example, in the 1960 trial resulting in perhaps the leading Canadian decision dealing with beer cartons, Unipak v Crown Zellerbach, 33 C.P.R. 1. The applicant was also a party to that action (see letter of July 12, 1973, p. 4). Obviously we are not dealing with novices bewildered by the intricacies of patent law, nor with an ill patent agent, close to his

death bed, both factors weighed by the Court in the Curlmaster decision in assessing whether inadvertence was present. When this was brought up at the Hearing Mr. Watson answered that anyone can inadvertently make a mistake, even the most competent, and that reissue must be linked to inadvertency, not to incompetency.

There is some other evidence which concerned the examiner, evidence suggesting that the applicant and his agent were aware of the limitations of the original claims, and had intended those limitations to be present. In his letter of July 12, 1973, applicant wrote:

It has also been suggested [apparently during the German prosecution] that Applicant's present invention might be anticipated by U.S. Specification No. 2,609,137 (Toensmeier). Again, Applicants would say that they are quite familiar with Toensmeier inasmuch as it was also cited in their infringement action reported in 33 C.P.R. 1 at 39. In considering claim 1 of the instant application on the one hand and Toensmeier on the other, the latter lacks the pair of connecting panels integral with and hinged to a marginal side edge of a selected one of his primary panels (21, 23). It will be recalled that in Applicants claim 1, the connecting panels and handle are also located between the pair of primary panels when the carton is erected. Accordingly, if it is considered that Toensmeier's panels 27, 29 form connecting panels (because they are located between the primary panels 21, 23 when the carton is erected) then such panels 27, 29 are clearly integrally and hingedly connected to his end wall panels 13, 17. (underlining added)

From this it would seem, the applicant was relying upon the existence of two connecting panels to distinguish over the prior art, and if that were so it would also appear that the inclusion of 2 panels in the claims was not inadvertent.

When we questioned Mr. Watson about this at the Hearing, his explanation was that in discussing Toensmeier in 1973 the point of distinction really being made was that Toensmeier had no connecting panel, whereas the applicant had connecting panels, and no special significance was being placed on the pair of connecting panels. The applicant, he says, was merely tracking the language of the claims as one customarily does during prosecution, and his invention distinguishes from Toensmeier whether there is one connection panel or two. At that point in the prosecution he said, the agent never addressed his mind to there being a particular significance in the words "a pair" of panels. I cannot agree,

however, that that was the case. I find that the applicant was really relying upon the attachment of the connecting panel to the partition, instead of to the end panels, as in Toensmeier.

On considering this matter I refer to an American decision on reissue, viz. In re Beyers (1956) 43 CCPA 804. In doing so I would mention that the provisions for reissuing in Canada are derived from the corresponding provisions in the United States Patent Act. I would also mention what was said about reissue in Hunter v Carrick (1884), 10 O.A.R. 449 at 468 (affirmed 11 S.C.R. 300) where we find:

Cases may arise for adjudication in which it will be important to keep in view the differences between the two statutes; but as far as they touch the immediate subject before us, viz: the effect of the reissue of a patent upon corrected specifications, as they are styled in the United States statute, or amended or corrected ones as they are indifferently styled in ours, we may for our present purpose regard them as covering the same ground; and I agree with the learned Judge, whose decision we are considering, that we should treat the judgements in the United States Courts, in which the effect of their statute has been declared, as laying down the rule which we should follow....

I note, too, that in Curl-Master v Atlas Brush, supra, at 527 & 530, Martland J. quoted with approval two United States decisions on reissue, while in Farbwerke Hoechst v Commissioner of Patents, (1966 SCR 606 at 614) he pointed to the distinctions which must be made where there are material differences in the provisions. See also Van Heusen v Tooke Bros. 1929 Ex. C.R. 89 at 100 and Leonard v. Commissioner of Patents, 14 Ex. C.R. 351 (1914) at 361. Keeping in mind, then, such proper distinctions as should be made, I return to the Beyers decision, supra, and find at p. 807:

Thus in Dobson v. Lees, 137 U.S. 258, the Supreme Court of the United States said:

A reissue is an amendment, and cannot be allowed unless the imperfections in the original patent arose without fraud, and from inadvertence, accident or mistake. Hence the reissue cannot be permitted to enlarge the claims of the original patent by including matter once intentionally omitted. Acquiescence in the rejection of a claim; its withdrawal by amendment, either to save the application or to escape an interference; the acceptance of a patent containing limitations imposed by the Patent Office, which narrow the scope of the invention as it first described and claimed; are instances of such omission.

Similarly in Shepard v. Corrigan, 116 U.S. 593, the Court said:

Where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent.

...

It is evident that since the deliberate cancellation of a claim in order to obtain a patent constitutes a bar to the obtaining of the same claim by reissue, it necessarily also constitutes a bar to the obtaining of a claim which differs from that cancelled only in being broader. That was the holding in In re White, 23 F. 2d 776, 57 App. D.C. 355, and in In re Murray, supra, this court quoted with approval the following statement from Ex parte White 1928 C.D. 6:

The deliberate withdrawal of a claim in order to secure a patent is conclusive of the presumption that there has been no inadvertence, accident, or mistake, and the invention thus abandoned cannot be regained either by construing the claims of the patent broadly or by obtaining a reissue with broadened claims. The rule is the same whether the claims sought by reissue or otherwise are identical, substantially the same, or broader than the abandoned claims.

Similarly, in In re Wadsworth et al, 27 C.C.P.A. (Patents)735, 107 F. 2d 596, 43 USPQ 460, it was held that the cancellation of a claim from an original application on which a patent was granted, reciting a process including two steps in a specified order precluded the obtaining by reissue of the patent of a similar claim which was broader than that cancelled in that it did not specify the order in which the steps were performed.

We are of the opinion that the appellant's action in limiting the scope of original claim 20 by amendment constituted a deliberate withdrawal of that claim as originally presented, in order to obtain a patent, and that such withdrawal is a bar to the obtaining by reissue of claim 20 as it originally stood, or of any claim differing therefrom only by being broader. Appealed claims 2 and 3, as above noted, differ from original claim 20 as presented, only in that they are broader than that claim [emphasis added].

I think it would also be appropriate to refer to In the Matter of Land's Patent (1910) 27 R.P.C. 481 to show that a deliberate action cannot be considered unintentional, even though that deliberate action was taken because of an error in appreciating what the law might be. That case involved the restoration of a lapsed patent, but I believe the reasoning adopted there is appropriate in assessing whether a deliberate action can be brought within the meaning of "inadvertence, accident or mistake" as used in Section 50 of the Canadian Patent Act.

In Curlmaster the error of the Patent Agent was in not comprehending the applicant's invention. The Supreme Court of Canada has, of course, in Burton Parsons v Hewlett Packard (1976) 1 S.C.R. 555 at 568 rejected a contention that there was no error from inadvertence or mistake because the error was made by the agent rather than by the applicant, saying:

As to the contention that there was no "error" because whatever inadvertence or mistake happened was that of the patent attorneys, not that of the inventor himself, I can see no reason for such a restrictive construction of the Act. On applications for extension of time, relief from a default and the like, no court would listen to the objection that the delay was that of the party's attorney, not of the party himself.

But conversely, where an agent deliberately takes an action, the applicant cannot disavow what his agent has done for him. In Benday Inc. v Vulcan Equipment 32 C.P.R. (2d) (a patent case), at 3, the Federal court accepted as correct the decision in Scherin v Paletta (1966) 57 D.L.R. (2d) 532 at 534, holding that

Where a principal gives an agent general authority to conduct any business on his behalf, he is bound as regards third persons by every act done by the agent which is incidental to the ordinary course of such business or falls within the apparent scope of the agents authority.

For the Hearing the applicant supplied a sample of a carton made by a competitor (Domtar Packaging Ltd.) illustrating the type of connecting panel which he is now attempting to claim. It has of course been held, at least in the United States courts, that it is not inadvertence, accident or mistake where an applicant specifies with particularity what he claims and only upon discovering a competitors device attempts to broaden his original claims by reissue (Whichita Visible Gasoline Pump Co. v. Clear Vision Pump Co., 19F (2d) 435, 438, C.C.A. 8(1927; and Roos v McMillan 64 F. 2d 568.) Certainly those courts have appeared to view with suspicion the seeking of a reissue by a patentee who has become aware of his "error" through exposure to a

competitor's work and seeks to reissue in order to embrace the same. Mr. Watson conceded at the Hearing that the appearance of the competitor's carton "may" have initiated a review leading to the reissue application, but contended that to be immaterial, since applicant is claiming the same invention as before. I need not place much weight upon this point, but it does cast further doubt upon whether the applicant had originally intended to claim what he now seeks to protect.

This case must turn upon whether there is present the essential prerequisite of inadvertence, accident or mistake. On the evidence before me I have concluded that there was no inadvertence, accident or mistake, and reject the application under Section 42 of the Patent Act. If any appeal is to be taken under Section 44 it must be commenced within six months.



J.H.A. Gariepy
Commissioner of Patents

Dated at Hull, Quebec
this 4th. day of January, 1979

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