

COMMISSIONER'S DECISION

Indefinite Claim - Plant Growth Regulant

A method claim referred to the amount of growth regulant used as "... an amount sufficient to produce the desired plant effect...." Quantitative terms such as an "effective amount," etc. may be proper in claims if the disclosure clearly indicates what that amount is, or if persons skilled in the art would generally know what amount to use to produce the desired result.

Final Action: Reversed

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Patent application 272797 (Class 260-578.5), was filed on February 28, 1977 for an invention entitled "Substituted Benzophenones." The inventors are Osamu Yamada et al. The Examiner in charge of the application took a Final Action on March 15, 1978 refusing to allow it to proceed to patent.

The application is directed to substituted benzophenones, a plant growth regulant.

In the Final Action the Examiner refused claims 6 to 10. Claims 6 to 9 were composition claims, while claim 10 was directed to a "method of use" type claim. In response to the Final Action the Applicant cancelled claims 6 to 10 and resubmitted claim 10 in an amended form as new claim 6. We presume that claims 7 and 8 should now be dependent on claim 6 and not claim 10.

We are therefore now just concerned with method of use claim 6. In the Final Action the Examiner stated that claim 10 was "rejected as indefinite" under Section 36 of the Patent Act.

In response to the Final Action the Applicant argued that the revised claim 10 "is identical with the method of use claims frequently accepted by the Patent Office in similar cases covering plant growth regulants." He goes on to say that "the claim specifies how the active compound is to be applied and in addition states the required effect based on that described on page 1 of the disclosure."

The question before the Board is whether or not amended claim 6 overcomes the rejection of indefiniteness in the Final Action. Claim 6 reads:

The method of regulating growth of plants which comprises applying to the plants or to a habitat thereof, an amount of one or more compound of formula [1a] as defined in claim 1 sufficient to provide at least one of the required effects of inhibition of seed germination, inhibition of root elongation or inhibition of plant (including algae) growth.

It appears that the Examiner in the Final Action refused claim 10 because the Applicant did not "limit the amount" of the compound used. That portion of the claim reads "... in an amount sufficient to produce the desired plant effect...."

The object of a claim, of course, is to define the extent of the monopoly of the invention to which protection is granted. Section 36(2) requires that this be done "... distinctly and in explicit terms...." Section 36(1) requires that "the specification correctly and fully describe the invention its operation or use... and set forth clearly the various steps in a process, or the method of constructing, making, compounding or using a machine, manufacture or composition of matter, in such full, clear, concise and exact terms ... to make, construct, compound or use it...." In other words the invention must be described (detailed account) in the specification and defined (set down the boundaries of the scope of monopoly) in the claims. In Riddel v Patrick Harrison (1956-1960) it was pointed out that "an inventor need not restrict his claims to what has been specifically described in the specification ... but within the breadth of his invention, may claim it as broadly as it would normally be construed by persons skilled in the art...."

We have carefully reviewed the disclosure and find an ample description of an invention which is "correctly and fully described" in "operation and use" including the "specific ranges" for best results or desired effect.

We think it is well established that expressions such as "an effect amount," or "an amount sufficient to produce the desired effect," are quite proper in claims if the disclosure clearly indicates the "amount," or of persons skilled in the art would readily know what amount of use to produce the desired effect or result.

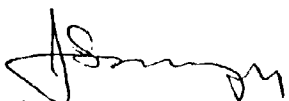
As a matter of interest in Burton Parsons v Hewlett Packard (1975) S.C. 17 C.P.R. 2d 97) we find the following expression in claim 17, which claim was held valid by the court: "... containing sufficient highly ionizable salt to provide good electrical conductivity ...."

We are therefore satisfied that claim 6 defines the scope of the monopoly of the invention in "explicit" terms and does not offend Section 36 of the Patent Act.

We recommend that the ground of rejection refusing the method of use claim 10, now claim 6, be withdrawn. The other ground of rejection was overcome by amendment.

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

I have reviewed the prosecution of this application and considered the recommendation of the Board. I concur with the reasoning and findings of the Board. Accordingly, I withdraw that ground of rejection and return the application to the Examiner for resumption of prosecution.

  
J.H.A. Gariepy  
Commissioner of Patents

Dated at Hull, Quebec

this 19th. day of June, 1979

Agent for Applicant

Fetherstonhaugh & Co.  
Box 2999, Station D  
Ottawa, Ont.  
K1P 5Y6