

COMMISSIONER'S DECISION

Subject Matter: Sec. 2: Townhouse Building Design

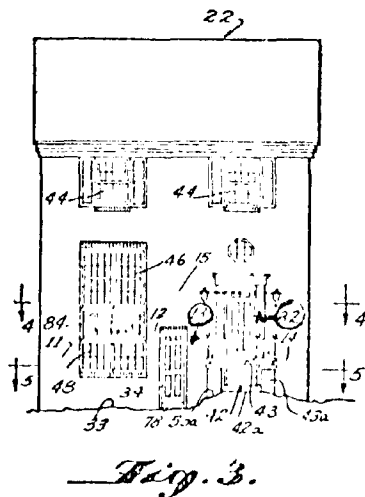
The design of the buildings compliment the natural terrain by constructing them with the ground floor at grade level both front and rear. There are two standard entrance doors in the front, each door leading to a different level, one being a formal main entrance door leading to the main or middle level, the other door being a fully exposed service door opening at ground level. In this manner a three storey townhouse has the appearance of only two stories. The rejection in the Final Action was affirmed because the application is directed to a layout, plan or design which is totally lacking in any mechanical or structural novelty, or invention.

Final Action: Affirmed

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Patent application 245995 (Class 20-1), was filed on February 18, 1976 for an invention entitled "Single Family Townhouse Units." The inventor is Myron S. Hurwitz. The Examiner in charge of the application took a Final Action on Sept. 2, 1977 refusing to allow it to proceed to patent. In reviewing the rejection, the Patent Appeal Board held a Hearing on June 13, 1979 and at which the Applicant was represented by D. Watson, Q.C.

The application is directed to single family townhouse units wherein the units are situated to compliment the natural terrain by building them with the ground floor level at grade in both the front and the rear. There are two standard entrance doors (for individuals) in the front, each door leading to a different floor level, one being a formal main entrance door leading to the main or middle level, the other door being a fully exposed service or convenience door opening at the ground floor level. Figure 3, below, illustrates that arrangement:



The main entrance door is designated at 32 and service door at 13.

In the Final Action the Examiner refused the application because in his view it fails to claim or describe subject matter that is patentable under Section 2 of the Patent Act. He went on to say that the alleged invention is, in essence, merely an architect's plan or design for the layout of the individual houses in a row of houses, which subject matter does not fall under Section 2 of the Patent Act. He concluded by saying that "the subject matter of this application is perhaps more along the lines of those things protected by the Industrial Design Act or the Copyright Act."

The Applicant in his response to the Final Action argued that the application was clearly, and without doubt, directed to patentable subject matter. He went on to explain that there is a decided distinction between an aesthetic design concept and a technical design concept. He had this to say, inter alia, on inventive concepts:

...

Building structure (architectural), mechanical (utility) patents obviously represent technical design concepts. In that regard it should be particularly noted that aside from the above cited design patents, applicant has obtained a utility or mechanical patent, namely U.S. Patent 4,041,661 issued August 16, 1977. Correspondingly other example of U.S. architectural utility or mechanical patents were listed in the present application. Within that category of utility patents there are three fundamental inventive concepts:

(1) a purely architectural (utility) design concept, wherein the novel 3-dimensionally working, utilitarian design concept does not rely on or have any particular relevance to construction (assembly) details per se;

(2) a purely architectural (utility) or structural design concept, wherein the novel 3-dimensionally working, utilitarian design concept consists solely of construction (assembly) details, and wherein the novelty designed details do not rely on or have any particular relevance to the overall design configuration of the building using those construction (assembly) details; and

(3) a combination of the preceding two fundamentally pure, clear cut types, wherein the novel 3-dimensionally working, utilitarian design concept consists of construction (assembly) details that specifically relate to a specifically designed building structure.

The present invention represents the first exemplified type, an architectural technical (utilitarian) design concept,

wherein novel entrance and egress solution for a townhouse does not rely on or have any relevance to technical design construction (assembly) details per se.

At the Hearing Mr. Watson argued that the subject matter of the present application clearly falls under Section 2 of the Patent Act. He also brought to our attention a number of Canadian patents which, in his view, were similar to the subject matters in the present application. He then gave a detailed account of the present application. He brought out, for example, such points as: a departure from the previous thinking, a two story effect and function in three story accommodations, and the importance of the utilitarian effect as opposed to purely aesthetic effect or design. Mr. Watson concluded by reviewing a number of court decisions.

With regard to Mr. Watson's discussion on the issuance of other Canadian patents having subject matter allegedly along the same lines as the present application, we point out that these cases were not before the Board and we do not believe that it is incumbent on us to consider them at this time.

The question for the Board to consider is whether or not the application is directed to subject matter which falls under Section 2 of the Patent Act.

Section 2 reads (in part):

'invention' means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter.

That definition is so broad that it has long been obvious that the section requires interpretation by the courts to give it reasonable boundaries. In the decision of Lawson v. Commissioner of Patents, (1970), 62 C.P.R. at 109, the Court took it as settled law that all new and useful arts and manufactures (and obviously processes) are not necessarily included within the definition of invention. To support the contention that words of limitation must be read into the broad definition, Mr. Justice Cattanach looked to the finding of the Supreme Court in the Commissioner of Patents v. Farbwerke Hoechst (1964) S.C.R. 49 that ingenuity is one such limitation. In another decision, Tennessee Eastman v. Commissioner of Patents (1973), 8 C.P.R. at 205 the Supreme Court also noted that the definition is circumscribed.

The Lawson case, supra, is related to a method for subdividing land with lot lines delineated in accordance with curved lines in configuration of a champagne glass. The court held that a method of describing or laying out parcels of land in a plan of subdivision of a greater tract of land is the skill of a solicitor and conveyancer and that of a planning consultant and surveyor. It was not considered an art or skill within Section 2 of the Patent Act.

The following decisions are also placed on record as of interest: G.F.C.'s Application (1942), 60 R.P.C. 1; Refrigerating Equipment Ltd. v. Drummond & Waltham System Inc., [1930] 4 D.L.R. 926, [1930] Ex. C.R. 154; National Research Development Corporation's Application (1961), R.P.C. 135; Moluch v. M.N.R. [1967] 2 Ex. C.R. 158, [1966] C.T.C.712; McGuire v. M.N.R. [1956] Ex. C.R. 264, [1956] C.T.C. 98' E.S.P.'s Application (1945), 62 R.P.C. 87.

The E.S.P. case, supra, was considered in the Lawson case, supra, and we will also consider it in detail. This was a patent application for a patent entitled "Improvement in building construction" relating to layout of contiguous houses in a row or terrace. The nature of that alleged invention is described in the following passage:

The building is provided with a straight ridge extending along the whole of its length, and the slope of the roof is equal on both sides thereof. So far the building does not differ from those hitherto known. According to the invention, however, the alternating units 1 and 2 have their front elevation, preferably comprising the bottom and first floor, alternately on one side and the other of the building, the back elevation of every unit, consisting preferably of the bottom floor only, facing towards the same direction as does the front elevation of its contiguous unit or units. Thus either side of the building has two-storeyed front elevations 3 which are set back in relation to the one-storeyed back elevations 4 situated on the same side of the building, so that the two-storeyed front elevation of every unit together with the projecting adjacent units borders three sides of a front garden sheltered from the wind.

This lay-out of the individual houses interrupts the monotony of the row so that such buildings or rows of contiguous houses no longer offer a dull picture marring the beauty of a town but rather constitute an adornment, brightening the picture of the district they are in. Every unit is well protected from being overlooked from the adjacent units, neither can the entrance to a unit be observed by the neighbours.

The relevant claim of that application reads:

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 on the case had this to say:

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.

I decide therefore that the Examiner's objection is well-founded, and I hereby, under the provisions of Section 3(2) of the Acts, refuse to accept the specification.

In our view the Lawson and E.S.P. cases are related to the consideration before us and we will discuss them further.

In order to more fully understand the alleged invention of the present application, we quote from page 14 of the disclosure "Summary of Main Objectives:"

...

Summarizing the foregoing, the principal objectives of the present invention are to provide one or more of the following features in townhouses of the type under consideration: utilization of optimum siting conditions with, for example: (1) all townhouse units being three stories, built with the ground floor level at grade, and adapted not only to appear to be two stories in height at the front but to functionally perform as such in practical use, (2) each townhouse unit to have two distinct and separate entrance doors in the front that lead to different floor levels, one being a formal main entrance door and the other a service or convenience standard entrance door that is fully exposed and yet aesthetically acceptable and which does not, as a result of being exposed to view, functionally compete in appearance with the formal main entrance door; (3) a service or convenience standard entrance door that opens directly into a generally centrally located service corridor, which is essentially at the ground floor level; (4) a formal main entrance door, located intermediate the ground and main (first floor) levels, that opens into the main (first) floor by way of a two level, formal entrance area of substantially the same width throughout, in which the lower level is at said intermediate level, constituting a formal entry area, and the upper level is coincident or substantially coincident with the main (first floor) level, constituting a formal foyer area; and where both formal entrance, open area levels are interconnected by a decorative and fully exposed stair treatment; (5) a physically spacious 2-level formal interior entrance area scheme, which to be practical should not as a result of its spaciousness, correspondingly detract in size from all the other rooms at the main (first floor) level or from all areas below and adjacent this two level formal entrance area which areas should be completely and functionally utilized so that, in essence, no space at any level in the townhouse unit is sacrificed by the implementation of the exterior and related interior embodiments of the invention; and (6) the attainment of these objectives to be achieved in a thoroughly practical and economic manner.

...

Claim 1 of the application reads:

An improved townhouse unit of the type having a plurality of floors including ground and main or first floors which together define the living space for a single family therein so that there is interior communication for the family between all floors of the said townhouse unit and a front portion having a main entrance which includes at least a single door positioned at an intermediate location between said ground floor and said main or first floor for providing entrance into said main or first floor by way of a formal entrance wherein the improvement comprises a second entrance door horizontally spaced to the

side of and vertically spaced intermediately to said main entrance, said second door being substantially the same width as said single door in said main entrance said second door being fully exposed in said front portion and opening into the ground floor of said townhouse unit.

The problems to be overcome by the alleged invention are listed on page

18(a) of the disclosure, line 6 f.f., and read:

Major problems to be overcome included the following:

(1) How not only to make a 3-story (front and rear) townhouse appear to be two stories in height at the front, but how to make it functionally perform as such in practical use; (2) How to locate the standard service door so that it would not be an eye-sore and would not compete with the main, formal entrance door, though it would be completely exposed to view; (3) How to include this additional width element, the standard service door, including the generally, centrally located service corridor at the ground floor level, within the limited width constraints of a typical townhouse; (4) How to get someone from grade to the middle (first floor), living room level without going up a continuous flight of stairs either inside or outside the townhouse unit; (5) How to achieve a spacious formal interior entrance area of two levels and of substantially the same width throughout, having an interconnecting, fully exposed, decorative stair treatment, without sacrificing room sizes or complete utilization of space on any floor level in the townhouse unit.

At the outset we believe that there is no novel significance in the building structure, per se. This in our view, is clear from the disclosure at page 70, line 9 f.f., which reads: "While no novel significance, per se, is being urged herein for such detail '[architectural construction; structural framing; mechanical equipment and duct work; plumbing equipment; waste and vent lines; etc.]' they were nevertheless integral to the complex and utilitarian design ...."

At the Hearing Mr. Watson argued that the present design is so arranged that "functionally, as a people container, it acts like a two-story house." We agree that from the outside it may have the aesthetic appearance of a two story house, but it clearly functions as a three-story house with the service entrance at a level lower than the main entrance. Page 18a. as mentioned, refers to "major problems to be overcome" as: "How not only to make a three-story (front and rear) townhouse appear to be two stories in height at the front, but ... [emphasis added]."

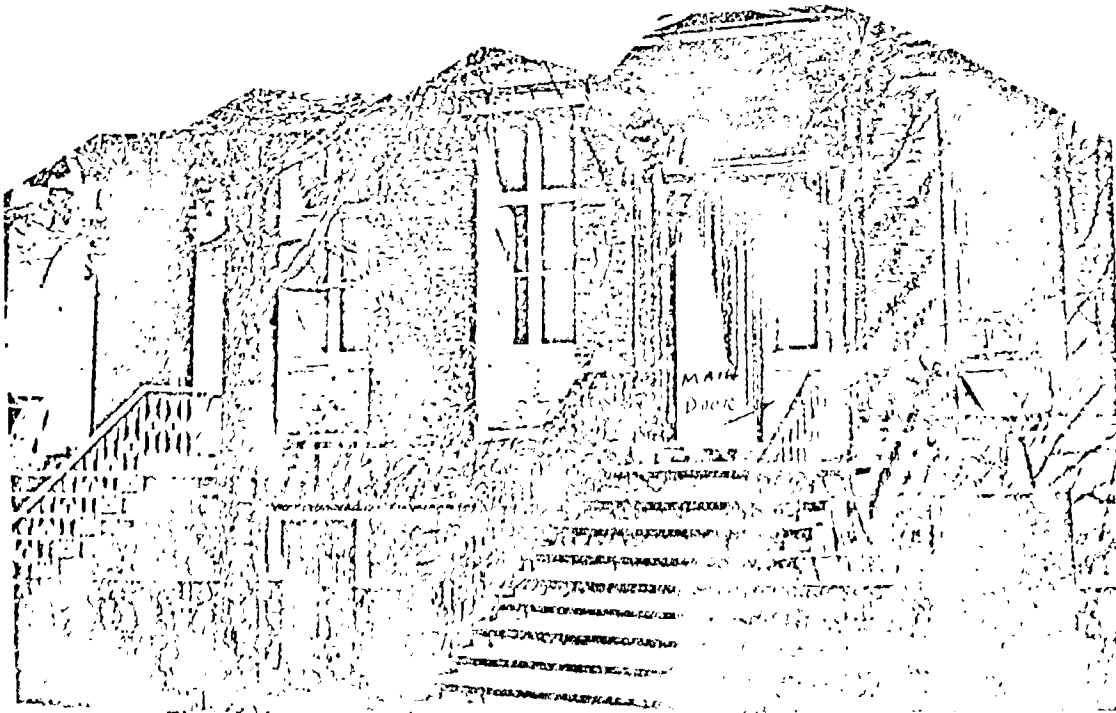
Mr. Watson also referred to other problems (see quotations above) such as how to locate the service door so that it would not be an eye sore..., how to include this additional width element (for the service door) within the constraints of a typical townhouse, the location of the stairs inside or out; how to achieve a spacious formal interior entrance area ... and a decorative stair treatment. All of these features have to do with the skills of a person in the relevant art and if it is merely a design arrangement without novelty and invention in the structure itself, there is no patent monopoly available. More on this point later.

Mr. Watson discussed E.S.P.'s application, supra, and pointed out that it was a layout or arrangement without mechanical or constructional differences in the individual houses. This as opposed to the present application where, according to Mr. Watson, there are many differences in the construction and arrangements i.e., functional and ornamental. We must keep in mind, of course, that aesthetic or ornamental considerations per se do not fall under Section 2 of the Patent Act, and as previously mentioned the disclosure at page 70 reads: "Consequently, the inherent details related, for example, to architectural construction, structural framing, mechanical equipment and ductwork .... While no novel significance, per se, is being urged herein for such details, they were nevertheless integral to the complex and utilitarian design...." And at page 56, line 4 f.f., we find: "Thus, one of the overriding novel intents of the invention was to make it appear that the exterior and interior design of the townhouse was based entirely on aesthetic considerations. The reality of a precise utilitarian scheme for functional intent was to be made totally unrecognizable." We believe, therefore, it is clear from the above that any mechanical or constructional differences are merely different but not inventively different. We readily agree of course, that a combination of old elements may in some instances be unobvious and thus inventive. The elements in the present application such as: the doors, entrance closet, powder room, side walk etc., are clearly aggregative elements.



In the Final Action the Examiner had this to say, inter alia: "No novelty is even alleged for the building method 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 advantages alleged for the layout are aesthetic novel arrangements and novel designs and positions of structure and functional and utilitarian considerations...." Although not specifically stated, this portion of the Final Action is clearly a refusal on lack of "inventive ingenuity" and according to the Examiner clearly "belong to the province of the architect," i.e. the normal skills of the architect.

On August 18, 1976 the Applicant submitted "a set of Exhibits 1 through 26." Exhibits 2 and 4 show two entrance doors on the front of a townhouse or rowhouse. One is a service door and the other is a main entrance door. We are at somewhat of a loss as to the reason why these were not cited as prior art. We find, however, that the present disclosure on page 3, line 5 f.f., reads: "Because most historical city townhouses did not have service alleys in the rear, a service or secondary entrance door in the front was essential. This service door was traditionally located under the formal exterior entrance stair or stoop...." Exhibit 2 submitted by the Applicant however clearly shows the service door to one side of the main entrance door, and thus appears to suggest the subject matter of claim 1. A portion of Exhibit 2 is shown below:



We will now consider the claims. For convenience, claim 1 is reproduced below:

An improved townhouse unit of the type having a plurality of floors including ground and main or first floors which together define the living space for a single family therein so that there is interior communication for the family between all floors of the said townhouse unit and a front portion having a main entrance which includes at least a single door positioned at an intermediate location between said ground floor and said main or first floor for providing entrance into said main or first floor by way of a formal entrance wherein the improvement comprises a second entrance door horizontally spaced to the side of and vertically spaced intermediately to said main entrance, said second door being substantially the same width as said single door in said main entrance said second door being fully exposed in said front portion and opening into the ground floor of said townhouse unit.

We totally agree with Mr. Watson's views about this claim (at least in part), when he stated that he was "a little worried about claim 1 because although there are some functional aspects to it, a lot of it is, perhaps, aspects of appearance...." In our view there is nothing but aspects of appearance in this claim. The claim is essentially defining a monopoly on a townhouse with a main entrance ... wherein the improvement comprises" ... a second entrance door horizontally spaced to the side of and vertically spaced intermediately to said main entrance ... substantially the same width .. [and] fully exposed ... and opening into the ground floor ...." This claim, in our view, is clearly directed to a layout, plan or design totally lacking in any mechanical or structural novelty or invention. Mr. Watson argued that this subject matter was different than a mere lay-out or plan in the E.S.P. application, supra, or in the Lawson case, supra. The difference, in our view, is in re-arrangement of known structural features in a non-inventive way and as the Applicant has mentioned (see above), "no novel significance, per se, is being urged for such detail...." There is of course nothing wrong with a claim that refers to a plan or design if it also includes

novel and inventive structure. We are not satisfied that this claim defined patentable subject matter and it should, in our view, be refused under Section 2 of the Patent Act.

Claims 2 to 26, which depend directly or indirectly on claim 1, are directed to, inter alia, features such as: an exterior stoop, the doors being recesses, service entrance corridor, windows, formal foyer, exposed stairways and railings, an entrance closet, a powder room, a sidewalk, service walking, a garage door and so on. To add well known features in an aggregative sense, i.e. no inventive structural arrangement to an unpatentable claim does not rise to the dignity of invention. The arguments used in refusing claim 1 apply equally to these claims. These claims should also be refused.

We have carefully read and re-read the 77 pages of specification and reviewed the drawings, but we fail to find subject matter that, in our view, falls under Section 2 of the Patent Act. We hasten to add however, that probably the author of the specification should have won some recognition for writing. We must remember that there are numerous forms of human endeavor that might at first sight appear to fall within the purview of the patent law but that, upon examination, will be seen to fall, on the one hand, into the sphere of other forms of industrial or intellectual property or, on the other hand, into the public domain and hence be incapable of acquiring any protection in the form of exclusive privileges. The Applicant has however received some protection in the form of an Industrial Design from the Canadian Patent Office. We do, however, observe that the Applicant has received a United States patent on a similar application.

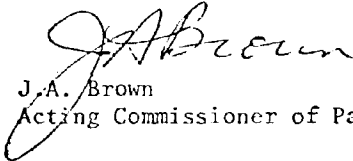
To summarize, we are not persuaded, in view of the above discussion and points raised, that the Applicant "has disclosed or claimed any subject matter that is patentable under Section 2 of the Patent Act." We therefore recommend

that the decision in the Final Action, to refuse the application, be affirmed.



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

I have carefully reviewed the prosecution of this application and considered the recommendation of the Patent Appeal Board. I concur with the reasoning and findings of the Board. Accordingly, I refuse to grant a patent on this application. The Applicant has six months within which to appeal my decision under the provision of Section 44 of the Patent Act.



J.A. Brown  
Acting Commissioner of Patents

Dated at Hull, Quebec

this 18th. day of July, 1979

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