

COMMISSIONER'S DECISION

Sec. 36, Rule 25; Indefiniteness, Inadequate Disclosure - Labelling Machine

Applicant claimed a labelling machine having a stop means to stop movement of either the printing head or the platen, depending upon which is moveable. The application was rejected for insufficient disclosure of a device where the printing head is moveable. It was concluded there was sufficient evidence that those skilled in the art would know how to construct machines with moveable printing heads and fit the stop means to it from the disclosure filed and prior art. Rejection withdrawn

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Patent application 160480 (Class 101-32), was filed on January 3, 1973 for an invention entitled "Printing Apparatus." The inventor is Robert M. Pabodie, assignor to Monarch Marking Systems, Inc. The Examiner in charge of the application took a Final Action on May 26, 1977, refusing to allow it to proceed to patent. In reviewing the rejection, the Patent Appeal Board held a Hearing on March 21, 1979, and at which the Applicant was represented by Mrs. Joan Noonan, Mr. Edward B. O'Connor and Mr. Paul Hamisch Sr., an expert witness.

Claims 1, 5, 7 and 13 were rejected under Section 36(2) of the Patent Act for indefiniteness, and under Rule 25 of the Patent Regulations as not supported by the disclosure. In addition, the disclosure was rejected under Section 36(1) for failure to explain the invention adequately.

The nature of the invention is indicated by claim 1 below, in which we have underlined the portion in which the Applicant states the invention resides. It relates to a machine used to print price tags and labels, in particular labels used in supermarkets to price tins of food, and the like.

1. Printing apparatus, comprising: a stationary frame, a print head and cooperable platen means, one of the print head and the platen means being stationarily mounted to the stationary frame and the other of the print head and the platen means being movably mounted to the stationary frame, means for driving the movable one of the print head and the platen means during each printing cycle to print data on a record member, the stationary frame and the movable one of the print head and platen means having cooperable stop means for stopping movement of the movable one of the print head and platen means at a predetermined stop position, the driving means including a resilient drive connection for yielding when the movable one of the print head and the platen means stops at the stop position, the impression on the record member being unaffected by the

action of the resilient drive connection, and means for regulating the stop means selective to vary the stop position and hence to effect printing impression control.

What is claimed is a stopping means to control movement of the printing head or the platen (depending upon which is moveable) in a labelling machine.

The Examiner has contended that there is insufficient disclosure of a printing apparatus in which the print head is moveable and the platen fixed. In reply to that contention, the Applicant supplied an affidavit from Mr. Paul Hamisch Sr., and another from Mr. William A. Jenkins, two experts in the employ of the Applicant. They have pointed to several U.S. patents of Mr. Paul Hamisch Sr., in which marking machines with either movable print heads and fixed platens or fixed print heads and movable platens were disclosed, several of which issued well before the priority date of this application.

The Examiner put his objection as follows:

...

In his amending letter dated September 29, 1976, the applicant argues that claims 1, 5, 7 and 13 should not be rejected as insufficiently supported by the disclosure because the embodiment wherein the print head is movable and the platen fixed can be constructed from the present disclosure by someone skilled in the art, without the exercise of inventive ingenuity.

It would appear that the applicant fails to understand part of the problem: it is very clearly stated in Office Action dated June 30, 1976, that claims 1, 5, 7 and 13 are indefinite per se in defining two different embodiments which are structurally non-equivalent.

Consequently, claims 1, 5, 7 and 13 stand rejected under Section 36(2) of the Patent Act for the above specified reason.

Furthermore, the examiner disagrees with the applicant that someone can construct the apparatus with a movable print head (rather than a movable platen) without the exercise of inventive ingenuity: the complete apparatus would have to be completely re-designed because none of the present gears would be the same; for example, the inking system would have to be timed with the print head movement; the massive print head would have to be pivoted, etc.... Fact remains that this embodiment is not specifically disclosed; the objection is therefore maintained.

The present disclosure stands rejected under Section 36(1) of the Patent Act as inadequate in explaining in details the embodiment wherein the print head is movable and the platen is fixed.

Claims 1, 5, 7 and 13 stand rejected under Rule 25 of the Patent Rules as not supported by the disclosure in the recitation in details of the embodiment wherein the print head is movable and the platen is fixed. There is no sufficient disclosure to enable someone skilled in the art to construct such an embodiment, and the applicant has failed to demonstrate that the said embodiment is more than just a mere idea for the purpose of securing a larger monopoly for an apparatus which he has failed to construct and prove effective (as implied in his last letter).

...

For his part the Applicant stated (inter alia):

...

Applicant would point out that the present invention is directed to an improved printing apparatus in which a print head and a platen are mounted for relative movement toward and away from each other, the improvement comprising providing a stop arrangement to limit the amount of travel of the print head and the platen toward each other. Preferably a resilient drive connection is provided which yields when a stop is abutted. Specifically, either the print head or the platen assembly is movably mounted and the movable one is connected to an eccentric by a connecting rod having a pair of relatively movable sections and a spring yieldably urging the sections apart. Impression control is thus effected. Thus it is completely immaterial to the invention whether the print head is movable or fixed and correspondingly whether the platen is fixed or movable. (underlining added)

...

Referring to page 3 of the Hamisch Affidavit, Applicant would point out that both of the aforementioned alternatives are well known in the art and when presented with specific details on how to make one alternative, Mr. Hamisch states that he could readily make the other. Thus, these alternatives are proper and obvious equivalents and claims 1, 5, 7 and 13 are not deficient with respect to Section 36(2) of the Act.

Again in the Affidavits Mr. Hamisch and Mr. Jenkins both indicate that a man skilled in the art could readily construct both forms of the apparatus when presented with the present specification and the common knowledge in the art as represented by the various U.S. patents referred to by Mr. Hamisch in his Affidavit.

It would appear that the main question to be considered when examining the Examiner's rejections is how specific must a disclosure be to support a claim. Applicant would submit that the answer is that the disclosure must contain sufficient information to allow the man skilled in the art, who is equipped with the common knowledge in the art, to carry out the invention.

...

Reference can also be made to the decision of the Supreme Court in Sandoz v. Gilcross Limited, wherein it was stated that:

"A specification is addressed to persons skilled in the art and, therefore, is to be construed by the standard of what such a person would understand on reading it."

...

In a similar vein, Applicant also cited the following cases to indicate what is required of a disclosure:

Unipak v Crown Zellerbach 20 Fox Pat. C. at 21

International Pediatric v Lambert 34 F.P.C. 58 at 4

BVD v Canadian Celanese 1936 Ex. C. R. 140

Riddell v Patrick Harrison 1956-60 Ex. C.R. 253

Burton Parsons v Hewlett-Packard 17 C.P.R. (2d) 97 at 105

At the Hearing the Examiner referred to several judicial decisions which indicate the heavy burden placed upon Applicants to disclose their inventions fully. In particular he mentioned:

R.C.A. v Raytheon 27 C.P.R. II, 1 (1957)

Leithiser v Pengo Hydra-Pull 12 C.P.R. (2d) 117 (1974)

and Mineral Separation v Noranda Mines 1947 Ex. C.R. 306

In the first of those we find the following passage at p. 12:

It is a cardinal principle of patent law that an inventor may not validly claim what he has not described. In the patent law jargon it is said that the disclosure of the specification must support the claims. If they do not, the claims are invalid. Moreover there is a statutory duty of disclosure and description that must be complied with if a claim for an invention is to stand. Section 35 [now 36] of the Patent Act [so requires].

At page 13 there is quoted the following passage from the Mineral Separation case:

...The purpose underlying this requirement is that when the period of monopoly has expired the public will be able, having only the specification, to make the same successful use of the invention

as the inventor could at the time of his application.

In Leithiser v Pengo Hydra-Pull (supra), Mr. Justice Heald said, at p. 132:

In summary, I have concluded that - each and every one of the claims in sort are invalid because in every claim, one or more essential characteristic of the patentee's invention are not described at all, thus making all the claims difficult from and much wider than the alleged invention. (For a similar view see: United Merchants & Manufactures Inc. v. A.J. Freiman Ltd. et al (1965), 47 C.P.R. 97, [1965] 2 Ex. C.R. 690, 30 Fox Pat. C. 206)...[Mr. Heald also relied upon R.C.A. v Raytheon quoted above].

However in assessing whether a disclosure suffices, we must keep in mind that it is addressed to one skilled in the art, and read it in the light of what such an addresser would comprehend. Mr. Thorson voices that caution in the following terms in Mineral Separations (supra) at p. 320:

The test of whether a specification complies with the requirements of the first sentence in section 14(1) [now Section 36] is whether persons skilled in the art, on reading the specification that the light of the common knowledge existing at its date and being willing to understand it, would be unerringly led to the invention and be enabled to put it to full use.

That was also the view expressed more recently by the Supreme Court in Burton Parsons v Hewlett-Packard 17 C.P.R. (2d) 97 at 101:

What must be ascertained is what the whole meant at the date of the patent to a person skilled in the art.

It is evident that what we must determine is whether those skilled in the art would know from the disclosure when it was filed how to practise the invention in the form in which it is claimed. The invention is said to be a stop mechanism which is combined with a printing apparatus in which either the print head is movable and platen fixed, or vice-versa.

Both Mr. Jenkins and Mr. Paul Hamisch Sr. have attested that it would be obvious to them, at least as of August 20, 1977, how to construct such machines. Mr. Hamisch has said:

11. That it is his opinion that he could construct from the teachings of the applications disclosure, a working machine embodying the disclosed and claimed invention and wherein the print head is movable and the platen is fixed and in so doing he would utilize only the skills of his art and not, in any manner, find it necessary to exercise his established inventive ingenuity.

That undoubtedly is so, but the issue is not really whether Mr. Hamisch or Mr. Jenkins could carry out the invention without inventive ingenuity by August 1977 when they lay claim to such ability, or even at some earlier date. The real issue is whether those skilled in the art generally could do so on January 6, 1972, which is the date when this application was filed, given the present disclosure and the knowledge of those skilled in the art at that date. Both Mr. Hamisch and Mr. Jenkins were in a privileged position as employees of the company which filed and obtained patents disclosing movable print heads. By August 1977 they would undoubtedly be aware of this development within their firm and it would take no ingenuity on their part and at that date to construct machines with movable print heads. As was stated in Applicant's companion application 160502, which was taken up at the same Hearing:

Applicant would readily admit the difficulties presented by the fact that each of these gentlemen is in the employ of the Applicant. However, under the circumstances it is rather difficult to obtain the opinions of other experts in the art. Firstly, the present applications are under prosecution and therefore secret, and Applicant would prefer, since the field is highly competitive that these applications remain secret until patents are granted in respect of them. Secondly, the state of the art as it exists today with respect to printing apparatuses of the present type, has been largely developed by the Applicant....

We do not believe information "secret" to the Applicant and his employees is satisfactory criteria to show what those skilled in the art generally would comprehend the invention.

What is more significant, however, are the patents referred to in Mr. Hamisch's affidavit which predate January 6, 1972, and the samples of prior labellers demonstrated at the Hearing which show both type of actions. For example, U.S. patent 2826988, granted March 18, 1958 (filed Jan. 10, 1955) is for a marking machine in which the print head is moveable and the platen fixed.

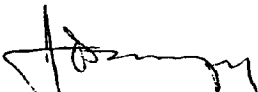
See also U.S. patent 3440123 issued April 22, 1969. Similarly U.S. patents 3180252, Apr. 27, 1965, and U.S. patent 3228601, Jan. 11, 1964 disclose marking machines in which the print head is fixed and the platen moveable. Taking it that there is an invention in the stopping means disclosed in the present device, we can see no problem in fitting it to either platen-fixed or print-head-fixed markers or printers. We have consequently concluded that those skilled in the art would, if given the Applicant's disclosure, have appreciated at the effective filing date that the invention would be useful for both types, and could easily fit it to either mechanism.

We recommend that the rejection on the basis of Section 36 and Rule 25 be withdrawn, and that the application be returned to the Examiner to resume prosecution.



G.A. Asher  
Chairman  
Patent Appeal Board, Canada

I have considered the arguments raised against this application and the recommendation of the Patent Appeal Board, which I now accept. The rejection is withdrawn. The application is to be returned to the Examiner to resume prosecution.



J.H.A. Gariépy  
Commissioner of Patents

Dated at Hull, P.Q.

this 20th. day of November, 1979

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