COMMISSIONER'S DECISION

Sec. 36, Rule 25, Indefiniteness, Inadequate Disclosure: Labelling Machine

Applicant claimed an inking system for label printing machines in which either the print head or the platen is movable, the other member being stationery. The application was rejected for insufficient disclosure of a device where the print head is moveable. It was found there was sufficient evidence that one skilled in the art would know how to fit the inking system to machines with moveable print heads from the disclosure and the prior art.

Rejection: Withdrawn

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Patent application 160502 (Class 101-101), was filed on January 3, 1973 for an invention entitled "Printing Apparatus." The inventor is Raymond L. Kirby, Jr. assignor to Monarch Marking Systems, Inc. The Examiner in charge of the application took a Final Action on December 2, 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 Noonen, Mr. Edward B. O'Connor and Mr. Paul Hamisch Sr., an expert witness.

All of the ten claims on file in the application 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 part 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 frame, printing means operable through successive printing cycles and including a print head and platen means, means mounting the print head and platen means for relative movement towards and away from each other during each printing cycle to print data onto a record member, one of the print head and platen means being fixedly mounted and the other of the print head and platen means being movably mounted, an inking mechanism including an ink roll for inking the print head, means for actuating the movable one of the print head and platen means and for actuating the ink roll, cam means movably mounted on and relative to the movable one of the print head and platen means and alternately moveable in opposite directions, and means drivingly connecting the cam means and the ink roll so that the ink roll is driven sequentially between an ink receiving location and inking contact with the print head.

The remaining claims add without further invention standard parts to the apparatus, such as motors to actuate the printer or ink transfer rollers. What is claimed is an inking system to be used in a printing machine in which either the print head (which carries the type) or the platen (the metal plate which presses the paper against the type) is movable, the other member being stationery.

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 them well before the priority date of this application.

The Examiner put his objection as follows:

> In his letter dated August 29, 1977 the applicant includes photo-copies of two affidavits signed by two of his employees, and filed in his copending application 160,480 which was finally rejected for similar objections. In summary, the affidavits mention that the two types of printers (print head movable and platen fixed, print head fixed and platen movable) are well known, and that from the teachings of the present application, one skilled in the art could build a printer with a movable head, without the exercise of inventive ingenuity.
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> The examiner is fully aware of the two types of printers referred to above, but one is so mechanically different from the other that he has to disagree with the applicant on the fact that the claimed printing apparatus could be built with a movable print head without the exercise of inventive ingenuity, e.g. the inking system would have to be timed with the print head movement, this print head would have to be pivoted, etc. Fact remains that the disclosure fails to define details or differences between the two structures.
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> In Scully Signal Co. v York Machine Co. Ltd, 23 C.P.R. 6 it was decided that nothing that has not been described can be validly claimed.

In Permutit v Borrowman , 43 R.P.C. 356 the judge ruled that an inventor must have reduced his invention to a definite and practical shape before he can be said to have invented.

It is held that the embodiment wherein the print head is movable and the platen is fixed is not described in the present disclosure but merely mentioned. It is further held that there is no evidence in the present disclosure that the said embodiment was reduced to a definite and practical shape before the filing date of the present application.

Moreover, claims 1 to 10 define two structurally different embodiments and are therefore indefinite per se.

Consequently, the objections set forth in the last Office Action dated June 6, 1977 are maintained:

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

b) claims 1 to 10 stand rejected under Rule 25 of the Patent Rules as not fully supported by the disclosure in the recitation of the embodiment wherein the print head is movable and the platen is fixed; and

c) claims 1 to 10 stand rejected under Section 36(2) of the Patent Act as indefinite per se in defining two structurally different embodiments.

...

While they are rather lengthy, we think it would be useful to reproduce applicant's written argument:

...

With all due respect, it is difficult to equate the Examiner's skill in the art with the skill of either Mr. William A. Jenkins or Mr. Paul H. Hamisch Sr. The Affidavits sworn by each of these gentlemen and filed in the present application and in Applicant's copending Application No. 160,480, do represent the opinions of individuals who have been involved in the invention and construction or printing apparatuses of the type described in the present application. 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. Thus, under these circumstances,

it is not seen how the Examiner can so readily dismiss the Affidavits submitted in the response filed August 29, 1977.

The present invention is directed to a printing apparatus of the type in which the print head and the platen are mounted for relative movement towards and away from each other during a printing cycle to print data on a record member. Either the print head or the platen can be fixed to the frame. An ink roll for applying ink to the print head is used and a cam and follower, the cam being situated on the movable print head or platen, drives the ink roll sequentially between an ink receiving location and inking contact with the print head. Thus, the present invention is directed to a particular inking system. The invention is not directed to the feature of providing a printing apparatus wherein either the print head or the platen is fixed to the frame. As is stated in the Affidavits filed in the response of August 29, 1977, the construction of these apparatuses is readily apparent to one skilled in the art when presented with a description of how to construct one of them.

Applicant noted that the Examiner has cited the Scully v. York case wherein it was decided that nothing that has not been described can be validly claimed. In that instance, the integer in question was considered to be an essential feature of the invention. The Court decided that the substitution of an alternative integer which was not disclosed or suggested in the application by another party did not constitute infringement of the claim in question.

It seems to be a well established principle that the doctrine of equivalents does not apply when substitution of an essential feature is made. See R.C.A. Photophone Ltd. v. Gaumont - British Picture Corp. (1936) 53 R.P.C. 167 at p. 197 "It is only in respect of unessential parts of an invention to which the principle of mechanical equivalents can be applied". Where an individual substitutes or omits an unessential part of an invention, he or she does not generally produce a new invention nor does he or she necessarily escape from infringement. In the present situation, to substitute an apparatus wherein the print head is movable and the platen fixed for one wherein the print head was fixed and the platen movable does not amount of another invention as this type of substitution relates to an unessential feature of the invention. As is stated above the invention is directed to an inking system for use in known printing apparatuses.

Applicant is well aware of the statement made in Permutit v. Borrowman: "It is not enough for a man to say that an idea floated through his brain; he must have at least reduced it to a definite and practical shape before he can be said to have invented a process." However, in the present instance, Applicant has reduced the invention to a definite and practical shape. It is not a mere idea that has floated through the inventor's brain. The fact is, that the present application specifically describes the best mode of carrying out the invention, which is a requirement of the Patent Act, while disclosing an obvious alternative thereof.

> The alternative mode is readily apparent to a man skilled in the art on reading the application. On this basis, Applicant would submit that it is unnecessary to provide a specific description of each of the embodiments. Applicant notes that in Fox on Canadian Patent Law, 4th Ed. at p.174, it is stated:
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> > "It is not necessary, where the patent is for an improvement, that it should describe in detail all the old and known parts of the machine to which the improvement relates. It is sufficient merely to state the type of machine to which the improvement is applicable."
>
> Applicant is somewhat confused by the Examiner's suggestion that there is no evidence in the present disclosure that the said embodiment (wherein the print head is movable and the platen is fixed) was reduced to a definite and practical shape before the filing date of the present application. Applicant cannot understand why there is any need for evidence of this nature in the application. Applicant would submit that it is a well established practice within the Patent Office to consider not only written disclosures in determining date of invention but also evidence attesting to oral disclosures. It is not necessary to reduce an invention to practical form at the date of invention. As long as the disclosures attesting to date of invention are sufficient for a person skilled in the art to put the invention into practice they have been considered suitable for this purpose. This practice has been upheld in the courts as well. Thus the Examiner's requirement seems entirely out of place and certainly not representative of Canadian patent practice.

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 suit 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 voiced 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 an inking mechanism, but one which in the claim 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 letter of March 2, 1978:

> 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. They all show inking mechanisms of one sort or another. Taking it that there is an invention in the inking mechanism 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.

At the Hearing it was also brought out that automatic inkers were known in the printing arts generally. Whether it would be obvious to adapt them to labellers is not clear to us, but since that was not the basis of the rejection, we need not explore it.

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. Gariepy
Commissioner of Patents

Agent for Applicant

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Dated at Hull, Quebec
this 20th. day of November, 1979