

COMMISSIONER'S DECISION

Conflict, no support, anticipation - Silicone Composition

By means of Section 11 Applicant learned of a Canadian application claiming compositions not disclosed in his own application. He then tried to insert claims to said compositions to provoke a conflict, in which he hoped to provide art to show that the other parties' application should not be allowed. Conflict proceedings are designed to determine priority, and are not to be used as form of Opposition proceedings. The art should be submitted under Rule 15. Furthermore a new claim proposed at the Hearing is anticipated by an earlier patent of the Applicant and is a statutory bar under Sec. 28(1)(b).
Rejection: Affirmed

Patent application 272178 (Class 400-89), was filed on February 21, 1977,
for an invention entitled "Oil Resistant Modified Silicone Composition."

The inventors are Patrick J. Adams et al, assignors to SWS Silicones Corporation. The Examiner in charge of the application took a Final Action on May 3, 1979, refusing to allow it to proceed to patent. In reviewing the rejection, the Patent Appeal Board held a Hearing on October 10, 1979, at which the Applicant was represented by Mr. M. Martin Marcus, the Canadian Patent Agent, and Mr. Marion Ford, from SWS Silicones.

The circumstances leading to this rejection are somewhat unusual. On November 29, 1977, the Applicant introduced new claims 13 - 17 into the Adams application for the purpose of provoking a conflict with an application of Ben Alfred Bluestein, filed by the General Electric Company. Adams had discovered through Section 11 of the Patent Act that there is a Bluestein application in Canada corresponding to French Patent 2256226, published July 25, 1975, which in turn corresponds to Bluestein's British Patent 1,487,853, October 5, 1977. Both the Bluestein patents relate back to a U.S. application 428010 filed on December 26, 1973, some three years before Adams' Canadian filing date, and now U.S. Patent 4,138,387, Feb. 6, 1979.

The claims so introduced (13-17) were rejected by the Examiner on the grounds that they were not supported by the Adams disclosure. Claim 13 was further rejected for being anticipated by an earlier Canadian patent of Adams, No. 919,339, issued January 16, 1973.

We do not need to consider claim 13 on the file further since in the response to the Final Action dated July 17, 1979, on page 4, at lines 17-18, Adams has already said:

Applicant is prepared to cancel claim 13, and consequently does not appeal the Examiner's final rejection of claim 13.

At the Hearing Mr. Marcus conceded that claims 14-17 were also not supported by the disclosure. He has further indicated in his reply of July 17, 1979, that his sole purpose for introducing them into the Adams application is conflict, and that the claims do not accurately reflect what occurs. See in particular page 4 of the letter at lines 19-21, page 2 para. 3, and page 4 at lines 11-16 and 26-28. At the Hearing Mr. Marcus again stated that the claims on file do not reflect what actually occurs and are in fact unallowable to either Applicant. Their objective on presenting the claims, he said, is to have a conflict established so that they can demonstrate during the conflict proceedings that neither party is entitled to the claims.

At the Hearing Mr. Marcus presented a new claim 13 to replace existing claims 13-17. The new claim, he says, is supported by both applications, and a conflict could be established on the basis of it. The Board then suggested that since neither the Examiner nor the Board had had the opportunity to assess new claim 13, the file should be remanded to the Examiner to consider it. Mr. Marcus, however, indicated that to expedite final disposition of the matter, and to have the conflict settled quickly, he would prefer the Board to make its determination without further prosecution.

The Hearing then concluded with the understanding that the Examiner and the Board would review new claim 13, together with certain statutory declarations made before the British Patent Office during the prosecution of Bluestein's British patent, and make a recommendation to the Commissioner. New claim 13 is as follows:

A process for the reaction of hydroxyl-terminated dimethyl-polysiloxane fluid with at least one of ethyl acrylate, methacrylonitrile, butyl acrylate, styrene, vinyl acetate monomer, divinylbenzene, methyl-methacrylate and allyl methacrylate, which comprises carrying out the reaction in the presence of a free radical initiator selected from azo(isobutyronitrile), benzoyl peroxide, tert-butylperoxoate, 1,1-di-tert-butylperoxy-3,3,5-trimethylcyclohexane, tert-butyl peroxide.

The review of new claim 13 has now been completed. We find that it is anticipated by Adams' prior Canadian patent 919339, January 16, 1973, which is a statutory bar to a claim being allowed in Adams' present application, which was filed on February 21, 1977. It is a bar by virtue of Section 28-1-b of the Patent Act. Claim 13, which is a broad claim, covers generally exactly the same processes described separately in examples 1 to 11 of the Adams patent. Indeed examples 1 to 11 of Adams' application are identical to examples 1 to 11 of his patent.

We think this is sufficient to dispose of the matter. There is a statutory bar against now claim 13 in so far as this application is concerned, and it should be refused. Nor can we agree with Applicant's contention that the application should be allowed to proceed with an unallowable claim so that it can be placed in conflict with Bluestein to prevent Bluestein getting a patent. The purpose of conflict proceedings is to determine priority between two allowable applications, not a forum to challenge the issuance of claims which the Applicant says are unallowable to another party. What the Applicant is trying to do is introduce a form of Opposition Proceedings similar to that practised in the United Kingdom into the Canadian Act, something which is not part of the Canadian legislation. If there were any validity to Applicant's objections to the Bluestein application he should resort to Rule 15 to protest against that application, a procedure which is established in Canada.

As was said in Texas Development v. Schlumberger 49 CPR 225 at 223:

... reading s.45 as a whole, it is my view that it provides for an interruption in an ordinary processing of an application for a patent for the sole purpose of deciding which of

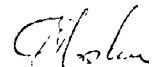
two Applicants is the inventor (sometimes described as the first inventor) of an invention which is claimed by each of two applications pending in the Patent Office. This interruption in the ordinary processing of applications is extraordinary and should, in my view, be restricted to the determination of the conflict it is designed to resolve.... (underlining added)

Obviously conflict should not be used for the purpose now proposed by the Applicant.

Though not necessary to dispose of the matter, we might also comment upon the statutory declaration of Mr. White and Mr. Bluestein provided by the Applicant. That of Mr. White demonstrates that the invention described and claimed in the present application is different from that described and claimed in the Bluestein disclosures. Bluestein is interested in preparing a stable polyolefin-filled organo-polysiloxane dispersion comprising two phases wherein there is substantially no grafted polysiloxane. Adams is interested in making an oil-resistant curable organo-polysiloxane by graft polymerizing a mixture of unsaturated monomers containing nitrile and ester functions with an organopolysiloxane, followed by cyclization at elevated temperatures (see: page 6, lines 16 to 22; page 6a, lines 7 to 14; page 7, lines 17 to 19, etc.). This one is concerned with graft polymerization, the other is not.

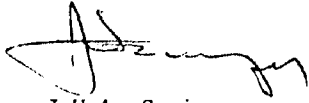
At the Hearing Mr. Marcus said that if Conflict were established, he intends to submit art at the Section 45(4) stage of the proceedings to show that the claims in question "are not patentable to either of the parties." He can, of course, submit such art under Rule 15, without resort to the elaborations of conflict, and we suggest he do so. Such art should be submitted quickly to avoid delaying the prosecution of Bluestein's application.

To conclude, we recommend that claims 13-17, and newly proposed claim 13, be refused.



G.A. Asher
Chairman
Patent Appeal Board, Canada

I have reviewed the prosecution of this application, and now refuse claims 13-17, and newly proposed claim 13, for the reasons advanced by the Patent Appeal Board. Said claims must be deleted within six months of the date of this decision.



J.H.A. Gariopy
Commissioner of Patents

Dated at Hull, Quebec

this 31st.day of December, 1979

Agent for Applicant

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