COMMISSIONER'S DECISION

Section 38: Silicone Dental Impression Composition

The examiner called for division. It was held claim 1 and 12 are directed to different compositions, which achieve different results. The requirement for division made under Section 38 is affirmed.

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Patent application 254987 (Class 400-73), was filed on June 16, 1976 for an invention entitled "Silicone Dental Impression Compositions." The inventor is Robert A. Smith, assignor to General Electric Company. The Examiner in charge of the application took a Final Action on November 21, 1979 refusing to allow it to proceed to patent.

The application is directed to improved silicone dental impression composition

In the Final Action the Examiner pointed out that claims 1 and 12 are deemed to be directed to separate and distinct alleged inventions. He went on to say:

> ...
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> .... Claim 18, although formally satisfying Patent Rule 60, is deemed to be an artificially broad claim as described in the Manual of Patent Office Practice, chapter 10.01, wherein it is stated "It should also be noted, however, that if an artificially broad claim covering several inventions is presented so that technically there is a single broad claim, an objection might still be in order, under Section 38".
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> The reason the examiner deems the claims 1 and 12 directed to separate inventions is that they are directed to separate compositions.
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> Both claims have in common 0.3 to 0.7 parts of a metal carboxylate salt catalyst per 100 parts of a base composition which comprises 0.05 to 2% of an organosilicon crosslinker.
>
> Claim 1 has besides 25% to 35% of a fluid organopolysiloxane of viscosity from 2,000 to 250,000 cps at 25°C and 63 to 75% of a zinc oxide, calcium carbonate and pumice mixture.
>
> Claim 12 has besides 15 to 25% of a fluid organopolysiloxane of viscosity 15,000 to 35,000 cps at 25°C, 70 to 85% of a low oil absorption calcium carbonate, 3 to 8% of mineral oil.

> The distinctions are first in the useful range of organopolysiloxane 15 to 25%; 25 to 35%: second in the fillers zinc oxide - pumice - calcium carbonate; low oil absorption calcium carbonate: third in the mineral oil only present in one of the compositions.
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> ...

In response to the Final Action the Applicant did not agree with the stand taken by the Examiner. In discussing whether or not claim 18 can be considered an artificially broad claim, he had this to say:

> ...
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> It is respectfully submitted that Applicant's claim 18 is not an artificially broad claim. As conceded by the Examiner, claim 18 formally satisfies Patent Rule 60. Furthermore, claim 18 is not broader than the invention originally disclosed. Claims 1 and 12 presently on file can find support in the specification as originally filed. This last statement may be considered unnecessary because the Examiner has not raised any objection to the effect that the claims are not supported by the disclosure. However, Applicant considers that such a statement should be made. To support Applicant's statement claim 1 finds support from original page 6 wherein "The first embodiment" of the invention is referred to and claim 12 finds support at original page 10 wherein "a second embodiment" of the invention is referred to. It should be noted here that Applicant in his disclosure has referred to the compositions claimed in claims 1 and 12 as first and second embodiments of the invention. A careful reading of claim 18 shows that claim 18 does not have a scope broader than the combined scopes of claim 1 and claim 18. Thus claim 18 is not broader in scope than the invention originally disclosed. Furthermore, because claim 18 is not directed to any additional compositions other than those claimed in each of claims 1 and 12, and because claims 1 and 12 are operable, then it is submitted claim 18 is only directed to operable combinations. Thus, claim 18 cannot be considered an artificially broad claim.
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> ...

In discussing claims 1 and 12, he had this to say:

> ...
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> The Examiner in his Final Action, after having deemed claim 18 as an artificially broad claim, deems claims 1 and 12 to be directed to separate inventions. The Examiner then draws some distinctions between claims 1 and 12, concluding claim 1 would not be infringed by claim 12 and vice-versa. It is quite evident the Examiner is relying on the infringement test as outlined in the Manual of Patent Office Practice to find claims 1 and 12 directed to separate

inventions. However, the above under-scored citation from the Manual of Patent Office Practice, Section 10.02, stipulates that if an artificially broad claim is present then an objection might still be in order under Section 38. But Section 10.02 discusses the relationship between Section 38 and Rules 58, 59 and 60, and thus the reference to an objection under Section 38 can not be construed to include Rules 58, 59, 60. Hence, the infringement test can not be relied upon to find independent claims directed to separate inventions when there is an artificially broad claim on file because the infringement test is used to determine if there is a claim on file that is broader in scope than any other, in other words, a claim that complies with Patent Rule 60. Thus the Examiner is in error when he employs the infringement test to deem claims 1 and 12 directed towards separate inventions. It should be understood that the remarks made by the Applicant herein do not represent an admission that claim 18 is artificially broad.

...

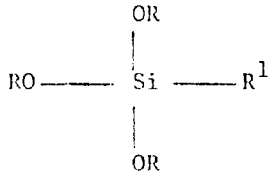
The first consideration by the Board is whether or not claims 1 and 12 are directed to separate and distinct inventions. Claims 1 and 12 read:

1. A room temperature vulcanizing silicone dental impression composition which, before curing, consists essentially of from about 0.3 to about 0.7 parts by weight of a metallic salt of a monocarboxylic acid as a catalyst to about 100 parts of a base composition consisting essentially of:

a) from about 25 to about 35% by weight of a fluid diorganopolysiloxane containing terminal silicon-bonded hydroxy groups and having a viscosity of from 2,000 t 250,000 cps. at 25°C.;

b) from about 63 to about 75% by weight of a filler composition consisting essentially of an admixture of zinc oxide, calcium carbonate and pumice, said zinc oxide and calcium carbonate each being present in at least a sufficient amount to provide bulking and whitening and said pumice being present in at least a sufficient amount to provide putty-like consistency;

c) from about 0.05 to about 2% by weight of an organo-silicon cross-linker having the general formula:



wherein R is a radical selected from the group consisting of alkyl, alkenyl and aryl radicals and R^1 is a member of the group consisting of alkyl, alkenyl, aryl and alkoxy radicals.

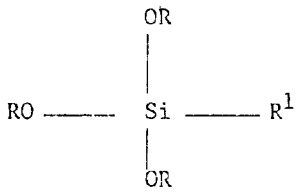
12. A room temperature vulcanizing silicone dental impression composition which, before curing, consists essentially of from about 0.3 to about 0.7 parts by weight of a metallic salt of a monocarboxylic acid as a catalyst to 100 parts of a base composition consisting essentially of:

a) from about 15 to about 25% by weight of a fluid diorganopolysiloxane containing terminal silicon-bonded hydroxy groups and having a viscosity of from about 15,000 to about 35,000 centipoise at 25°C.;

b) from about 70 to about 85% by weight of a filler consisting essentially of low oil absorption calcium carbonate;

c) from about 3 to about 8% by weight of mineral oil; and

d) from about 0.05 to about 2% by weight of an organo-silicon cross-linker having the general formula:



wherein R is a radical selected from the group consisting of alkyl, alkenyl and aryl radicals and R^1 is a member of the group consisting of alkyl, alkenyl, aryl and alkoxy groups, said composition having a non-sticky feel before curing, and a smooth, non-grainy appearance after curing.

We find that claim 1 generally defines a composition comprising a specific catalyst and a base composition as follows:

(a) 25 to 35% of polysiloxane of viscosity 2,000 to 250,000 cps at 25°C,

(b) 63 to 75% of a zincoxide-calcium carbonate-pumice filler,

(c) 0.05 to 2% of an organosilicon crosslinker.

Claim 12 generally defines a composition comprising a specific catalyst and a base composition as follows:

(a) 15 to 25% of polysiloxane of viscosity 15,000 to 35,000 cps at 25°C,

(b) 70 to 85% of a calcium carbonate filler,

(c) 3 to 8% of mineral oil,

(d) 0.05 to 2% of an organosilicon crosslinker.

These claims are clearly directed to separate compositions. Both claims, however, have in common 0.3 to 0.7 parts of a metal carboxylate salt catalyst per 100 parts of a base composition which comprises 0.05 to 2% of an organosilicon crosslinker. The distinctions are in the useful range of organopolysiloxane 15 to 25% as opposed to 25 to 35%; second in the fillers zinc oxide-

pumice-calcium carbonate as opposed to low oil absorption calcium carbonate, and third in the mineral oil only present in one of the compositions (claim 12).

We find also that when pumice is used in the mixture it "surprisingly" produces "greater hardness" in the filler. This was discussed on page 9, line 3 f.f., as follows:

> The various components of the filler work in combination. Calcium carbonate and zinc oxide are used as bulking as well as whitening agents. Pumice is used to provide a putty-like consistency to the composition. Pumice is also more easily wetted into the formulation and thus assures more consistency from batch to batch than other types of filler. Surprisingly, it has also been found that when pumice is used as a component of the filler, greater hardness is obtained with the composition within a relatively short time after addition of the catalyst and curing. All three components of the filler must be present to produce the advantageous results achieved with this embodiment.

It is our view then that the claims cover different inventions and not just different embodiments of the same invention. Supposing that claim 1 was in a citable patent, we think that the Applicant would argue strongly that claim 12 is indeed directed to subject matter different from claim 1 and object to it as a proper reference.

To summarize, we are satisfied that claims 1 and 12 define different subject matters of invention. The Applicant must elect to prosecute in this application either claim 1 (together with claims 2 to 11 and 17) or claim 12 (together with claims 13 to 16). This notwithstanding that the compositions may be used for the same purpose and have some similar properties.

The addition of claim 18 may satisfy Rule 60 of the Patent Rules, but it does not satisfy Section 38(2) of the Patent Act where it specifies that the claims must be limited to one invention only. If claim 18 is to remain it must be restricted so that it is consistent with the elected claims.

The Applicant argued that claims 1 and 12 find support in the specification as originally filed. We do not, however, find this argument germane to the question before us, nor was it brought up by the Examiner.

The Applicant also argued that claims 1 and 12 are not open to objection under Section 38(1) of the Patent Act. The Examiner, however, made it clear that he was rejecting under Section 38(2) of the Patent Act and not Section 38(1)

We therefore recommend that the decision in the Final Action to refuse the application, as it presently stands, be affirmed.

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

I have 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 as it presently stands. The Applicant has six months within which to submit an appropriate amendment, as discussed above, or to appeal my decision under Section 44 of the Patent Act.

J.H.A. Gariepy
Commissioner of Patents

Dated at Hull, Quebec
this 6th. day of November, 1980