

COMMISSIONER'S DECISION

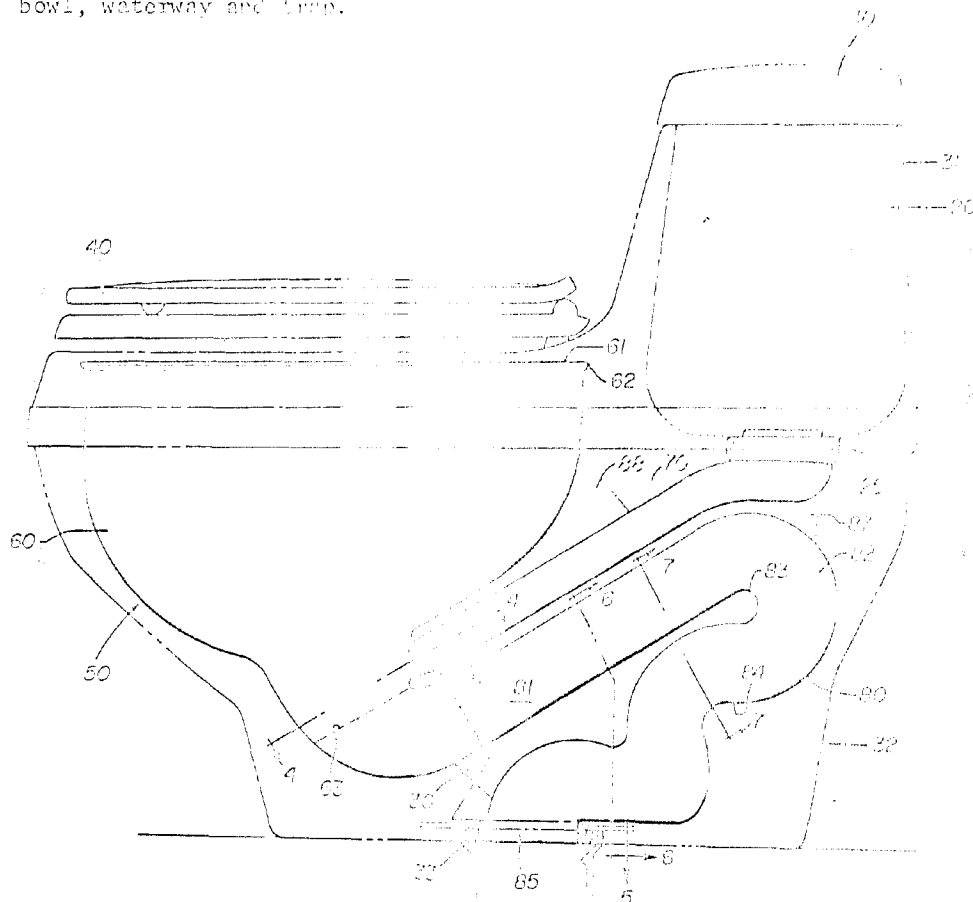
Section 36: Plastic toilet bowl

The product claims satisfy Section 36 without the need to limit these claims to a particular process disclosed for making it. The Final Action refusing the product claims under Section 36 was withdrawn.

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Patent application 294,156 (Class 4-29), was filed on December 30, 1977 for an invention entitled "Unitary Bowl, Waterway and Trap for a Toilet, and the Method of Making Same". The inventors are Samuel C. Crosby et al, assignors to Trayco, Inc.. The Examiner in charge of the application took a Final Action on November 8, 1979 refusing to allow it to proceed to a patent. In reviewing the rejection, the Patent Appeal Board held a Hearing on October 29, 1980, at which the Applicant was represented by Mr. R. Bell. Also in attendance was the United States Patent Attorney, Mr. R. Craver, and from the Applicant Company Messrs. C. Bahroos and D. Schrook.

The application is directed to a method of making, by blow molding, an integral plastic bowl, waterway and trap for a toilet and the product thereof. Figure 1, below, shows a side elevation view of the integral bowl, waterway and trap.



In the Final Action the Examiner refused all of the product claims (claims 1-4, 7-9 and 13) because, in his view, they are "indefinite and not in compliance with Section 36(2)" of the Patent Act. He had this to say (in part):

...

The present claims 1-4, 7-9 and 13 stand rejected as indefinite and not in compliance with Section 36(2). It is held that the essential aspect of forming the fixture using a pair of blow mold sections operating on a parison with the mold sections forming bulbous sections of the fixture as well as pinched closed flow passages when fluid is blow into the parison interior be included in these claims. Claims 5, 6 (dependent on 5), 10, 11 and 12 are allowable. Any product claim made dependent on method claim 11 would also be allowable. Method claim 11, it is held, is the heart of the disclosed invention.

The claims must not go beyond the disclosure. The claims must define and limit with precision that which is claimed to be the invention. The claims must be restricted to the limitation of the disclosure, and must not be broader than is warranted by the disclosure.

The point to be stressed is that it is the invention as claimed which is at issue and not the invention as disclosed.

An inventor should not be rewarded beyond what he gives to the public. It is possible that a claim for all means of arriving at a desired result would be broad enough to cover later discovered means wholly independent of the first means for arriving at the same final result. In such a case the inventor would be over protected.

The disclosure must contain a description which is not calculated to deceive or mislead the persons to whom the specification is addressed and render it difficult for them without trial and experiment to comprehend in what manner the invention is to be performed. It must not, for example, direct the use of alternative methods of putting the invention into effect if only one is practicable, even if, persons skilled in the art would be likely to choose the practicable method. The description of the invention must also be full; this means that its ambit must be defined, for nothing that has not been described may be validly claimed.

Looking at the specification as a whole it is clear applicant requires the presence of a pair of blow mold sections operating on a parison with the mold sections forming bulbous sections of the fixture as well as pinched closed flow passages when fluid is blown into the parison interior. Every bit of this detail is required by applicant to achieve success. There is no direction to omit any of it. Applicant has provided in his specification no alternatives or alternate embodiments whatsoever....

In response to the Final Action the Applicant did not agree with the stand taken by the Examiner and argued against the rejection under

Section 36(2). The Applicant had this to say, inter alia:

...

It is respectfully submitted that this objection is clearly not justified under Canadian patent law or under current Canadian patent practice. It appears that the Examiner has taken the position in the fourth paragraph of the Office Action that it is essential to recite in the rejected product claim the method steps of forming the claimed fixture in a particular manner, namely, the method of formation disclosed in the present application. Although it might be necessary to recite the indicated method steps in a method claim, as has been done in present method claim 11, there is certainly no need to recite the method used in the product claims. The applicant takes the position that the product itself is new and unobvious and its utility cannot be doubted. It is noted that the Examiner has not rejected the product claims in their present form on the basis of any prior art. It must therefore be assumed that the present product claims distinguish over any prior art of which the Examiner is aware. Certainly it is the applicant's position that the product claims do in fact distinguish over the prior art of which it is aware.

If one compares the scope of the various product claims in this application, it appears that present claim 13 is the broadest claim. This claim is directed to a fixture for a toilet (obviously a useful article) which includes a bowl, a trap and a tubular waterway, all of which are arranged in a particular manner having proven utility. The primary distinctive structural feature recited in the claim is found in the last three lines wherein it is stated that "the bowl, waterway and trap are formed from a single integral piece of water-impervious plastic, free of any joints and having an essentially smooth interior surface".

At the Hearing Mr. Bell submitted an amended set of product claims for consideration before the Board. It follows that the consideration before the Board is whether or not the amended set of claims satisfy the requirement of Section 36(2) of the Patent Act. We should point out at this time that no prior art was cited against the rejected claims. Proposed Claim 1 reads:

A toilet fixture including a bowl having a large upper opening and a small discharge opening at its bottom leading onto a trap, the upper portion of the bowl being essentially symmetrical about a vertical longitudinal reference plane, the trap being tubular and having an inlet end communicating with the discharge opening of the bowl and an outlet end for connection to a water closet flange, a tubular waterway having an inlet end communicating with a holding tank and an outlet end communicating with a chamber defined by the bowl and that portion of the trap located between the bowl and the water-level establishing lip of the trap, wherein the bowl, waterway and trap are formed from a single integral piece of water-impervious plastic, free of any joints and having an essentially smooth interior surface, the trap and waterway each being substantially aligned with and intersected by the reference plane for at least substantially all of their respective lengths, and at least a substantial portion of the length of the waterway being located between the bowl and trap.

At the Hearing Mr. Bell pointed out that in his view the Examiner's primary objection to the product claims is the fact that they are not limited to a fixture made by the specific blow molding method described in the application. We think that is a fair assessment of the situation.

Mr. Bell went on to argue that it is quite clear to those skilled in the art that the fixtures of the present application could be made by known techniques, other than the blow molding method described in the present application. In an Affidavit submitted by Mr. G.R. Bahroos, Project Engineer at Mosco Corporation, it was stated that two other well-known methods, centrifugal casting and rotational casting, could have been used. At the Hearing Mr. D. Schrook also stated that the same two methods were well known to him. According to the information before us Mr. Schrook is a skilled person in this art.

In any event on the record before us the applicant has produced a new product and adequately defined it by structure. There is no need to limit it further to the particular process disclosed for making it, because the applicant is entitled to the product, if inventive and Section 36 is satisfied, no matter how it is prepared. The exception to this is, however, if the product falls under Section 41 of the Patent Act, which calls for the product to be limited to the method of manufacture. The applicant must, of course, describe how the product is made, but that is the role of the description in the disclosure, not the claims.

We have carefully reviewed amended claim 1, above, and on the record before us it clearly satisfied Section 36(2) of the Patent Act. It defines distinctly and in explicit terms what the Applicant regards as new. The same arguments apply equally to the remainder of the product claims (Claim 2 to 12). We therefore recommend that the product claims, referred to above, should be accepted.

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

I have reviewed the prosecution of this application and considered the recommendations of the Patent Appeal Board. I concur with the reasoning and findings of the Board. Accordingly, I will accept the amendments and remand the application to the Examiner for resumption of prosecution.



J.H.A. Gariépy,  
Commissioner of Patents

Dated at Hull, Quebec

this 21th day of November, 1980.