

COMMISSIONER'S DECISION

REISSUE: FASTENER DISPENSING APPARATUS

Applicant's claims are broader in scope than those deliberately cancelled during prosecution of the original patent and are directed to a different invention than that previously claimed.

Rejection: Affirmed

Patent application 330,333 (Class 93-93), was filed on June 15, 1979 for an invention entitled "Apparatus For Dispensing Fasteners." The inventor is Arnold R. Bone, assignor to Dennison Manufacturing Company. The Examiner in charge of the application took a Final Action on July 11, 1980 refusing to allow it to proceed to patent. In reviewing the rejection, the Patent Appeal Board held a Hearing on October 7, 1981 at which the Applicant was represented by Mr. K. Carton and Mr. J. Macera.

The Applicant is seeking to reissue a patent which relates to apparatus of the type used for dispensing anchoring tags to be attached to articles of apparel, or coupling buttons to coats. Figures 2, 4 and 26 of the application are shown below:

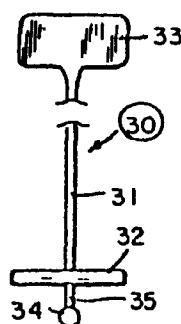
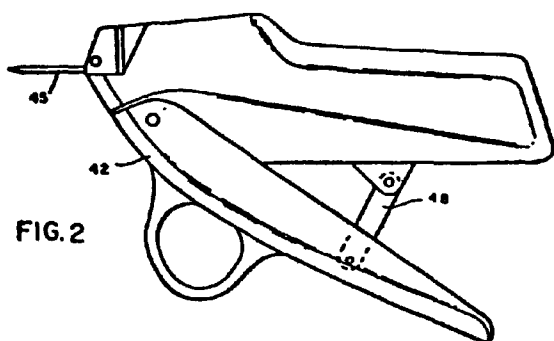
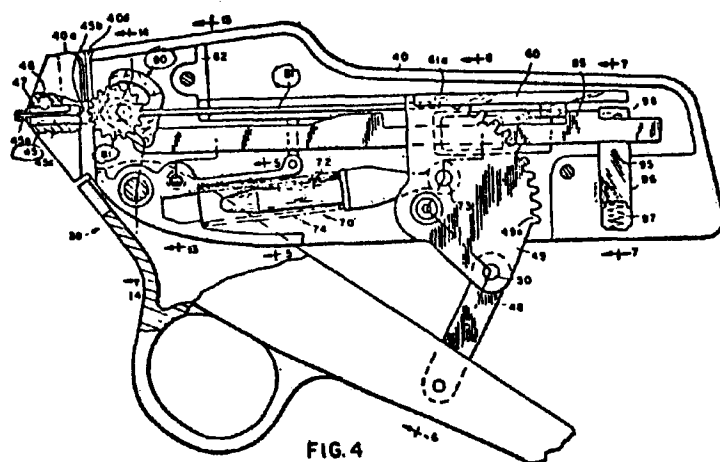


Fig. 26

Tag 30 moves through guide-way 40d under the control of indexing mechanism 80, 81, and is dispensed through hollow slotted needle 45 by plunger 61 when handle 42 is actuated.

The Examiner refused the application to reissue for failing to meet the requirements imposed by Section 50 of the Patent Act. He stated (inter alia):

...

The refusal of this application is maintained and the grounds for such rejection are as follows:

1. Plurality of Inventions

Claims 19-29 presently on file are not directed to the same invention as the claims allowed in the original patent (which claims have been refiled in the instant application as claims 1-18) and as such are contrary to Section 50.

Comparing claims 1-18 and 19-29 it is evident that the additional claims (i.e. claims 19-29) are directed to a plurality of alleged inventions all of which are different from the one defined in the claims allowed in the original patent (i.e. present claims 1-18).

In his remarks the applicant did not dispute the above objection but attempted instead to justify the insertion of these claims on the ground that Section 50 of the Patent Act specifically provides for reissuance when the patentee claimed less than he had right to and therefore he is entitled to insert the additional claims which should have been inserted originally but were omitted due to inadvertence accident or mistake.

Clearly this view can not be entertained as a valid conclusion. Although Section 50 provides for claiming "more or less" nevertheless the reissue must be directed to the same invention as that described and claimed in the original patent. The provision for claiming "more" may not be construed as a right of applicant to insert a greater number of claims directed to different alleged inventions.

2. Reassertion of previously cancelled claims:

Claim 22 (old claim 23) the broadest claim in the group of claims 19-27 directed to one of the alleged inventions is also broader in scope than the original claim 21 cancelled during the prosecution of the original patent in response to the requirement for a restriction of claims to a single invention.

As claims which are broader in scope than those deliberately cancelled during the prosecution of the original patent may not be re-asserted in the reissue, the above claims are rejected.

Applicant's arguments with respect to the above have been noted, however, his reliance on the original claim 1 in these arguments is not understood as no reference to this claim appears in the previous office action. It is claim 22 (old claim 23) which is considered to be the broadest claim in the group and as such must be compared for its scope with the claims deliberately cancelled during the prosecution of the original patent.

3. Duplicate claiming.

The applicant has concurred with offices objection and cancelled the old claim 22 defining a subject matter which is being concurrently prosecuted in applicant's copending application #262,159.

However, the particular facts presented in items 3, 4 and 5 of the Petition in connection with the above have now proven to be incorrect thereby rendering the petition defective.

4. Lack of support.

Claims 28 and 29 are directed to a concept of a particular mode of lost motion operation which is not supported by the disclosure. Lost motion may be inherent in the actuating mechanism described, however, a lost motion per se is known and a particular mode of lost motion operation as defined in the claims is not described as such in the disclosure of the original patent nor was it recognized as inventive therein.

In the letter of February 28, 1980 applicant has merely stated that it is a particular mechanism for achieving lost motion that is being claimed and not "lost motion" per se, however he did not indicate where in the disclosure a support for the particular mode of lost motion operation may be found.

5. Defective Petition.

Items 2 and 3 of the Petition are defective as stated in the previous office action in that with the resubmission of the disclosure and claims (1-18) of the Original Patent without inserting a claim to the same invention but of a broader scope to justify applicant's contention of claiming more than in the allegedly defective patent the Petition does not conform to the requirements of Section 50 of the Patent Act as it can not be said that the description is insufficient or that the patent claims less than applicant had right to claim.

...

In response to the Final Action the Applicant argued (in part):

...

Section 50 first requires that the patent be "deemed defective.... by reason of the patentee's claiming....less than he had a right to claim as new...". Paragraph 2 of the petition for reissue satisfies this requirement. Paragraph 3 of the petition outlines the way in which the patent is deemed to be defective or inoperative - that there was a failure by the patentee's patent agents to appreciate fully the various aspects of the present invention and hence a failure by the patentee's patent agents to claim various aspects of

the present invention as broadly as the inventor had a right to claim as new. This has been recognized as a reason to allow a patent to reissue. See Curl Master v. Atlas Brush (1967) S.C.R. 514.

The Examiner has stated that since the disclosure for reissue has not been altered (except for the new statement of invention, which means it has been altered), and since the original claims have not been altered, there can be no error. Obviously this does not follow. An error can be an error of omission as well as one of act, and the Petition filed states that it is one of omission, that the patent agent of the applicant failed to appreciate the various aspects of the invention, and that he failed to claim what he should have.

The Examiner has also stated that there is no evidence of any error in not including in the original patent the subject matter of the present claims 19-29. It is submitted that the fact that these claims are directed to what the inventor had a right to claim as new, that these claims were not included in the original patent, and that the Petition states the reason for not including these in the original patent is due to the error of the patentee's patent agent, is evidence of an error of omission, and in full compliance with the first portion of section 50 of the Patent Act. Hence items 4 and 5 of the Petition cannot be defective since the evidence of the error is explained in the Petition and is self-evident. Hence there is more here than a mere allegation of error. The existence of claims which are supported by the disclosure and which are novel and inventive and broader than the claims allowed, and which were not included in the original application, is evidence of an error of omission.

The principle objection of the Examiner seems to relate to the last part of Section 50(1) which deals with the words "same invention". It is submitted that these words mean that newly discovered matter may not be added to the disclosure or claimed, or that matter which was invented but not disclosed or claimed or shown in the drawings may not be added to the disclosure or claimed. But where the disclosure and drawings describe certain aspects of an invention, but were not claimed, then it is proper to reissue the patent to claim these aspects. It is submitted that inventors would normally claim everything to which they have a right to claim, if the inventor is properly advised by a patent agent who appreciates the invention. Hence, there is a presumption of intention on the part of the inventor to claim all various aspects of the invention. This presumption is especially true where there is an error of the patent agent in which the claims are not directed to all aspects of the invention.

In the case of Withrow v. Malcolm (1884), 6 O.R. 12, Ferguson J. held that the words "same invention" were directed to inventions which were comprehended in the surrendered patent, and that claims cannot be broadened to import something new into the reissued patent - viz. some invention not contained or comprehended in the surrendered one. This case appears to permit reissue with additional and broader claims provided that the claims are directed to inventions comprehended in the surrendered patent. The Petition filed supports this contention, as well as the disclosure of the patent. Hence if the invention is described in the patent, then it is the "same invention" for the purposes of section 50(1) of the Patent Act.

In the case of Farbwerke Hoechst AG et al v Commissioner of Patents (1965), 31, Fox. Pat. C.64;(1966), 33 Fox. Pat. C. 99, it was held that the reissue must not go beyond the scope of the invention as disclosed in the original patent, but that a patent may reissue with added claims for the invention disclosed by the original patent and not for any new invention. See also Northern Electric Co. Ltd. et al v. Photo Sound Corp. et al (1936) Ex. C.R. 75 where the words "same invention" are interpreted in contrast to the words "new invention". It was held that a reissue patent may disclose and protect the patentable subject matter which it was the purpose of that patent to secure to its inventor. This is on all fours with the present case - the inventor intended to protect that which was disclosed in his patent. Due to error of the inventor's patent agents, the subject matter was not protected. Hence, the patentee wants to reissue the patent.

...

The issue before the Board is whether or not the original patent should be reissued.

Parts 2 to 5 of the petition for reissue read as follows:

(2) THAT the said Patent is deemed defective or inoperative by reason of insufficient description or specification and by reason of claiming less than was entitled to be claimed.

(3) THAT the respects in which the Patent is deemed defective or inoperative are as follows:

The Patent may be defective in that, although a generalized statement of invention is set forth in the disclosure at page 1, line 17 to page 2, line 13, that statement does not conform strictly with the various aspects of the invention disclosed in the detailed description and accordingly the disclosure may not distinctly point out the invention as required by Section 36(1) of the Patent Act.

The Patent may also be defective in that it claims less than the Inventor had a right to claim, since there is a failure to cover all aspects of the invention.

In particular the claims do not cover the Inventor's lost-motion mechanism feature in which a slide that is movable between two end positions operates a ratchet assembly for the advancement of fasteners. In addition the claims do not cover that aspect of the invention by which a needle with an integral cutting edge is removably mountable within a device for dispensing attachments.

(4) That the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention in the following manner:

The said Canadian Patent No. 969,399 claims priority from United States Patent Application Serial No. 169,413 which was filed in the United States Patent Office August 5, 1971. Said United States Patent Application and the subsequently filed Canadian Patent Application Serial No. 969,399 were prepared by U.S. attorneys, Roberts, Cushman & Grover, who were not fully familiar with Canadian practice and law and thus did not appreciate the desirability of including in the disclosure statements of invention conforming to the main aspects of the invention.

Furthermore, the said U.S. attorneys failed to comprehend and appreciate properly the importance of several further inventive aspects of the dispensing apparatus and thus failed to include claims in the application directed thereto. The Inventor, Arnold R. Bone, is not familiar with patent law and practice and did not recognize the possible defects in the Canadian Application, nor the desirability of including in the Canadian Application the matters referred to above.

Additionally, the prosecution of the Patent Application before the Canadian Patent Office was controlled by the said U.S. attorneys, through their Canadian patent agents, Messrs. Marks & Clerk, and as a result the above noted various defects in the specification were not noticed by said Canadian patent agents.

(5) THAT knowledge of the new facts in the light of which the new claims have been framed was obtained by your Petitioners in November 1978 in the following manner:

In March 1976 a review of the counterpart U.S. patent indicated that there were aspects of the invention that had not been claimed originally because of inadvertence or mistake.

The foregoing failure to claim less than the inventor had a right to claim arose because certain aspects of the invention apparently were overlooked by the attorney who handled the original prosecution of the case. In March of 1976 the inventor was advised by another attorney that he appeared to be entitled to protection on the originally unclaimed aspects of the invention in view of the fact that his filing date disclosing the claimed subject matter is August 5, 1971, and his actual reduction to practice was before September 30, 1970.

Subsequently, an application for reissue was filed in the U.S. on March 18, 1976. This application became U.S. Reissue Patent No. 29,310 on July 19, 1977. Thereafter, in the light of the U.S. action a review was made in November 1978 to determine if other cases should be considered for reissue and it appeared that the Canadian case would qualify. In addition it was decided to correct the specification in accordance with Section 36 (1) of the Patent Act.

There are 29 claims, of which claims 1 to 18 are identical to those in the original patent. At the Hearing Mr. Carton stressed that the reissue application was directed to the same invention as found in the parent. He stated that claim 8 contains the essence of the invention, is the broadest claim of the reissue application, and defines each part of the invention.

In the Final Action it is alleged there is a plurality of inventions, of which "claims 19-29 on file are not directed to the same invention as the original patent (which claims have been refiled in the instant application as claims 1-18) and as such are contrary to Section 50".

Claim 8 reads as follows:

8. Apparatus for dispensing fastener attachment members one at a time, the fastener attachment members being coupled to a carrier by a coupling member, the apparatus including a body, a hollow needle having an elongate slot along one side supported by the body and extending therefrom, an ejector supported by the body for driving a head of a fastener attachment member through the needle with a filament of the fastener attachment member coupled to the head projecting through the slot, and an indexing mechanism comprising an indexing wheel having a plurality of teeth positioned about the circumference thereof, a pawl having a hook-like end for engaging the teeth of the wheel one at a time to rotate the wheel in one direction, the pawl having a slotted pivot hole, a support positioned in the pivot hole for supporting the pawl and at the same time permitting the pawl to rock back and forth thereon, and drive means coupled to the pawl to move the wheel in increments as the pawl rocks back and forth on the support.]

In the above claim the portion between the brackets is identical to the wording found in claim 1. Clearly then, claim 1 is broader in scope than claim 8. Claims 2 to 18 inclusive are infringed by the terminology found in claim 1 and are considered as directed to the same invention. When looking at claims 19 to 29 we are unable to find terminology relating to the indexing mechanism described in claim 1 which would infringe those claims. Consequently we agree with the Examiner that claims 19-29 are not directed to the same invention as the claims allowed in the original patent.

Section 50 permits reissuing to claim the "same invention" as was claimed originally, not a different invention. As was stated by Mr. Justice Maclean, for example, in Northern Electric v Photosound, 1936 Ex. C.R. 75 @89:

It is quite clear that the amended patent must be for the same invention and cannot embrace any new invention.

In the vast majority of cases in which a patent is defective or inoperative, its defects must be found to reside in the description given of the invention in the specification or drawings, or in both, and it was to cure such defects that relief was provided by statute. Hence, in most cases, the purpose of a re-issue is to amend an imperfect patent, defects of statement or drawings, and not subject-matter, so that it may disclose and protect the patentable subject matter which it was the purpose of that patent to secure to its inventor. Therefore the re-issue patent must be confined to the invention which the patentee attempted to describe and claim in his original specification, but which owing to "inadvertence, error or mistake," he failed to do perfectly; he is not to be granted a new patent but an amended patent. An intolerable situation would be created if anything else were permissible. It logically follows of course, that no patent is "defective or inoperative" within the meaning of the Act, by reason of its failure to describe and claim subject-matter outside the limits of that invention, as conceived or perceived by the inventor, at the time of his invention.

Therefore claims 19-29 fail to meet the requirements of Section 50 of the Patent Act.

Another objection raised in the Final Action was the reassertion of previously cancelled claims, of which claim 22 is the broadest in the group of claims 19-27. It also pointed out that claim 22 is broader in scope than claim 21 of the original application which was cancelled during prosecution in response to the requirement for restriction of claims to a single invention.

The Applicant responds by arguing that "now claim 22 is not broader than old claim 21, but is different from old claim 21." He reasons that "it cannot be said that all the features in original claim 21 are covered by new claim 22 and hence new claim 22 is not broader than original claim 21."

We have looked carefully at claim 22 of this application and cancelled claim 21 of the patent as filed. While claim 22 does describe the attachment members in greater detail, the invention is for dispensing apparatus, and the terminology relating to the apparatus for dispensing the attachment members is broader in scope than that of cancelled claim 21.

Provisions for reissuing in Canada are derived from the corresponding provisions in the United States Act. This is recognized by the Courts as we find in Hunter v Carrick (1884), 10 O.A.R. 449 at 468 (affirmed 11 S.C.R. 300) where it states:

Cases may arise for adjudication in which it will be important to keep in view the differences between the two statutes; but as far as they touch the immediate subject before us, viz: the effect of the reissue of a patent upon corrected specifications, as they are styled in the United States statute, or amended or corrected ones as they are indifferently styled in ours, we may for our present purpose regard them as covering the same ground; and I agree with the learned Judge, whose decision we are considering, that we should treat the judgments in the United States Courts, in which the effect of their statute has been declared, as laying down the rule which we should follow....

We note, too, that in Curl-Master v Atlas Brush (1967) S.C.R. 514 at 527 & 530), Martland J. quoted with approval from two United States decisions on reissue, while in Farbwerke Hoechst v Commissioner of Patents (1966 SCR 606 at 614) he pointed to the distinctions which must be made where there are material differences in the provisions. See also Van Heusen v Tooke Bros. 1929 Ex. C.R. 89 at 100 and Leonard v. Commissioner of Patents, 14 Ex. C.R. 35.

(1914) at 361. Keeping in mind, then, such proper distinctions as should be made, we turn to *IN RE BYERS* (1956) 43 CCPA 804 and find at p. 807:

Thus in *Dobson v. Lees*, 137 U.S. 258, the Supreme Court of the United States said:

A reissue is an amendment, and cannot be allowed unless the imperfections in the original patent arose without fraud, and from inadvertence, accident or mistake. Hence the reissue cannot be permitted to enlarge the claims of the original patent by including matter once intentionally omitted. Acquiescence in the rejection of a claim; its withdrawal by amendment, either to save the application or to escape an interference; the acceptance of a patent containing limitations imposed by the Patent Office, which narrow the scope of the invention as it first described and claimed; are instances of such omission.

Similarly in *Shepard v. Corrigan*, 116 U.S. 593, the Court said:

Where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent.

...

It is evident that since the deliberate cancellation of a claim in order to obtain a patent constitutes a bar to the obtaining of the same claim by reissue, it necessarily also constitutes a bar to the obtaining of a claim which differs from that cancelled only in being broader. That was the holding in *In re White*, 23 F. 2d 776, 57 App. D.C. 355, and in *In re Murray*, supra, this court quoted with approval the following statement from *Ex parte White* 1928 C.D. 6:

The deliberate withdrawal of a claim in order to secure a patent is conclusive of the presumption that there has been no inadvertence, accident, or mistake, and the invention thus abandoned cannot be regained either by construing the claims of the patent broadly or by obtaining a reissue with broadened claims. The rule is the same whether the claims sought by reissue or otherwise are identical, substantially the same, or broader than the abandoned claims.

Similarly, in *In re Wadsworth et al*, 27 C.C.P.A. (Patents) 735, 107 F. 2d 596, 43 USPQ 460, it was held that the cancellation of a claim from an original application on which a patent was granted, reciting a process including two steps in a specified order precluded the obtaining by reissue of the patent of a similar claim which was broader than that cancelled in that it did not specify the order in which the steps were performed.

We are of the opinion that the appellant's action in limiting the scope of original claim 20 by amendment constituted a deliberate withdrawal of that claim as originally presented, in order to obtain a patent, and that such withdrawal is a bar to the obtaining by reissue of claim 20 as it originally stood, or of any claim

differing therefrom only by being broader. Appealed claims 2 and 3, as above noted, differ from original claim 20 as presented, only in that they are broader than that claim. (Emphasis added)

We think it would also be appropriate to refer to In the Matter of Land's Patent (1910) 27 R.P.C. 481 to show that a deliberate action cannot be considered unintentional, even though that deliberate action was taken because of an error in appreciating what the law might be. That case involved the restoration of a lapsed patent, but we believe the reasoning adopted there is appropriate in assessing whether a deliberate action can be brought within the meaning of "inadvertence, accident or mistake" as used in Section 50 of the Canadian Patent Act.

In this case we are satisfied that the Applicant now proposes to enlarge claim 22 by deleting limitations intentionally included to obtain a patent.

We are not satisfied that the necessary element of inadvertence, accident or mistake is present to justify reissuance of the original patent. Therefore we agree with the view expressed in the Final Action that "claims which are broader in scope than those deliberately cancelled during the prosecution of the original patent may not be re-asserted in the reissue."

The Applicant has referred to Cur1 Master supra as establishing that an error by the Applicant's attorney is sufficient justification for reissue. In the Cur1 Master decision the patent was found defective by reason of insufficient description, and that resulted in a mistake, namely, a failure on the part of the patent agent to fully comprehend and describe the invention for which he has been instructed to seek a patent. We have already noted in the application before us that the action of the Applicant's agent, in the surrendered patent, was deliberate, and therefore not an error which may be corrected by reissue.

Apparatus for inserting attachment members having a filament and head on either end has been in use for some time. The original patent issued for an indexing mechanism for this type of apparatus. This indexing mechanism is clearly defined in claim 1 of the application which describes the component elements

and their cooperation one with another. Claims 2 to 18 are also directed to this indexing mechanism. Claim 19 describes improvements in another component of the apparatus, more particularly the ejector component, while only acknowledging the presence of an indexing mechanism (not necessarily that of claims 1-18). Consequently claims 19-29 are directed to a different invention than that of claims 1 to 18. In the original patent Applicant claimed the indexing mechanism. In this application he wants to claim not only that invention, but also a second invention not claimed in the original patent, viz the ejector.

While it was not raised during the prosecution of this application, and does not form the basis for our rejection, it may be noted that the present reissue application was the subject of a protest filed by a commercial rival of Dennison, namely, protest J2480-13-224, filed by Monarch Marking on Feb. 29, 1980. The basis for the protests is the belief:

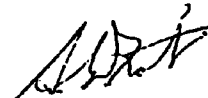
that Dennison is attempting to recapture abandoned patent protection to cover Monarch's Model 1310 tag attacher as well as the recapture of abandoned patent coverage on the knife and needle idea to obtain claims in Canada of the same scope as U.S. Reissue patents 29,819 and 29,310.

As we indicated above, however, there has been no need to bring the issues raised by the protestors into our reasons for rejection; but it does underline the need for the Patent Office to scrutinize carefully petitions for reissue, which could affect the interests of other manufacturers.

We are satisfied that the Applicant is not entitled by law to reissue his patent and recommend that the decision of the Examiner to refuse the application be upheld.

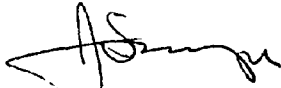


G.A. Asher
Chairman
Patent Appeal Board, Canada



S.D. Kot
Member

I concur with the recommendations of the Patent Appeal Board and refuse to grant a patent on this application. The Applicant has six months within which to appeal this decision under the provisions of Section 44 of the Patent Act.



J.H.A. Gariépy
Commissioner of Patents

Dated at Hull, Quebec
this 21st. day of December, 1981

Agent for Applicant

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