COMMISSIONER'S DECISION

Double Patenting - Oil Recovery Process

Two applications were found to overlap but by amendment the applicant restricted the second application to an inventive improvement encompassed by the first application. This type of overlap is permissible provided there are in fact separate inventions. Normally two applications for patent should not be refused for double patenting until one of them has issued to patent, but the examiner is justified in pointing out the existence of overlap prior to grant. In this instance, the applicant requested the issue to be settled prior to grant so he could select which application should proceed.
Rejection overcome by amendment.

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Patent applications 243466 and 244897 were filed by the Marathon Corporations for a process to recover oil from subterranean deposits. Both are in class 31, sub-class 31. The inventors involved in both applications are the same (Donald E. Schroeder, Mark A. Plummet and Wayne Roszelle). The Examiner in charge of the applications rejected both of them on July 24, 1979 on the grounds of overlap. The Applicant has asked that those rejections be reviewed.

In our view two pending applications should not normally be refused for overlap, since until one of them issues to patent the question of double patenting does not actually arise, and it is double patenting which is objectionable in patent law. One can refuse an application because a patent has already issued for the invention, but not because there is another application for the invention. Nevertheless the Examiner acted quite properly in pointing out that the applications overlapped, so that the Applicant would have the opportunity to amend to avoid any difficulties that might subsequently arise. Furthermore fin this instance the Applicant has asked that the issue of overlap be settled so that he could select which application should issue to patent, viz. 243466 (see his letter of Sept. 18, 1979) if it is considered they do overlap.

Subsequent to the rejection the Applicant removed the claims the Examiner found objectional in 243466, and on Sept. 10, 1979, submitted fresh claims to replace them. It is those new claims of Sept. 10 which we will consider, rather than the claims entered on the file at the moment.

Claims 1 of each application illustrate what is involved. Underlining has been added to indicate the differences between them.

Claim 1 of 244897

In a process of recovering hydrocarbon from a subterranean formation having at least one injection means in fluid communication with at least one production means and wherein a micellar dispersion comprised of water, hydrocarbon, cosurfactant, electrolyte and petroleum sulfonate obtained by solfonating whole or tope crude oil is injected into the formation and displaced toward the production means to recover hydrocarbon therethrough, the improvement comprising incorporating amounts of the cosurfactant into the micellar dispersion in excess of the amounts required to cause the micellar dispersion to go through a maximum viscosity and thereafter increasing the amount of the cosurfactant to establish a micellar dispersion of desired viscosity for the flooding of the subterranean formation and then injecting the micellar dispersion into the formation.

Claim 1 of 243466

In a process for recovering hydrocarbon from a subterranean formation having at least one injection means in fluid communication with at least one production means and wherein a micellar dispersion comprised of water, hydrocarbon, cosurfactant, electrolyte, and petroleum sulfonate obtained by sulfonating whole or topped crude oil is injected into the formation and displaced toward the production means to recover hydrocarbon therethrough and wherein the cosurfactant concentration is present in excess of that concentration required to produce in the micellar dispersion a viscosity maximum, the improvement comprising incorporating within the micellar dispersion about 1.5 to about 4.5 weight percent of active sulfonate groups which are attached to the petroleum sulfonate within the micellar dispersion and thereafter injecting the micellar dispersion into the formation.

The alleged improvement of having 1.5 to 4.5 weight percent of active sulfonate groups present is disclosed in 244897 (page 5, line 26), but is not specifically claimed in 897. We understand that if there had been no such disclosure, the Examiner might well have allowed both applications on the basis that 897 is an inventive improvement over the 466 invention.

The crux of the matter, as we see it, is whether the 1.5 - 4.5 range is an inventive improvement over the invention claimed in the 466 application. If it is, it does not really matter that it was disclosed in 466 provided it was not claimed in 466. Now the claims of the 897 application are broad enough to encompass those of 466, but the claims of any patent which is an improvement over a basic patent are bound to infringe the basic patent.

Since the Examiner would allow the claims of 466 if there was no reference to the 1.5 - 4.5 range in the disclosure of 897, we conclude that the

subject matter is a different invention from what is claimed in 897. Clearly
it provides improved results, and we find that it is inventively different.

Consequently we recommend that the rejection for overlap should be withdrawn.

There is, of course, no doubt that the claims on file in 897 at the time of the final rejection, for example claim 4, were directed to the 1.5 to 4.5% range of sulfonate groups and did overlap the invention claimed in 466.
The Examiner was of course fully justified in making his objection at that
time.

G.A. Asher
Chairman
Patent Appeal Board, Canada

I have reviewed the prosecution of these applications and agree with the recommendations of the Patent Appeal Board. The rejections are reversed, and the applications remanded to the Examiner to resume prosecution in accordance with this decision.

G.R. McLinton
Acting Commissioner of Patents

Dated at Hull, Quebec
this 12th. day of February, 1982

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