COMMISSIONER'S DECISION

Lack of Invention; Home Building Development

Selecting another use for a building after it has served its initial purpose was held to lack inventive ingenuity in view of the art. Such change of use does not relate to a manual art or skill that falls under Section 2 of the Act. Rejection affirmed.

****

This decision deals with Applicant's request for review by the Commissioner of Patents of the Examiner's Final Action on application 310,519 (Class 20-7)assigned to North Oakland Development Corporation entitled HOME BUILDING METHOD AND APPARATUS. The inventor is Leon Blachura. The Examiner in charge issued a Final Action on November 14, 1980 refusing to allow the application.

This invention is directed to a method of developing a residential tract of land with completed buildings by constructing an on-site structure which serves as a factory for manufacturing the buildings designed for the tract until it is fully developed, and which, after each building has been fabricated and placed, finally serves the completed development in another manner, such as a shopping center. The method also includes creation of individual foundations for the buildings, as well as transportation of the buildings to the foundations and placement thereon. Figure 1 below depicts that arrangement:

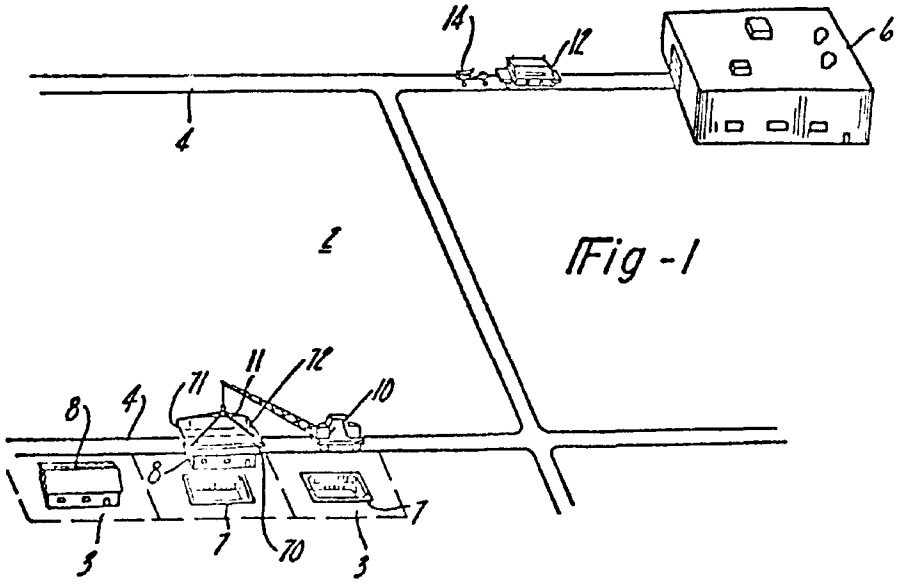

Fig-1

In the Final Action the Examiner refused claim 1, the only claim, as being contrary to Section 2 of the Act, and as not patentably distinguishing over the following reference:

German Offenlegungsschrift

2,309,509 Sept. 6, 1973 Anyos et al

The Anyos et al publication discloses a system for development of a tract of land which uses a large building in which are prefabricated complete, as well as partially completed, prefabricated dwellings, and a transporting means to move the finished units to various parts of the tract for placement as desired, e.g. on pre-formed foundations. Figure 15 below illustrates the arrangement:

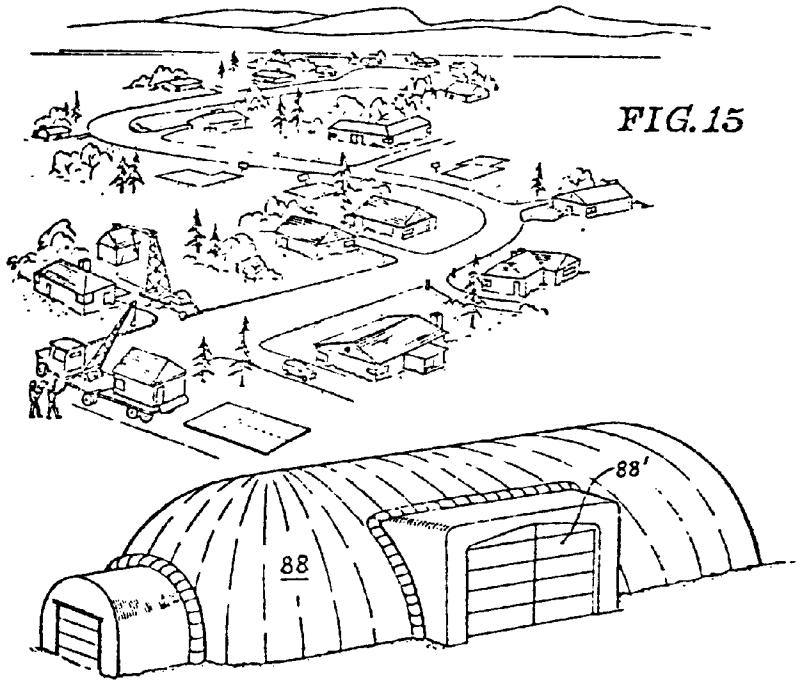

FIG. 15

In the Final Action the Examiner stated (in part):

> ...
> The cited German publication shows in figure 15, a building site under development. There is a factory 88 in which houses are built. The houses are then trucked to the foundation by a vehicle and unloaded by a crane and placed on the foundation. Since the patentee uses a temporary type of structure for his factory, it is assumed that it would not be practical to convert it into a civic center or whatever after the site is completed. This is the only difference between the art and the applicant's claims. This difference is considered to be purely and simply a matter of choice. It is well within the skill of any tradesman to convert Buildings into anything feasible and practical. For example, schools have been converted into factories and factories have, no doubt, been converted into schools. This is simply a matter of expediency and does not amount to invention.
>
> Applicant's arguments with respect to the German patent have been considered, however, they are not persuasive. The concept of planning a building initially with the thought that you might someday use for something else is old. Many homeowners have done this. For example, many people build a 4 or 5 room house because they have a big family and actually plan, at the outset, to convert an extra bedroom into a study or workshop. There is no invention in doing this.
>
> Applicant's claim is further rejected in that it is contrary to Section 2 of the Patent Act. Chapter 12, paragraph 12.03.01 (e) of the manual of Patent Office Practice is applicable. The rejected claim falls into the category of subject matter being a scheme or plan or system of doing business and the like and is thus not patentable under Section 2.
>
> ...

In presenting his case for allowance, Applicant argued (in part):

> ...
>
> The Examiner rejects the claims as being obvious and well within the skill of an ordinary tradesman to convert buildings into anything feasible and practical, citing the example of the conversion of schools to factories. However, the concept set forth in this claim is not the mere idea of converting buildings to another use, but rather the method of building a residential community having a central structure usable for a number of uses. The structure being employed is a factory building for the prefabrication of residence buildings. That is, according to this concept, a permanent structure is erected on the site rather than the temporary structure of the German patent and the permanent structure is then converted to nonfactory use thereafter.
>
> It is necessary to the concept to initially have such conversion in mind at the time the residential development is being constructed such that a structure suitable for such conversion is initially erected.
>
> Such concept is clearly not derivable from the German patent which does not conceive, contemplate or teach such approach to construction of a residential subdivision.
>
> Accordingly, the question is not merely whether it is obvious to convert the structure from one use to another but rather whether it is obvious to initially erect such a building with a conversion in end use in mind. Applicant respectfully submits that based on the prior art cited by the Examiner, such concept is clearly not obvious.

> The claim employs the language "factory building". It is respectfully submitted that the term "building" clearly distinguishes over temporary shelters of the sort described in the German patent.
>
> Webster's Dictionary defines the term "building" as "a usually roofed and walled structure built for permanent use...". Accordingly, it is respectfully submitted, "building" is a reasonably defined term to distinguish over temporary shelters of the sort described in the prior art reference.
>
> The claim language is drawn to the concept of fabricating a permanent building structure on the tract in the context of carrying out a residential development, constructing the houses in the building and then converting the building to an after-construction other use.
>
> ....
>
> The Examiner also asserts that the method set forth is merely a scheme or plan or system of doing business and thus not patentable. Clearly, however, this claim is not directed to a manner of doing business but rather to a physical process. That is, the process of constructing a development complete with a large permanent structure suitable for nonresidential use after the development has been completed.
>
> Such process of physical construction results in the production of vendible products and can not accurately be deemed a method of doing business and it is respectfully submitted that the Examiner's rejection is not well founded.
>
> ...

The issues before the Board are whether or not the claim is directed to a patentable advance in the art and whether or not the claim falls within the ambit of Section 2 of the Patent Act. Claim 1 reads:

> A method of constructing a residential development comprising, in combination, providing a suitable unitary tract of land; constructing on the tract a factory building suitable for the simultaneous, progressive fabrication of several dwelling houses, fabricating complete houses in the factory building; delivering the houses from the factory to locations on the tract and installing the houses on the foundations; and converting the factory building on its original site to use in providing services to the occupants of the residential development upon termination of fabrication of the houses and installation on the foundations.

We are informed by Applicant's arguments that he considers that his concept is the method of building a community of structures having one structure which may be employed as a factory building or for other different uses. We find in the Anyos et al publication (hereafter Anyos), that a central structure is used as a factory building in which

preformed full standing dwellings, or sections of dwellings, are completed, and that thereafter, the preformed units are transported to a building site. We derive from Anyos that Applicant's alleged new concept of using an on-site factory building to prefabricate building units is not new as it has been disclosed by Anyos.

We are of the view that the selection of the kind of use for a building is a choice based on design and does not involve inventive ingenuity. It is well known that swimming pools and tennis courts have been placed in buildings which may be formed either with rigidly connected walls and roof, or with air supported walls and roof. Further, the use to which a building is put depends to a large extent on the cost. Thus, we believe that the selection of a building which has rigidly supported walls and roof, or air supported walls and roof, is a matter of choice of design influenced, at least in part, by the costs of the different designs. In view of Applicant's remarks on the definition of 'temporary' we add also, that the connotation 'temporary' to describe a building applies equally to a building with rigidly connected walls and roof, such as the 'temporary' buildings which were built in Ottawa during World War II, a few of which are still standing.

In Applicant's arrangements we are not persuaded that the inclusion of a 'permanent' structure as the central structure rather than the 'temporary' structure of Anyos, is an act that involves inventive ingenuity, nor are we persuaded that selecting another use for a building after it has served its initial purpose amounts to invention. It is our view that the uses envisaged may involve planning and organizing the sequence to be followed, but we are satisfied that inventive ingenuity has not been exercised.

In summary we are satisfied that claim 1 is not directed to a patentable advance in the art in view of the cited reference. This is assuming, arguendo, that the subject matter falls under Section 2 of the Patent Act.

From the above it appears academic whether or not the subject matter falls under Section 2 of the Patent Act, because we have found nothing patentable. The method in question is directed to different uses for a building in a residential development. We will, however, comment on the matter.

In determining whether Applicant's conversion of a factory building to a different use relates to a scheme or plan or system of doing business, we believe it is pertinent to the issue to state that conversions of buildings to different purposes is extremely well known. By way of example, we refer to buildings such as a department store, or a factory, or an airplane hangar, or a garage which have been converted to various other respective uses such as office space, or warehouse, or sports area, or bedroom space, as accommodation needs for business or housing dictate. We are of the view that the determination of the above kinds of conversion falls within the skills of an architect or a planning consultant. Thus, we believe that Applicant's proposal to convert a building to another use on completion of the development falls into the category of a scheme or plan or system related to a business proposal. Therefore, we are satisfied that Applicant's proposed change of use aptly falls within the confines of the skills exercised by an architect or a planning consultant, and does not relate to a manual art or skill that falls under Section 2 of the Act.

We recommend, therefore, that claim 1 be refused as failing to define a patentable advance in the art in view of the cited art, and further that the application should not be considered as defining subject matter that is an invention within the meaning of Section 2 of the Act.

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

M.G. Brown

M. Brown
Member

I concur with the reasoning and findings of the Patent Appeal Board. Accordingly, I refuse to grant a patent. The Applicant has six months within which to appeal my decision under the provisions of Section 44 of the Act.

J.H.A. Gariépy
Commissioner of Patents

Dated at Hull, Quebec

this 2nd. day of April, 1982

Agent for Applicant

Smart & Biggar
Box 2999, Station D,
Ottawa, Ont.
K1P 5Y6