

COMMISSIONER'S DECISION

AGGREGATION: Visor and Garage Door Operation Assembly

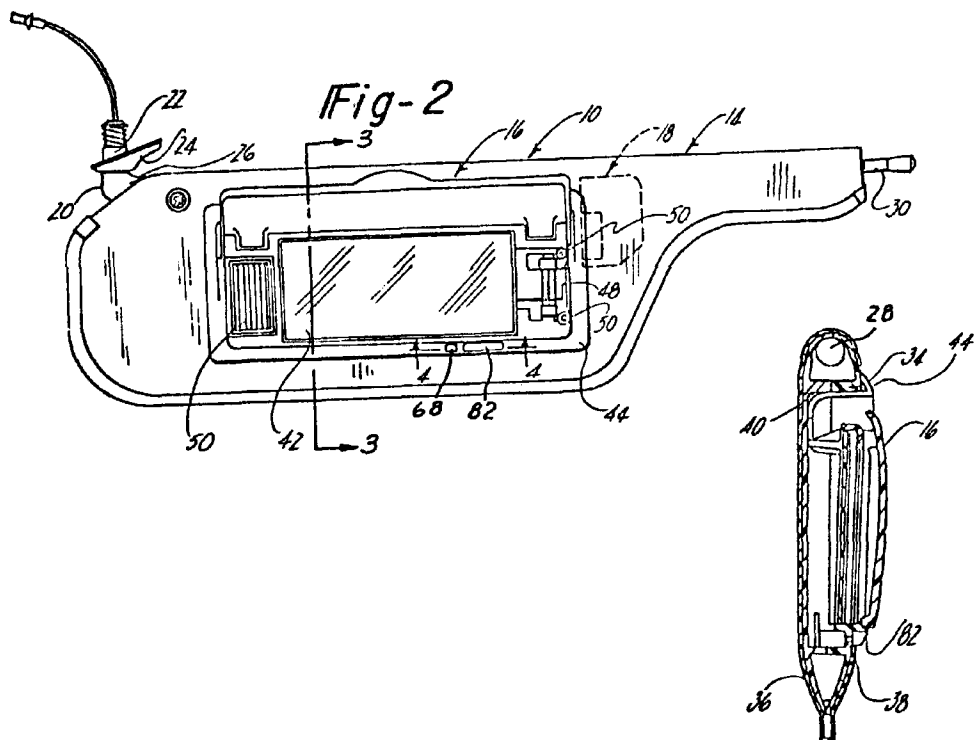
Incorporation of the transmitter unit within the visor framework yields a combination where all the elements contribute a part to produce a unitary result.

Final Action: Reversed, amended claims are acceptable.

Patent application 308,760 (Cl. 347), was filed on August 4, 1978 for an invention entitled "Visor And Garage Door Operation Assembly." The inventor is Konrad H. Marcus assignor to Prince Corporation. The Examiner in charge of the application took a Final Action on March 6, 1981 refusing to allow it to proceed to patent. In reviewing the rejection the Patent Appeal Board held a Hearing on February 10, 1982, at which the Applicant was represented by Mr. E. O'Connor. Also in attendance were the Inventor, Mr. Marcus, the United States Agent Mr. Haneveld and the Company representative Miss. K. Corth.

The subject matter of this application relates to an automobile visor which houses a transmitter of a radio controlled garage door-operating system.

Figures 2 and 3 are illustrative of that arrangement.



Visor 14 consists of a polypropylene core 34 which houses mirror 42, lights 50 and transmitter 18.

The claims were rejected in the Final Action as being directed to an aggregation.

In that Final Action the Examiner stated (inter alia):

The claims are directed to transmitter mounted in a visor. Each element performs its function independently of the other, and the elements fail to cooperate with each other to achieve a unitary result that is other than the sum of the results of the individual elements. The visor will perform its function just as well without the presence of the transmitter. The transmitter will perform its function just as well without the presence of the visor. The visor no doubt provides a convenient site on which to locate the transmitter, but the two elements operate independently of one another. There is no new function.

This assembly is comparable to a lead pencil having an eraser on one end. It provides convenience to a user to have the two elements attached together, but there is no joint operation. The assembly can be compared also to a pistol having a whistle mounted therein. It may be convenient to a user to have the pistol and the whistle mechanically coupled, but the functions of the two elements are independent, and quite different (See Lester vs. Commissioner of Patents, Exchequer Court 1946).

The applicant has argued that the visor and transmitter assembly achieve a unitary result that is more than the sum of the results of the individual elements. The examiner contends that there is no unitary result, but that there are two independent results. The results produced by the visor is quite different from the result produced by the transmitter.

The applicant argues that the transmitter and visor (and the switch, etc.) are mounted to provide easy access to the transmitter. The examiner contends that ease of access does not mean that a unitary result is produced. In the case of the eraser mounted on the end of a lead pencil (the classical case of aggregation) the eraser is mounted to provide ease and convenience of access. However, it is not a patentable invention.

The applicant argues that the location of the transmitter is optimum for transmitting a signal since it is not surrounded by metal housings and the like. The examiner contends that although the visor may provide a good location to mount the transmitter, the transmitter would function just as well in this location mounted with a mounting device other than the visor. The function of the transmitter has nothing to do with the function of the visor.

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

A review of this jurisprudence indicates some vagueness as to the line to be drawn between that which constitutes a patentable combination and that which constitutes an unpatentable aggregation. However, it is believed fair to state that a reasonable test to be applied is whether the known integers, when placed together, have some working inter-relation producing an improved result as compared with the mere placing side by side of old integers so that each performs its own proper function independently of any of the others.

Therefore, the question to be asked in respect of the combination being claimed in this application is believed to be nothing more than whether there is some working inter-relation between the known integers, producing an improved result? The Examiner maintains that there is no such relationship and the applicant maintains that there is, for reasons already of record.

However, it would appear appropriate to review these reasons as advanced by the applicant.

Applicant's claimed invention can be compared with that known arrangement disclosed by the applicant in the second paragraph of page 1 of its disclosure, that is a sun-visor to which is clipped a battery operated hand held transmitter used as a garage door opener control.

As noted in the disclosure, there are disadvantages to this known structure. These include a relatively heavy transmitter due to the presence of batteries, which when attached to a visor exert an excessive load on the friction connection relied on to hold the visor in its storage position. Applicant's claimed structure which locates the transmitter within the visor and interconnects the transmitter through a switch in the visor to the vehicles power source, provides a result not obtainable by way of the prior art which is specifically that the battery weight is removed from the visor which in turn provides the advantage that the friction connection between the visor and its mount will be better able to maintain any position at which the visor is set, as compared with the same visor to which is clipped a transmitter having its own batteries.

Furthermore, the location of the transmitter within the visor removes it from sight when the visor is in its "up" position and due to the lightweight transmitter used in the visor of applicant's invention as claimed, the visor will not tend to fall down from its up position thereby exposing to view a transmitter, for possible theft.

These improved results alone warrant allowance of the claims presently being prosecuted in this application. These results are not available from the known arrangements and these results are obtainable only through the combination of the transmitter being located within the visor and connected through the visor to the automobiles power source.

Continuing, reference is made to the arguments already of record in the response filed November 5th, 1980 and to repeat a statement made in that response, clearly the elements do cooperate with each other to achieve a unitary result and that result not only differs from that which was obtainable by way of the prior art but is an improved result, as compared with the prior art. Were it not for the combination of the relatively lightweight batteryless operator located within the visor and interconnected through the visor to the vehicles power source the advantage of the light load on the visor would not be achieved and the advantage of maintaining the actuator hidden would not be achieved. The same results cannot be achieved with the previously known arrangements disclosed by the applicant on page 1 of its disclosure and if the same results cannot be achieved, then applicant's claimed combination is in fact a combination and not simply a juxtaposition of a number of known integers.

Claims 1 to 6, as an alternative to the claims on file were also submitted by the Applicant in response to the Final Action.

The issue before the Board is whether or not the claims are directed to an aggregation. Alternative claim 1 reads:

A visor assembly for a vehicle or the like comprising:

a support means adapted to be mounted on the windshield header of a vehicle;

a visor pivotally mounted on said support means from an upper storage position to a lower sunshade position and having a recess formed in the side thereof facing the driver when in said lower sunshade position;

an illuminated mirror unit having a frame mounted over said recess, a mirror mounted within said frame and lighting means mounted adjacent to said mirror;

transmitter means mounted in said recess for transmitting a signal to a receiver for operating a garage door opening system;

electrical connection means adapted for connection to the power source of the vehicle, said electrical connection means being connected to the transmitter means and lights through said support means and said visor, said transmitter means being connected to said electrical connection means through an actuator switch which is adapted for coupling the transmitter means to said electrical connection means and said power source of the vehicle so as to energize said transmitter means;

said switch including an actuator element mounted on said frame.

At the Hearing there was considerable discussion with respect to the question of aggregation versus combination. It is the Examiner's position that each element of the Applicant's arrangement performs its function independently of the other thereby failing to achieve a unitary result. On the other hand the Applicant maintains that the elements do cooperate with each other to achieve a unitary result that not only differs from that obtained from the prior art but also is an improved result which is obtained by his combination.

An aggregation may be considered as a mechanism or arrangement of elements each giving its own result but without any unitary result flowing from that arrangement (Vide, Smith v. Goldie (1883) 9 S.C.R. 46, and Barton v Radiator Specialty Co. of Canada Ltd. (1965) 29 Fox Pat. C. 89 at 96). The mere placing of elements together without the production of a common result cannot make them into a patentable combination (Vide, Durable Electric Appliances Co. Ltd. v Renfrew Electric Products Ltd. (1928) S.C.R.8).

Mere juxtaposition of parts is insufficient for patentability. The elements must combine for a unitary result. If any element in the arrangement gives its own result, without any result flowing from the combination, then there is no invention (Domtar Ltd. v. MacMillan Bloedel Packaging Ltd. (1977) C.P.R. (2d) 33 182 at 189).

The essential qualification for a combination is that the elements of which the combination is composed are combined so as to produce a result to which all the elements of the combination contribute their part. Upon this principle depends the entire definition and understanding of what constitutes a combination in the law of patents (vide, Baldwin International Radio Co. of Canada Ltd. v Weston Electric Co. Inc. (1934) S.C.R. 94 at 101), or as was stated in British United Shoe Machinery Co. Ltd. v A. Fussell & Sons Ltd. (1908) 25 R.P.C. 631 at 657 "... a collocation of intercommunicating parts so as to arrive at (what might be called) a simple and not a complex result." This case was cited in the Baldwin v. Weston decision, supra.

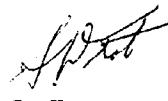
The result produced by the combination must, therefore, be what may be termed a common or unitary result, in the sense that all the elements of the combination are brought together in such relation to each other that each element contributes its own particular share to the production of that result (vide, Riddell v Patrick Harrison & Co. Ltd. (1957) 17 Fox Pat. C. 83). The combination, however may be one for the production of a new result, or for an old result "in a more convenient, cheaper, or more useful way" (vide, Baldwin v Western, supra).

In Wandscheer v Sicard Ltd. (1948) S.C.R. 1 at 4, Taschereau J. stated: "Of course a combination may be the subject-matter of a valid patent even if it is merely the juxtaposition of known elements. But this juxtaposition must produce a useful and operative contrivance which has the indispensable character of novelty [invention]." This combination of course must produce a unitary result.

According to the Applicant the placing of the lightweight battery-less transmitter within a recess of the visor frame results in a number of advantages over the transmitter that is clipped on the visor. Some of these are that the lightweight transmitter does not interfere with normal visor operation, there is no warping of the visor, a concealed transmitter eliminates threat of theft and the transmitter provides a constant output range due to the use of the car battery power source.

In the Applicants visor frame structure a recess is required to house the transmitter. There is also a switch arrangement on the visor to supply power from the car battery. Mounting the transmitter in the visor frame housing does yield certain advantages which were stated above. In our view this represents a combination where all the elements contribute their part to produce a unitary result, which is reflected in proposed claims 1 to 6. Having reached this conclusion we contacted Mr. O'Connor to have these claims formally submitted. On March 9, 1982 Mr. O'Connor had the proposed claims officially entered into the application. We recommend acceptance of these claims on the information before us, for example, we did not have to consider inventiveness.


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


S. Kot
member

I have reviewed the prosecution of this application and concur with the reasonings and findings of the Board. Accordingly I withdraw the Final Action and direct that prosecution should resume on the basis of the amended claims.


G.R. McLinton
Acting Commissioner of Patents

Dated at Hull, Quebec
this 6th. day of April, 1982

Agent for Applicant

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