

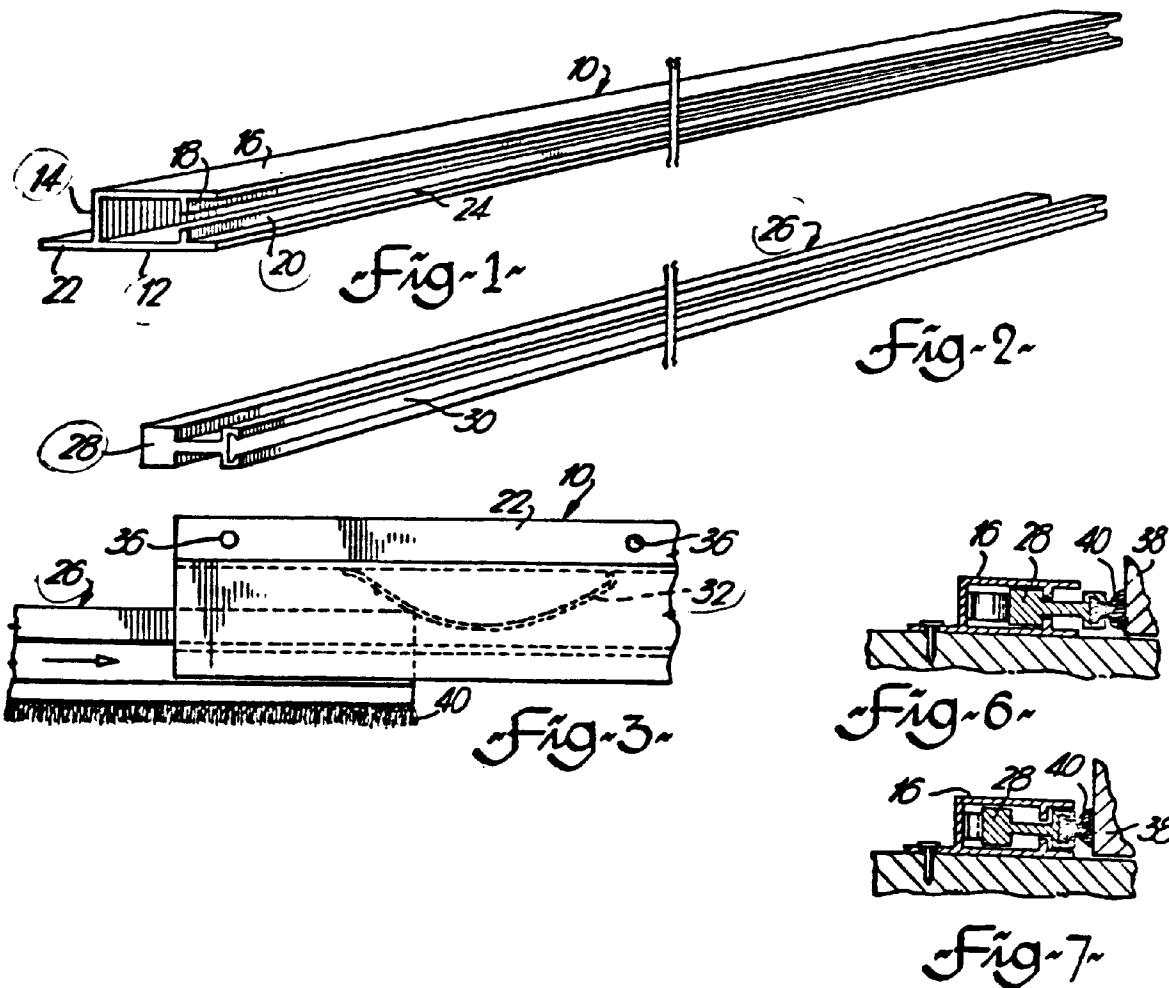
COMMISSIONER'S DECISION

REISSUE: ADJUSTING WEATHER STRIP

The original application was filed by the inventor and the agent was appointed after the initial response to an examiner's action. Affidavit evidence shows a lack of communication between the inventor and agent. Use of a single bar spring rather than a plurality of bar springs to actuate the moveable sealing member is acceptable. Final Action - Reversed.

Patent application 341,876 (Class 108-58), was filed on November 20, 1979 for an invention entitled "Self Adjusting Weather Strip". The inventor is George Khallil. The Examiner in charge of the application took a Final Action on February 11, 1982 refusing to allow it to proceed to patent. In reviewing the rejection, the Patent Appeal Board held a Hearing on December 15, 1982, at which the Applicant was represented by Mr. R. Frayne.

The subject matter of this application relates to a self-adjusting weather strip used for sealing a door. It consists of a hollow "U"-shaped channel base member with a groove on one side in which a spring loaded inter-fitting piston-type I-beam sealing member moves. Figures 1, 2, 3, 6 and 7 are illustrative of the application.



Base member 12 has a groove in wall 20 where central portion sealing member 26 moves. Spring 32, placed between wall 14 and bar 28 of member 26, biases the member 26 outwardly of the channel to contact it against door 38.

In the Final Action the Petition for reissue is refused because "claim 3 is directed to a different subject matter from that which the Applicant has disclosed and claimed in his immediate identified patent."

In that action the Examiner stated (in part):

...

Once again, it is maintained that part 3(b) of applicant's petition erroneously stated that "the invention disclosed in my said patent is operable and commercially feasible with a single such bar spring". The invention disclosed in applicant's patent nowhere specifically entertains the possibility, commercial feasibility, or the operability of using a single bar spring.

Note that, on page 1 line 12 the patent refers to "spring means". On page 1 line 28, the patent specifically describes "a plurality of curved bar springs within said channel". On page 2 line 34, the patent states that "the channel of aluminum extrusion 10 is adapted to receive a plurality of springs 32". On page 4, line 9, the patent deals with "the action of springs 32". However, nowhere, does the patent deal with the operability, the feasibility, or even the possibility of using a single bar spring.

It is also maintained that part 3b of applicant's petition erroneously states that "if a single bar spring is employed as is evident from my disclosure, such short extension is not an essential component of the bar spring". As is established immediately above, it is not evident from applicant's patent disclosure that a single bar spring is, or can be, employed. Furthermore, it is not evident from applicant's patent disclosure that the short extension is not an essential component of the bar spring.

On page 1 line 29, applicant specifically establishes "said springs each having an integral short extension projecting from one end thereof adapted to bite an aluminum surface" etc. On page 3, lines 3-13 consistently develop the object of using that specific form of bar spring.

However, nowhere in the patent, does applicant specifically discuss, or in fact even suggest or imply that the short extension is not an essential component of the bar spring.

Applicant's patent claims are essentially, specifically, and unequivocally directed to an assembly which distinguishes over the prior art through the expedient of a plurality of bar springs of the conformation shown in Figure 5, for the express purpose of inhibiting movements of the plural short springs with short extensions 34 along the extrusions.

Claim 3 does not suggest any of the immediate subject matter.

Furthermore, applicant's attention is drawn to the fact that, nowhere in the disclosure of his Reissue Application does he specifically discuss, nor even imply that his weather strip is commercially feasible and operable using a single bar spring. Nor does applicant's reissue application specifically establish that the short extension is not an essential component of the bar spring.

Note that a study of the disclosure of the Reissue Application reveals that a plurality of springs, each with the pertinent short extension is essential to the operation of applicant's weather stripping, a situation diametrically opposed to the content of part 3(b) of applicant's Petition For Reissue.

Consequently, neither applicant's patent, nor his application for Reissue will support a claim of the breadth and concept of claim 3 of this Reissue application.

Concomitantly, there is no evidence that "as a result of inadvertance, accident or mistake, the applicant herein was granted a claim narrower than that to which he is entitled" to quote from applicant's letter dated July 31, 1981, on page 2.

Certainly, it does not appear that applicant is entitled to a claim of the breadth and specific limitations found in claim 3.

It is reiterated, that, on the basis of applicant's originally filed disclosure of his patent, there is no evidence whatever that applicant intended to protect the subject matter of extant claim 3 in his patent, or, in fact, that he was aware of the subject matter of claim 3. Furthermore, it appears that on the basis of the disclosure of this application, applicant's claim 3 is directed to a weather stripping structure which is not specifically described in the disclosure.

In part 4, of the Petition For Reissue applicant contends that error arose because "I did not emphasize to my patent agent that a single bar spring would also serve the desired purpose within the scope of my invention".

It is again reiterated that applicant's failure to emphasize that a single bar spring without an extension might be used is irrelevant to the disposition of this Reissue Application.

...

In response to the Final Action the Applicant stated (inter alia):

...

For example, in the Official Letter dated January 9, 1981, nine Canadian patents were cited as completely anticipating claim 3. In fact, none of this prior art, taken alone, or in combination has any direct relevance to the invention disclosed and claimed. The prior art is discussed in detail in applicant's response dated January 28, 1981.

All prior art was subsequently withdrawn, and has not been further relied on by the Examiner.

Applicant's invention is thus submitted to be capable of broad patent protection. At issue is the definition of the spring means used in the self adjusting weather strip disclosed.

While spring means are an essential part of the invention it is applicant's submission that the pair of extrusions disclosed and which cooperate to provide a "piston" action, are the heart of applicant's invention. The spring means therefore are of secondary importance only. Nowhere in the prior art can be found a weather strip having the interacting elongate extrusions as specifically disclosed herein.

In the Final Action the Examiner holds that the reissue application does not disclose a single elongate spring means for use in combination with the pair of cooperating extrusions.

We are enclosing herewith an affidavit by the inventor-applicant, for consideration by the Appeal Board.

In his affidavit the inventor describes his initial experiments with a single elongate spring, having a wavy configuration, and his discarding of this spring, in favour of the short springs disclosed, in view of a stretching effect of the single long spring, over a period of time, in use. It will be further noted, in the final paragraph of the inventor's affidavit that competitors have adopted the essence of the subject invention, the pair of cooperating extrusions, and are competing unfairly with the applicant, by using a long, wavy spring.

We draw the attention of the Appeal Board to the decision of the Federal Court of Appeal, Deere & Co. v. Commissioner of Patents, November 17, 1981, 59 C.P.R. (2d) at page 1.

...

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

Parts 3 to 5 of the Petition for Reissue read as follows:

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

(a) One independent claim is present in Petitioner's Canadian Patent No. 1,042,725, this claim including the following limitation:

"a plurality of curved bar springs within said channel between the side thereof opposite said elongate opening and the square bar of said I, said springs each having an integral short extension projecting from one end thereof adapted to bite an aluminum surface when urged thereagainst and to maintain said spring positioned thereagainst;"

(b) This limitation is directed to "a plurality of curved bar springs", whereas the invention disclosed in my said patent is operable and commercially feasible with a single such bar spring, so as to support a claim reading:

"A self-adjusting weather strip assembly comprised of:
a main aluminum extrusion having a flat elongate base plate with an integral channel therealong, said channel being rectangular in cross section and having an elongate opening along one side thereof;
a second elongate aluminum extrusion configured generally as an I beam in cross section, one cross bar of the I being approximately square in cross section and being adapted to be slidably received in the channel of said main extrusion with the stem of the I passing through said elongate opening thereof, the other cross bar of said I having means to retain an elongate weather strip facing member;

at least one curved bar spring within said channel between the side thereof opposite said elongate opening and the square bar of said I; and

weather stripping affixed along the face of the second cross bar."

That while my disclosure details the short extension on a curved bar spring, to bite one face of the aluminum extrusion within which it is contained, if a single bar spring is employed, as is evident from my disclosure, such short extension is not an essential component of the bar spring.

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

Your Petitioner prepared Canadian patent application Serial No. 274,043, and received rejection from the Canadian Patent Office, after which the services of a patent agent were retained, in order to re-write the application in a form acceptable to the Canadian Patent Office. In preparing such re-written disclosure my patent agent followed as closely as possible my original disclosure, and my original claims, all of which claims were directed to a plurality of bar springs, and I did not emphasize

to my patent agent that a single bar spring would also serve the desired purpose within the scope of my invention.

- (5) THAT knowledge of the new facts in the light of which the new claim has been framed was obtained by Your Petitioner on or about the 15th day of October, 1979, in the following manner:

There came to my attention in Kentville, Nova Scotia, where I reside, weather strip products manufactured by the following three Canadian companies:

- (1) Jacobs & Thompson Limited,
89 Kenhar Drive,
Weston, Ontario.
- (2) R.C.R. Limited,
2295 Metropole,
Longueil, P.Q.
- (3) Stop Aluminum Company,
Perkay, Longueil, P.Q.

That Your Petitioner purchased weather strip sold by these companies, and forwarded samples to my patent agent for his advice as to preventing such sales of infringing weather strip. My patent agent advised that each of the weather strip products offered for sale in Canada by the above three companies fell within the scope of my invention with the exception that a single elongate bar spring was used, rather than a plurality of relatively shorter bar springs as claimed in my patent, and that on this basis the manufacturers of such competing weather strip would probably be able to defend any infringement action which I might bring against them. I discussed the problem with my patent agent on the telephone on October 31, 1979, and instructed him to attempt to obtain a reissue patent in order to include the claim, as set out above, in order that my invention as disclosed might be fully protected in Canada.

There are three claims in the application, of which claims 1 and 2 are identical to those in the original patent. Claim 3 reads:

A self-adjusting weather strip assembly comprised of:

a main aluminum extrusion having a flat elongate base plate with an integral channel therealong, said channel being rectangular in cross section and having an elongate opening along one side thereof;

a second elongate aluminum extrusion configured generally as an I beam in cross section, one cross bar of the I being approximately square in cross section and being adapted to be slidably received in the channel of said main extrusion with the stem of the I passing through said elongate opening thereof, the other cross bar of said I having means to retain an elongate weather strip facing member;

at least one curved bar spring within said channel between the side thereof opposite said elongate opening and the square bar of said I; and

weather stripping affixed along the face of the second cross bar.

At the Hearing Mr. Frayne stressed that the inventive concept is found on page 1 in paragraph 3 of the application. That paragraph reads as follows:

The invention disclosed herein provides a weather strip which is self-adjusting, with the novelty residing in a pair of aluminum extrusions, one extrusion having a channel, with an elongate opening along one side, the channel being adapted to receive a portion of the second extrusion, which projects through the opening, with spring means within the channel normally urging the second extrusion toward one side thereof, as will become clear hereinafter. The weather stripping disclosed herein is effective in sealing a door or the like even though that door has a considerable warp. Further, the spring action provided by the subject weather strip effectively creates a maximum seal between the weather strip and the door or the like to which it is applied such seal being greatly enhanced by the novel spring means provided.

In the Final Action it is stated that the "invention disclosed in the Applicant's patent nowhere specifically entertains the possibility, commercial feasibility, or the operability of using a single bar spring."

Mr. Khallil, the inventor, prepared and filed the original application in 1977. After responding to an Examiner's action on that application he obtained the services of a patent agent, Mr. Frayne, who revised that application which resulted in C.P. 1,042,725.

An affidavit from Mr. Khallil was included in the response to the Final Action.

Items 2 to 7 of that affidavit read as follows:

2. THAT I prepared and filed the original patent application which eventually matured into Canadian patent No. 1,042,725, after having engaged the services of a patent agent, namely, Robert D. Frayne, Ottawa;

3. THAT in designing my adjustable weather stripping, which is the subject of my Canadian patent application, I first designed the two cooperating extrusions, as disclosed in my patent application, and then experimented with springs to be inserted in the extrusions, to urge the male extrusion outwardly towards the lip of the female extrusion;

4. THAT the first spring I used in my experiments was a steel measuring tape, which I manually folded into the form of a long, wavy configuration;

5. THAT I placed this long spring in the female extrusion and pushed the male extrusion over the spring inside the female extrusion which gave me the piston action I desired to achieve on the weather strip;

6. THAT the result was not satisfactory to me as I discovered that the long spring, after a period of use, would stretch, and lose its spring strength;

7. THAT I continued experimenting in order to find a better spring, and eventually decided on the short springs described in my patent application, and it is these springs which I used in the weather strip I manufacture commercially, and which were specifically claimed in my original patent;

We were also provided with an affidavit from the agent, Mr. Frayne, in which the following statements are made:

4. THAT I have acted on direct instructions from Mr. Khallil in connection with the prosecution of both the subject reissue application and its parent, since early February, 1978;

5. THAT on or about the first week of February, 1978, I was visited in my office by Mr. Khallil who had himself prepared and filed Canadian patent application Serial No. 274,043 (now Canadian Patent No. 1,042,725);

6. THAT Mr. Khallil provided me with a copy of his Canadian patent application and a copy of a "response" he had filed to a first Official Action dated July 28, 1977;

7. THAT it was very apparent to me that his patent application required extensive re-writing, in order to comply with the requirements of the Patent Act and Rules thereunder, and in consultation with Mr. Khallil, during the first week of February, 1978, I proceeded to undertake this re-writing, the resulting amended application having been filed in the Patent Office on February 9, 1978, by me;

8. THAT Mr. Khallil at no time discussed with me the development stages of his self-adjusting weather strip as covered by the patent application filed in the Canadian Patent Office by him;

9. THAT only following grant of the said Canadian Patent, and the appearance in the market place of weather stripping embodying the essence of Mr. Khallil's novel weather strip did it become known to me that Mr. Khallil had devised and experimented with alternative forms of spring means for use in his weather strip;

From the above affidavits it is clear that Mr. Khallil did use one spring (a steel measuring tape folded into the form of a long wavy configuration) during development of his self adjusting weatherstrip. However, Mr. Khallil only made brief mention of this embodiment in the original application and amplified the description relating to his commercial embodiment which uses a number of short springs. It was only the commercial embodiment that he discussed with Mr. Frayne, who drafted the claims issued to patent, and which is covered in items 8 and 9 of Mr. Frayne's affidavit.

The circumstances found in Curl Master Manufacturing Co. Ltd. vs Atlas Brush Ltd. (1967) S.C.R. @514 are similar to those before us. The self adjusting weather strip has achieved commercial success. Inventor Khallil wanted to protect the invention made but he "had no prior experience in relation to patents." When drafting the application he emphasized his commercial embodiment and that was the form on which instructions to the patent agent were directed. We believe that the invention as made by the inventor was claimed in specific terminology because the information divulged to the agent, retained after the inventor's response to the initial official action only dealt with the commercially manufactured aspect of the invention as described in item 7 of the Khallil affidavit.

The defect that is sought to be rectified is the claimed limitation of ..."a plurality of curved bar springs...adapted to bite an aluminum surface..." We have previously reproduced paragraph 3 of page 1 on which the Applicant relies for support of claim 3. At the Hearing Mr. Frayne demonstrated the weather strip using one centrally located bar spring to show that it did provide sufficient force along the entire length to function in the manner set out in the above mentioned paragraph.

Section 50 of the Patent Act permits reissue when "any patent is deemed defective by reason of insufficient description or specification or by reason of the patentee's claiming more or less than he had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention,".

As stated in the petition the reason for reissue is that the patentee claimed less than he had a right to claim. More specifically, the original patent claims are maintained with an additional independent claim in which "at least one curved bar spring" is used.

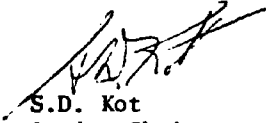
When the original application was filed by the inventor, he referred to "a spring shape of spring steel on drawing (figure 5) which was "inserted under (B) figure 4 as shown in figure (7)". We think that paragraph 3 on page 1 which we have previously reproduced discloses "spring means" which, when considered with the original filed application, does provide support for "at least one curved bar spring" in a claim. Therefore we do not agree with the Final Action statement that "the invention disclosed in applicants patent nowhere specifically entertains the possibility, commercial feasibility, or the operability of using a single bar spring."

The original patent claimed less than that which the applicant had a right to claim as new because of insufficient communication between the inventor and agent. Information describing the use of a single wavy spring is found in the Khallil affidavit. There was no information given to the agent with respect to the development of the invention as described in items 8 and 9 of the Frayne affidavit. We are satisfied that there was no fraudulent or deceptive intent on the part of the applicant. We can understand the position taken by the Examiner when issuing the Final Action but in view of the subsequently filed affidavits we are persuaded otherwise.

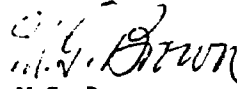
In view of the affidavit evidence, we find it useful to refer, in part, to circumstances found in Curl Master Manufacturing Co. Ltd. vs Atlas Brush Ltd. (1967) S.C.R. @514. There a particular embodiment had been disclosed but through inadvertence, accident, or mistake, and with no fraudulent intent, all of the original invention had not been claimed.

We are satisfied that Applicant has established in this instance a right to claim in broader terms the subject matter sought by reissue of his patent.

Therefore, we recommend that the Final Action refusing the petition for reissue because "claim 3 is directed to a different subject matter from that which the Applicant has disclosed and claimed" be withdrawn.



S.D. Kot
Acting Chairman
Patent Appeal Board, Canada



M.G. Brown
Member

I have reviewed the prosecution of this application and considered the recommendation of the Patent Appeal Board. I concur with the reasoning and findings of the Board. Accordingly I withdraw the Final Action and the application is returned to the Examiner.



J.H.A. Gariépy
Commissioner of Patents

Dated at Hull, Quebec

this 28th. day of February, 1983

Agent for Applicant

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