

Commissioner's Decision

A growing method and a flower pot for dwarfing plants in accordance with section 2 of the Patent Act. Claims relating to the container are complete.

The present decision follows from the request made by the Commissioner of Patents for a review of the examiner's final decision to reject application No 279,962 (Class 47-18). The invention is entitled CONTAINERS AND PROCESSES FOR DWARFING PLANTS. Mr Bruno Greber is the inventor. The examiner responsible for reviewing the application rejected the claims.

This application relates to a growing method and a flower pot for dwarfing plants. The pot is open at its upper end and has corrosion-resistant walls in which minute holes have been pierced. The main pot is placed inside another container. A small plant, a seed, a young shoot or a bulb is placed in the pot; the pot used is not big enough to contain the amount of nutritive substances necessary for normal development of the plant. The holes are too small for enough roots to grow through them into the outside container in order to obtain the nourishment required for the plant to reach its normal size; however, they allow dissolved nutritive substances from the outside container to penetrate into the pot. Figure 5 illustrates the pot dealt with in the claims.

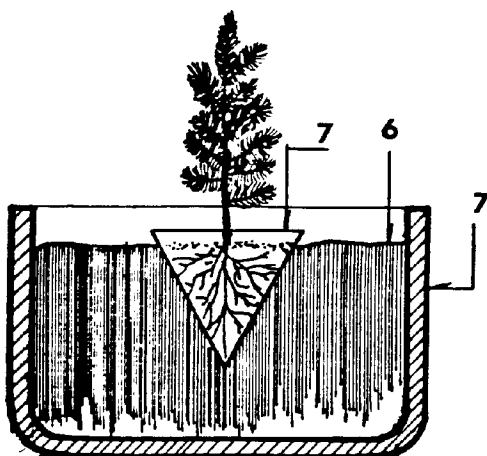


FIG. 5

In his final decision, the examiner dismissed the claims relating to the method, stating that they did not describe an invention within the meaning of section 2 of the Patent Act. He also dismissed the claims relating to the pot because, in his opinion, these were incomplete.

In his final decision, the examiner stated (in part):

. . .

Method claims 1 to 5 stand rejected for being directed to a method which resides outside the definition of Section 2 of the Patent Act. The examiner is of the opinion that such a dwarfing of plants can occur by chance in nature without the intervention of man. This chance dwarfing may occur when the plant is growing in a hostile environment with poor weather conditions, for example a tree growing on the side of a rocky mountain in a part of the country where there is little rainfall. Such a process is not patentable since it does not fall within the definition of invention in Section 2 of the Patent Act.

Article claims 6 to 19 stand rejected for being incomplete. The examiner considers it an essential feature of the functioning and purpose (utility) of the containers that the nutritive substances pass through the holes upon initial growth of the plant probably carried by water but once the plant has been growing for some time, the nutritive substances pass through the holes carried by sap in the small roots which have penetrated the second container through the holes. Failure by applicant to include this essential functioning of the article in the claim results in the claims reading on a host of flower pots having holes through which nutritive substances pass to feed the plants. It is to be noted that applicant admits to this essential functioning of his article in his letter of March 2, 1979, paragraph 2.

. . .

To answer the objections expressed by the examiner, applicant stated (in part):

. . .

. . . Claims 1 to 5 are all limited to the specific step of placing a plant or propagating material into a container which is of a size and has apertures to a required extent and of a certain size to restrict the growth of the roots of the plant. The chance occurrence cited by the Examiner, even if the same did occur, would not respond to the limitations of the method claims in the case under discussion. Accordingly, it is not seen that the Examiner's objections insofar as they are understood by Applicant's Agent, are well founded or based in fact or in law.

. . .

Applicant would point out that the claims of a patent are essentially a means of defining and limiting the ambit of the Patent Grant and are an essential part of the statutory consideration for the grant - see, for example, Skelding -vs- Daly, 1 Fox 1 at 6. In this respect, in relevant British jurisprudence, it has been held that:

"A Patentee who describes an invention in the body of a specification obtains no monopoly unless it is claimed in the claims"

cited in Rowley Cycle -vs- Miller & Co., 63 RPC 113 at 122.

. . .

The Commission must therefore decide whether the claims relating to the method are patentable within the meaning of section 2 of the Patent Act, and whether the claims relating to the containers are complete.

While the application was being reviewed, some changes to the claims were proposed. The applicant has therefore amended the claims relating to the method and has given reasons which he believes justify acceptance of the claims relating to the container. The applicant has made it clear in his claims that the purpose of the method was to dwarf plants. To support his claims relating to the container, he has pointed out, moreover, that the size of the holes and their role, which is to allow enough nutritive substances to pass through from the outside container, were clearly described and that no other details were necessary.

We should point out that the examiner in no way questioned the fact that the claims related to an unpatentable device, but rather that they did not describe it completely. After examining the applicant's letters dated June 11 and 23, 1981 and the attached claims for the device, the Commission is certain that the descriptions of the structure and the functional limits of the device are acceptable. Given that the claims for this device are consistent with the disclosure and that they did not raise any other objections, the Commission is of the opinion that the rejection of claims 6 to 19 should not be upheld.

Claim No 1, as amended, reads as follows:

[Translation]

Process for the purpose of dwarfing plants, characterized, first, by the fact that a plant together with its roots, or a seed, a cutting or a bulb of this plant, is placed in nutritive soil in a container which is too small to hold the amount of nutritive soil necessary to nourish a plant of normal size

and which has a wall perforated by many openings which are arranged close together and are of a size such that the number and thickness of the roots that can grow through are insufficient to nourish a plant of normal size, but which nevertheless permit dissolved nutritive substances to pass through in quantities just sufficient to nourish a plant of restricted size and, second, by the fact that the container is surrounded with nutritive substances, for example, by being placed in soil so that this soil surrounds the container wall.

To determine whether the method conforms with section 2 of the Patent Act, we have examined the jurisprudence relating to the patentability of processes or methods. As the courts have clearly stated, well-defined restrictions exist concerning the types of methods and processes that can be patented. As the Exchequer Court stated in Lawson v the Commissioner of Patents (1970), 62 CPR 101, "I take it as well settled that all new and useful arts and manufacturers are not necessarily included in Section 2(d) of the Act." We reached an analogous conclusion in Tennessee Eastman v the Commissioner of Patents, SC, December 22, 1972. In the present application, however, which differs from these two cases, it seems that the device is a patentable invention. In the case before us, the claims made with respect to the process are also related to the method of use of the special device which was described and for which claims are made. The Commission considers them to be very narrow in scope because they apply only to this device. Consequently, we do not share the examiner's opinion when he states in his final decision that the claims with respect to the method comprise processes which occur by chance in nature. The Commission has some doubts as to the patentability of a process for the artificial production of a dwarfed plant but, taking into consideration the accepted patentability of the device used, we believe that they should be resolved in favour of applicant.

We recommend, therefore, that all the claims be accepted and that the application be referred to the examiner.

(signed)

A McDonough
Chairman of the Patent Appeal Board

(signed)

S D Kot
A member

I reviewed the proceedings relative to this application and I concur with the findings of the Patent Appeal Board. I quash the final decision to refuse the claims and refer the application to the examiner.

(signed)

J H A Gariépy
Commissioner of Patents

Dated at Hull, Quebec
This 8th day of November 1983

Agent for the Applicant

Messrs McFadden, Fincham and Co
251 Bank Street
Ottawa, Ontario
K2P 1X3