

COMMISSIONER'S DECISION

Sulfurizing Lard Oil Product-by-process, composition per se: Claims to product-by-process and to the composition per se were offered and accepted during conflict, and no reason found now to disagree that they better define the invention. Rejection reversed.

This decision deals with the Applicant's request that the Commissioner of Patents review the Examiner's Final Action on application 134,156 (Class 253-86). The application was filed February 8, 1972, by Sun Research and Development Company and is entitled PROCESS OF SULFURIZING LARD OIL AND OLEFIN AND RESULTANT PRODUCT. The inventor is Alexander D. Recchuite. The Examiner in charge issued a Final Action on November 19, 1982 refusing the application.

The application relates to a process and a composition which involves blending from 90 to 50 and preferably from 88 to 70 parts by volume of triglyceride and from 10 to 50 and preferably from 12 to 30 parts by volume of an olefin, adding sulfur or sulfur monochloride, and then blowing the sulfurized blend with a gas to remove hydrogen sulfide.

In the Final Action the Examiner rejected certain claims for indefiniteness, for redundancy, and for lack of support by the disclosure. He said in that action, in part, as follows:

The refusal of claims 41, 43-46, 47-51 and 52-57 is maintained. Claim 1-40(sic) are allowable.

Product claims in per-se and by-process form may not be retained in the same application. Chapter 8.04.02 of M.O.-P.O.P. outlines the requirements needed for a product not governed by Section 41 of Patent Act. These include the definition and the best form (structure), if known, under Section 36 of the Patent Act. Claim 18 of the present application defines a composition in terms of its specific constituents in per-se form as do claims 30, 39 and 40. Product-by-process claims 42 and 52 to 57 either define the same product and they are therefore redundant or represent product claims of a different but indeterminate mixture and of a different scope. The above by-process claims are indefinite. The presence of both types of claims makes it impossible to determine what composition the applicant regards as new and in which he claims an exclusive property or privilege.

Claim 47 to 51 and 43 to 46 are rejected for lack of support by the disclosure and of being irrelevant to the subject matter of the entire specification. There is no statement or disclosure in the present specification or any experiment specifically teaching the presence of a free fatty acid as being essential to the present invention. There is nothing in the disclosure correlating a free fatty acid with the utility of the process and composition.

Firstly, the existence of a free fatty acid in the lard oil is incidental and undesirable as disclosed on page 3 last paragraph, for solubility reasons. Secondly the present composition can be prepared without free fatty acid components, as disclosed. The applicant neither thought of a composition purposely containing free fatty acid as essential ingredient nor explained the function of this ingredient. The applicant simply never invented a composition as the one described in claim 47 etc., which he introduced long after the filing of this application. Finally the above claims contain subject matter that is entirely different and not pertinent to the original specification. The above claims must be deleted.

. . .

In presenting his case for allowance of the claims, Applicant argued, in part, as follows:

. . .

The Examiner in the Official Action had suggested that product claims in per se and by process form may not be retained in the same application and has brought to attention certain claims which define a composition in terms of specific constituents in per se form and also claims which define the product-in-process dependent form. In considering the product-by-process claim, claim 42, it is brought to the attention of the Examiner that claim 42 was originally in the conflict and bore marginal designation C9. It was the Examiner who introduced such form of claim and it is respectfully brought to the attention of the Patent Office that claim 18 as well as claims 30, 39 and 40 were on file at that time. It is Applicant's understanding that any claim presented for conflict purposes should be an allowable claim to the Applicant if successful in the conflict.

. . .

In view that both forms of claims have been introduced by the Patent Office into the application via the conflict Applicant believes that he should also be entitled to additional product-by-process form of claims as represented by claims 52 to 57. Although the Examiner suggests that the claims to the composition per se and product-by-process form of claim define the same product and would be considered redundant this has not been substantiated and as previously indicated interpretations vary thus Applicant believes that both form of claims are necessary to permit Applicant full coverage of the inventive concept and to prevent domination by another party.

. . .

The Examiner in the Official Action had also rejected claims 47 to 51 and claims 43 to 46 as lacking support in the disclosure and as being irrelevant to the subject matter of the entire specification. This rejection by the Examiner is most strenuously traversed. There is in fact clear support for the fatty acid in Applicant's disclosure as clearly outlined on pages 3 and 4 of the instant application. As indicated on page 3 of the disclosure, the preferred commercial material contains 2 to 5 percent free fatty acids however 12 to 20 percent content of free fatty acid in lard oils is also indicated as being suitable. For the Examiner to suggest that the composition purposely containing free fatty acid as essential ingredient was not

thought of as being an inventive concept has not been substantiated and it is respectfully submitted that the presence of the free fatty acid has been clearly taught as being incorporated in the compositions employed.

. . .

Indeed, Applicant makes it clear that his preferred compositions are made from lard oil containing 2 to 5% free fatty acids. It is clearly erroneous to refuse as unsupported by the disclosure the very composition which Applicant has disclosed as being preferred.

. . .

The issues before the Board are whether or not Applicant is entitled to retain claims to the product in per se form as well as in product-by-process form, whether or not the claims are supported by the disclosure, and whether the product-by-process claims are indefinite.

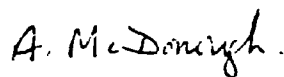
We note that claims 41 and 42 were drafted by the Office to better define the invention during the conflict proceedings. Applicant has argued that the Examiner in the Final Action has not substantiated that the composition per se and the product-by-process claims are redundant, adding furthermore that both forms of claims are necessary to provide Applicant with full coverage of the inventive concept.

During conflict the Office suggested claims which were considered as better defining the invention, and we find no reason to disagree with that point of view now. We agree with Applicant that he should be entitled to such claims, particularly since he placed on file what was considered during the conflict the best form of claims to define his invention, and which distinguished his product from all others.

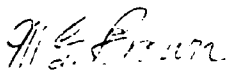
We should also point out that the Applicant has, more than once, drawn to the Examiner's attention an issued Canadian patent which was copending with this application in the Patent Office. Applicant has insisted that the claims rejected by the Examiner should be allowed in re Fry v. Commissioner of Patents. Since the relevance of the Canadian patent to this application was not raised in the Final Action we will not deal with the matter here. We simply note that Applicant has requested allowance of the application in re Fry with all the claims now present.

We have reviewed the disclosure and we agree with Applicant that there is support in the disclosure for the rejected claims, and that he is entitled to claim what he has disclosed. We also find that the objection to the claims for indefiniteness should not be sustained. The dependency of the product on the process does not in our opinion make it indefinite.

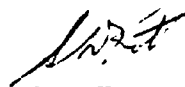
We note that there has already been a lengthy prosecution, involving conflict proceedings resulting in a decision in Applicant's favor, followed by this Final Action. We recommend that the refusal of the claims on all counts in the Final Action be reversed, and that the application be returned to the Examiner for action in accord with the conflict decision.



A. McDonough
Chairman
Patent Appeal Board



M.G. Brown
Assistant Chairman



S.D. Kot
Member

I concur in the findings and recommendation of the Patent Appeal Board.

Accordingly, I withdraw the Final Action and return the application for prosecution consistent with the recommendation.



J.H.A. Gariépy
Commissioner of Patents

DATED AT HULL, QUEBEC
this 10th. day of August 1983.

Agent for Applicant

Ridout & Maybee
Suite 2300, Richmond-Adelaide Centre,
101 Richmond St. W.
Toronto, Ont.