

COMMISSIONER'S DECISION

REISSUE - TOOTHBRUSH KIT

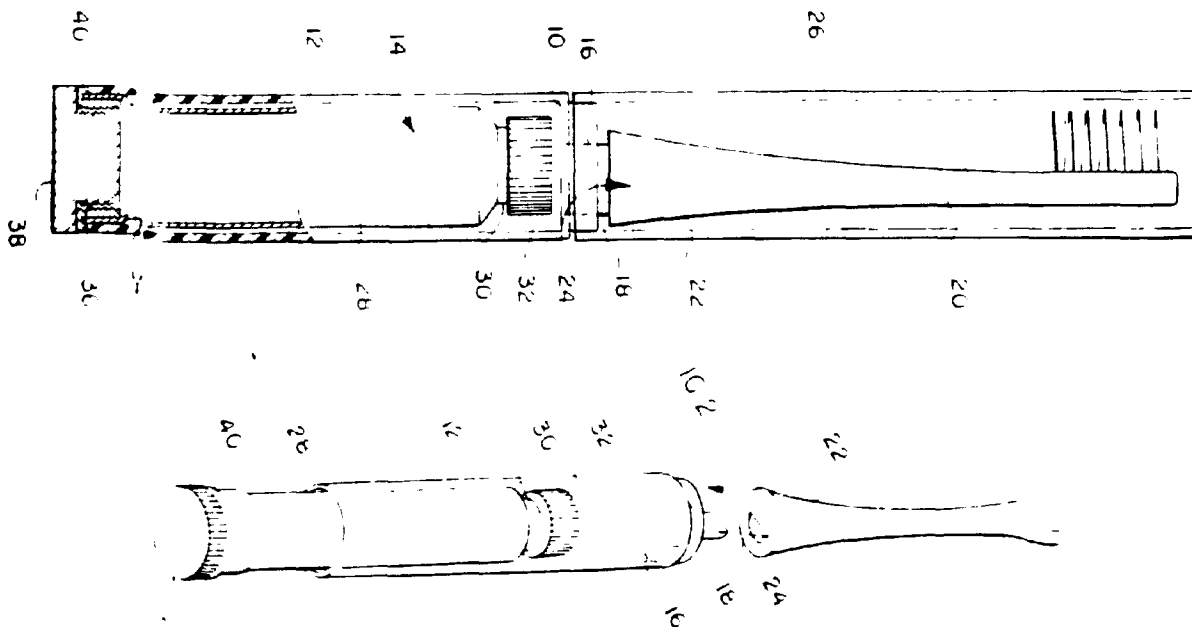
Claim 1 is broader in scope than patent claim 1 and covers what was known by others but not known by the applicant. It is refused for claiming matter that was not part of the applicant's invention at the time of issue.

Final Action: Affirmed

Patent application 342,200 (Class 15-108.1) was filed on December 19, 1979 for an invention entitled DENTAL HYGIENE KIT. The inventor is John A. Manfredi. The Examiner in charge of the application took a Final Action on November 24, 1982 refusing to allow it to proceed to patent. In reviewing the rejection, the Patent Appeal Board held a Hearing on April 18, 1984 at which the Applicant was represented by Mr. G. Rolston and Mr. F. Forfan.

The subject matter of this application relates to a portable toothbrush kit in which the brush is housed in a cylindrical sleeve member and the hollow handle serves as a casing for the toothpaste tube. Figures 1 and 2 are illustrative of the application.

Fig. 1



Toothbrush 20 is contained in protective sleeve 26 and refillable toothpaste tube 28 is in hollow handle 12. Figure 2 shows the components in disassembled form. Plug 38 screws into thread sleeve 40 located at the bottom of tube 28. Tube configuration and thread sleeve manufacturing alternatives are the areas which are of concern to the applicant.

In the Final Action the Examiner refused the application for reissue because of failure to satisfy Section 50 of the Patent Act. That action stated in part:

...Thus the applicant and his agent displayed no error from inadvertence, accident or mistake, but accurately defined the essential features of the invention in view of the relevant facts known at the time of filing the original application....

...pages 3 and 4 of the affidavit, implies that no error, mistake or inadvertence arose since the applicant was not aware of the different manufacturing techniques. Thus the applicant is not entitled to claim techniques of which he had no knowledge at the time of filing of the original application....

....It is further noted in the affidavit of George A. Rolston included in the petition for reissue on page 3 it states, "Apparently, at the time I was drafting this claim it was not perceived that there were in fact other ways in which this structure could be made." Claim 1 states, "a generally cylindrical reinforcement at the other end of said toothpaste container, said cylindrical reinforcement, together with said toothpaste container being adapted to make a tight push fit within said open end of said handle whereby to retain said toothpaste container therein." Thus the applicant did in fact encompass alternative ways in which the structure could be made. United States patents 793,259 and 1,505,363 do in fact describe ways the applicant encompassed in the original claim 1. Hence the applicant amended the claims in view of the prior art. The applicant may not have perceived other ways that the structure could be made, but in fact claimed other ways....

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

...

As at the time prior to 1976 there were several different manufacturing techniques which were well known in the plastics industry. The dispensing container could have been made by any and all of these techniques.

Mr. Manfredi, and myself, were not aware of all of these techniques at the time.

Mr. Manfredi and myself believed in fact that the only technique by which the article could be made was the technique shown in Figure 1 of the application.

This belief was a mistake.

The claims, during the course of prosecution were amended so that they were more or less specific to this technique.

There is in fact no newly conceived matter at all. The matter to which the Examiner is believed to be referring in this passage, relates to the different manufacturing techniques which were well known in the plastics industry prior to 1976, but were not known to the inventor and myself.

This cannot be considered as "new" matter which was discovered or conceived by the inventor.

The inventor is not suggesting that he is the discoverer or that he has conceived these techniques.

They are techniques which were standard in the industry, and which industry experts were very familiar with. (see affidavit of Bahen).

...

The issue before the Board is whether or not the present reissue application should be allowed to proceed to patent.

Reissue claim 1 reads:

A portable dental hygiene kit of the type having a toothbrush and a removable toothpaste container within a handle portion of the brush, said dental hygiene kit comprising:

a main body portion having brush-attaching means thereon and a toothbrush removably attached to said main body portion;

handle means extending from said main body portion and a recess within said handle means, said recess having a blind end and an open end and a generally regular shape with a predetermined internal diameter;

a toothpaste container having flexible side walls, a nozzle and a cap at one end, being freely removably disposable within said recess, being of a generally regular shape from its said one end to a point short of its other end, and having an external diameter less than said internal diameter of said recess;

a cylindrical reinforcement member disposed at said other end thereof, and having an internally threaded bore, said reinforcement member forming a radially outwardly enlarged terminal portion of said container, such enlarged portion making a tight push fit within said open end of said handle means for retaining said toothpaste container therein;

a threaded plug closure screwed into said threaded bore of said cylindrical reinforcement member and being removable therefrom to permit refilling of said toothpaste container through said bore;

an external annular flange on at least one of said cylindrical reinforcement member and said threaded plug to limit the extent of insertion of said toothpaste container into said handle, and,

removable cover means for covering said toothbrush when not in use.

In the petition for reissue the applicant in parts 3 to 5 makes the following statements:

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

Claim 1 refers to "handle means...having a recess...of a cylindrical shape...".

The interior shape of the recess appears to be irrelevant to the patentability of the invention, and in addition, it is in fact capable of being made in a variety of different configurations without suffering any loss of the essential function or utility for which it is provided.

In addition, Claim 1 also refers to "an annular sleeve disposed within the interior of said toothpaste container at the other end thereof and having...an external diameter greater than the internal diameter of the container so as to radially outwardly distend the terminal portion of said container.

It is again felt that this wording is unduly restricted, since it introduces limitations on the specific form of construction, which are essentially unnecessary to the function or utility of the features as claimed.

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

THAT when amending the wording of the claims in the course of prosecution, new terminology was used, by the patent agent of record, which it now appears was not well chosen.

(5) THAT knowledge of the new facts stated in the amended disclosure and in the light of which the new claims have been framed was obtained by Your Petitioner on or about the 12th. day of July, 1979 in the following manner, as a result of a meeting between the inventor and the patent agent, and a detailed study of the wording of the claims, with a view to possible future legal action.

We are mindful that Section 50 of the Patent Act permits the reissue of a patent when the error arose from inadvertence, accident or mistake. Further we believe that a person relying upon a mistake under Section 50 has to establish that the patent which issued did not accurately express the inventor's intention with respect to the description or specification of the invention or with respect to the scope of claims. (see Hoescht vs Commissioner of Patents 50 CPR 220 @254-5)

At the Hearing Mr. Rolston described the history of the prosecution on the issued patent. He pointed out that neither he nor inventor Manfredi had any experience in plastics manufacture and that he had very little guidance from the inventor in drafting the application. An affidavit from Mr. Rolston was presented with the petition for reissue. That affidavit stated in paragraphs 3 and 4 of page 3 that:

Apparently, at the time I was drafting this claim it was not perceived that there were in fact other ways in which this structure could be made, so as to achieve these functions. It now appears that there may well be other ways in which the toothpaste container can be provided with an enlarged or distended lower portion, to provide this wedging fit, using techniques which are apparently already in use in the plastics industry.

The inventor himself is understood to have only recently have been made aware of these manufacturing techniques, and I myself was not aware of them. It is not suggested that such manufacturing techniques are themselves inventive, and indeed it appears that to persons knowledgeable in this particular art in the plastics industry such techniques are quite well known.

The purpose of the presently proposed revisions to lines 14 to 23 are therefore to ensure that the claim shall cover the toothpaste container having the essential functional utility of the toothpaste container described in the specification, while being made according to techniques which it now appears are relatively well known in the plastics industry, although were not known to the inventor at the time that the specification was drafted.

The affidavit and the petition clearly establish that the inventor and his agent were not familiar with the manufacturing techniques available in plastic manufacturing when the patent was being prosecuted. Mr. Forfan argues that ignorance of these techniques resulted in unduly restricted claims in the issued patent and maintains that the Applicant is entitled to the broader claims now in the reissue application.

We turn first to the amendments contained in reissue claim 1 concerning the handle means. The recess is now said to be a "generally regular shape with a predetermined internal diameter", whereas in patent claim 1 the recess is recited as a "cylindrical shape with a predetermined internal diameter". In the Agent's affidavit filed December 19, 1979, Mr. Rolston argues the term "cylindrical" with respect to the handle is unnecessarily restrictive, and so far as the handle is concerned, since the limitation "predetermined internal diameter" remains in the claim, we find no objections to making that amendment.

With respect to the changes proposed for the structure of the toothpaste container, we make the following observations. The container in reissue claim 1 is described as being a "generally regular shape" whereas in patent claim 1 it is a "generally regular cylindrical shape". Each of the shapes referred to above are also modified by the term "an external diameter less than the internal diameter" of the recess of the handle. This portion of the reissue claim would not seem, by itself, to present any difficulty in finding acceptance.

We next consider the term in reissue claim 1 "cylindrical reinforcement member disposed at" the other end of the toothpaste container, which replaces "an annular sleeve disposed within the interior" of the container, as found in patent claim 1. In Exhibits A and B submitted with the Manfredi affidavit of November 14, 1980 we see the arrangements now covered by the above term in reissue claim 1. Manfredi says in part 3 of his affidavit he believed the threaded collar had to be forced inside the flexible wall, and we note that his patent claim 1 reflects this construction. Part 3 of the Manfredi affidavit also informs us of meetings with experts in plastics design describing spot welding and injection molding techniques to form the larger diameter integrally with the smaller diameter. Manfredi also says he did not know these facts when his application was being processed to patent. In part 5 of the Petition it is stated the knowledge of the new facts was obtained on July 12, 1979. This date is after the issue of the patent. In our opinion, reissue claim 1 in reciting the cylindrical reinforcement disposed at the other end of the toothpaste tube, encompasses the techniques known by others at the time the patent issued. We do not find in any of the evidence submitted, or in the original application, a disclosure that any technique other than that covered by patent claim 1 was known to the inventor when his patent issued. We consider reissue claim 1 is broader in scope than patent claim 1 and covers what was known by others, but not known by Applicant. We are satisfied therefore that reissue claim 1 in reciting the reinforcement member disposed at the other end of the toothpaste container, is claiming matter that was not part of Applicant's invention at the time of issue.

We are guided by the finding of the court in Northern Electric vs Photo Sound

Corp. 1936 S.C.R. 649 @652 where it states:

These conditions necessarily imply that the inadvertence, accident or mistake must be inadvertence, accident or mistake affecting the sufficiency of the description or specification in the original patent, and it is only in respect of such inadvertence, accident or mistake that the statute contemplates relief.

The statute does not contemplate a case in which an inventor has failed to claim protection in respect of something he has invented but failed to describe or specify adequately because he did not know or believe that what he had done constituted invention in the sense of the patent law and, consequently, had no intention of describing or specifying or claiming it in his original patent. The tenor of the section decisively negatives any intention to make provision for relief in such a case.

and at 653 where it reads:

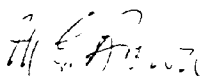
There is no suggestion that the original patent was inoperative or could be deemed inoperative. It is essential, therefore, to enable the appellants to invoke the section, that the original patent should have been deemed defective by reason of insufficiency of description or specification arising from inadvertence, accident or mistake.

It is immaterial to my present purpose whether the word "deemed" contemplates the view of the Commissioner or the view of the Court before whom the question of the validity of the re-issue patent comes for decision, or the view of the parties concerned. At the lowest, the statute must contemplate some kind of reasonable ground for apprehension on the part of the original patentee that the patent is defective in the sense of the section. It would, in my opinion, be an abuse of this language to apply it to a case in which it is obvious that a patent completely fulfils the intention of the applicant, where there is plainly neither insufficiency of description nor specification, for the purpose which the applicant had in view; where, in other words, the invention in respect of which the patentee intended to obtain protection is quite certainly and sufficiently described and specified. In such a case, the patent is not in any proper sense of the phrase defective.


In the patent the issued claims resulted from an amendment to overcome cited art while still keeping them within the teaching of the disclosure which described what the patentee knew at the time. Therefore we believe that when the prosecution of the original patent took place the specification adequately described the invention in terminology which both the inventor and agent considered to be the inventor's advance in the art. From the evidence before us, we do not find that it was ever the intention of the applicant to include the subsequent knowledge which he now wishes to enter in the application as part of his invention because, as he states in his affidavit, it was not known to him at the time. We do not see therefore how that knowledge could have been drafted for inclusion in the original disclosure. From the above Northern Electric case we think that knowledge, obtained

by the inventor subsequent to the issue of a patent, is not the type of error for which Section 50 of the Act contemplates relief. Further, that knowledge is said to have been well known by others at the time of issue and it is not stated how, nor do we believe that it could be considered as forming any part of his invention.

In our view the application does not comply with the requirements under Section 50 because the inventor did not intend to define the scope of monopoly of the invention in terms as now expressed in claim 1. This claim and claims dependent thereon define an invention not intended to be claimed in the original application (Vide Northern Electric vs Photo Sound) and we recommend that the rejection of the application for reissue be affirmed.



M. G. Brown
Assistant Chairman



S.D. Kot
Member

I have reviewed the prosecution of this application and concur with the reasoning and findings of the Patent Appeal Board. Accordingly, I refuse the claims of this application. The Applicant has six months within which to appeal this decision under the provisions of Section 4- of the Patent Act.



J.E.A. Gariépy
Commissioner of Patents

Dated at Hull, Quebec

this 16th. day of August, 1984

Agent for Applicant

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