

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application 379,817 having been rejected under Rule 47(2) of the Patent Regulations, the Applicant asked that the Final Action of the Examiner be reviewed. The rejection has consequently been considered by the Patent Appeal Board and by the Commissioner of Patents. The findings of the Board and the ruling of the Commissioner are as follows.

Agent for Applicant

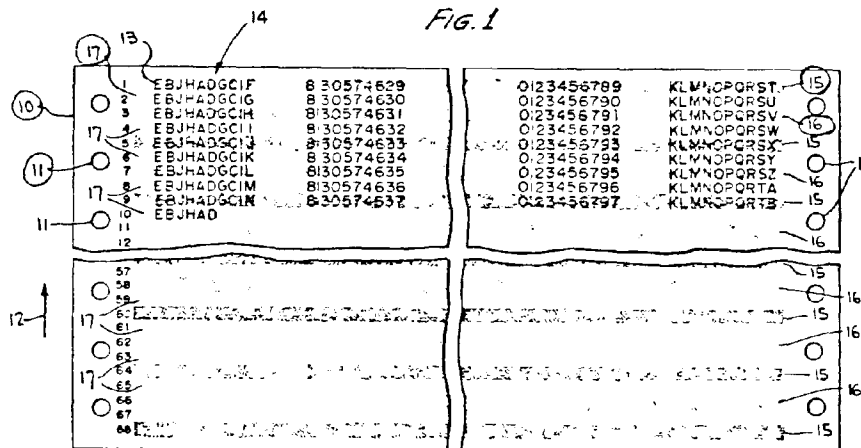
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COMMISSIONER'S DECISION

Reissue. The prosecution to obtain the patent showed exercise of judgement in claiming over the prior art. No intent found for broadening the claims. Rejection of two parts of the petition affirmed.

This decision deals with Applicant's request for review by the Commissioner of Patents of the Final Action on application 379,817 (Class 281-10) for the reissue of Canadian Patent 1,012,183 granted on June 14, 1977. The application is assigned to Moore Business Forms Inc. and is entitled MACHINE IMPRINTABLE BUSINESS FORMS WITH TRANSVERSE COLORED BARS. The inventors are Alan M. Gould and Robert H. Allen. The Examiner in charge issued a Final Action on September 24, 1982 refusing to allow the application. A Hearing was held on December 5, 1984, at which Applicant was represented by his Patent Agent Mr. D. Morrow.

The application relates to a business form provided with a plurality of pre-printed parallel color bars. In figure 1 shown below, form 10 has a plurality of parallel bars of at least three different and unlike colors. Bars 15 and 16 of different colors are printed on the form which provides lighter color spacing bars 17 between them, for example a bright white color, to facilitate a clear distinction of one bar from another. The form may be fed into a machine by feed holes 11.



In rejecting the application for reissue, the Examiner refused amendments relating to items (a), (f), (g), (h), (i) (l), and (m) of part 3 of the petition for reissue, and said (in part) as follows:

...

Applicant has not established that the items refused in the application for reissue were intended to be described or claimed in the original patent, nor that the description in his original application was not clear and complete and all this due to error.

...

His grounds for refusing items (a) and (i) are as follows:

...

Item (a) It is true that the claims have always referred to "at least three colors", but inserting in the disclosure new details such as in lines 7 to 13 on page 7, only because they are within the scope of the claims, cannot be accepted. Furthermore this cannot be justified as the result of an error.

...

Item (i) The applicant states that the words "different" and "unlike" are synonyms and their meaning is exactly the same and they are redundant. This explanation is not convincing. First of all, the patentee always used the two terms together connected by an "and". He never interchanged "different" for "unlike", and therefore, a distinct meaning was conveyed by these two words. Leaving them as in original patent they will describe and define the same invention as in the original patent. However, deletion of "unlike" modifies the scope of the claims. No previous intention of not having the two words combined can be found in the original specification.

In response, Applicant accepted the Examiner's position for items (f), (g), (h), (l) and (m) and made appropriate deletion, amendment, or cancellation. He maintained the matter in items (a) and (i) was acceptable and argued for their retention, (in part) as follows:

...

(a) The claims have always referred to "at least three" colours, and therefore clearly have always contemplated more than three colours. The amendment to the disclosure at page 7, lines 9-13 merely inserts an explicit statement corresponding to the scope of the claims. Clearly, the applicant has always contemplated the use of more than three colours; this is of course inherent in the claims. The error in question is, purely and simply, a patent attorney's error, since patent attorneys are supposed to know that claims are supposed to be supported by the disclosure. The amendment sought is of a kind that has been repeatedly permitted in reissue applications. Its purpose is simply to correct a technical error by a patent attorney. It is respectfully submitted that this amendment ought to be allowed, and the statement has been retained in the disclosure.

...

- (i) We respectfully maintain this amendment. This is plainly another instance of attorney's error. The words "different" and "unlike" are dictionary synonyms. Even if their meaning does not precisely coincide, it clearly substantially overlaps. The words are redundant.

No applicant for patent intends to include redundancies in his claims. However, every applicant represented by an attorney is in the hands of that attorney when it comes to details of claim terminology. Nothing in the prosecution of the application turned on this particular terminology. This is an error of claiming which has been perceived subsequent to issuance of the patent. We respectfully submit that it is simply a matter of amending the application to delete an obviously ambiguous limitation in the claims. Whether or not the claims, in their present wording, or as amended, cover two different shades of a single colour is a hypothetical question that is beside the point, and need not be discussed in connection with this application. We respectfully submit that this amendment should be allowed.

...

The issue before the Board is whether or not parts 3(a) and 3(i) of the petition for reissue of the application are acceptable under Section 50 of the Act.

In his letter of March 24, 1983 responding to the Final Action, the Applicant considered the only issues were whether or not several paragraphs of the petition for reissue are allowable. Since then discussion between the Applicant and the Examiner has narrowed those paragraphs to two paragraphs, (a) and (i) of part (3) of the petition. At the Hearing Mr. Morrow felt these two paragraphs were the only subject matter to be resolved, noting all other aspects of the petition had been approved by the Examiner or, alternately, portions of the rejection had been withdrawn. He stated that the patentee deems the term "at least" in the claims to be limited to three colors, and now desires that the meaning of "at least" should be interpreted to permit the meaning that more than three colors may be found in any sequence of four bars even though the disclosure in one area does not read that way. He says the Applicant deems there is nothing specific that would exclude more than three colors in the disclosure. At the Hearing the Board asked whether there may

be indefiniteness in the claim wording because one part of one claim covers more than three colors, and another part of the same claim seems to be directed only to three colors. The agent said that problem of claiming has been cured since the Examiner is no longer pursuing that kind of objection to the claims. The agent stresses that Applicant seeks to cure the disclosure. He reasons no patent attorney would use a different term in the disclosure to describe the same feature at two different places.

At the Hearing considerable discussion took place with respect to Section 50 of the Patent Act. As this section contains no provision to amend the petition, any failure in the petition is a basis for refusal of the reissue. In the situation before us the Examiner has viewed parts of the petition as acceptable and other parts as improper. Our concern is whether or not the petition is acceptable. If it fails to comply with what is required by Section 50 then the application for reissue is improper.

In general terms the agent agreed with the Board on this point, but he said he did not come prepared to deal with that kind of rejection i.e. a rejection of this petition, because as he understood the rejection there were only two outstanding differences to be resolved, between the Applicant and the Examiner, parts (a) and (i), above. Mr. Morrow urged that if the error, accident or mistake was made by the patent attorney and not the inventor himself, and if the Commissioner is satisfied the facts stated in the petition are not at variance with what is sought to be corrected, no impediment to reissue should exist.

In this case, he points out some amendments met with approval by the Examiner, while others did not and have been withdrawn. He referred to the prosecution of the original application, noting that preoccupation by the patent attorney with the prior art to distinguish the claims therefrom caused the errors.

Mr. Morrow said the amendments now sought relate to technicalities of draftsmanship and in his view the original attorney did not turn his mind to specification drafting.

It appears that the Examiner did not maintain his initial rejection of certain parts of the petition, and we will not deal with them, although we think what is significant in our view is the Notice to the Patent Profession published in the Patent Office Record of July 22, 1969 p.vii and viii. There the Commissioner notes that no amendments, other than typographical, will be permitted to parts (3), (4), (5) of petitions for reissues and comments that if the facts in these parts of the petition proved to be incorrect the only way to make correction would be to file a completely new application for reissue (if time permits) and pay new fees. The Notice reads:

#### NOTICE TO THE PATENT PROFESSION

##### Petitions For Reissue

In filing an application to reissue a patent, a petition in Form 10 is to be completed. In this petition the petitioner indicates in parts (3), (4), & (5) pertinent data supporting the reasons why a reissue patent should be granted.

Applicants are advised that once a petition to reissue has been filed, no amendments will be entertained relating to parts (3), (4) & (5) of the form, other than the correction of simple typographical errors obvious from the document itself. Where necessary it is permissible to file additional evidence supporting the facts presented in the petition, but they may not be added to the petition itself.

If the facts presented in the parts (3), (4) & (5) of the first petition subsequently prove to be incorrect, the only way to make correction will be to file a completely new application for reissue (if time still permits) and to pay new fees.

During the Hearing we commented on the letters Applicant submitted during prosecution leading to the issue of the original application. We believe an awareness of what occurred during its prosecution is important in considering the rejection of parts 3(a) and 3(i) of this petition. In the original prosecution, after a first notice of allowance on March 12, 1976, two amendments after allowance, a supplement to an amendment after allowance, and a voluntary amendment were submitted. On August 23, 1976 the case was withdrawn from allowance. Then an action was written citing art and two responses were submitted before the case was allowed a second time on February 1, 1977. Following this, another amendment after allowance was filed, a change of inventorship was recorded, and the patent issued June 14, 1977. During all this prosecution the term "different and unlike" was

retained. At the Hearing it was suggested that where an agent makes an error, a plea of accident, inadvertence or mistake may be made describing how the error arose; and we enquired if in this case there might be bad judgement involved leading to the error rather than accident, inadvertence or mistake. Mr. Morrow said that in a proper circumstance where bad judgement has been visited on an applicant, the applicant has to live with it. Mr. Morrow feels however, this is a case where no judgement was made by the attorney on the above term. He argues a mistake was made and it should not be a burden on Applicant. He urges the patentee always intended to define what he now wishes to add to the application. He emphasizes that the argument over the prior art was the reason the previous attorney failed to consider the technical importance of the words.

We have reflected on the very ably presented reasons by Mr. Morrow why this reissue application should be allowed, and his opinion with respect to only two issues being open for review, viz items (a) and (i) of part (3) of the petition. In determining the acceptability or otherwise of these items, we find our course of action is set by Section 50 of the Act and the Commissioner's Notice to the Patent Profession. We are directed to determine if parts 3(a) and (i) of the petition satisfy Section 50. A study of what is said to be the invention in the original application and its prosecution must therefore be made.

To determine what lead to the acceptance of the claims in the patent, we refer to the original application and the argument in the letter of amendment of December 13, 1976 during its prosecution. On page 2 of the original application a broad aspect of the invention is said to be a business form having a plurality of bars "...of at least three different and unlike colors, one of which is lighter than the other two colors." From this, we agree with the impression that the Patentee is now said to have, namely, there are not more than three colors specifically stated. In the last five lines of page 2 a repetitive spacing of the bars is said to be "in such manner that

the lighter color bars are spaced from each other alternately by a single bar of one of the other colors..." Another feature is then said to be "...any sequence of four adjoining bars included bars of at least three different colors...". We note, as does Applicant, nothing specific is said about more than three colors. Turning to page 3 a second aspect of the invention is given, and the plurality of bars are "...of at least two colors different and unlike each other and the color of the surface...". The color and surface bars are spaced repetitively, as in the broad aspect, so that "...the color bars are alternately disposed on the surface and each color bar adjoins a surface bar on either side...". The sequence of four adjoining bars is said on page 4 to include "...at least one surface bar and two different color bars...", and a preferred form is given having two different colors "...with the spacings therebetween being surface bars of bright white color to facilitate a clear distinction of one bar from the other..." From all the examples provided in the original application in describing the invention, we find it is silent about more than three colors. We appreciate Applicant's concern that it describes not more than three colors in any four bar sequence.

We turn to Applicant's letter of amendment of December 13, 1976 on the patent file, responding to the examiner's action in which all claims had been rejected in view of prior art. On page 3 thereof the Applicant refers to his use of three different color bars, one of which colors is lighter than the other two, and to his sequence of bars as an important part of the invention. He says in that letter the arrangement is expressed in his claims, noting the lighter color bars are spaced from each other alternatively by a single bar of one of the other colors. He defines the sequence of bars as, light color - X color - light color - Y color - light color - X color, et seq. He argues as a further limitation in the claims that in "...any sequence of four adjoining bars, there are bars of at least three different colors." He then



dismisses the prior art, referring particularly to the shortcomings of the Eberhardt and Baskerville patents arguing they do not supply the features that he describes on page 3. Further in that letter, his argument refers to every other bar as being white and shows how his system cannot be found in either of the two patents. We view the arguments at that stage as a clear statement not only of what Applicant believed the invention to be, but also as a deliberate attempt to show how the invention was patentable in view of prior art. In view of Applicant's illustration of how his system provides a four bar arrangement which uses one light color - the white paper - as a bar not only to border each of the X and Y colors but also to separate them, we are persuaded the sequence of the light color is not intended to include different light colors. Moreover we find the disclosure and the arguments are silent concerning an understanding that the light color is intended to be alternating different light colors. We are satisfied Applicant's term "at least three" is used in the sense that only three colors are to be used in his four bar sequence, two being darker than the third which separates the two darker colors at all times. We are not persuaded by the arguments the Applicant advances in the prosecution of this reissue application and by the agent during the Hearing, that an error due to inadvertence, accident, or mistake was made. We have an opposite view, the evidence shows judgement was exercised to obtain the claims that were allowed in the patent.

We now turn to the information provided in Applicant's letter of July 16, 1982 during the prosecution of the reissue application. He says the attorney prosecuting the original application did not give "...any extensive consideration to the question of scope of claiming, or the scope of the invention". From our review above, we do not share that view. Further, in determining when the aspect now being considered occurred to the inventors, we find the first mention occurs in the letter of July 16, 1982, wherein Applicant says this aspect "...was not seriously considered until counsel was retained

subsequent to issuance of the patent...". This brings us to our concern that the petition for reissue does not meet the requirements of Section 50. In Northern Electric Co. Ltd. v Photo Sound Corp. et al (1936) SCR 651, the court comments:

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 has 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.

Further in the letter of July 16, 1982, in referring to interviews with the inventors, the Applicant says:

The inventors further considered that the essence of their invention was the use of at least three colours in a business form, where one of the three is substantially lighter than the other two, and where the two darker colours alternate with the lighter colour. This was the essential feature of the invention, not disclosed in the prior art, that facilitates lengthwise reading of multiple characters printed by a business machine.

Applicant now says there are unnecessary limitations in the issued patent which do not accord with the appreciation held by the corporate patentee. He also argues that such an error on the part of an attorney is ground for reissue.

With due respect we cannot sustain Applicant's arguments. We agree that an error on the part of an attorney may be ground for reissue in a proper case. Here we see no error caused by accident, inadvertence or mistake has occurred. In our view the prosecution of the original shows the agent fully considered the descriptive material and used his judgement in arguing on the basis of that description. We note that during the original prosecution the attorneys presented a strong argument, including detailed reasoning and explanation, to show why the sequence of four bars using only three colors presented a patentable invention in view of applied art. After reviewing the prosecution of the original application and the written and oral arguments presented in this application, we see from the evidence that only subsequent to issuance of the patent was there consideration given to the possibility of encompassing

more than three colors in a four bar sequence. We conclude that prior to issue, Applicant was satisfied with the wording in his claims and the scope of his disclosure. We believe the additional matter provides the base for broadening the scope of the claims, a base we believe was not envisaged by the inventors nor by Applicant prior to issue. We do not find any intent in the original application or its prosecution to claim in the manner now desired. Further, we agree with the Examiner that deletion of "unlike" from the term "different and unlike" broadens the coverage of the claims beyond what was originally intended.

We are satisfied from the evidence on the patent file that Applicant did not at any time prior to issuance of the patent intend to describe the additional matter presented for reissue. Keeping in mind the requirements of Section 50, we have determined parts 3(a) and 3(i) of the Petition for Reissue have not advanced acceptable reasons, nor have satisfactory arguments been advanced in support of these parts, to enable us to find the reissue application to be acceptable.

We recommend the application for reissue containing the scope of the subject matter presented for reissue by parts 3(a) and 3(i) of the petition for reissue, be refused for failing to establish clearly that the matter now sought was intended to be described and claimed in the original patent.

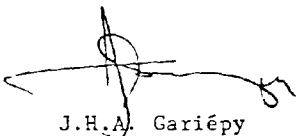


M.G. Brown  
Acting Chairman  
Patent Appeal Board



S.D. Kot  
Member

I concur with the findings and the reasoning of the Patent Appeal Board. Accordingly, I refuse to grant a reissue patent on this application containing the subject matter of parts 3(a) and 3(i) of the petition. The Applicant has six months within which to appeal my decision under Section 44 of the Patent Act.



J.H.A. Gariépy  
Commissioner of Patents

Dated at Hull, Quebec  
this 21 day of January 1986

Agent for Applicant

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