

COMMISSIONER'S DECISION

Reissue: The claims sought by reissue were found to be directed to an invention different from that patented, and to be related to claims cancelled from the original application in the interest of expediting its issue. Rejection affirmed.

This decision deals with Applicant's request for review by the Commissioner of Patents of the Final Action on application 342,635 (Class 93-93) for the reissue of Canadian Patent 980,612 granted on December 30, 1975. The application is assigned to Dennison Manufacturing Co. and is entitled FASTENER ATTACHMENT SYSTEMS. The inventor is A.R. Bone. The Examiner in charge issued a Final Action on February 4, 1983, refusing to allow the application. A Hearing was held on April 17, 1985, at which Applicant was represented by his Patent Agent Mr. J.K. Carton.

The application relates to apparatus for dispensing from a cartridge-like assembly, individual bar-lock fasteners for ticketing or attaching articles. Each fastener comprises a thin filament joining bar-like end parts. The device of the patent is shown by figures 5, 6 and 7 reproduced below:

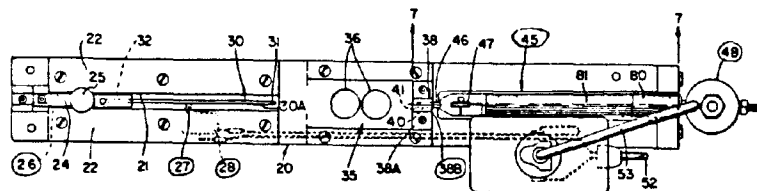


FIG. 5

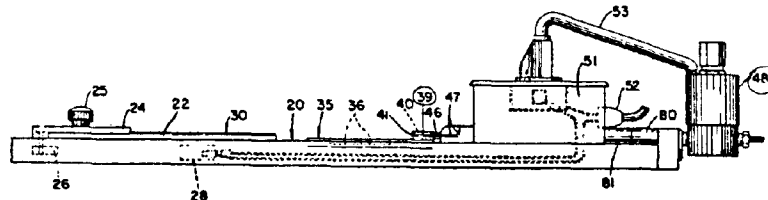


FIG. 6

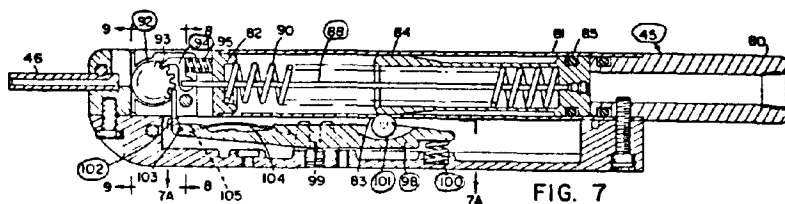


FIG. 7

The claimed apparatus for feeding and dispensing a bar-lock fastener comprises guide means 38B having a slot 39, a rod 88 driving an end of a bar of the fastener (not shown) through the guide means with the filament projecting through the slot, means 92 bringing the fastener into register with one end of the guide means, a triggerable motor means 45, to drive the rod against the bar end of the fastener, and means 26, 27, 28 and 48 triggering the motor.

In his Petition for Reissue, the petitioner deems the patent to be defective or inoperative by reason of claiming less than was his entitlement, and believes there is a failure to cover all aspects of the invention. He includes reasons, in part, as follows:

...

In particular the claims do not cover the inventor's feeding and dispensing apparatus in which a plunger (88) which is at least partially movable in a guide is provided in apparatus with a feed mechanism (92) for bringing each fastener of an assemblage of fastener attachments (60) into position to be pushed by the plunger (88) characterized in that a further mechanism (84) is included which is movable with the plunger to cause operation of the feed mechanism. In addition the claims do not cover that aspect of the invention by which fasteners can be ejected by a plunger (88) and a transport wheel (92) in a guide channel characterized in that a claw (102) is movable between stops and is coupled with a pusher (84) that is movable together with the plunger so that the claw, with each advance of the plunger is advanced by at least one division by the teeth of the wheel (92).

...

The petitioner attributes the failure to include claims to the several further inventive aspects of the dispensing apparatus to the U.S. attorneys who failed to comprehend and appreciate them. He relates the knowledge of the new facts occurred in July 1977 on reviewing the counterpart U.S. patent.

In the Final Action the Examiner refused claims 8, 9 and 10 of the application for reissue, for being directed to a different invention from that patented in the original patent, and noted claims 1 to 7 were identical to those patented. He compared claim 1 of the patent to claim 8 of the reissue application, in part, as follows:

...

Claim 1 calls inter alia for "triggerable motor means" and "means for triggering motor means" whereas claim 8 recited "motor mechanism (84) ... to cause operation of the feed mechanism (92)". The two are not the same and the disclosure is quite explicit in describing element (84) as a piston which is separate and distinct from triggerable means.

...

and made the following observations:

...

The limitations of triggerable means was included in the claim to overcome the art cited during the prosecution of the original patent. The new claim was submitted in the amendment dated November 5, 1974 where it was stated "To make the distinction (over cited art) clear the motor means in claim 1 has been qualified by reciting that it is triggerable i.e. not operated by manual motive power".

...

The broadest claim of the three added claims is claim 8 which claim is substantially identical with claim 20 as originally filed in the application #110,588 now patent #980,612. This claim was one of the claims that were cancelled during the prosecution of the original patent. As the claims were deliberately cancelled during the prosecution they may not be reasserted in the reissue.

...

The Examiner also refused claim 8 in view of United States patent 3,185,367 May 25, 1965 to Rieger, cited during prosecution of the patent, and claims 9 and 10 for indefiniteness.

In responding to the Final Action, the applicant considered claim 8 defines the same invention as claim 1, but in terms suitable for the aspect or embodiment he refers to as the "... interaction of the feed mechanism aspect and dispensing aspect...". He drew attention to a difference in the claim language appearing in claim 8 from that in claim 20 cancelled from the original application. He discussed his amendment to claim 8 from the standpoint of the operation of his device, and contrasted the Rieger action to what he calls the direct action by applicant's pawl 102 after the ejector pin is positioned for the advance of the fasteners. Applicant submitted that the Examiner has no authority to refuse any re-issue claim on the ground that it is a reassertion, and that reliance on American statutory interpretation is inappropriate. He argued the correct course of action is to read the provisions of Section 50 of the Patent Act in light of Canadian law.

It is appropriate therefore, to record Section 50(1):

Whenever any patent is deemed defective or inoperative 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, the Commissioner may, upon the surrender of such patent within four years from its date and the payment of a further prescribed fee, cause a new patent, in accordance with an amended description and specification made by such patentee, to be issued to him for the same invention for the then unexpired term for which the original patent was granted.

The issue before the Board is whether or not a reissue patent may be permitted under Section 50 of the Act with claims of the scope of amended claims 8, 9 and 10, and of additional claims 11 to 14 submitted during prosecution.

Amended claim 8 reads:

Apparatus for feeding and dispensing assemblies of fastener attachments (60) in which the individual attachments are secured by a neck (63) to an assembly rod (64), the apparatus comprising a plunger (88) at least partially movable in a guide provided in the apparatus and adapted to push the fastener attachments, a feed mechanism (92) for bringing each fastener of the assembly into position to be pushed by the plunger (88) characterized in that a motor mechanism (84) is included which is movable with the plunger (88) to cause direct operation of the feed mechanism (92).

We believe it is useful in considering reissue to refer to the decision in Northern Electric Company Ltd. v Photo Sound Corporation (1936) Ex. C.R. 75 at 89 (affirmed (1936) SCR. 649):

It is quite clear that the amended patent must be for the same invention and cannot embrace any new invention.

In the vast majority of cases in which a patent is defective or inoperative, its defects must be found to reside in the description given of the invention in the specification or drawings, or in both, and it was to cure such defects that relief was provided by statute. Hence, in most cases, the purpose of a re-issue is to amend an imperfect patent, defects of statement or drawings, and not subject matter, so that it may disclose and protect the patentable subject matter which it was the purpose of that patent to secure to its inventor. Therefore the re-issue patent must be confined to the invention which the patentee attempted to describe and claim in his original specification, but which owing to "inadvertence, error or mistake," he failed to do perfectly; he is not to be granted

a new patent but an amended patent. An intolerable situation would be created if anything else were permissible. It logically follows of course, that no patent is "defective or inoperative" within the meaning of the Act, by reason of its failure to describe and claim subject-matter outside the limits of that invention, as conceived or perceived by the inventor, at the time of his invention.

In determining whether amended claim 8, submitted by applicant in his response to the Final Action, is related to the subject matter of claims 1 to 7, we look first at claim 8 as filed. We see the examiner not only compared claim 8 to claim 1 in the reissue application, but also to a claim 20 cancelled during prosecution leading to applicant's patent 980,612. In his letter dated August 4, 1983, applicant argued his claim 8 is directed to an interaction aspect of the invention and therefore defined the same invention as claim 1, saying "While it is true that the subject matter of claim 8 is similar, in broad terms, to that of claim 20, it is also true the claim language, which defines the embodiment sought to be protected, is different."

We observe the wording of the first nine lines of claim 1 ending at "guide means" is similar to the first eight complete lines of claim 8. During prosecution leading to issuance of patent 980,612, applicant inserted the triggerable motor means now found after "guide means" in claim 1 to overcome the Rieger patent. According to applicant's disclosure, motor means 45 is triggered by an electromagnetic solenoid valve 48 which opens and closes to provide fluid to the chamber of motor 45. When cam 26 engages element 27, the switch 28 is closed and valve 48 is actuated.

We note no triggerable motor means appears in claim 8, and after the first eight lines the following elements are recited: motor mechanism 84, plunger 88 and feed mechanism 92. In the drawings these are shown as piston 84, rod 88, and indexing gear 92 respectively. The application describes the piston and rod as connected to move together, the piston acting on roller 101 and the rod acting on the end of a bar of a fastener. We find nowhere in the patent specification that the piston, the rod or the gear of claim 8, singly or in combination are described as being, or capable of being, either the triggerable motor means or the means for triggering. In our opinion

claim 8 presents an independent part or form of the apparatus disclosed in the application but not defined in patent claim 1, and is directed to a distinct, separate combination, that is not the same invention defined in claim 1.

The inclusion of "direct" in amended claim 8 does not impart any characteristic that we consider would bring to claim 8 an aspect equivalent to that of claim 1. In our opinion "direct" further emphasizes the distinct differences between claims 1 and 8. The piston 84 cannot cause direct operation of gear 92. As may be seen in figure 7, piston 84 has an inwardly sloping surface to act on roller 101 riding in a grooved surface at one end of a pivoted, spring actuated lever 98, 100, whose other end has a pawl 101. When piston 84 moves to the right the roller is pushed down as is the right end of the lever, and the pawl pushes up against a tooth of gear 92. The gear rotates and moves the cartridge of fasteners positioning a bar end in line with rod 88. Spring detent 94 prevents backward rotation of the gear. On leftward movement of the piston, the rod pushes the end of the bar to advance the fastener through the guide. Due to an opening in housing 81 and the shape of the piston the roller is caused to ride up and release the spring pressure to pivot the lever, causing the pawl to move down in readiness for the next advance. We are satisfied the phrase "...to cause operation of the feed mechanism (gear 92)..." in claim 8, by itself or modified by "direct" in amended claim 8, does nothing to make these claims equivalent to the invention in claim 1.

At the Hearing Mr. Carton argued the revocation of Rule 60 of the Patent Rules should bring a different meaning to the doctrine of equivalents and expressed his view that different embodiments may be defined within a patent. We do not see how the revocation of Rule 60 may be interpreted to bring a change to the requirements of Section 38 nor to Section 50 concerning

the situation before us, in view of the guidance provided by jurisprudence, viz Northern Electric v Photo Sound, supra. During his discussion concerning the effect the term 'direct' brought to the claimed matter in claim 8, the agent referred to it as defining a different embodiment of the same invention. He also noted that term is not an equivalent to the limitation that was introduced in the original application prior to its issue. He stressed 'direct' does not depart from the spirit of the invention, but overcomes the prior art, and is supported by the disclosure.

We consider 'direct' is not an equivalent to the limitation introduced by amendment to overcome the prior art cited during the prosecution of the patent. Further, we believe the connotation brought to claim 8 by deleting the triggerable motor means and the triggering means, and replacing them with different elements which provide a different function from that of patented claim 1, is of such magnitude that neither the original nor amended claim 8 is directed to the same invention as claim 1. One of the main requirements of Section 50 is that any reissued patent be directed to the same invention. We believe the situation before us has been covered by Northern Electric v Photo Sound, supra. To illustrate our reasoning, we refer again to page 89 of that decision, and in particular to a passage from Robinson on Patents, Vol. 2, page 318, noted by Maclean J. as presenting an effective discussion on what may or may not be embraced in a reissue, and it reads, as follows:

If the idea of means had possibilities of further development or application, which the inventor did not then perceive, these did not enter into his actual invention. If his idea, as already conceived and apprehended, was divisible into other ideas of means, only a part of which had been reduced to practice, the latter alone could have constituted his invention. If his idea presented different aspects, capable of embodiment in essentially distinct inventions, each of which would have formed matter for an independent patent, the one selected by him as the subject of the patent whose amendment

is in question is the sole invention which that patent could, if perfect, have secured. The limits of this invention thus exclude all new developments of the idea of means which have taken place since the original patent issued, all ideas which were not reduced to practice before the application for the original patent, and all distinct and independent parts or forms of the invention which were not embraced within the subject-matter of the patent already issued; and therefore no defect or insufficiency of statement concerning these can render the original patent inoperative or invalid, or furnish an occasion for its amendment. All that it can be made to cover, by any degree or species of correction is that completely conceived, perceived, and practically operative means for which the inventor then sought and the government then bestowed protection. Intervening inventions, whether wholly distinct or consisting in substantial variations in or improvements on the old, subsequently discovered attributes of the invention or any of its parts, independent arts or instruments though tracing their origin to the same fundamental idea, and new matters of any kind, are equally beyond the scope of the original patent and of any correction or enlargement of its terms by a re-issue.

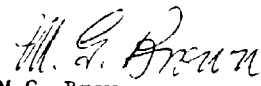
Turning to claims 9 and 10, we find the invention defined therein is related to that of amended claim 8. On reviewing claims 11 to 14 submitted after the Final Action, we find they are variations of the arrangements presented by claims 8, 9 and 10, and therefore are not directed to the same invention that is defined by the patent claims 1 to 7. Having determined claims 8 to 14 not to be for the same patented invention, we find the basic requirement of Section 50, namely that a reissue patent may only issue for the same invention, has not been established. On review of the written submissions and the viewpoints on various court cases expressed at the Hearing, we are satisfied no error arose from inadvertence, accident or mistake which meets the requirements of Section 50(1) in view of the Canadian jurisprudence we have discussed. It should be recalled from his letter dated June 13, 1975 during the prosecution leading to patent 980,612, applicant cancelled claims 8 to 13 in the interest of expediting that prosecution, noting he reserved the right to present those claims in a divisional application. Further, applicant also cancelled a claim 20 during that prosecution which contains subject matter similar to claims 8 to 14 in this application.

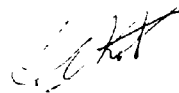


In view of Mr. Carton's argument that amended claim 8 is clearly patentable over the Rieger patent, we comment briefly on it vis-a-vis claim 8. In Rieger's device a plunger has a camming device which acts on a clutch arrangement to actuate the mechanism to feed a fastener. The action in Rieger and that set out in claim 8 are similar. We are not so sure the inclusion of "direct" would overcome the Rieger patent.

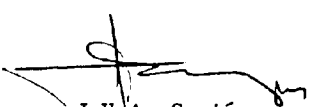
In summary, we find the subject matter of claims 8 to 14 is directed to the subject matter of claim 20 which was cancelled during the prosecution of the application leading to Canadian Patent 980,612, and is not directed to the same subject matter in claims 1 to 7 of that patent. Further it is our opinion that the acts of cancelling the sets of claims, namely 8 to 13, and the set including claim 20 discussed herein, represent a deliberate action on the part of the applicant in order to obtain a patent. We believe these acts should not be considered an error through inadvertence, accident or mistake. We see that applicant was aware of the course of action open to him prior to issue of patent 980,612 namely, the filing of one or more divisional applications directed to the non-elected subject matter before the issue of the original application.

We recommend the rejection of claims 8, 9 and 10, as filed and as amended, be affirmed for being directed to a different invention from that of patent 980,612, and that additional claims 11 to 14 submitted after the final action be refused for the same reason.

  
M.G. Brown  
Acting Chairman  
Patent Appeal Board

  
S.D. Kot  
Member

I concur with the findings and the recommendation of the Patent Appeal Board. Accordingly, I refuse to grant a reissue patent on this application. The Applicant has six months within which to appeal this decision under the provisions of Section 44 of the Patent Act.

  
J.H.A. Gariépy  
Commissioner of Patents