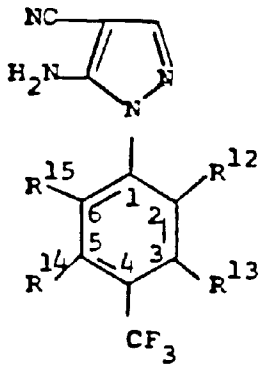
COMMISSIONER'S DECISION

Compound and Composition. Herbicidal Compound and Composition. A new compound, and a composition thereof mixed with acceptable carriers, useful for herbicidal purposes, represent different aspects of the same invention and may be allowable in the same application, absent prior art. Rejection withdrawn.

This decision deals with Applicant's request for review by the Commissioner of Patents of the Final Action on application 407,320 (Class 260 - 315.3) filed July 15, 1982. It is assigned to May & Baker Ltd. and is entitled N-PHENYLPYRAZOLE DERIVATIVES. The inventors are L.R. Hatton, E.W. Parnell, and D.A. Roberts.

The Examiner in charge issued a Final Action on June 7, 1985 refusing to allow claims 11 to 31 in the application with claims 1 to 10, and 32 to 55.

The application relates to a herbicidal composition including a carrier, and a compound of the formula:



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R^{12} to R^{15} represent, respectively, a chlorine atom, a hydrogen, fluorine or chlorine atom, a hydrogen or fluorine atom, and, a hydrogen, fluorine or chlorine atom. There is a proviso that when R^{14} is a fluorine atom, R^{15} is a fluorine or chlorine atom, or, R^{12}, R^{13}, and R^{15} each represents a fluorine atom and R^{14} is a hydrogen or fluorine atom. When R^{13} is a hydrogen atom, R^{14} is preferably a hydrogen atom. The compounds are used in formulations comprising a carrier that promotes applications to crops for weed control.

Claims 11 to 31, directed to herbicidal compositions, are rejected in view of Gilbert v Sandoz 64 C.P.R. (1971) - , 8 C.P.R. (2d) (1973) 210, and Agripat v The Commissioner of Patents 52 C.P.R. (2d) 229. The Examiner considers there is no "further inventive step" in mixing the compound defined in these claims with with an acceptable carrier. The Examiner contends the decision of Shell Canada Company v The Commissioner of Patents of November 2, 1982 gives direction, and in making his rejection, he says, in part, as follows:

> The Shell Oil application presented a class of plant growth regulant compounds which were both new and old. Claims were made to the new compounds per se and to compositions containing both the new and old compounds. Following a rejection of the composition claims based on the Sandoz decision, Shell Oil maintained claims to the compositions only. These claims were rejected by the Patent Office.
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> The findings of the Supreme Court is set out on page 16 as follows: "I find no obstacle in Section 36 or any other provision of the Act to the grant of a patent to the appellant on these compositions."
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> The next sentence reads:
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> "I make no observation, however, on whether or not the appellant can succeed in a subsequent application for patent on a subordinate element of its invention, namely, the compounds themselves. This is not before us, the appellant having abandoned such a claim at an early stage of the proceedings."
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> Clearly, this portion of the Shell Oil decision does not give guidance on the allowability of claims to both the compound and the composition in the same application.
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> In developing her argument in Shell, Wilson J. at page 13 on, re Hoechst and Agripat says as follows:
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> "They did establish, however, that no inventive ingenuity is involved in mixing a compound with a carrier. Accordingly, if the compound is patented, there is no invention in the composition. That proposition, in my view, makes eminent good sense whether the substance S. 41 or not and I think it affords an adequate basis for the result reached by the Federal Court of Appeal in Agripat".
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> "Agripat is, of course, distinguishable from the instant case in that no claim is being made for the compounds in this case".
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> Thus the Supreme Court clearly accepted the principle that, if the compound is patented, there is no invention in the composition and using this principle, looked with favour in the decision rendered by the Federal Court in Agripat.
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> Applicant has stated on page 3 that "The Shell Decision has established that compositions containing novel compounds are in fact patentable". This is not so. ... There were no claims to the novel compounds per se in the Shell case.

In Applicant's view, all claims are patentable in the same application, and he argues, in part as follows:

> The Shell Oil Decision contains the statement "Accordingly, if the compound is patented there is no invention in the composition". The rejection based on lack of invention in mere dilution of a new compound with a carrier might appear to be supported by this statement. However, the interpretation of this passage which the Examiner effectively now seeks to adopt does not do full justice to the Court's decision or to the Applicants' present case. Considering the above passage in the context of the full decision, the Court was apparently referring to the case where an Applicant seeking to obtain a patent on compositions containing an active compound in association with a carrier already had a patent on the active compound. The words quoted are, in effect, directed to a "double patenting" situation as the expression is commonly interpreted under United States practice (where an Applicant cannot in an application of later date claim an invention which is not patentably distinct from his own invention already patented on an earlier application). Without such a provision, an Applicant could file a series of applications on successive dates based on the same discovery of utility, to claim (a) novel compounds, (b) compositions containing them and (c) the method of using the compositions. Such a series of applications could have the effect of prolonging the term of patent protection based on a single discovery of utility. An unfair advantage might thereby be secured.
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> However, in the present application the three types of claims have the same date. There is no question of "double patenting". ... (Applicant) is simply seeking to safeguard his position on the basis of the fundamental difference between product claims and herbicidal composition claims. If, later in the life of the patent, one or more compounds within a product claim are found to be old but the disclosure of the compounds does not refer to herbicidal utility, the product claim could be invalidated whereas a herbicidal composition claim could stand. The simple statement, without any qualification, that there is no inventive ingenuity involved in mixing a compound with a carrier does not do justice to the distinction between compound and composition claims just mentioned.
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> ...
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> ... The Applicants' present claims 11 to 31 are in fact directed to an aspect of the invention claimed in claim 1. The disclosure of a utility for the novel compounds entitles the Applicants under Canadian practice to an unrestricted claim to the compounds per se. The fact that their invention, based on the discovery of herbicidal utility for the compounds, can be claimed in various ways which are closely associated with the discovery should not preclude the inclusion of claims to separate aspects of the same invention.
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> ...
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> ... It has, however, long been a feature of Canadian practice that an Applicant could claim various aspects of the same invention in a single application provided that the application satisfied the requirements for unity of invention. ... In Canadian, as in United States and British practice, claims of progressively diminishing scope have always been allowed in a single application. Such claims are generally directed to preferred embodiments of the single invention claimed and safeguard the Applicants' position in the event that the invention in its broadest aspect subsequently proves to be old. ... In Canada, prior to the Shell Decision, the Patent Office would accept in the same application claims to a compound and a claim to a method for its use. However, when a claim to a compound has been found allowable to the inventor in one

application, then claims in an unrelated application of the same inventor to methods of using that compound which are obvious from the utility disclosed for the compound, and upon which utility the patentability of the compound was predicated, are not allowed.

...

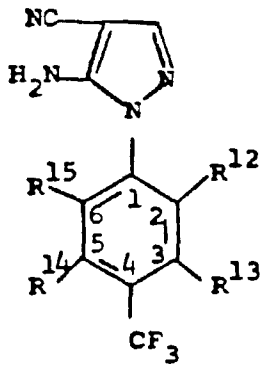
It is respectfully submitted that, following the Shell Oil Decision, which has established the patentability of claims to compositions containing novel compounds, claims to herbicidal compositions naturally fall to be considered in the same way as claims to methods of use.

...

... Both represent aspects of the same invention. Neither involve the application of inventive ingenuity resulting in a separate invention. Method of use claims have been previously allowed in the same application as compounds claims and it is respectfully submitted that, on the same basis, claims 11 to 31 are allowable in the present application.

The issue before the Board is whether or not claims 11 to 31, directed to herbicidal compositions, are allowable in the same application as claims 1 to 10, and 32 to 55 which are directed to the new compounds, and a method of use in a herbicidal composition. Claims 1 and 11 read:

1. N-Phenylpyrazole derivatives of the general formula:-



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wherein R^{12} represents a chlorine atom, R^{13} represents a hydrogen, fluorine or chlorine atom, R^{14} represents a hydrogen or fluorine atom and R^{15} represents a hydrogen, fluorine or chlorine atom, with the proviso that when R^{14} represents a fluorine atom, R^{15} represents a fluorine or chlorine atom, or R^{12}, R^{13} and R^{15} each represent a fluorine atom and R^{14} represents a hydrogen or fluorine atom.

11. A herbicidal composition which comprises, as active ingredient, at least one N-phenylpyrazole derivative of the general formula depicted in claim 1, wherein R^{12}, R^{13}, R^{14} and R^{15} are as defined in claim 1, in association with one or more compatible herbicidally-accepted diluents or carriers.

After considering the Farbwerke Hoechst line of cases, and Agripat, Mme. Justice Wilson noted in Shell Oil that the former fell within Section 41, whereas Agripat did not. She felt that cases like Farbwerke Hoechst did not stand for a broad principle that "compositions containing new compounds mixed with an inert carrier were not patentable" We learn from her remarks, that regardless of whether a substance is covered by Section 41 or not, when a compound is patented, there is no invention in another application in the composition containing that compound for the same use.

The Applicant desires to secure protection for his product claims and herbicidal compositions. He reasons that if one or more compounds within a product claim is later shown to be old, but there is no disclosure of herbicidal activity for the old compound, his product claim may be invalidated, but he would retain protection for his claim to the herbicidal composition if it were present in his patent. He does not interpret Shell Oil as establishing, either, an unqualified statement that there is no inventive ingenuity in mixing a compound with a carrier, or, an illustration that serves to prevent the claiming of the compound and the composition claims in one application under the circumstances he outlines above.

The Applicant points to Canadian practice which permits the claiming in one application of various aspects of the same invention, for example, claims of diminishing scope. He notes that his application presents three types of claims having the same filing date. He stresses the three types are aspects of the same invention based on his discovery of utility, and concludes they should be permissible in one application.

In dealing with Applicants' concern that an old, later found compound may invalidate his compound claim, we look to the following passage from Shell Oil in which Mme. Justice Wilson summed up the Appellant's arguments in that case:

> "I recognize that these compounds are old; I acknowledge that there is nothing inventive in mixing them with these adjuvants once their properties as plant growth regulators have been discovered; but I have discovered these properties in those old compounds and I want a patent on the practical embodiment of my invention".

She then concluded:

> I think he is entitled to receive it.

In assessing Applicants' invention we are mindful of the discovery he has made. This discovery relates to a means of controlling weeds in crops. One aspect of this is found in the composition presented in claims 11 to 31, another is the compound described in claims 1 to 5, another is the process defined in claims 7 to 10 for preparing the compound, and still another is the process set out in claims 32 to 55 of applying the composition defined in claim 11. We believe that mixing the new compound within the scope of Applicants' invention represents only one aspect of the invention. We see another aspect of the invention is set out in the process of applying the composition. In our view, Applicant has disclosed various aspects related to controlling weeds in crops. The non-rejected claims as they form part of the same application, may not be considered prior art, and therefore present no obstacle to the grant of a patent for claims 11 to 31. We are of the opinion the groups of claims in the application may be considered as aspects of the same invention that are permissible in the same application. It is noted that no prior art has been cited, and we make no comments on the allowability of the claims.

Also pertinent to a determination of whether or not Applicants' various groups of claims may be allowable together, is another portion of the decision in Shell Oil. Mme. Justice Wilson looked to Lawson v The Commissioner of Patents (1970) 62 C.P.R. 101 at 109, and considered with approval the reasoning set down by Mr. Justice Cattanach in the following passage:

> In the earlier development of patent law, it was considered that an invention must be a vendible substance and that unless a new mode of operation created a new substance the invention was not entitled to a patent, but if a new operation created a new substance the patentable invention was the substance and not the operation by which it was produced. This was the confusion of the idea of the end with that of means. However, it is now accepted that if the invention is the means and not the end, the inventor is entitled to a patent on the means.

In our opinion, claims 11 to 31 represent one aspect that forms part of Applicants' invention and is so closely intertwined with the other aspects for achieving Applicants' means for controlling weeds, that it may be included in the same application as the non-rejected claims. We see no meaningful distinction between the various aspects defined by the claims to the compound, the composition, or the method of use that would prevent their acceptance in the same application.

We recommend that the rejection of claims 11 to 31 for not being directed to the same inventive concept in claims 1 to 10, and claims 32 to 55, be withdrawn.

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 withdraw the rejection of the application and I remand it for prosecution consistent with the recommendation.

J.H.A. Gariépy
Commissioner of Patents

Dated at Hull, Quebec
this 9 day of October 1986.

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