

COMMISSIONER'S DECISION

Non-Statutory, S.2: The elevator system for directing cars according to calls received presents patentable subject matter. Rejection withdrawn.

This decision deals with Applicant's request for review by the Commissioner of Patents of the Final Action on application 347,700 (Class 364-17) filed March 14, 1980. It is assigned to Westinghouse Electric Corp. and is entitled ELEVATOR SYSTEM. The inventors are A.F. Mandel, L.M. Capuano, P.R. Otto and K.M. Eichler. The Examiner in charge issued a Final Action on July 20, 1982 refusing to allow the application.

The application relates to an elevator system shown in figure 1 reproduced below. System controller 72 processes and sends signals to a device 64 for a display of the number and location of up and down hall calls at the various stations. The RAM 80 stores the up and down calls and the ROM 78 includes a look up means for them. Controller 72 processes the signals received from these two units to update the display device as the calls are answered and received.

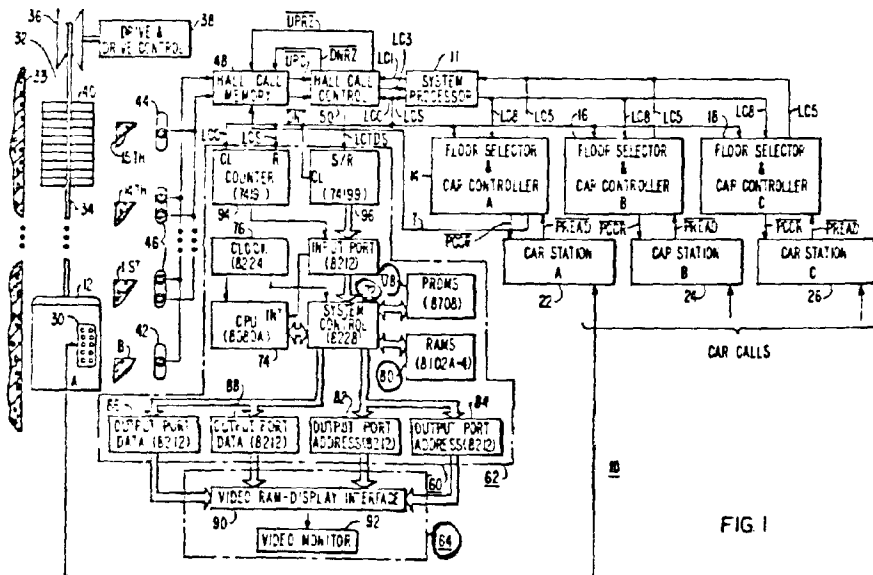


FIG 1

The Examiner rejected the application and claims for not being directed to patentable subject matter under Section 2 of the Act. He cited Canadian patent 1,108,781 September 8, 1981 to Mandel et al of interest to show that the hardware components of this application are the same as those described in the patent. In reasoning that the programs were different, he says, in part, as follows:

The only difference between the cited patent and this application is the program, a non-statutory subject matter which requires no time restriction. The "in re Fry" situation does not exist, because (1) the claims in this application differ from the claims in the cited patent; (2) in both cases, the applicant is the same and there is a common inventor; and (3) this application consists of the non-statutory subject matter under Section 2 of the Patent Act.

. . .

...The examiner is well aware of the opinion of the United States Supreme Court in Diamond vs. Diehr (209 USPQ 1, 1981). However the examiner is not in a position to apply United States patent law to allow this Canadian application but has to follow the present Canadian Office practice to refuse this application, as stated in the "Grounds for Rejection". Under the present Canadian Patent Office Practice, in order for a claim to be patentable, the subject matter in the claim must have the three constituents of utility, novelty and inventive ingenuity. To program a prior art microprocessor to operate the known elevator display hardware in a new mode, is expected skill of computer programmers and requires no inventive ingenuity.

. . .

...The difference in subject matter between the state of the art and this application lies in the computer program which is non-statutory under Section 2 of the Patent Act, and therefore this application is refused. In view of the state of the art or applicant's patent, the disclosure of this application is adequate and the Section 36(1) refusal is withdrawn.

. . .

In responding to the Final Action, the Applicant considers his elevator system operates in a manner not previously known, and argues, in part, as follows:

. . .

...The Examiner has drawn a reference to Mandel et al to the applicant's attention in previous correspondence and relies heavily on the Mandel et al reference as grounds for refusing the present application. (The Mandel et al reference is not applicable to the claims of this application in view of its late issue date).

The Examiner, therefore, is caught in a trap. Either the Mandel et al reference is pertinent and citable or it is not. If it is a valid reference, the applicant would appreciate a rejection of the claims in view of Mandel et al reference. If it is not, the reference should be withdrawn.

With respect to the Office Position in the interpretation of the Patent Office record of August 1, the applicants argument is well set out on pages 3 and 4 of the response of November 12, 1981. It is surprising that the Office is reluctant to add the Diamond vs. Diehr decision to its group of U.S. cases considered in reaching that decision. Even if the examiner is not in a position to apply the decision, certainly, it is believed that the Canadian Patent Office should (in view of its previous policy decision) consider the Diamond vs. Diehr decision to be very pertinent and incorporate it into its policy. For the above reasons, it is believed that the claims of this application are allowable and the Mandel et al reference should be withdrawn and the Diamond vs. Diehr decision which is of considerable importance must be considered in the refusal of this application.

. . .

Noteworthy from Applicant's response of November 12, 1981, are the following excerpts:

Claim 1, therefore, relates to an elevator system wherein an elevator car is mounted in the hoistway means in a multi storied building system having a call means, a memory means, a control means, means for removing calls from the memory means, a display means, and further, a display means including further visual means.

Thus, the Examiner has chosen to reject claim 1 in accordance with the stated position taken by the Patent Office in its publication on page XXVI of the August 1, 1978 C.P.O.R. Thus, it is seen that claim 1 must either fall in a category of being a claim to a computer program per se, or a claim to a new method of programming a computer, or a claim to a computer programmed in a novel manner expressed in any or all modes where the novelty lies solely in the program or the algorithm, in order to be rejected by the Examiner.

It is clearly seen from the previous examination of claim 1 that claim 1 is not directed to any one of the three categories. Thus, it is the applicant's contention that claim 1 is clearly patentable as are the remaining claims. In addition to the cases referred to in the August 1, 1978 issue of the C.P.O.R., the recent case of Diamond V. Diehr has yielded some interesting results.

The Supreme Court found "in determining the eligibility of respondents claimed process for patent protection under Section 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of old elements in the

analysis. This is particularly true in a process claim because a new combination of steps in a process may be patentable even if all the constituents of the combination were well known and in a common use before the combination was made.

The novelty of any element or steps in a process or even the process itself is of no relevance in determining whether the subject matter of the claim falls within the Section 101 categories of possible patentable subject matter.

The issue before the Board is whether or not the application and claims are directed to patentable subject matter in view of Section 2 of the Act.

Claim 1 reads:

An elevator system, comprising:  
a building having a plurality of floors and hoistway means,  
an elevator car mounted in the hoistway means of said building to serve the floors therein,  
call means for registering calls for elevator service,  
memory means for storing registered calls,  
control means directing said elevator car to serve registered calls for elevator service,  
means removing registered calls from said memory means when said elevator car serves a call for elevator service,  
and display means,  
said display means including signal preparation means which provides output signals responsive to the registered calls stored in said memory means,  
said display means further including visual means responsive to the output signals from said signal preparation means for visually displaying at least certain of the registered calls stored in said memory means one at a time, in a predetermined timed sequence, at a first common display location, such that each call in the predetermined sequence is displayed at the same location as the previous call in the sequence.

We remark that the Examiner has indicated there is no "in re Fry" situation. He is satisfied the Applicant's claims differ from the claims in the cited patent and that the Applicant's disclosure is adequate. We agree with his observations.

We turn to the Examiner's refusal on the ground that the application and claims are directed solely to a computer program. The Applicant has referred to the United States Supreme Court decision in Diamond v. Diehr (209 USPQ 1, 1981) and the comments therein that the combination presented by the application and the claims must be considered as a whole. We agree with the applicant that there are informative passages therein. We are mindful too, in dealing with the subject matter of this application, of the guidance to be found in the decision in Schlumberger Canada Ltd. v. The Commissioner of Patents (1981) 56 C.P.R. 204. Pratte J. provides direction for computer-related subject matter in the following excerpts therefrom:

In order to determine whether the application discloses a patentable invention, it is first necessary to determine what, according to the application, has been discovered.

and

I am of opinion that the fact a computer is or should be used to implement discovery does not change the nature of that discovery. What the appellant claims as an invention here is merely the discovery that by making certain calculations according to certain formulae, useful information could be extracted from certain measurements. This is not, in my view, an invention within the meaning of Section 2.

In considering what has been discovered, we learn that the application relates to the elements of an elevator system including means to store registered calls, means to direct elevator cars according to the calls received, a certain kind of signal display means for displaying up or down hall calls one at a time, and signal output means responsive to the registered calls, and these form the combination of Applicant's invention. His claims reflect this combination, which is not the subject matter of the cited Mandel et al specification, as recognized by the Examiner. While it may be that certain components in Applicant's elevator system are the same or similar to those in the Mandel et al patent, we find that a different operation is provided by Applicant's combination from that obtained in the cited patent. Applicant's discovery for his combination is that a different mode of elevator service may be obtained from what was previously known.

Even assuming that all the components of Applicant's system were well known and in common use before, the particular combination that achieves the new mode of operation must be considered, as must the results obtained. Here we see that the result provided by Applicant's particular group of components is not within the capabilities provided by the cited patent. We recall moreover, one of the components, the display device that Applicant uses is not considered by the Examiner to provide the same operation since he recognizes Applicant's claims are different. In our view, the signals provided for the display means and the operation obtained, are different from those available from the control system in the Mandel et al patent.

The Examiner contends the computer program, which we see as providing the different signals of operation, is non-statutory under Section 2. We believe Applicant's particular combination, including as it does some known components and a component providing operating signals different from the cited art, and the results the combination derives, to be in the domain of an improved elevator system. We think Applicant has disclosed more than merely a computer program.

In summary, we are persuaded, heeding the guidance provided by Schlumberger, supra, that the subject matter of the application is acceptable under Section 2. We recommend therefore the withdrawal of the refusal of the application and claims for being directed to non-patentable subject matter.

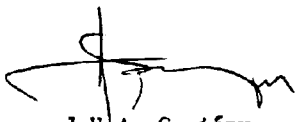


M.G. Brown  
Acting Chairman  
Patent Appeal Board



S.D. Kot  
Member

I concur with the findings and the recommendation of the Patent Appeal Board. Accordingly, I withdraw the refusal of the application and remand the application for prosecution consistent with the recommendation.



J.H.A. Gariépy  
Commissioner of Patents

dated at Hull, Quebec  
this 18th day of August 1986