

COMMISSIONER'S DECISION

REISSUE Agricultural Fungicidal Composition

Rejection based on intention and different invention. Claims 1 to 19 of the Patent represent one aspect of the invention, an agricultural fungicidal composition. Compounds claims 20 to 40 sought by reissue represent another aspect that is narrower than and included within the breath of the compound that forms the active ingredient in the composition claims. Final Action Reversed.

Patent Application 371,218 (Class 260-253) was filed on February 18, 1981 for an invention entitled Agricultural Fungicidal Compositions. The applicant is Sankyo Company Limited and UBE Industries Ltd. The Examiner in charge of the application took a Final Action on April 19, 1982 refusing to allow it to proceed to patent.

This is a reissue application of Canadian Patent 1,086,642. The reason for the reissue is to add compound claims 20 to 40.

A Hearing was originally requested and was subsequently cancelled by the applicant in a letter dated October 25, 1984.

The subject matter of this application relates to agricultural fungicidal compositions containing as an active ingredient one or more of 4-amino-quinizoline derivatives. These compositions show a controlling effect against blast, brown spot, sheath blight and bacterial leaf blight of rice plants, late and early blight of tomatoes; and anthracnose, downy mildew and powdery mildew of cucumbers. They also exhibit insecticidal and acaricidal properties.

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):

...The refusal of this application is maintained.

The basic reasons for the rejection are that:

- a) applicants do not meet the test of intention as set out by the tribunals
- b) The claims sought to be added constitute an invention different from that defined by the claims of the patent.

The policy governing the present situation is outlined in M.O.P.O.P., chapter 14.01 as follows: "A reissue must be confined to that invention which was completely conceived and formulated by the inventor before the application for the original patent was filed, and to that invention which the patentee attempted to describe and claim in his original application but which, owing to error arising from inadvertence, accident or mistake, he failed to do perfectly. Whenever a reissue contains claims that are broader than the claims in the original patent, they must be directed to what the patentee was attempting to protect in the original patent". Therefore, matter shown in the original specification but not recognized therein as inventive and not claimed cannot be subject-matter for reissue claims.

The judgement in Northern Electric v. Photo-Sound, Ex.C.R. - 1936 at page 89, supports the above position in these words: "The purpose of a reissue 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 was the purpose of that patent to secure to its inventor. Therefore the reissue 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. 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 other words "It is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification. It must appear from the document that what is covered by the reissue application was intended to have been covered and secured by the original".

In the present application the claims do not form a unitary subject-matter. The discovery of new use for known compounds is distinct from the synthesis of new chemical substances and such distinct matters are not allowable in the same application. The guidelines of the above cited jurisprudence and the ensuing policy spelled in chapter 14:01 of M.O.P.O.P. apply clearly to this application....

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

....It is submitted that here no reference is made to the application as filed. Reference is only made to the issued patent. Clearly therefore, the tribunals in order to limit the use of Section 50(1), to what the applicants had intended to claim at the time of filing the application, must set this out in clear and unequivocal broad terms and, it is submitted that the tribunals have not so done and, in fact, the decisions of our Courts would support a position that provided the invention being claimed in the reissue application was conceived by the inventor before the filing of the application and, provided that the claims are supported by the disclosure of the specification, the reissue is a valid one.

It is respectfully submitted that none of the jurisprudence referred to by the Examiner, or the parts of the Manual of Patent Office Practice (M.O.P.O.P.) referred to by the Examiner, provide any basis for rejecting Claims 20 to 40 of this application, directed to the compounds per se....

....The other point raised by the Examiner is that the claims sought to be added, constitute an invention different from that defined by the claims of the patent. In this direction the Examiner refers to the case of Fuso Electro v. C.G.E., 1940 S.C.R., at page 385, where the specification of the reissue application was the same as the original patent and, the assertions are made by Kerwin J. that the reissued must be confined to the invention that the inventor attempted to describe and claim in the original patent. Again, it is noted that reference is made to the original patent and not the original specification. Clearly, the inventor must have attempted to describe the invention in the specification and he must have attempted to claim it in the original patent and, this is precisely the situation in this application. The invention is fully described in the original specification and, before issuance of the patent the applicant intended to claim the invention now being claimed. It is respectfully submitted that the invention now being claimed is not a different invention from the invention claimed in the original application, it is the same invention claimed more broadly than the original application, in that the applicants are eliminating from the claims to the compositions comprising the novel compounds, the fungicidal carrier, as they are entitled to such broader claims....

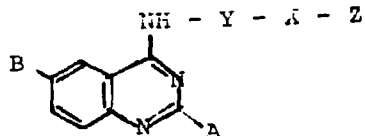
....The reissue application is not concerned with these old compounds, it is concerned with the novel compounds, and certainly, Section 50, sub-Section 3, allows for separate reissue applications to be filed for distinct and separate parts of an invention patented. Further, it is always open to the applicants to cancel the composition claims. However, the Examiner has not got into this area in his examination, he has from the start simply rejected the reissue application.

In summary therefore, it is respectfully submitted to the Commissioner that the invention now being claimed in the reissue application was made, conceived and perceived by the inventors and applicants before the filing of the original Canadian Application No. 304,843. That Canadian Patent No. 1,086,642 which issued upon the application, did not represent the applicant's intentions at the time of filing or, at the time of issuance of the patent with regard to the invention he wished to claim. That the critical time for the intention of the applicant is the time of issue of the patent, and not the time of filing the application. The applicant would have been entitled, during the prosecution of the application, to add Claims 20 to 40 of the reissue application to the original application and he failed to do so by inadvertence, accident or mistake, as is evidenced by the petition. Applicants also submit that the invention of the reissue application is the same as the invention perceived and conceived by the applicants before the filing of the original application, and applicants further point out that the specification of the original application fully supports the claims....

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 are as follow:-

THAT claims to the 4-amino quinazoline derivatives per se, having the formula:



wherein:

A and B each represents a hydrogen atom;
X represents an alkylene group;
Y represents an oxygen atom or a sulfur atom; and
Z represents an unsubstituted phenyl group or a phenyl group substituted with 1 to 3 substituents which are the same or different and selected from the group consisting of a lower alkyl group, a lower alkoxy group, a lower alkylthio group, a phenyl group, a trifluoromethyl group and a halogen atom or salts thereof as novel and inventive compounds are not asserted in the patent.

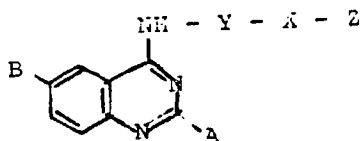
(4) THAT the error arose from inadvertance, accident or mistake, without any fraudulent or deceptive intention in the following manner:-

THAT at the time of filing Application No. 304,843 on June 6, 1978, from which Patent No. 1,086,642 issued, the applicants had been aware of the fact that certain of the compounds, namely, compounds numbers 1, 2, 91 and 92 as disclosed in the specification of Canadian Patent No. 1,086,642 were known compounds having been published in German Offenlegungsschrift No. 2,106,510 on August 26, 1971, and further, that at the date of filing the application the claims to the use of the compounds of the formula set out in Paragraph 3 as agricultural fungicides, namely, the claims to the agricultural fungicidal compositions and their use, were adequate for the protection of the invention on the basis of the applicant's biological evaluation of the compounds. However, on further biological evaluation of the compounds, after the filing of the Application 304,843, they realized that the claims to the agricultural fungicidal use of the compounds, as in the application as filed, was inadequate for the protection of the invention. It was their intention to file claims to the novel compounds set out in Paragraph 3, as these claims became important to the applicants and, claims to the compounds set out in Paragraph 3 were introduced into the corresponding South African application which was filed on the same date as the Canadian application. These claims to the compounds per se were filed on or about November 8, 1978 at the South African patent has issued such claims.

(5) THAT the knowledge of the new facts in the light of which the new claims have been framed, was obtained by Your Petitioner on or about September 25, 1979, in the following manner, namely, that subsequent to the discovery, by the applicant's Japanese attorneys, that the product claims were not present in the application which was shortly to issue to patent and, after consultation with the applicants, the Japanese attorneys instructed their Canadian agents of record, by telex, to insert the product claims in the Canadian application. However, on receipt of the instructions from their Japanese attorneys, the Canadian agents of record ascertained that the application was in issue and it was thus impossible to insert the claims to the compounds per se into the Canadian Application before issue, although it was the applicants intention to do so, on September 30, 1980.

There are forty claims in the application of which claims 1 to 19 are identical to those in the original patent. These claims are directed to composition and method of use. Claims added in the reissue application relate to the compound of which claim 20 reads as follows:

A compound having the formula



wherein: A and B each represents a hydrogen atom; X represents an alkylene group; Y represents an oxygen atom or a sulfur atom; and Z represents an unsubstituted phenyl group or a phenyl group substituted with 1 to 3 substituents which are the same or different and selected from the group consisting of a lower alkyl group, a lower alkoxy group, a lower alkylthio group, a phenyl group, a trifluoromethyl group and a halogen atom; or a salt thereof.

One of the basic reasons for rejection of the application set out in the Final Action is that the "applicants do not meet the test of intention as set out by the tribunals". In support of this position the examiner quoted from M.O.P.O.P. chapter 14.01 and the judgement in Northern Electric v. Photo-Sound Ex.C.R. 1936 @ 89.

We note that the disclosure of the reissue application is identical to the disclosure of patent 1,086,642. The compounds of claims 20 to 40 are disclosed as is the exemplification of preparation of specific compounds and detailing physical data. In response to the Final Action the applicant argues that "it is manifestly clear from the specification as filed, that the invention, as set forth in claims 20 to 40 was clearly conceived and perceived by the applicants before the filing of Application No. 304,843." We agree that the applicant conceived and disclosed the compounds in his original application.

Looking at M.O.P.O.P. 14:01 we find that a reissue must be confined to "that invention which was completely conceived and formulated by the inventor before the application for the original patent was filed." There is no question that the applicant does comply with this requirement. From Northern Electric we note that Justice McLean stated that "I think it is quite plain that the reissue patent is not confined to the invention which Arnold described in his original specification; there is introduced additional descriptive matter, new subject matter, many of the claims in the reissue are based on the new subject matter described in the specification of the reissue patent". Since the application before us does not have additional descriptive matter we do not find Northern Electric to be of assistance to the Examiner's position with respect to intention.

From part 5 of the petition we are informed that the Japanese agent instructed the Canadian agent of record to insert the product claims in the Canadian application. Because the application was in the process of issuing the Canadian agent decided that it was not possible to insert the claims to the compounds at that time. An affidavit by the Japanese attorney filed subsequent to the final action response states the following:

5) THAT from an understanding of Canadian practice in this office, it was decided that both sets of claims in a single Canadian application would have brought an objection from the Canadian Examiner of plurality of invention and, that during the prosecution of the Application No. 304,843 the applicants would have had to delete one set of claims from the application and file a divisional application thereto.

6) THAT in view of our understanding of Canadian practice, and in order to minimize the cost of obtaining protection for the applicant's invention in Canada, it was decided in this office that as the fungicidal use of the compounds was of primary commercial importance, to file claims only to the fungicidal use of the compounds, namely, to compositions containing the compounds of broad Formula I of Page 2 of Canadian Application No. 304,843 and a fungicidal carrier.

7) THAT while, on the grounds of economics, it was decided in this office, in the first instance, to file only claims to the fungicidal compositions, it was well recognized that the compounds per se were novel and that also the compounds had pesticidal activity and the specification was drafted accordingly, namely, the specification was drafted to emphasize the pesticidal activity of the compounds, giving exemplification of the experimental data with regard to pesticidal activity, on Pages 56 and 57 of Application No. 304,843, and further, to provide methods of preparing the compounds which were novel, and give specific exemplification of the compounds which were novel.

8) THAT if there had been no problems of unity of invention appreciated in this office, claims to the compounds per se and the pesticidal use of the compounds, would also have been included in the application.

9) THAT subsequently during the prosecution of the application in becoming aware of the fact that the pesticidal activity of the compounds was also of commercial importance and, it was realized that the claims filed with the application did not provide sufficient protection for the applicant's invention, as disclosed to us by the applicants before the filing of the application and, it was therefore decided to broaden the claims of the overseas applications by way of insertion of claims to the novel compounds per se, and this was done in the South African application on or about November 8, 1978. However, inadvertently, this was not effected in the Canadian application and instructions were not sent to applicants' Canadian agents of record until it was too late to insert them into the Canadian application, as the Canadian application was in issue, the final fee having been paid.

It is clear that the claims to the compound are fully supported by the original disclosure and that applicant's instructions were to enter them in Canada but appropriate action was not taken by the Canadian agent before the issue of the original application. Consequently we do not agree with the Examiner's rejection that "applicants do not meet the test of intention as set out by the tribunals".

We next consider the rejection made on added claims which are said to "constitute an invention different from that defined by the claims of the patent". Applicant maintains that the claims in the reissue application are directed to a single invention namely "the discovery of fungicidal and pesticidal properties in a class of compounds, a large number of which are novel".

Claims 1 to 19 represent one aspect of the invention namely, an agricultural fungicidal composition wherein the active ingredient is broadly set out and the method of combatting bacteria and fungi are recited. We see the compound of the invention now inserted by reissue claims 20 to 40 to be an aspect that is narrower than and included within the breadth of the compound that forms the active ingredient in the composition claims. Moreover, the restrictions in claims 20 to 40 clearly fall within the scope of the compound recited for example in claim 1. Further, Applicant's recognition that certain of the compounds he has disclosed have more than one use should not present a barrier to claiming them, providing they fall within the breadth of the compounds that form his invention and "arise out of the same factual discovery or inventive act", Hercules Inc. v. Diamond Shamrock Corporation 62 C.P.R. 43 @ 61. In Shell Oil v Commissioner of Patents Supreme Court of Canada Nov. 2, 1982 Mme. Justice Wilson considered Lawson v The Commissioner of Patents (1970) 62 C.P.R. 101 @ 109 and looked with approval to the reasoning by Mr. Justice Cattnach where he stated:

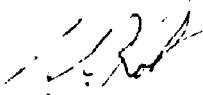
In the earlier development of patent law, it was considered that an invention must be a vendible substance and that unless a new mode of operation created a new substance the invention was not entitled to a patent, but if a new operation created a new substance the patentable invention was the substance 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 view compound claims 20 to 40 represent part of the means of achieving the end as expressed in composition claims 1 to 19. While each group recites varying aspects of the Applicant's inventive idea we are unable to find any distinction that would prevent their acceptance in the same application.

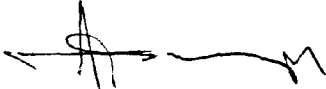
Therefore, we recommend that the Final Action refusing the application be withdrawn.



M.G. Brown
Acting Chairman
Patent Appeal Board


S.D. Kot
Member

I have reviewed the prosecution of this application and considered the recommendation of the Patent Appeal Board. I concur with the reasoning and findings of the Board. Accordingly I withdraw the Final Action and the application is returned to the Examiner.

A handwritten signature in black ink, appearing to be 'J.H.A. Gariépy', written over a horizontal line.

J.H.A. Gariépy
Commissioner of Patents

Dated at Hull, Québec
this 27th day of November 1986

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