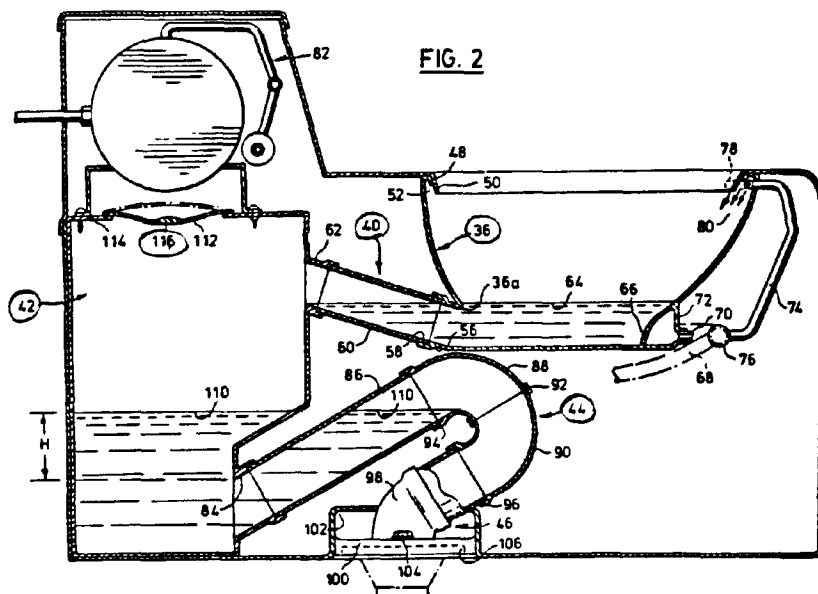


COMMISSIONER'S DECISION

Reissue: Intent of inventors was established. The disclosure was found to support the broader claim sought. Rejection withdrawn.

This decision deals with Applicant's request for review by the Commissioner of Patents of the Final Action on application 400,496 (Class 4-20) filed April 5, 1982, for reissue of Canadian Patent 1,072,255 granted on February 26, 1980. It is assigned to International Water Saver Toilet Inc. and is entitled WATER CONSERVING TOILET. The inventors are A. Hennessey and J.D. Inch. The Examiner in charge issued a Final Action on August 19, 1983 refusing to allow the application.

The application relates to a water conserving toilet shown in figure 2 reproduced below. A first water trap 40 extends upwardly from a first waste bowl 36 to a second waste holding compartment 42 having a volume exceeding the volume of liquid discharged from the first bowl. A second trap 44 leads from the compartment to a sewer inlet. A flexible diaphragm 116 is fitted to the compartment at a level above that at which liquid discharges from the bowl to accommodate air expansion in the compartment.



In part 3 of the Petition for Reissue, Applicant describes his patent protection as being unduly narrow. He sets forth the essential features of the invention as follows:

- a) a bowl for receiving waste;
- b) a waste outlet extending laterally from the bowl and defining a first, shallow trap arranged so that a relatively shallow body of liquid is normally retained in the bowl for preventing gaseous communication through the trap;
- c) a flush system arranged, when operated, to deliver a charge of flushing liquid into the bowl in a direction to cause the body of liquid and waste to be discharged through the outlet;
- d) an enlarged chamber communicating with the bowl outlet for receiving waste from the bowl;
- e) an outlet extending outwardly from the chamber and adapted for connection to a sewer inlet, the chamber outlet defining a second trap of substantial height capable of preventing reverse flow of sewer gas into the chamber in use; and,
- f) means communicating with the chamber and adapted to relieve increasing gas pressure caused by liquid entering the chamber from the bowl, whereby back pressure resistance to flushing of liquid from the bowl is reduced.

He says it was intended originally to obtain broader claims to these features.

He relates that in patent claim 1 the specific recitation of a flexible diaphragm is only one example of a pressure relieving means, and that the larger volume of the holding tank relative to the bowl is a non-essential feature.

The inexperience of the inventors is said in part 4 to have resulted in a failure to appreciate the restricted claims in the patent. The failure is attributed to a breakdown in inventor-patent agent communication. The results of four patent searches are set out, after which the patent application was drafted. It is said the inventors failed to appreciate the breadth of the patent claims.

Part 5 outlines the events leading to the filing of a reissue application, on behalf of the Petitioner, a corporation, in part, as follows

. . . other shareholders became involved and on August 12, 1981, a meeting took place between one of these shareholders, Mr. Roland Belanger, and Mr. David Langton of Rogers, Bereskin & Parr for the purpose of discussing the overall patent protection relating to the toilet in view of plans by the corporation to proceed towards the manufacture of the toilet on a commercial scale in Canada and marketing both in Canada and other countries. During the course of this meeting, the claims of the Canadian patent were reviewed and the scope of the claims was explained to Mr. Belanger in detail. At a subsequent meeting between Mr. Belanger and Mr. Langton on

October 29, 1981, Mr. Belanger instructed that a Petition for Reissue of the Canadian patent be prepared in view of the undue limitations present in claim 1 of the patent.

The Examiner refused the application for reissue on the ground that the evidence did not establish satisfactorily the intent of the inventor prior to issue of the petitioner's patent. He said in part, as follows:

. . .

In the latest response of July 18, 1983 no evidence at all is submitted which substantiates that the inventors intended to have the claims worded as presently proposed prior to the issue of the original patent. The response sets forth the inventor-patent agent relationship wherein the agent is given direction to obtain the best patent possible, in the words of the response, page 2, "to obtain the broadest protection for their invention to which they were entitled." It is fair to say that this sort of arrangement applies in every case where an inventor has his application handled by an agent. In this particular case, there is no evidence on record which alters these normal and usual circumstances.

It is indeed unfortunate that a more useful patent may not issue to Canadian inventors especially when the United States has issued a patent with broader claims but jurisprudence and practice in Canada does not to date permit us to provide a reissue patent in the present set of circumstances.

The petitioner is advised that parts (3), (4) and (5) of the petition for reissue (illustrated in Form 10 of the Patent Rules) may not be amended after the petition is filed, other than to correct simple typographical errors obvious from the document itself. Additional evidence supporting the facts presented in the petition may be submitted to be put on file, but not added to the petition itself. Section 50 of the Patent Act does not provide for amendments to the petition which significantly change the reasons for reissue. . . .

. . .

In presenting reasons for acceptance of the Petition, the Applicant argues, in part, as follows:

. . .

In any event, as far as it is understood, the Examiner's objection appears to be that the record fails to show that the inventors intended to have the claims worded as proposed in the reissue application. This requirement to show the intent of the inventors is clearly not present in Section 50(1) of the Patent Act and the Final Action contains no support for this position. The Examiner, Mr. Johnstone, and his section chief, Mr. Cillis, kindly granted applicant's agent an interview on February 15, 1984 at which time the present application was discussed and it was pointed out to applicant's agent that the requirement to show the inventor's intent is based on established office practice. It is understood that this practice derives from the decisions in Northern Electric Company Limited v. Photo Sound Corporation (1936) SCR 649 and Farbwerke Hoechst v. Commissioner of Patents 50 CPR 220. However, it is respectfully submitted that the facts in the present case may be contrasted from the facts in those two decided cases in that, in both of those cases, the applicant for the reissue patent was attempting to present claims of a different class than the claims appearing in the original patent. In the Northern Electric case, the reissue claims were directed to subject matter disclosed but not claimed in the original

patent. It should also be noted that the decision in that case was given under the previous statute which contained no provision for reissue in a case in which the patentee had claimed less than he had a right to claim as new; in other words, under that statute, it was not permissible to reissue in order to obtain broader claims. In the Hoechst case, the purpose of the reissue was to add specific claims to a compound and a process for its preparation in order to comply with an intervening decision by the Exchequer Court of Canada on the interpretation of Section 41(1) of the Patent Act. The Supreme Court found that judgment was exercised by the patentee and a decision reached to rely upon the original process claim in the patent and that there was therefore no mistake of the kind falling within Section 50 of the Patent Act. The Court considered that the patentee had deliberately elected to make a process claim in the widest possible terms and had no intention of restricting its invention solely to the production of a particular compound referred to in the claims sought to be added to the reissue.

The facts in the present case are not on all fours with the facts in the Hoechst case in that the patentee in the present case simply failed to appreciate the scope of protection which would be afforded by the claims originally issued in Patent No. 1,072,255.

. . .

In concluding, it may be of relevance for the Patent Appeal Board to be aware that the applicant company in this case, International Water Saver Toilet Inc. is in bankruptcy and that the assets of the corporation including Canadian Patent No. 1,072,255 and related patents in other countries have been transferred to Jenrob Development Limited of Belleville, Ontario. That company is controlled by Mr. Roland Belanger, formerly Vice-President Finance of International Water Saver Toilet Inc. Since his involvement with International Water Saver Toilet Inc., Mr. Belanger has made extensive efforts to promote commercialization of the invention and in fact significant interest in the invention has been shown by a number of manufacturing companies in Canada and by potential customers in other countries. However, development has been hindered by internal disputes between the shareholders of International Water Saver Toilet Inc. which resulted in the corporation being placed in bankruptcy. As a consequence of these proceedings, the inventors are no longer co-operative with the present owners of the invention.

. . .

The issue before the Board is whether or not the Petition for Reissue of the application and the evidence submitted present acceptable reasons for reissue under Section 50 of the Act. Claim 1 of the application reads:

1. A toilet which includes:

- a bowl for receiving waste;
- a waste outlet extending laterally from the bowl and defining a first, shallow trap arranged so that a relatively shallow body of liquid is normally retained in the bowl for preventing gaseous communication through the trap;
- a flush system arranged, when operated, to deliver a charge of flushing liquid into the bowl in a direction to cause said body of liquid and waste to be discharged through said outlet;
- an enlarged chamber communicating with said bowl outlet for receiving waste from said bowl;
- an outlet extending outwardly from said chamber and adapted for connection to a sewer inlet, said chamber outlet defining a second trap of substantial height capable of preventing reverse flow of sewer gas into said chamber in use; and,
- means communicating with said chamber and adapted to relieve increasing gas pressure caused by liquid entering the chamber from the bowl, whereby back pressure resistance to flushing of liquid from the bowl is reduced.

Subsequent to the Final Action, the petitioner submitted an affidavit executed by Arnold Hennessey, one of the inventors. It identifies the particular features, a to f, set out in part 3 of the petition. Mr. Hennessey says they are the essential features of the invention. He writes that he and Mr. Inch, the co-inventor, were inexperienced in patent matters and did not appreciate their patent protection would be restricted to the features found in patent claim 1. That claim, he points out, additionally contains (i) pressure relieving means in the form of a flexible diaphragm, and (ii) an enlarged second chamber and a second trap containing a substantially large volume of liquid compared to the volume discharged from the bowl.

In assessing the merits of this application, we look to a passage given by Maclean J. in Northern Electric Company Ltd. v. Photo Sound Corporation [1936] Ex. C.R. 75 at 89, as follows:

. . . 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.


Martland J. referred to the above passage in Curl-Master Mfg. Co. Ltd. v. Atlas Brush Ltd. [1967] S.C.R. 514 at 530, and also to the following reasons in United States jurisprudence, Wilson v. Coon, Vol. 19 U.S. Off. Patent Gaz. 482:

The new patent must be for the same invention. This does not mean that the claim in the reissue must be the same as the claim in the original. A patentee may, in the description and claim in his original patent, erroneously set forth as his idea of his invention something far short of his real invention, yet his real invention may be fully described and shown in the drawings and model. Such a case is a proper one for a reissue. A patent may be inoperative from a defective or insufficient description, because it fails to claim as much as was really invented, and yet the claim may be a valid claim, sustainable in law, and there may be a description valid and sufficient to support such claim. In one sense such patent is operative and is not inoperative, yet it is inoperative to extend or to claim the real invention, and the description may be defective or insufficient to support a claim to the real invention, although the drawings and model show the things in respect to which the defect or insufficiency of description exists, and show enough to warrant a new claim to the real invention.

We see from the affidavit evidence that the inventors intended to obtain more protection for their invention. We learn from the original application that the holding tank and the diaphragm are of such dimensions to prevent a syphoning effect when contents from the bowl are flushed to the holding tank. The tank is said to have a volume sufficiently in excess of the bowl so that the volume of liquid it receives from the bowl will cause the contents of the tank merely to overflow. The flexible diaphragm functions to accommodate upward displacement of the air in the tank when liquid is received from the bowl. These two elements are recited in claim 1 for reissue respectively as an enlarged chamber, and means communicating therewith to relieve increasing gas pressure above the liquid in the tank when matter arrives from the bowl thereby reducing resistance to flushing of wastes from the bowl. We accept the Petitioner's arguments that broader claims are supportable by the disclosure, and that it was the intent of the inventors to obtain claims commensurate in scope with their disclosure.

On review of the prosecution we note no prior art has been cited. Further, no references were applied during the prosecution of the original application, that application issuing without any Examiner's report being made prior to allowance. In short, we find no impediment to the issue of a new patent containing the claims of this application for the unexpired term of Canadian patent 1,072,255 in view of the Petition for Reissue and the evidence before us.

We recommend withdrawal of the refusal of the reissue application for lack of intent to claim the invention in broader terms than the patent.



M.G. Brown  
Acting Chairman  
Patent Appeal Board



S.D. Kot  
Member

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



J.H.A. Gariépy  
Commissioner of Patents

Dated at Hull, Quebec  
this 3rd day of December 1986.

Rogers, Bereskin & Parr  
P.O. Box 313  
Commerce Court Postal Station  
Toronto, Ontario  
M5L 1G1