

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent applications 446,291 and 502,373 having been rejected under Rule 47(2) of the Patent Regulations, the Applicant asked that the Final Actions of the Examiner be reviewed. The rejections have consequently been considered by the Patent Appeal Board and by the Commissioner of Patents. The findings of the Board and the ruling of the Commissioner are as follows:

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COMMISSIONER'S DECISION

Filing cancelled claims, from an application where agreement was reached to claim its allowance as a result of their cancellation, in another application under the guise of divisional claims is considered unacceptable, as is the filing of such cancelled claims in a reissue application under the pretense of inadvertence, accident, or mistake to justify reissue. Rejection affirmed.

This decision deals with the Applicant's request that the Commissioner of Patents review the Examiner's Final Actions, on application 446,291 for reissue of Patent 1,131,273, and on application 502,373 for reissue of Patent 1,171,117 which was filed as a divisional application of the original application resulting in Patent 1,131,273. The Petitioner in each application (identically entitled ROLL-UP TARP FOR TRAILERS) is Wahpeton Canvas Company Inc., the original Applicant. The inventors are Jerry R. Dimmer et al.

The Examiner in charge issued a Final Action on August 20, 1985, and May 4, 1988 respectively, refusing reissue of the patents. Although the applications will be considered together for purposes of the review, it is agreed by the Applicant that the decision taken will form part of the file of each application. A Hearing covering both of them was held on July 12, 1989, Mr. F. Farfan, the Patent Agent, representing the Applicant.

Subsequent thereto, Mr. Farfan submitted a supplemental submission on July 16, 1989.

The applications disclose a roll up tarp system for covering a semi-trailer as shown in figures 1, 4 and 5 reproduced below. The tarp is fixed at 28 and attached to tube 36 which rolls it to its position under downwardly and outwardly canted plate 50 to prevent movement by wind. The tube, through universal joint 44, is rolled by rod 46 and crank 48 which acts with bar 58 to secure the tarp under the plate.

(see figure I)

In refusing application 446,291, the Examiner said in part, as follows:

The number of claims in this application is 64.
The refusal of claims 14 to 64 is maintained. Claims 1 to 13 are allowable.

A reissue is an amendment which cannot be allowed unless the imperfections in the original patent arose from inadvertence, accident or mistake. Hence the reissue cannot be permitted to enlarge the claims of the original patent by removing restrictions once intentionally inserted. Acquiescence in the amendment of a claim, either to save the application or to escape a conflict, which narrows the scope of the invention as it was first described and claimed represents clear evidence of intent on the part of the applicant and thus cannot be reversed by reissue.

Applicant should note that as a result of the interview between the agent then representing the applicant and the examiner, applicant agreed to include the restriction latch plate 50 being canted outwardly and downwardly, in all claims. A record of this interview is noted in applicant's letter dated May 12, 1982 which forms part of the file of C.P. 1,131,273.

Claims 14 to 64 do not include the above noted and agreed to restriction, hence their refusal is maintained.

In response, the Applicant says its Patents 1,131,273 and 1,171,117 are defective due to insufficient description or in claiming less than it had a right to claim, and it requests one or more patents for the fullest protection to which it is entitled. The Applicant argues in part:

...

In short, the invention merely requires, among other things, a restraining means to restrain the upward movement of the bar as it is wound up. The rolled material is not wedged into place. It is held in tension against the restraining means by a crank. A particular type of latch plate is not critical to the invention.

... the Examiner has requested that the limitation be added to include a latch plate extending outwardly and downwardly. This feature is not part of the invention for the reasons given in paragraphs 3(c) to (e) of the Petition for Reissue. The presence of this limitation is one essential reason for the filing of this reissue application.

...

The amendment of May 12th, 1982 in the original application states that "[as] a result of the recommendations of the Examiner, a number of changes have been made in the claims". The submission then goes on to discuss a number of amendments, including the cancellation without prejudice of Claim 1 as then filed, which did not include the limitation now requested by the Examiner.

... The applicant's agent made inquiries in March, 1982. On April 20th, 1982, he filed a request for action. In May, 1982, he again made further inquiries. On about May 4th, 1982, the applicant's agent spoke on the telephone with (the) Director of Examination ...

On about May 6th, 1982, the applicant's agent received a telephone call from the Section Chief ... On about May 6th or 7th, 1982, the Examiner telephoned the applicant's agent, stating that he had some suggestions for changes to the claims ...

Furthermore, the official action of August 20th, 1985 states "... as a result of the interview between the agent then representing the applicant and the examiner, applicant agreed to include the restriction latch plate 50 being canted outwardly and downwardly, in all claims".

The limitation requested herein by the Examiner was included in the original application and patent by error arising from inadvertence, accident or mistake. After the interview of May 10th, 1982 between the Examiner and the applicant's agent, the agent reported promptly to the instructing United States agent by telephone. The United States agent instructed the Canadian agent to proceed with the amendment. The amendment was not discussed by the United States agent with the applicant or the inventors. He thus erred in failing to discuss the proper scope of the invention with them. He also erred in failing to comprehend the true nature of the invention. He also erred in failing to seek the broadest possible protection for the invention.

The Canadian agent proceeded with the amendment on the mistaken instructions of the United States agent. The Canadian agent thus inadvertently incorporated the error into the Canadian application, as described in paragraph 4 of the Petition for Reissue. Thus, the failure to include a

broad claim, unrestricted by such a limitation, was in error, made by inadvertence, accident or mistake.

On May 12th, 1982, the amendment was filed with the intention of filing a divisional application incorporating the cancelled claim. It was anticipated that any conflict problems would be resolved in such a divisional application. The claim was in fact included in divisional application no. 408,317 filed on July 28th, 1982. No conflict problems were ever raised during prosecution thereof.

...

The Examiner took his Final Action on application 502,373 in part, as follows:

...

Claims 1 to 13 of the present divisional application are identical to the claims in the parent application now patent 1,131,273 and the subject of reissue application bearing number 446,291. As stated previously, the applicant considered these claims to be a different invention from the single claim as prosecuted and issued in patent number 1,171,117. A reissue application must be for the same invention as stated in Section 14.01 of MOPOP the last sentence of the first paragraph. Therefore claims such as claims 1 to 13 cannot be considered as proper claims for reissue in this application.

In addition, the applicant is referred to Section 10.08.03 of MOPOP second last paragraph, which basically states that the applicant cannot justify claims appearing in the divisional application by inserting them in the parent application after the divisional application has been filed. Claims 1 to 64 as originally filed in this application were never in the parent application 364,734 (with the exception of claims 1 to 13) prior to the filing of divisional application 408,317. The last paragraph in Section 10.08.03 of MOPOP states that if a divisional claims subject matter at any time that had not been claimed in the parent, the applicant is advised that the application is not entitled to divisional status because it claims matter not claimed in the parent. Therefore, it is concluded that the present application contains subject matter not previously claimed in the present application and is not entitled to divisional status. All reference to divisional status must be deleted from the present application.

Claims 14 to 64 as filed originally are considered to be different inventions from the single claim as issued in patent 1,171,117 and reference is once again made to Section 14.01 of MOPOP last sentence of the first paragraph.

It is noted that claims 1 to 64 as filed in this application are identical to claims 1 to 64 of copending reissue application 446,291 which is the reissue application of the present divisional parent application.

Amended claims 14 to 54 of the present application are considered to be directed to a different invention from the invention as in the single claim as issued in patent 1,171,117 and cannot be considered as proper claims for reissue as per Section 14.01 of MOPOP, last sentence of paragraph one.

Claims 1 to 54 (with the exception of claims 1 to 13) of the present application claim subject matter that had not been previously claimed is the parent application (and are) not entitled to divisional status. All reference to divisional status must be deleted from the present application as stated in Section 10.08.03 of MOPOP last paragraph.

With the loss of divisional status this application reverts to an ordinary application filed February 20, 1986 and all citations become applicable, that is Canadian Patent 1,131,273 dated September 7, 1982 corresponding to United States Patent 4,302,043 dated November 24, 1981 and Canadian Patent 1,132,168 dated September 21, 1982.

In item 4 of the petition for reissue the applicant states that the patent agents failed to consult with the petitioner and therefore failed (page 4) to claim the invention. Effectively, the applicant states that there was insufficient "superinvention" by the patent attorney to provide claims as broad as they could be had. ...

Superinvention, thus depends on the skill and experience of the claim draftsman rather than on failure to communicate the original invention.

The Supreme Court of Canada ... in *Burton Parsons v. Hewlett Packard* (1976) 1 S.C.R. 555 at 568 rejected a contention that there was no error from inadvertence or mistake because the error was made by the agent rather than by the applicant, saying:

"As to the contention that there was no "error" because whatever inadvertence or mistake happened was that of the patent attorneys, not that of the inventor himself, I can see no reason for such a restrictive construction of the Act. On application for extension of time, relief from default and the like, no court would listen to the objection that the delay was that of the party's attorney, not of the party himself".

But conversely, where an agent deliberately takes action, the applicant cannot disavow what his agent has done for him. In *Bandag v. Vulcan Equipment* 32 CPR (2d) (a patent

case), at 3, the Federal Court accepted as correct the decision in *Scherin v. Palette* (1966) 57 D.L.R. (2d) 532 at 534, holding that:

"Where a principal gives as agent general authority to conduct any business on his behalf, he is bound as regards third persons by every act done by the agent which is incidental to the ordinary course of such business or falls within the scope of the agent's authority".

. . .

... in *Northern Electric v. Photosound*, 1936, S.C.R. 649 at 652:

"The statute does not contemplate a case in which an inventor has failed to claim protection in respect of something he has invented but failed to describe or specify adequately because he did not know or believe what he had done constituted invention in the sense of the patent law and, consequently had no intention of describing or specifying or claiming it in his original patent. The tenor of the section decisively negatives any intention to make relief in such a case".

Also at 653:

"At the lowest, the statute must contemplate some kind of reasonable ground for apprehension on the part of the original patentee that the patent is defective in the sense of the section. It would, in my opinion, be as abuse of this language to apply it to a case in which it is obvious that a patent completely fulfills the intention of the applicant, where there is plainly neither insufficiency of disclosure nor specification, for the purpose which the applicant had in view; where, in other words, the invention is respect of which the patentee intended to obtain protection is quite certainly and sufficiently described and specified. In such a case, the patent is not in any proper sense of the phrase defective".

Reference is made to an American decision on reissue, viz *In re Beyers* (1956) (109 USPQ 53 at 56):

... in *Dobson v. Lees*, 137 U.S. 258, the Supreme Court of the United States said:

A reissue is an amendment, and cannot be allowed unless the imperfections in the original patent arose without fraud, and from inadvertence, accident or mistake. Hence, the reissue cannot be permitted to enlarge the

claims of the original patent by including matter once intentionally omitted. Acquiescence in the rejection of a claim, its withdrawal by amendment, either to save the application or to escape as interference; the acceptance of a patent containing limitations imposed by the Patent Office, which narrow the scope of the invention as it first described and claimed, are instances of such omission.

Similarly in *Shepard v. Corrigan*, 116 U.S. 593, the Court said:

Where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claims by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent.

... The following statement from *Ex parte White* 1928 C.D. 6 states:

The deliberate withdrawal of a claim in order to secure a patent is conclusive of the presumption that there has been no inadvertence, accident or mistake, and the invention thus abandoned cannot be regained either by construing the claims of the patent broadly or by obtaining a reissue with broadened claims. The rule is the same whether the claims sought by reissue or otherwise are identical, substantially the same, or broader than the abandoned claims.

If one looks at claim 56 as originally filed in this application, it is quite apparent that the claim has been broadened, as well as amended claim 37, both of these claims appear to be rejectable in view of United States Patent 2,976,082 issued March 21, 1961 to Dahlman and which had originally been cited in the Office Action of May 22, 1981 in the prosecution of the original parent application bearing serial 364,734 and now issued as patent 1,131,273. One must then conclude that the applicant is reissuing to change the claims because the patent is being circumvented by others, and such contention is borne out by the litigation referred to on page 6 of the petition. Reference is made to Section 14.08(J) of MOPOP which given an unacceptable reason for reissue.

... reference is also made as covered by *Northern Electric v. Photo Sound*, supra and at page 89 of that decision and is particular to a passage from *Robinson on Patents*, Vol. 2, page 318...

... 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 ideas 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 sought and the government then bestowed protection. Intervening inventions, whether wholly distinct or consisting of substantial variations 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 reissue.

. . .

The Applicant responded to the Final Action on application 502,373 in part as follows:

The only intention of the applicant in prosecuting this application and the parent reissue application has been to obtain one patent of the scope to which it is entitled -- no more and no less. The applicant has simply been seeking to correct the various errors arising in the prosecution of both original applications.

During the course of prosecution of the parent reissue application, a 1981 decision of the Patent Office was brought to the attention of the undersigned (the decision, although believed to be unreported, was briefly noted in Newsletter #85 of the Patent and Trademark Institute of Canada dated September 30, 1981; a copy of the note has been filed). The case related to Canadian reissue patent 1,101,917. In that case, two Canadian patents -- a parent and a divisional patent -- were surrendered and reissued as

one patent. In view of the precedent setting nature of that decision, the applicant made this application and surrendered its divisional application.

The circumstances of this case are virtually identical to those of patent 1,101,917. The applicant has now surrendered both its parent and divisional patents and is seeking the same relief as granted with respect to patent 1,101,917. The facts upon which the applicant bases its request for reissue have been fully stated in the petitions filed. The applicant is prepared to amend either or both of its petitions in any way requested by the Patent Office in order to give effect to its intentions stated above.

The examiners involved in the prosecution to date of this reissue application and of the parent reissue application have consistently maintained that in their view the fact that certain actions were taken voluntarily by the applicant's agents now precludes the granting of a reissue patent. The applicant's position throughout has been that, notwithstanding any voluntary aspect of any such actions, such actions were still taken in error arising by accident, inadvertence or mistake, thus entitling the applicant to a reissue patent.

. . .

. . . The divisional patent is an issued patent. There is no basis for asserting that it should lose its status as a divisional. The application before the Examiner is a reissue application. It is not a new application filed February 20, 1986 and under no circumstances is there any authority for treating it as a new application.

The only decision which the Examiner is entitled to make is whether the criteria for reissue set forth in section 50 of the Patent Act have been satisfied in respect of the divisional patent. It is acknowledged that the reissue application is subject to examination on art. However, as referred to in paragraph 14.10.02 of MOPOP, such examination is limited to new art which ought to have been applied (or old art which was applied) against the original application. No such new art has been cited or relied upon by the Examiner.

In view of the above, it is respectfully submitted that Canadian patents 1,131,273 (corresponding to United States patent 4,302,043) and 1,132,168 are irrelevant to the prosecution of this application. ...

. . .

. . . the applicant denies that it is seeking to augment "insufficient superinvention". The fact is the invention

was fully described and exemplified in the original parent application. The deficiencies referred to is the petitions arose not in the disclosure of the invention, but in the claims to the invention as fully supported by the disclosure. The applicant's position is that claims 1 to 13 of the original parent patent and claim 1 of the original divisional patent do not correctly claim the invention, in that they are not of the scope to which the applicant (on the basis of the invention described) was entitled. It is the applicant's position that it was, and has always been, entitled to the broader claims it now seeks because they are fully justified and supported by the original disclosure. It was through the errors set forth in the petitions that such claims were not obtained in the original patents.

The Northern Electric case ... applies only to the situation where "a patent completely fulfills the intention of the applicant" or where "the invention in respect of which the patentee intended to obtain protection is quite certainly and sufficiently described and specified" (underlining added).

. . .

The applicant also states that Bandag, also cited by the Examiner, did not relate in any way to Section 50 and is thus irrelevant to the issues in this application ... the authority given by an applicant to a patent agent is to obtain claims to the invention of the scope to which the applicant is entitled. This is a fact of which the Patent Office is well aware and is the very basis on which all patent applications are prosecuted. Finally, the applicant points out that if the Examiner's position with respect to Bandag were to prevail, the result would be completely contrary to the clear law laid down by the Supreme Court of Canada ... in the Burton-Parsons case. ...

The Examiner also relies upon the United States cases In re Beyers, Dobson v. Lees, Shepard v. Corrigan and Ex parte White to support his contention ... If United States case law states otherwise, then it is respectfully submitted that such case law is not the law of Canada and has no application in Canada.

. . .

. . . it is also pointed out that Dobson, She and and White were all decided prior to and, obviously, without any consideration of the Curlmaster sad Burton Parsons cases.

. . .

. . . Dahlman teaches as apparatus using a complicated arrangement of springs to tension the tarpaulin. He

certainly does not suggest, let alone teach, the use of any restraining means to prevent the winding up of the tarpaulin to tension same. . . .

. . .

The applicant denies the contention that it is now seeking protection for a new invention developed after the original patents issued. The nature of what it is seeking is clearly set out in the petitions.

. . .

The issue before the Board is whether or not the applications for reissue of Patents 1,131,273 and 1,171,117 should be permitted to proceed. A comparison of claim 1 in each application may be seen below:

Application 446,291

Application 502,373

A cover assembly for an elongated body having an elongated opening, comprising:
a flexible covering material having a longitudinal dimension approximately equal to the longitudinal dimension of said opening and having a lateral dimension slightly greater (the same) than the lateral dimension of said opening, said covering material having one longitudinal edge adapted for attachment to one longitudinal edge of said opening;
a bar member attached to the other longitudinal edge of said covering material;
crank means attached to said bar member for rolling said bar member transversely of said body for rolling or unrolling said covering material; and

means (the same)

a plate adapted for engagement to an opposite longitudinal edge of said opening, said plate

(the same)

being canted outwardly and downwardly

having a surface extending away

from said opening for
holding said bar sad said
material in a wedged
condition when said material
is unrolled from said bar
over said plate and
reversely rolled onto said
bar against said surface.

(the see)

This decision uses the section numbering of the Patent Act is force on
December 12, 1988, whereas the Final Actions and the Applicant's
responses
use that in effect before that date.

At the hearing Mr. Farfan discussed five figures purporting to show what
he
describes as "rolling to tension", a page headed "Overview of the
Invention", and two pages entitled "List of Mistakes". He argues this
submission augments the information in the respective Petitions for
Reissue
in the applications and sets out the scope of claim coverage originally
intended. Mr. Farfan refers to Part 5 of the 502,373 Petition for a
description of the contribution of a United States attorney, James P.
Ryther, in arriving at an appreciation of the kind of action and
structure
in rolling a tarp beneath a support member to obtain a "rolling to
tension"
of the tarp, in contradistinction to the limitations in Patent 1,131,273
of
a plate canted outwardly and downwardly, and a wedging of the tarp. He
points out Mr. Ryther developed the "rolling to tension" aspect from May
20
through August 1, 1982, a time period before Patent 1,131,273 issued
September 7, 1982.

Mr. Farfan argues that "rolling to tension" is possible using either a
canted or a horizontal plate, as shown by figures 2 and 4 in his
presentation, as reproduced below:

In each figure he says the tarp is reverse wound across the top of the
plate and down until the winding causes it to touch the underside of the
plate, and then only further wound to create a tension in the tarp, but
not
to wedge it against the side of the container for example, thus achieving
the "rolling to tension". Mr. Farfan argues the limitations of a canted
plate outwardly and downwardly and the wedging of the tarp, in claim 1 of
Patent 1,131,273 as a result of the amendment made on May 12, 1982,
unduly
limit the scope of the invention. Mr. Farfan says the inventors should
not
be deprived of subject matter they intended to be covered, and relies on

Curl Master v. Atlas Brush (1966) Ex. C.R. 4; (1967) S.C.R. 514.

In the July 18, 1989 submission Mr. Farfan refers to the outwardly and downwardly canted flange of the Applicant's applications compared to the horizontal flange in the Michel patent 1,132,168. He notes the Michel roller would rotate a fraction of a turn until the tarp was about 90.degree. to

Michel's flange to tension the roller as Michel claims. In saying there is no material difference between Michel's claim 1 and claim 1 of Patent 1,131,273, Mr. Farfan contends the Office erred by failing to declare a conflict involving the Applicant's applications and Michel's then pending application.

The Board believes there is an added dimension in considering the issues in the applications for reissue before it, additional to the direction provided by Curl Master, supra, in which the description and the drawings of the application were carefully looked at. The added dimension arises from the circumstances relating to the desire by the Applicant when prosecuting the original application to obtain a patent in Canada. In this

regard the record shows there was an urgency by the Applicant in that a special order was made, followed by lengthy discussions between the Applicant's Canadian Agent and the Examining staff in reviewing the description and the drawings to reach an understanding of what subject matter could be claimed and patented, culminating in the amended claim 1 that issued in Patent 1,131,273. The Curl Master case does not have this added dimension.

The Applicant argues there was no conflict declared involving the application leading to Patent 1,171,117, in which the broad claim, cancelled from the application leading to Patent 1,131,273, was filed by the Applicant as being a divisional claim. At the Hearing, the Division Chief, who had participated in the discussions leading to that Patent, identified that on May 10, 1982 agreement was reached with the then Agent for an acceptable claim supportable by the description and the drawings of

the application, and of the acceptance on May 12, 1982 by the United States

representatives. The record shows amended claim 1 was filed with the letter dated May 18, 1982, no mention included of intent to file the cancelled claim as a divisional claim is another application. In any event

the Applicant filed a divisional application, containing as its sole claim

the cancelled claim 1, which Mr. Farfan notes was copending with the Michel

application from July 28, 1982 until September 22, 1982 when the Michel patent issued.

Regarding the arguments re cancellation without prejudice, the broad claim

was cancelled and replaced by an amended claim to obtain Patent 1,131,273.

Concerning those that there was no declaration of conflict involving the application issued to Patent 1,171,117, it is observed that the Applicant's

act of removing the broad claim would then permit the Office to allow both

this party's application and that of the other party. Indeed, the records show the Examiner allowed the Applicant's original application 364,734 and

the Michel application on the same date May 26, 1982. From the Board's understanding of the reasons set out in Section 14.08 of the Manual of Patent Office Practice, to file a broad cancelled claim later as the only claim is an application the Applicant identified as a divisional application, in view of its previous deliberate cancellation is a dubious way of invoking conflict proceedings.

A concern arises in determining whether the idea now presented by Mr. Farfan by figures 1 to 5 of his presentation was perceived by the inventor or by the pronouncement by Mr. Ryther subsequent to the involved discussion by the Patent Agents and the Examining staff in May 1982.

Another concern relates to whether the limits of the invention said to be covered by that pronouncement are ". . . subsequently discovered attributes

of the invention . . . beyond the scope of the original patent . . .", as found

in Robinson on Patents quoted by the Examiner from Northern Electric v. Photo Sound, supra. A further concern stems from the deliberate amendment,

in order to obtain patent 1,131,273, that was made in May 1982, bearing in

mind the comments on reissue referred to is the United States case in re Byers 109 USPQ 53 on page 56, column 1, originating from the United States

Supreme Court in Dobson v. Lees 137 U.S. 258, as follows:

A reissue is an amendment, and cannot be allowed unless the imperfections in the original patent arose without fraud, and from inadvertence, accident or mistake.*** Hence the reissue cannot be permitted to enlarge the claims of the original patent by including matter once intentionally omitted. Acquiescence in the rejection of a claim; its withdrawal by amendment, either to save the application or to escape an interference; the acceptance of a patent containing limitations imposed by the Patent Office, which narrow the scope of the invention as at first described and claimed; are instances of such omission.

Further discourse concerning reissue and deliberate action by an applicant

is found in re Byers column 2 page 56 in the passage from is re White 23 F. 2d 776 and Ex parte White 1928 C.D. 6:

(5) It is evident that since the deliberate cancellation of a claim in order to obtain a patent constitutes a bar to the

obtaining of the same claim by reissue, it necessarily also constitutes a bar to the obtaining of a claim which differs from that canceled only in being broader. That was the holding in *In re White*, 23 F. 2d 776, 57 App.D.C. 355, and in *In re Murray*, supra, this court quoted with approval the following statement from *Ex parte White*, 1928 C.D. 6: The deliberate withdrawal of a claim in order to secure a patent is conclusive of the presumption that there has been no inadvertence, accident, or mistake, and the invention thus abandoned cannot be regained either by construing the claims of the patent broadly or by obtaining a reissue with broadened claims. The rule is the same whether the claims sought by reissue or otherwise are identical, substantially the same, or broader than the abandoned claims.

Consideration by the Board of the direction provided by the above United States jurisprudence is believed acceptable in view of the Exchequer Court

case, *The Detroit Fuse and Manufacturing Co. v. Metropolitan Engineering Co. of Canada* Vol. XXI Ex. C.R. 277 at 280:

The general similarity of the patent law between the Canadian and the American Statutes, --as stated by Patterson, J. in *Hunter v. Carrick* (1), will be a justification to seek support upon that ground from the American authorities. In *re Allen v. Culp* (2) it was held that "when a patent is thus surrendered (for a re-issue) there can be no doubt that it continues to be a valid patent until it is re-issued, when it becomes inoperative." See also Walker on Patent, 3rd Ed. 214 et seq.

Moreover, the Board notes that the Supreme Court of Canada in *Farbwerke Hoechst Aktiengesellschaft Vormals Meister Lucius Bruning v The Commissioner of Patents* (1966) S.C.R. 604 at 613, compared the issue before

it with certain views expressed by the Supreme Court of the United States in *Mahn v Harwood* (1884) 112 U.S. 354 at 363.

The Board reads in Part 5 of each Petition for Reissue that new facts stated in the amended disclosure were obtained by the Petitioner June 9, 1982 and in light of them the new claims are framed. On May 20, 1982 the Petitioner obtained Mr. Ryther, counsel, in United States litigation between *Wahpeton Canvas Co. v. Frontier, Inc. and Koffler Mfg. Inc.* Civil No. A3-82-61. From May 20 through August 1, 1982 he obtained copies of the prior art references, met with the inventors, and obtained documents of the

invention and viewed its operation. On comparing the references with the invention disclosed, Mr. Ryther reached the conclusion the claims of the

United States Patent 4,302,043 corresponding to Patent 1,131,273, had been

too narrowly drafted. The Petition says it was apparent the improved cover

assembly could be employed with various latching mechanisms and did not

require a particular form of plate.

Consequently in or about April 1983, a review of the Canadian patent was made, with the finding it did not sufficiently describe and claim the features intended to be covered. The reissue application for Canadian patent 1,131,273 was filed January 27, 1984. Part 5 of the Petition for Reissue of patent 1,171,117 says the Petitioner desires to obtain at least one patent with claims of the proper scope and decided therefore to surrender Patent 1,171,117.

The Board sees from the record that Mr. Ryther's review of the Wahpeton's Canadian Patent 1,131,273 occurred as a result of litigation between Wahpeton's United States patent and the Michel patent in the United States. In his deposition on August 3, 1983, during that litigation, Mr. Michel says of his November 1980 working model that his pipe hooked under an angle iron with no more excessive rolling, whereas the Wahpeton pipe drops down and is rewound under a flange. The Board thinks these statements may be helpful in establishing a date of first to invent, but it does not, in the Board's view, establish what the inventors understood with respect to the kind of features now sought by reissue of either or both of the Canadian Wahpeton Patents. The Board recalls that claim 1 is reissue application 446,291 is identical to claim 1 in Patent 1,131,273, and particularly defines the crank means, the outwardly and downwardly canted plate, and reverse rolling feature and that it was acceptable after extensive review. The direction provided by the United States Supreme Court in the United States decision *Dobson v. Lees* is significant in assessing the terms inadvertence, accident, or mistake found in Section 47(1) of the Canadian Patent Act.

As the Exchequer Court commented in *Detroit Fuse v. Metropolitan Engineering* supra, there is general similarity in the reissue provisions in

Canada and the United States and there is justification therefore in regarding United States jurisprudence in the field of reissue.

The Board finds no jurisprudence persuasive for acceptance of the Applicant's arguments. According to *Robinson on Patents*, inter alia, if the idea of means had possibilities of further development or application which the inventor did not then perceive or was not reduced to practice before the application for the original patent or, if there are subsequently discovered attributes of the invention or any of its parts, then these are beyond the scope of the original patent and say not be accepted in a reissue application. From jurisprudence provided by the United States Supreme Court, reissue is not permitted in cases of intentional omission to escape as interference procedure involving conflicting applications.

The Board cannot overlook the fact that the claims in Patent 1,131,273

issued September 7, 1982 and were strenuously sought after as witnessed by the good faith discussion and endeavor on the part of the Patent Agent and the Examining staff that resulted in those claims. The Board is not persuaded it should find acceptable the revisions to the meaning of Patent specification 1,131,273 brought to it by Mr. Ryther subsequent to the review by the previous Agent and the Examining staff to obtain a patent. As stated in each Petition, Mr. Ryther was retained on May 20, 1982 as counsel by Wahpeton in litigation in the United States involving it and Frontier Inc. et al, and from May 20 through August 1, he obtained copies of the prior art. No date is given in the Petitions for his conclusion that the claims of the corresponding United States Patent 4,302,043 were too narrowly drafted. In the Applicant's letter dated February 20, 1986 on application 446,291 it is said a corresponding United States reissue application was filed September 9, 1982. According to the Petition, Wahpeton reviewed Canadian Patent 1,131,273 in or about April 1983. The Board sees no definite indication by the inventors at any stage that signals their intent, either before or after the issuance of Patent 1,131,273. The Board notes that in re Application 009,562, Patent 930,656

12 C.P.R. (2d) 163 referred to by the Applicant, there was an affidavit indicating what the inventors intended. The Board considers that case touches only one of the points under consideration here and not all the circumstances, and therefore does not assist the Applicant.

In application 446,291, claims 1 to 13 are identical to the thirteen claims in Patent 1,131,273 and are acceptable. Claims 14 to 64 are unacceptable in that they fail to specify the features agreed upon to obtain issuance of the above patent, namely, the crank means, the outwardly and downwardly canted plate, and the reverse rolling, and in that they are couched in the terms developed, during litigation of patent matter involving another party in the United States by Wahpeton's counsel, Mr. Ryther.

Regarding application 502,373 for reissue of Patent 1,171,117, the Board is satisfied it should not be accepted. In the Board's view, the presence of a broad claim alone in a second filed application that was taken from a first filed application, with no claim in the second application to say embodiment claimed in the first filed application, does not meet the requirements to accord divisional status to the second application. A broad claim in the second application, by the nature of its construction, is directed to and covers the embodiment in the first application, and if issued later in time acts to extend the life of the first issued patent. The Board notes that such a condition contravenes the term of a patent set under Section 46 of the Patent Act, and transgresses the intent of Section 36(1) of the Act to issue one patent for one invention. The sole claim in

Patent 1,171,117 is directed to the combination of elements found in, but in broader terms than, Patent 1,131,273. Claims 14 to 54 of application 502,373 are not acceptable in that they define subject matter that has not been claimed at any time in Patent 1,171,117 nor in the original application leading to Patent 1,131,273, and in that they are couched in the terms developed during United States patent litigation by Wahpeton's counsel. Further, claims 1 to 13 of application 502,373 may not be included therein as they are identical to claims 1 to 13 in application 446,291 and which issued only in Patent 1,131,273.

The Board notes with interest the reference to the Canadian Patent 1,101,917 as identified by the Applicant in Newsletter #85 published by the Patent and Trademark Institute of Canada.

In part 6 of that patent's Petition for Reissue it is stated: THAT the said Patent 1,000,185 is also deemed defective. Based on the facts given in paragraph 5 above, your Petitioner believes that Patent 1,000,185 is defective in two possible alternative ways. It is apparent that had the prosecution of Application 183,360 been given the attention it deserved, then Application 233,639 which later matured to Patent 1,000,185 would never have been filed, and would never have been granted.

Further, if the request made in this Petition for the reissue of your Petitioner's patent 985,619 is granted either in respect of paragraphs 3(a)(i) and (ii) above, or in full, then your Petitioner's rights to a separate monopoly in Letters Patent 1,000,185 for the only use to which the apparatus disclosed and claimed in the reissue of Letters Patent 985,619, is open to doubt. It is the belief of your Petitioner that double patenting may then exist since these two groups of claims both need not and should not exist in separate Letters Patent having different dates. Without any intent to deceive or defraud the public your Petitioner believes that it will have obtained protection for a single invention through these two patents for more than the 17 year period prescribed by Section 48 of the Patent Act. Your Petitioner believes that it is within your discretion to accept the surrender of two patents simultaneously, even though reissue of only one of them is being sought.

The Applicant notes the surrender of two Canadian patents was offered for the issuance of that patent. As expressed in that Petition there was a concern that the two groups of claims in those patents should not exist in separate patents as they would have obtained protection for a single invention for more than the 17 years prescribed by the Act.

Here, the set of circumstances present in the previous prosecution together

with the evidence submitted establish a situation different from that found in the prosecution of Patent 1,101,917. It may be there is a similarity in the concern that the Applicant's patents provide more than a 17 year period of protection for a single invention. However, after its above review, the Board is satisfied that no reissue of either of the Applicant's patents is permissible. The Board notes that in Section 47 of the Act the provisions for reissue of patents are designed to provide a new patent that contains an acceptable amended version of the original patent, but that reissue is not for the sole purpose of withdrawal of the original patent by surrender without replacing it with as acceptable amended version. Section 47 reads:

(1) Whenever any patent is deemed defective or inoperative by reason of insufficient description and 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, on the surrender of the 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 the patentee, to be issued to him for the same invention for the then unexpired term for which the original patent was granted.

(2) The surrender referred to in subsection (1) takes effect only on the issue of the new patent, and the new patent and the amended description and specification have the same effect in law, on the trial of any action thereafter commenced for any cause subsequently accruing, as if the amended description and specification had been originally filed in their corrected form before the issue of the original patent, but, in so far as the claims of the original and reissued patents are identical, the surrender does not affect any action pending at the time of reissue or abate any cause of action then existing, and the reissued patent to the extent that its claims are identical with the original patent constitutes a continuation thereof and has effect continuously from the date of the original patent.

(3) The Commissioner may entertain separate applications and cause patents to be issued for distinct and separate parts of the invention patented, on payment of the fee for a reissue for each of the reissued patents. R.S., c.P-4, s.50.

The Board thinks the Applicant's arguments concerning misjoinder of inventors are not helpful. As noted in M.O.P.O.P. 14.08(f) misjoinder of inventors is not a reason for reissue. In any event, the Board is persuaded by the factors relating to the deliberate action taken to obtain

a patent.

In summary, the Board recommends that applications 446,291 and 502,373, for reissue of Patents 1,131,273 and 1,171,117 respectively, be refused.

M.G. Brown
Acting Chairman
Patent Appeal Board

I concur with the findings and recommendation of the Patent Appeal Board. Accordingly, I refuse acceptance of the petitions for reissue of Patents 1,131,273 and 1,171,117 as presented in applications 446,291 and 502,373, respectively. The Applicant has six months within which to appeal my decision under the provisions of Section 42 of the Patent Act.

J.H.A. Gari,py
Commissioner of Patents

Dated this 21 day of December 1989.
Hull, Quebec.

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