

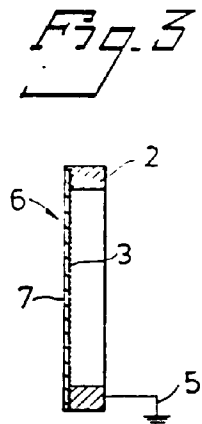
COMMISSIONER'S DECISION

Divisional Status, Supplementary Disclosure:

Claims not prosecuted to allowance in the original application but which, albeit in less distinct terms, set out the invention sought in the divisional application, were found to form a proper basis for the invention claimed in the divisional. The Supplementary Disclosure was recognized by the Applicant as different from that in the original application. Refusal withdrawn, application remanded for further prosecution.

This decision deals with Applicant's request for review by the Commissioner of Patents of the Examiner's Final Action on application 528,799 (Class 317 - 3). The application was filed February 2, 1987 by the inventor Mats Hedstrom, and is entitled PORTABLE RADIATION AND STATIC ELECTRICITY SUPPRESSION AND ANTIGLAKE SCREEN. The inventor is claiming divisional status based on original application 406,105 filed on June 28, 1982. The Examiner in charge issued a Final Action on September 2, 1987, refusing to allow divisional status to the application, and refusing to accord to a Supplementary Disclosure accompanying it, the date of a Supplementary Disclosure filed with the original application. A hearing was held on March 15, 1989 at which the Patent agent, Mr. M. Marcus, represented the Applicant.

The divisional application is directed to the method and apparatus for intercepting the movement of electrically charged particles in display screen environments by providing a grounded screen between the display screen and the user, as shown in the embodiment depicted in figure 3, reproduced below:



The portable screen 6 has an electrically conductive frame 2 grounded at 5, with an electrically non conductive net 3 stretched across the frame. A transparent conductive layer 7 is applied to the net and electrically connected to the frame.

In taking his Final Action, the Examiner said in part, as follows:

...firstly, the application in respect of the Supplementary Disclosure differs in substance from the Supplementary Disclosure in the alleged parent application, and the claims based thereon could never have been supported by the alleged parent case; secondly, claims 1-4 and 7-11 based on the principal disclosure (in so far as they may be patentable which is by no means conceded) are for an invention or an alleged invention which was never claimed in the alleged parent application.

Claims 5 and 6, finally rejected in the previous application, must be removed or the application will be held abandoned by failure to comply with Rule 35 of the Patent Rules.

In the matter of the supplementary disclosure then, the alleged parent application no. 406,105 (now patent 1,224,522) on page SD9 at lines 7, 9 and 14 instructs the reader as follows:

"The net is mounted within the electrically conductive frame..."  
and "The entire unit is now immersed in a solution..."  
and "This provides an electrically conductive layer all around the threads of the nylon mesh net as well as adding such (a)...layer to the ... frame."

By contrast this application, alleged to be a divisional of the above, says on page SD7 at lines 7, 10, and 12 that:-

"The net is immersed in a solution..."  
and "This provides a transparent electrically conductive layer all around the threads of the nylon mesh net"  
and "The net...is now mounted within the...frame".

Thus there has been a transposition of the two operations of "immersing" and "mounting within the frame" and one Supplementary Disclosure "differs in substance" from the other. The Applicant's emphasized allegation on page 7 of his amendment letter that the two are "identical, word for word" lacks any basis in fact, Claims SD12 and SD13 in this application illustrate a sharp contrast with claims SD11 and SD12 of Patent No. 1,224,522.

It is common ground that claims 1, 2, 3 and 4 have never appeared in the alleged parent case. Applicant's argument seems to be that they should be given divisional status because they are narrower than improper claims which were filed in the alleged parent in the amendment dated May 6, 1986. If this statement is incorrect Applicant is challenged to show where claim 1 for instance appeared in the alleged parent application.

The point surely is that those improper claims in the alleged parent application never represented an invention; the alleged parent application only claimed an invention after the lengthy Final Action dated August 27, 1986 and the amending response of February 2, 1987. In cancelling those claims, Applicant in effect conceded that those claims were unpatentable. Hence "Section 38(2) of the Patent Act upon which the Applicant relies" is irrelevant because this case is not one "where an application describes and claims more than one invention...". To the contrary, despite three actions and an interview which the Examiner had hoped would expedite allowance, the Applicant refused to claim even one invention in the alleged parent case until forced to do so by the Final Action.

The Examiner does not quite understand how the Commissioner's decision in ~~the~~ Application No. 120,389 (Patent No. 962,101) 12 C.P.R. (2d) 171 is relevant to the instant application. However, the Examiner would point out that in the Manual of Patent Office Procedure the paragraph 10.08.03 is entitled "Invention must have been claimed in parent" and observes that "... an omnibus claim in the parent is not sufficient to justify divisional status under Section 38". Claims which the Applicant has tacitly agreed are similarly unpatentable cannot be used to justify divisional status.

Claims 5 and 6 must be removed from this application. These claims were rejected as claims 3 and 4 filed in the alleged parent on May 6, 1986 and cancelled in response to the Final Action dated August 27, 1986. Any appeal should have been taken at that time. This information is in the public domain in Patent No. 1,214,522.

The Applicant asks for case law citation; he is informed that similar efforts to circumvent Final Actions have occurred, but as no such Commissioner's Decisions have been appealed, details are not available under Section 10 of the Patent Act. Possibly the courts reject such appeals by analogy with the doctrine of res judicata.

Close inspection shows claims 7-11 fall into the category of not previously claimed because there has been a change in substance. Applicant's representation that they are merely using "acceptable terminology from the claims of the parent" (see the paragraph bridging pages 4 and 5 of the amendment letter) is misleading.

Unless the Applicant amends to:-

- 1) Remove the reference to a divisional application in the petition;
- 2) Remove the reference to a divisional application on page 1 of the disclosure; and
- 3) Remove claims 5 and 6

this action terminates the prosecution of the application, before examination on the merits of the case, because the documents in the case are not prepared as prescribed, under authority of Rule 35 of the Patent Rules.

In his response the Applicant argued for divisional status in part, as follows:

It is applicant's submission, to be discussed in greater detail hereinafter, that the claims in the present divisional application are within the ambit of the "invention or inventions defined in claims" which appeared in the parent application.

To be granted divisional status, it is only necessary that the subject-matter of the divisional application previously be "described and claimed".

There is no requirement, as applied by the Examiner, that a divisional application can only be directed to claims which have already been allowed by the Examiner. The only requirement is that the claims be directed to what the applicant considers as being his invention. If those claims, upon later examination, are found not to be patentable, then, at that time they can be rejected. There is no requirement under divisional practice pursuant to Section 38 to make a determination of patentability before divisional status may be granted.

The matter of entitlement to divisional status is governed by Section 38 of the Patent Act, and the judicial interpretations thereof, and not by reference to the Manual of Patent Office Procedure.

Section 38(2) of the Patent Act, upon which applicant relies as providing such divisional status, reads as follows:

"(2) Where an application describes and claims more than one invention the applicant may, and on the direction of the Commissioner to that effect shall, limit his claims to one invention only, and the invention or inventions defined in the other claims may be made the subject of one or more divisional applications, if such divisional applications are filed before the issue of a patent on the original application; but if the original application becomes abandoned or forfeited, the time for filing divisional applications terminates with the expiration of the time for reinstating or restoring and reviving the original application under this Act or the rules made thereunder."

Firstly there is no requirement in Section 38(2) which holds that the divisional application may not contain "claims which have never appeared in the parent application". The statute clearly and unequivocally states that an applicant may make

"the invention or inventions defined in the other claims... the subject of one or more divisional applications".

It is submitted that the claims presented herein do represent an invention that was defined in the parent application, and that was both described and claimed in

the parent application. The claims in this divisional application are directed to the embodiment described in Figure 3 as follows:

"The screen 6 includes, as with the screen 1, an electrically-conductive frame 2 with a nylon net 3 stretched across it, but the wires 4 of the screen 1 have been replaced by a transparent, electrically-conductive layer 7, applied to the net 3, and electrically-connected to the frame 2".

The claims in this divisional application are directed to subject-matter previously claimed in the parent case, i.e., in former parent claim 3: "a transparent electrically-conductive layer which is applied to the rear face of said fine mesh net,"; and in former parent claim 7: "an electrically-conductive transparent layer physically connected to the rear face of said mesh means and electrically connected to said electrically-conductive frame means"

All the other matters raised by the Examiner are non sequitur to the principal issue, namely granting this application divisional status according to the clear wording of Section 3b of the Act. Moreover all other matters raised by the Examiner can effectively be dealt with in ex parte prosecution before the Patent Office, after the divisional status has been granted.

The issue before the Board is whether or not the subject-matter of the claims of this application was claimed in the Applicant's original application in terms which would merit the accord of divisional status to this application, and whether or not the accompanying Supplementary Disclosure merits the date of the Supplementary Disclosure filed with the original application. Claim 5 of this application, as amended July 7, 1987, reads:

A portable, radiation and static electricity suppression and anti-glare screen intended to be placed in front of a display screen, said screen comprising: an electrically-conductive frame intended for grounding; a fine mesh net of an electrically-non-conductive plastics material stretched over, and mounted in, said frame, said fine mesh net being unsupported by a rigid backing, and being exposed to the surrounding environment at least at its front face; means physically connecting said screen to electrically-conductive means, said electrically-conductive means comprising a transparent, electrically-conductive layer which is applied at least to the rear face of said fine mesh net; means electrically connecting said electrically-conductive frame; and means for grounding said electrically-conductive frame;

The Board uses the section numbering of the Patent Act in force on December 12, 1988 whereas the Final Action and the Applicant's response use that in effect before that date.

The Applicant argues in his submission and at the Hearing that the requirement in Section 36(2) of the Patent Act for obtaining a divisional status for an application is that the original application must have described and claimed more than one invention. Further attention is drawn to the provisions of Section 36(2) setting out that an invention described and claimed in an original application may be made the subject of a divisional application. The Applicant stresses that the claims of a divisional application need not already have been found allowable by the Examiner before they may be admissible in a proper divisional application. The Board agrees with these viewpoints, and turns to an assessment of what is set forth in the claims of the original application 406,105, now Patent 1,224,522.

In original claims 1 and 2 of the original application, a fine mesh net stretched over an electrically conductive earthen frame was claimed, the net being in contact with either electrically conductive wires or a transparent conductive layer and the frame.

In the action of February 6, 1986 taken on the original application, several groups of claims, one being group A, were listed as showing a plurality of inventions, and a requirement made for limitation to one invention. Of the claims in that group A, claim 2 was directed to electrically conductive wires stretched over or woven into the fine mesh net, and claim 3 defined a transparent electrically-conductive layer applied to the mesh net.

Arising as a result of the Final Action on the original application, the Applicant submitted an amended claim 1 and it defined a combination having electrically conducting wires spaced across the fine mesh net. The Board notes that in the claims which were cancelled from the original, cancelled claim 6 was directed to the aspect of the wires, whereas cancelled claim 7 defined the transparent conductive layer. The Board recognizes in cancelled claims 6 and 7 the same subject matter, albeit in modified terms, as that matter set out in original claims 1 and 2 of the original application.

The Board sees no reason why the subject-matter, such as in cancelled claim 7 discussed above with respect to the original application may not be claimed in a separate application, nor why divisional status may not be accorded to this application for subject-matter appearing in a claim such as claim 7 above. Neither does the Board see any reason why a claim in a divisional application, such as claim 7 above, could not be open to examination by the Examiner, using cited art, whether it be that used in the original application, or newly found references. However if such a claim for example, were satisfactorily amended in the divisional application to overcome the cited art, the force of the objection would be removed and the amended claim would be allowable therein.

In the Board's opinion, the amended claim 1 in this application is directed to a combination that claims the aspect of the transparent layer connected to the mesh as set out in cancelled claim 7 above.

The Board does not share the Examiner's view that principal claims 5 and 6 of this application as amended July 7 1957, must be removed or the application will be held to be abandoned under Rule 35 of the Patent Rules. The Board notes these amended claims 5 and 6, containing the limitation that the electrically conductive means comprises an electrically conductive layer, are different from those rejected in the original application. As such, these amended claims are to a different combination from that allowed in the original application.

During the Hearing it was noted that in the prosecution of application 406,105, the Applicant was required to limit that application to one invention from among several groups of claims identified by the Examiner. The discussion centered on whether or not the Applicant would be entitled to prosecute the other groups in separate divisional applications even though the other groups did not contain allowable claims for example, in view of cited art or because they lacked support by the disclosure. The Board believes the Applicant would be so entitled, in view of Section 36(2) of the Patent Act that requires the invention be described and claimed in the original. That Section however, makes no statement that the claims

must be found patentable or in allowable condition in the original application before they may be accepted by the Office for prosecution in a divisional application.

The Board thinks the particulars of the issue before it are similar to the above circumstances. In the prosecution of application 406,105 the Applicant submitted amended claims directed inter alia to the aspect of the electrically conductive wires and the mesh net, and in cancelling the other claims under rejection noted they were to the embodiment of figure 3 and were "being made the subject of a divisional application of even date herewith", the filing date of this application, February 2, 1987. The amended claims issued in patent 1,224,522. The cancelled claims were submitted in this application, and divisional status requested on the basis of application 406,105. Of those claims, claims 5 and 6 were refused by Office letter dated April 14, 1987, and these were amended on July 7, 1987. Amended claims 5 and 6 are still directed to the aspect of the electrically conductive layer and the mesh net, an aspect that has been maintained throughout the prosecution of application 406,105.

In view of Section 36(2) of the Act, the Board is satisfied that amended claim 5 and 6 are proper divisional claims. The Board considers they are directed not only to an aspect that was claimed consistently throughout the prosecution of the original application, but also they need not have been prosecuted to allowance in order to qualify as being directed to a divisional aspect of the original application. The Board considers the rejection based on Rule 35 of the Patent Rules is not well founded.

Concerning the other principal claims, namely 1 to 4 and 7 to 11, the Board finds they are directed to the conductive layer and net aspect.

In summary, the Board sees no violation of Section 36(2) of the Patent Act in the request for divisional status for this application.

In finding all the principal claims in this application directed to proper



subject matter in a divisional application, the Board believes such acceptance does not of itself, cause them to be allowable over pertinent art. It is noted however, no references have been cited in the Final Action. At the Hearing, Mr. Marcus indicated that the Applicant was willing to amend further the claims in this application to present them in acceptable form, if such action were needed.

The Board turns to a consideration of the Supplementary Disclosure with this application. This Supplementary Disclosure describes an embodiment of the conductive layer on the mesh net, in which the mesh net is immersed in a solution to obtain an electroconductive layer around the threads. The so formed mesh and layer about the threads is then mounted within the frame. This embodiment is set forth in claims SD 12 and SD 13 of this Supplementary Disclosure.

The Board agrees with the Examiner's view that this instant Supplementary Disclosure differs in substance from that in the original application. There, the embodiment relates to a frame having a mesh net mounted therein after which the frame and net are immersed in a solution whereby both frame and net are coated. The subject matter in this Supplementary disclosure is different from that appearing in the Supplementary Disclosure of the original application. In this regard Mr. Marcus completely agrees, reserving the right for the Applicant to cancel it and submit another. The Board finds the earliest date that may be accorded to the Supplementary Disclosure of this application is the date it first appeared in this application namely February 2, 1987.

The Board recommends that divisional status be accorded to this application based on the original application 406,105 filed June 28, 1982, and that the Supplementary Disclosure accompanying this application be accorded the date of February 2, 1987.



M.G. Brown  
Acting Chairman  
Patent Appeal Board

I concur with the findings and the recommendation of the Patent Appeal Board. Accordingly, I accord divisional status to this application, and I accord to the Supplementary Disclosure the date of February 2, 1987. I remand the application to the Examiner for prosecution consistent with the recommendation.



J.H.A. Gariépy  
Commissioner of Patents

Dated at Hull, Quebec  
this 21 day of April 1989

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