

IN THE CANADIAN PATENT OFFICE  
DECISION OF THE COMMISSIONER OF PATENTS

Patent application 615,585 having been rejected under Rule 47(2) of the Patent Regulations, the Applicant asked that the Final Action of the Examiner be reviewed. The rejection has 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:

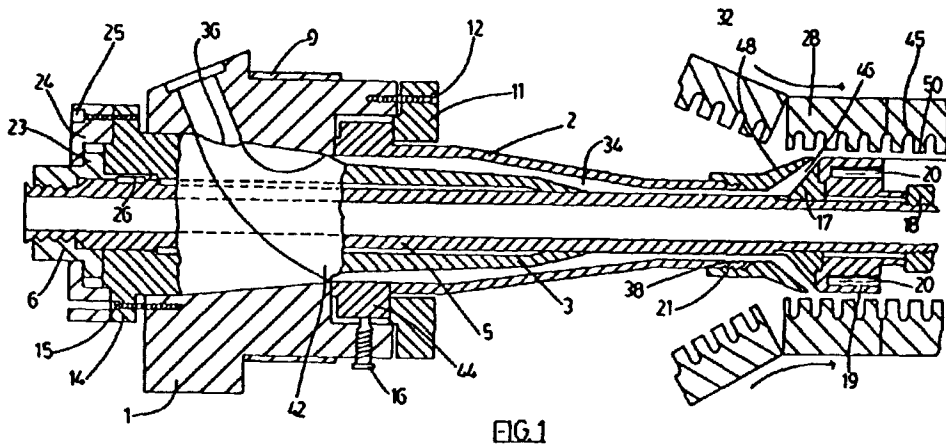
Agent for Applicant

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Patent application 615,585 (class 18-741) was filed on 28 December 1989 in the name of Manfred A. A. Lupke and is entitled "Extrusion Die for Externally Ribbed Plastic Tubing". This is an application for the reissue of Canadian patent 1,258,156 which issued on August 8, 1989. This decision deals with the Applicant's request that the Commissioner of Patents review the Examiner's Final Action dated March 19, 1991. A hearing before the Patent Appeal Board, composed of Mr. Frank Adams, Chair; Mr. Murray Wilson, member and Mr. Tom Virany, member was held on January 22, 1992. Mrs. Jane Parsons represented the applicant at the hearing.

The reissue application relates to an extrusion die for externally annularly ribbed seamless plastic tubing. The die has an elongated nozzle within which a hollow mandrel is placed to define an annular extrusion orifice. A portion of the orifice is conical in shape with the angle of the cone being more than 45° from the longitudinal axis of the nozzle in order to ensure that the mould cavities which correspond to the annular ribs are efficiently filled with extruded material.

Figure 1 of the application shows the applicant's extrusion die.



The applicant's extrusion die comprises an elongated extrusion nozzle 2 which is located coaxially about an elongated mandrel 3 to define an annular channel 34. The downstream end of the elongated extrusion nozzle carries a funnel shaped member 46 and it forms a diverging exit channel 48 with exit mandrel 17. Extrudate enters the die, is forced through the annular channel and the exit channel and enters travelling mould 32 which is made of two conveyors of cooperating mould blocks 28 which come together to form a mould tunnel. The exit channel is generally cone shaped, with the generatrix of the cone forming an angle of more than 45° with the longitudinal axis of the exit mandrel.

In part 3 of the Petition for Reissue, Applicant states that the description and specification of his patent are insufficient in that the language of the disclosure and claims contains errors and ambiguities which obscure the intended meaning of the claims and certain parts of the disclosure. More specifically, the Applicant stated:

"....claim 1 of the patent No. 1,258,156 included the following limitations: "an extrusion head having a central bore with a lateral opening for receiving an extrudate of a thermoplastic material under pressure therefrom,".

This limitation is directed to the lateral input of extrudate to the extrusion head upstream of the nozzle. The application was intended to be general as to the arrangement of extrusion head and extrusion die, the invention lying in the exit angle of the extrusion nozzle. This limitation is directed to the direction of input of the extrudate, that is, "lateral" input, whereas the invention disclosed in the patent and contemplated by the inventor is operable with all conventional arrangements including both axial and lateral direction of input.

Moreover the claims were limited to an extrusion die where clearly the whole tube producing apparatus is contemplated with or without the specific mould tunnel and smoothing plug for the inner wall.

The description to the drawings is too succinct and insufficiently explanatory and is possibly misleading due to unintended ambiguities introduced by the unskilled draftsman to whom English is a second language.

Especially the disclosure is contradictory in indicating on page 3 that it is the whole invention which is illustrated in the drawing while page 6 indicates that it is only an exemplary embodiment."

In part 4 of the petition, the Applicant gives details of how the error arose. The inventor disclosed the invention to Mr. Fishgal, who was employed by the inventor to assist in connection with obtaining patents. It is noted that Mr. Fishgal is identified as Mr. Seymour Fishgal in some places and as Mr. Seymon Fishgal in others. Mr. Fishgal was not a registered patent agent, however, he had some knowledge of patent matters. Because the inventor's native tongue is German and Mr. Fishgal's native tongue is Russian, neither appreciated that Claim 1 contained at least one limitation which was not essential to the definition of the invention.

Part 5 of the petition outlines the events that led to the filing of a reissue application as follows:

In August 1988, the inventor dispensed with the practice of employing unqualified patent assistances (sic). As substantive matters arose on pending cases they were put into the care of a Registered Patent Agent. However, no substantive matters arose concerning the Canadian patent application which has now issued as Canadian Patent No. 1,258,156. When the final fee became due it was paid. After allowance of the Canadian application and payment of the final fee the inventor became aware of a competitor whom he believed to be providing an extrusion die according to his invention. The inventor consulted Jane Parsons, a Registered Patent Agent of Blake, Cassels & Graydon. It was at this point that the inventor realized the unintentional inclusion of the limitation of lateral opening, which is not part of his invention.

On March 19, 1991, the examiner issued a Final Action refusing the application for reissue on the grounds that (1) the original patent is not defective or inoperative, (2) there was no inadvertence, accident or mistake, (3) the applicant failed to show that he intended to claim the invention that he is now claiming in the reissue application and (4) that the invention

now being claimed is not described in the original patent. He stated as follows:

Patent 1,258,156 is not inoperative as the device will operate as described and claimed. Further applicant does not cite inoperativeness as the reason for reissue.

Applicant claims the patent to be defective by reason of insufficient language in the disclosure and claims. The insufficient language being the limitation in claim 1 (and in all other claims) of "extrusion head having a central bore with a lateral opening for receiving an extrudate of a thermoplastic material under pressure therefrom".

"Insufficient description or specification" is limited to insufficiency arising from inadvertence, accident or mistake in describing or specifying in the original patent the invention in respect of which the applicant therefore intended to ask protection. 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 that what he had done constituted invention in the sense of the patent law and, consequently, has no intention of describing or specifying or claiming it in his original patent. The original patent cannot be deemed defective in a case where it obviously completely fulfilled the applicant's intention - where the invention in respect of which he intended to obtain protection is quite certainly and sufficiently described and specified. Therefore the patent is not defective.

Further, according to Section 47(1) of the Patent Act, there must be "inadvertence, accident or mistake". It is submitted there was no inadvertence, accident or mistake.

Respective part 4 of the petition, the applicant engaged the services of Mr. Seymon Fishgal to prepare a patent application, being fully aware that Mr. Seymon Fishgal was not a registered patent agent. The engagement of Mr. Fishgal may not have been a very sound decision, but the engagement was deliberate and did not arise from inadvertence, accident or mistake.

In August 1988, well before the issue of Canadian Patent 1,258,156, (issued August 8, 1989), applicant employed the services of a Registered Patent Agent and "no substantive matters arose concerning the Canadian Patent application". Therefore the applicant, who now had a registered agent, was satisfied with the specification of the application and let it proceed to issue.

After allowance of the application and payment of the final fee (the exact date is not clear) applicant became aware of a competitor. At this point applicant became aware of the limitation of the lateral opening, which is in all claims of the original patent, and therefore of the limitation of the invention. From the foregoing it is clear that the applicant only became aware of the limitation of the invention of the original patent because of a competitor after the payment of the final fee and applicant did not, before the competitor's appearance, intend to have claims without the limitation in the original patent.

In response to the Examiner's Final Action, the Applicant discussed each of the 4 reasons given by the Examiner for refusing the application for reissue. The Applicant stated, in part:

THE FIRST REJECTION

It is the Applicant's position that the Patent No. 1,258,156 is defective, and as a result may be inoperative, for the purpose for which it was intended due mainly to the fact that, in error, he claimed less than he was entitled to claim and that the specification is insufficient.

The patent is believed to be defective in that the claims are textually constructed so that the invention is applied only to one specific type of extrusion die rather than to the general type for which the invention was intended.

There is disagreement between the disclosure of Patent No. 1,258,156 and its claims, in that the disclosure refers to the provision of an inventive extrusion nozzle to general apparatus such as that known and described in, for example U.S. Patent Nos. 3,891,007, 3,998,579 and 4,365,948.

.....

THE SECOND REJECTION

The Examiner states there was no inadvertence, accident or mistake. On the contrary, the filing and prosecution of the application contains more than one such inadvertence, mistake and possibly also accident. It is alleged by the Examiner that the engagement of Mr. Fishgal may not have been a very sound decision, but the engagement was deliberate and did not arise from inadvertence, accident or mistake.....

The applicant, as a prolific inventor wished to employ a patent agent in his payroll rather than pay fees to an outside firm patent agent. In interviewing potential individuals for the post, he was informed by Mr. Fishgal that Mr. Fishgal's status was not important. The applicant employed Mr. Fishgal and, by doing so, made a mistake. This mistake appears to be a matter of fact rather than opinion. Thereafter, a number of mistakes were made or inadvertence occurred.....

While Mr. Fishgal was employed by the applicant, the applicant at least usually signed communications to the Patent Office himself. Nevertheless, Mr. Fishgal due to his own allegations as to his competence and due to the applicant's belief therein, was certainly in the position of a patent attorney. As such his mistakes, in addition to any personally made by the applicant, are contributory to the defects in Patent No. 1,258,156.

THIRD REJECTION

The examiner bases his contention that the applicant did not intend to claim the invention more broadly on the fact that the error was not discovered until a competitor was noticed in the marketplace. It is contended that the time of discovery of the error is totally irrelevant to the fact that an error was made. The applicant has submitted evidence in the form of an affidavit in the German language as to what his intentions were at the time he instructed Mr. Fishgal to file a patent application. The applicant's statements are corroborated by the disclosure itself which, contrary to the allegations made by the Examiner, outlines the invention in a broad manner. For

example it states the drawback of known dies as described in U.S. Patent Nos. 3,891,007, 3,998,579 and 4,365,948. These patents have been previously discussed and it is reaffirmed that one of them does not mention the orientation of the entry of the extrudate into the die, one of them utilizes both lateral and in-line entries, and the remaining one mentions an in-line entry.

#### FOURTH REJECTION

..... apparatus without a lateral feed for extrudate to the die has been described in that the invention is stated to overcome the drawbacks of previously mentioned U.S. patents. Moreover, during the prosecution of corresponding U.S. Patent 4,712,993 in the United States, the Examiner allowed issue of a claim which is not limited with respect to the nature of the entry to the die. It was, therefore clearly the opinion of the U.S. Examiner that there was basis for claim 4.

The issue before the Patent Appeal Board is whether or not the Petition for Reissue of application 615,585 and the evidence submitted present acceptable reasons for reissue under Section 47 of the Patent Act.

#### Examiner's Rejection 1

It is a well established principle that the reference in Section 47(1) to a patent that is "deemed defective or inoperative" does not mean that the invention protected by the patent must be defective or inoperative. If the invention were inoperative, that would result in an invalid patent because of lack of utility. Instead, it is the patent itself which is defective or inoperative. This principle was expressed by Martland J. in Farbwerke Hoechst Aktiengesellschaft v. The Commissioner of Patents [1966] S.C.R. 604 at 615:

Section 50 (now Section 47) deals with a patent which is defective or inoperative. In my opinion it contemplates the existence of a valid patent which requires reissue in order to become fully effective and operative.



We feel that the applicant has set forth sufficient evidence that his original patent is defective in that the claims are restricted to one specific type of extruder with a lateral inlet whereas he intended to claim a device which could be used with extruders having different types of inlets. The extrusion die is the portion of the complete device in which the inventive features lie and it is not specifically adapted to operate with an extruder that has a lateral feed.

The applicant has stated that his company is in the business of producing dies for all types of extruders. It is therefore evident that the original patent was defective because the patentee had restricted the claims in such a manner as to claim less than he had a right to claim.

#### Examiner's Rejection 2

The Applicant has alleged that two mistakes were made during the prosecution of the original patent application.

The first error was the employment of Mr. Fishgal to do the applicant's patent work. Mr. Fishgal was not a patent agent and his first language was not English. These two facts lead us to agree that this was perhaps an error but we do not believe that this is the type of error to which the Section 47 of the Patent Act refers and therefore is not relevant to the situation.

The second error was the inclusion of the word "lateral" in the claims. This appears to have been a genuine mistake and the evidence of the applicants's corresponding United States patent would indicate that he did not intend to be restricted to lateral feed extruders.

As a result, we agree with the applicant that the inclusion of the word "lateral" was an error and that this error was made without any fraudulent or deceptive intention. There was no discussion of the type of inlet during the prosecution of the original patent and inlet type does not appear to have been a significant factor in the determination of patentability.

The applicant has described the events which took place as the original application was being prosecuted. There were changes in personnel, language problems and a lack of understanding of the complexities of the patent system. These factors could account for the inclusion of the word "lateral" which the applicant would now like to remove.

#### Examiner's Rejection 3


The applicant has stated that his company produces equipment which is used with both lateral feed and axial feed extruders. The prior art mentioned by the applicant in the disclosure includes both of these types of extruder. There does not appear to be any reason why the applicant would want to limit his invention to lateral feed extruders and there do not appear to be any technical reasons why the invention could not be used on other types of extruders. Therefore, we feel that the applicant did not intend to not exclude any particular type of extruder.


#### Examiner's Rejection 4

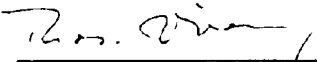
It appears, from a review of the prior art which the applicant has included in the disclosure of the original patent, that there is support in the original application for a claim which is directed to a general type of extruder, rather than the specific lateral feed extruder claimed in the original patent. The U.S. patents mentioned by the applicant in the disclosure of the original patent are directed to the manufacture of externally ribbed plastic tubing, the same product which is made by the apparatus disclosed and claimed in this application. These prior patents show that this type of tubing can be produced by extruders with either type of feed. The applicant states in the original application that this device is an improvement over these devices. Therefore, it is an improvement over extruders with either a lateral or an axial feed.

From the foregoing, the Board is of the opinion that the original patent is defective or inoperative because of the inclusion of the word "lateral" and that the error arose from inadvertence, accident or mistake.

As a result, we recommend that the refusal of reissue application 615,585 be withdrawn and that the application be returned to the examiner for further prosecution.

  
F.H. Adams  
Chairman  
Patent Appeal Board

  
M. Wilson  
Member  
Patent Appeal Board

  
T. Virany  
Member  
Patent Appeal Board

I concur with the findings and the recommendation of the Patent Appeal Board. The Petition for Reissue satisfies the requirements of Section 47 of the Patent Act. Accordingly, I remand the application to the Examiner for further prosecution.



M. Leesti  
Commissioner of Patents

dated at Hull, Quebec  
this 29<sup>th</sup> day of October, 1992  
29th October 1992