

IN THE CANADIAN PATENT OFFICE  
DECISION OF THE COMMISSIONER OF PATENTS

Patent application 616,196 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:

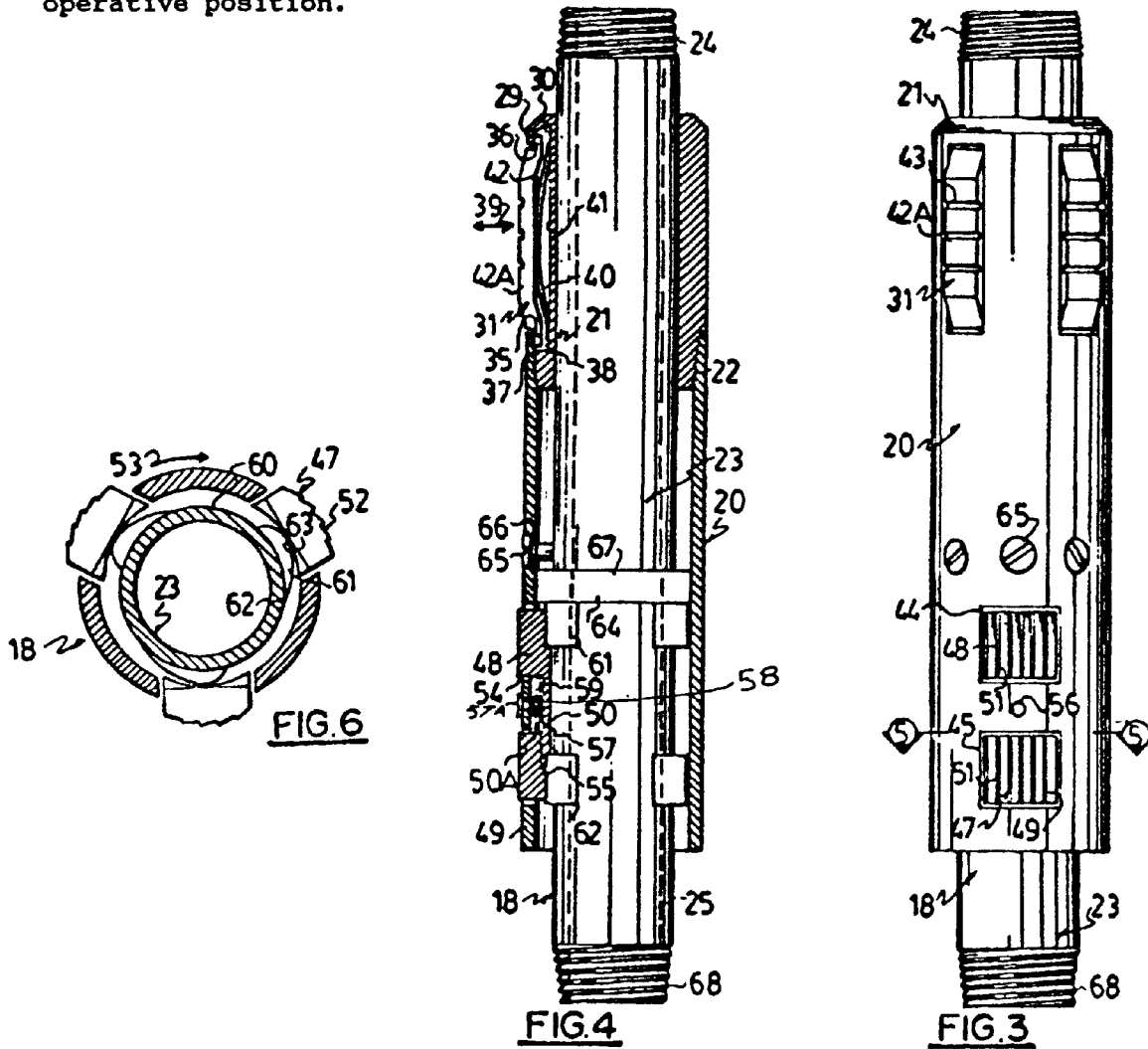
Agent for Applicant

Mr. Murray Thrift  
c/o Ade & Company  
1700 Winnipeg Square  
360 Main Street  
Winnipeg, Manitoba  
R3C 3Z3

This decision deals with applicant's request for review by the Commissioner of Patents of the examiner's Final Action, dated June 23, 1992, on application 616,196 (Class 166-26) filed October 18, 1991, and entitled No-Turn Tool. The inventor is James L. Weber and the application is assigned to Halbrite Well Services Co. Ltd. Application 616,196 is an application to re-issue patent 1,274,470 which issued on September 25, 1990.

A hearing before the Patent Appeal Board, composed of Mr. Frank Adams, Chair, and members Mr. Vic Duy and Mr. Murray Wilson, was held on December 16, 1992 at which time the applicant was represented by Mr. James L. Weber, the inventor, and Mr. Murray Thrift, a patent agent with the firm of Ade & Company.

The original patent and this application relate to a no-turn tool and its application with well head equipment. Figure 3 is a front elevation of the no-turn tool, figure 4 shows the tool partly in section, and Figure 6 shows a cross-section of the tool in the operative position.



The no-turn tool is intended to be attached to the lower end of a rotary pump which is, in turn, connected to the lower end of an oil well production string. As shown in the above figures, the tool 18 comprises a casing 20, a drag block casing 21 and an internal mandrel 23. In operation, drag blocks 31 engage the inner surface of the well casing and the internal mandrel is rotated in a clock-wise direction so that cam 61 forces a slip 47 outwardly into tight engagement with the well casing, thus preventing rotation of the casing and the production tubing which is attached to the upper end of the inner mandrel. The tool can be released by rotating the mandrel in the opposite direction. If the mandrel cannot be rotated to release the tool, a force from the well surface moves the mandrel vertically so that shear ring 64 can shear pins 65, and further vertical movement will clear the cam from the slip, permitting the slip to move inwardly and out of contact with the well casing.

In part (3) of the Petition for Reissue, the applicant states that the patent is deemed defective or inoperative as follows:

"Claim 1 of the patent recites a combination of elements, one of which is defined as "casing engaging means carried by the stationary means and operable to engage the casing so as to prevent right-hand rotation of the stationary means in the casing while permitting vertical movement of the stationary means in the casing." It is not an essential characteristic of the invention that the casing engaging means permit vertical movement of the stationary means in the casing. Amended claim 1 omits this limitation."

In part (4) of the Petition, the applicant identifies a series of events during the prosecution of the original application 586,660, that issued to Patent 1,274,470, which the applicant states led to the alleged error. In particular, the examiner rejected the main combination claim as being directed to a desired result. This rejection was repeated in a second examiner's report and then in a Final Action. There was some urgency to obtain a patent and as a result the application was advanced for examination out of its routine order. In response to the Final Action, the applicant and his agent discussed adding limitations to the claim, which would not be too limiting in a practical sense, in order to obtain allowance of the application.

As a result of these discussions, claim 1 was amended to read as follows:

"Apparatus for pumping oil from an oil well having a casing therein, said means comprising in combination a production string having stationary production tubing, a rotary pump drive means in the production tubing, a screw-type pump at the lower end of said string, said

pump including a stator and a screw-type rotor rotatable therein, and a no-turn tool operatively secured to the lower end of said stator to prevent right-hand rotation of said stator and said production tubing, said no-turn tool comprising stationary means secured to the stator and casing engaging means carried by the stationary means and operable to engage the casing so as to prevent right-hand rotation of the stationary means in the casing while permitting vertical movement of the stationary means in the casing."

The portion of the above claim which is underlined was added as a result of the discussions between the applicant and his agent. The application issued as patent 1,274,470 on September 25, 1990.

In part (5) of the Petition for Reissue, the applicant states:

"During discussings (sic) between your Petitioner and his Patent Agents on June 10, 1991, a reanalysis of the invention as claimed led to the conclusion that in certain applications of the NO-TURN TOOL, the ability to move the tool vertically within the pipe casing was unnecessary. Thus, it was concluded that other parties could manufacture and use no-turn tools while avoiding infringement by making the tools so that they would not move vertically within the pipe casing when set."

The June 10, 1991 discussions between the applicant and his agent concluded that the above underlined portions of the claim, which had been added during the prosecution of the application, were too limiting. This led to the filing of the reissue application containing a broader claim.

In the reissue application, the applicant proposes to remove the phrase "while permitting vertical movement of the stationary means in the casing" from claim 1 of the patent, leaving a claim which is broader in scope than the claim of the original patent because of the absence of the functional statement related to vertical movement.

The examiner refused the Petition for Reissue and issued a Final Action on June 23, 1992. In summary, the examiner gave three reasons for refusing the Petition, and the Board will deal with each of these separately.

The examiner's first reason, which the Board considers to be the most substantial reason for the refusal, was stated as follows:

"no error arose from the inadvertence, applicant or mistake which meets the requirements of Section 47(1) of the Patent Act in view of the Canadian Jurisprudence discussed."

In reply to the Final Action, the applicant stated, in part:

"In the official action of March 25, 1992, the examiner states the grounds for refusal of the applicant's Petition as being in (sic) absence (sic) "inadvertence, accident or mistake, in the original Patent". The basis of this allegation is apparently the examiner's belief that if something is done with forethought or in any way intentionally, there can by definition be no "inadvertence, accident or mistake" in the action taken. Given that premise, it seems that it would not be possible or (sic) reissue any patent and very definitely not to broaden a claim by reissue. This is clearly incorrect as the Patent Act, Section 47, specifically entitles A (sic) patentee to reissue a patent."

The question before the Board is whether or not the applicant has satisfied the statutory provisions for reissue in the Patent Act. Under these provisions, it is well accepted that in order to obtain a reissue patent, a patentee must establish that the issued patent does not accurately express the inventor's intention to protect that which is being sought by reissue, and that the failure to so protect the invention was as a result of a mistake of the kind contemplated by Section 47 of the Patent Act.

In the decision of Farbwerke Hoechst Aktiengesellschaft Vormals Meister Lucius Bruning v. The Commissioner of Patents, (1966) S.C.R., 604, at 615, the Supreme Court commented with respect to the requirement that an inventor must have originally intended to protect the invention being sought via reissue, as follows:

"Assuming, without deciding, that a mistake of law could constitute that kind of mistake which is contemplated by s. 50 (now s. 47), in my opinion the section can only operate if the patentee can satisfy the Commissioner that, because of his mistake, the patent fails to represent that which the inventor truly intended to have been covered and secured by it." (underlining and note regarding s. 47 added)

Furthermore, on the question of whether a deliberate act qualifies as an error under Section 47 of the Patent Act, the decision in Paul Moore Co. Ltd. v. Commissioner of Patents, (1980) 46 C.P.R. (2d), 5, states at 9, as follows:

"The appellant's counsel also argued that the Commissioner's decision was based on the erroneous view that what is done intentionally cannot be done by mistake. The attack is not without foundation. In a passage of his reasons, the Commissioner seems to express the view, which is certainly erroneous, that a deliberate act cannot be considered as having been done by mistake. However, in my opinion, that is not what the Commissioner meant. What he wanted to say was merely that applicant could not be said to have been the victim of a mistake if it was found that the reference to the pair of connecting panels in claims 1 and 4 had been made intentionally, with full knowledge of its consequences. (underlining added)

The applicant alleges that a mistake was made in the prosecution of the original application in that the functional statement concerning vertical movement was included when it may not have been essential. A careful study of the applicant's petition does not show any evidence that there was any intention to claim in the application the invention which is now being sought through reissue. In fact, the petition leads the Board to conclude that the scope of the claim which issued in patent 1,274,470 was as broad as the applicant felt was possible at the time that the patent issued. In order to obtain the patent, the applicant was involved in a lengthy and complicated prosecution that culminated in the examiner issuing a Final Action. The applicant indicates, in part (4) of the Petition for Reissue, that careful consideration was given to what limitations were necessary to overcome the examiner's rejection and that some limitations were added which would not be too limiting. At the hearing, the applicant's agent also referred to telephone discussions with the examiner in this regard.

In the Board's opinion, the information provided by the applicant in his Petition for Reissue does not provide the relevant evidence required to show that the inventor had intended to claim in the original patent what he now seeks to claim by reissue. In our view, the alleged mistake made by the applicant was not of the kind contemplated by Section 47 of the Act because it did not, based on the evidence provided, arise from inadvertence, accident or mistake. Therefore, the Board does not find the applicant's grounds for reissue, as expressed in part (5) of the Petition for Reissue, convincing.

The examiner's second reason for refusing the petition is:

"claims broader in scope than claims deliberately cancelled during the prosecution of the original patent because of an objection made by the Examiner and with full knowledge of the relevant facts and knowledge in Part 4 of the Petition (i.e. Final Action on the original application);"

It appears that the examiner is addressing the issue of an attempt by the applicant to recapture subject matter that was claimed in a claim which was deliberately cancelled during the prosecution of the original application. A comparison of claim 1 as originally filed in application 586,660, and which was cancelled during the prosecution of the application, with claim 1 of the instant application, shows that the latter pending claim is of narrower scope. For this reason, the Board does not agree with the examiner that this is an attempt by the applicant to recapture lost subject matter.

The examiner's third reason for refusing the petition is:

"the claims are being changed because the patent was being circumvented by others."

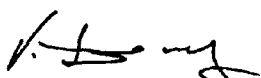
From this statement, it appears that the examiner feels the patentee was aware of other manufacturers who were circumventing the patent and, in order to catch them as infringers, is now trying to broaden the scope of the claims. In part (5) of the petition, the applicant states that knowledge of the error regarding claim 1 came in the light of a reanalysis of the claims on June 10, 1991. This reanalysis concluded that other parties could manufacture the no-turn tool and avoid infringement by making the tool so that it would not move vertically. The Board does not read that portion of the petition to necessarily mean that avoidance of infringement was or is taking place, since no evidence has been presented to show that circumvention has in fact taken place.

It is a widely accepted principle that a patent cannot be reissued merely to broaden the scope of the claims in order to catch subsequent infringers. At the hearing, there was some discussion of infringement and Mr. Thrift stated that no infringement was taking place, to the best of his knowledge. However, it was left unclear as to whether there were any non-infringing manufacturers of no-turn tools who would become infringers if the scope of the claims were to be broadened through reissue.

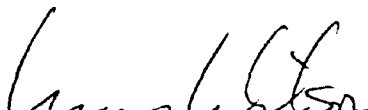
In summary, on the basis of its findings with respect to the examiner's first reason for rejecting the petition for reissue, the Board believes that the applicant has not satisfied the basic reissue requirements of Section 47 of the Patent Act and, as a result, recommends that application 616,196 for reissue of patent 1,274,470 be refused.



F.H. Adams  
Chairman  
Patent Appeal Board



V. Duy  
Member  
Patent Appeal Board



M. Wilson  
Member  
Patent Appeal Board

I concur with the findings and the recommendation of the Patent Appeal Board. Accordingly, I refuse to grant a patent on this application. Under Section 41 of the Patent Act, the Applicant has six months within which to appeal my decision to the Federal Court of Canada.



M. Leesti  
Commissioner of Patents

Dated at Hull, Quebec  
this 27<sup>th</sup> day of May 1993.