

IN THE CANADIAN PATENT OFFICE
DECISION OF THE COMMISSIONER OF PATENTS

Patent application 407,909 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:

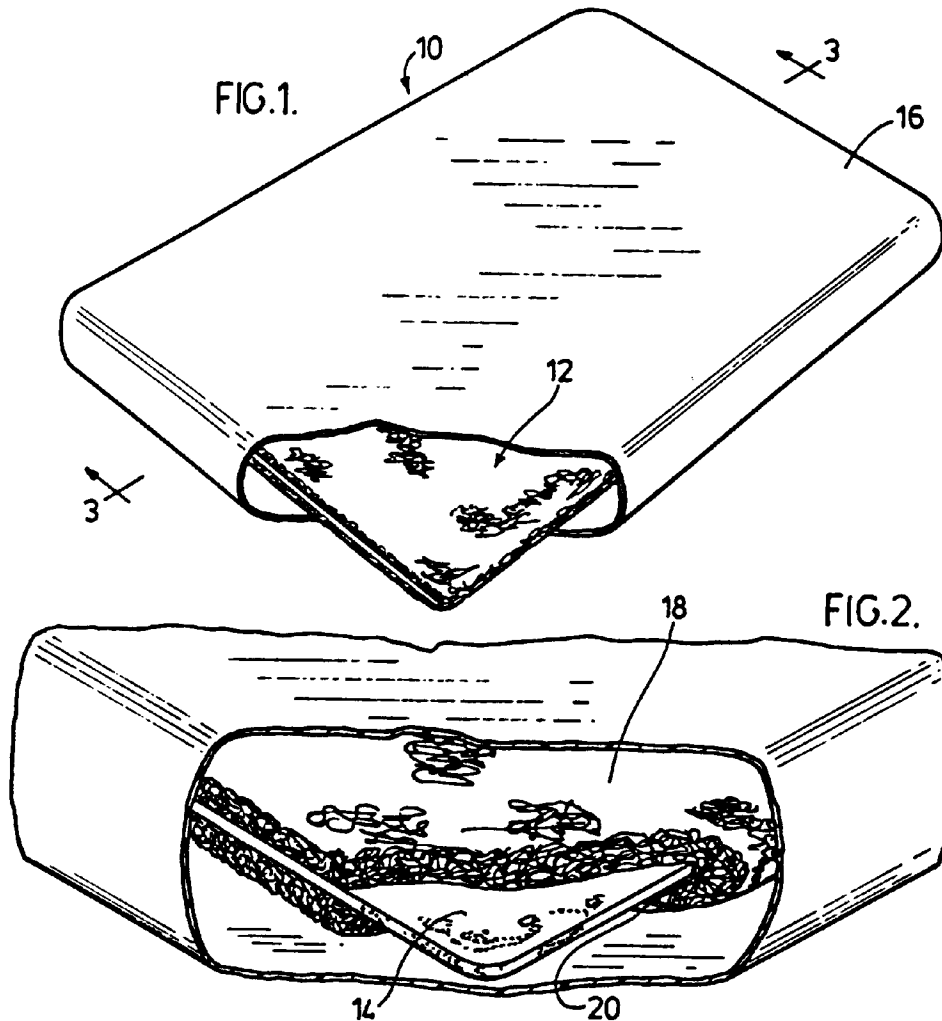
Agent for Applicant

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This decision deals with the Applicant's request that the Commissioner of Patents review the Examiner's Final Action on application 407,909 (Class 360-1), filed July 23, 1982 entitled "Damping Structure (B)". The Applicant is Halcyon Waterbed Co. Ltd. and the inventor is Andre Kocsis. A Hearing before the Patent Appeal Board was requested but this request was withdrawn in a letter dated November 6, 1991.

The application relates to a damping structure for damping wave motion in a waterbed mattress. Waves would normally be generated in such a mattress when a user reclines. A foam pad, surrounded by fiber material having loft, is located under the top sheet of the mattress.

Figures 1 and 2 of the application show the applicant's damping structure.



The applicant's damping structure 12 is used to damp wave action in a waterbed mattress 10. The structure consists of a foam pad 14 which is surrounded by a fiber product with loft 18 and 20. The specific gravity of the structure is less than 1 so that it floats beneath the top sheet 16 of the mattress.

The Examiner issued a Final Action on April 15, 1991 refusing to allow the application to proceed to patent because it contains the same subject matter as an earlier application (application number 401,967, April 29, 1982) filed by the same applicant. The claims in the earlier application were lost, as a result of conflict proceedings, to another inventor.

In the Final Action the following United States Patents were cited as references of interest:

4,301,560	November 24, 1981	Fraige
4,467,485	August 28, 1984	Hall

Each of the above patents describes a damping structure, having fiber material with loft, for a waterbed mattress. The Hall patent corresponds to the Canadian application which was in conflict with the Applicant's earlier application.

In refusing the application the Examiner, in the Final Action, stated, in part:

The rejection of this application is maintained and the reason for such rejection is that the instant application contains the same subject matter as already presented in the applicant's earlier application Serial No. 401,967.

Claims of said earlier applicant's application have been refused in the result of the conflict with another Canadian application Serial No. 388,747 (now United States Patent 4,467,485).

Applicant claims firstly that the invention in this application is embodied in the presence of a loft in the fiber product used for making a damping structure for a waterbed mattress and secondly that said loft has not been described in his earlier mentioned application.

In the previous Office Actions it has been stated that the loft is well known to those skilled in the art, that it has been described in earlier patents and publications (see Webster's dictionary under loft), that the loft is a basic property of the fiber product, representing its resilience, and that the amount of loft in the fiber depends on several factors like e.g. orientation of fibers, quantity of binder used etc.

United States Patent to Fraige, No. 4,301,560 (issued November 24, 1981) cited in the Office Action of January 13, 1984, describes lofted fiber material used for dampening as material which have fibers spaced apart in relation to each other though randomly touching one another. Patent continues that the lofted fiber materials "should compress to at least approximately one-tenth or less of their original size" (column 2, line 32).

United States Patent to Hall, No. 4,467,485 states that the layer of fibers oriented both vertically and horizontally provides more loft and therefore more dampening than if the fibers were only horizontally oriented (or had less loft) (column 4).

As far as applicant's argument is concerned that there is no disclosure of fiber product having loft in his earlier application Serial No. 401,967, it is held that on page 3, lines 7 to 9, the disclosure of said application sets forth that "the dampening structure utilizes the unwoven or loosely woven fiber product (which can be unbonded or bonded with a binder)". This applicant's statement confirms, without any doubt, the existence of loft in the fiber product. At this point, it is worth stressing that the loft is present even in a binder treated fiber, but its amount varies depending on the amount of the binder used.

Further presence of loft in the applicant's earlier application is disclosed plainly in the drawings (Nos. 2 to 5) showing fiber material having fibers oriented randomly, horizontally and vertically. Incidentally, the same fiber product, 40 denier, DACRON is used in both applicant's applications.

It is held that since the property of lofted fiber is commonly known, its existence in fiber product recognized, its significance in dampening appreciated by those skilled in the art, therefore it is not sufficient for the applicant, in order to differentiate this application from his earlier one, to merely state in the disclosure and claims that the fiber used for dampening has a loft.

It is considered that since this application describes the same subject matter as the applicant's earlier application Serial No. 401,967 and that the claims of said earlier application have been awarded, in the result of the conflict, to another applicant, therefore this application is rejected.

In response to the Final Action, the Applicant took the position that the subject matter of the present application and that of the applicant's earlier application are different and that the Examiner should have declared conflict between the present application and the Hall application 388,747.

The Applicant's reply included the following:

While it is the applicant's position that the present application contains subject matter which is not presented in its earlier application, the applicant submits that even if identical subject matter is disclosed there is no basis under the Patent Act for the Examiner's refusal of the claims.

The proper procedure to determine first inventorship is for the Examiner to declare a conflict pursuant to Section 45 of the Patent Act. The only authority of the Commissioner to decide prior inventorship is through the prescribed statutory framework of Section 45.

Section 45 of the Patent Act provides:

(1) Conflict between two or more pending applications exists

(a) when each of them contains one or more claims defining substantially the same invention; or

(b) when one or more claims of one application describe the invention disclosed in one of the other applications.

(2) When the Commissioner has before him two or more applications referred to in subsection (1), he shall [emphasis added]

(a) notify each of the applicants of the apparent conflict and transmit to each of them a copy of the conflicting claims, together with a copy of this section; and

(b) give to each applicant the opportunity of inserting the same or similar claims in his application within a specified time.

Clearly there are now two pending applications in conflict and there is a positive duty to declare a conflict.

There is no provision under the Patent Act for the Examiner to merely assume that one applicant is the prior inventor over another. The Patent Act contains a specific mechanism which must be followed to determine prior inventorship, namely, conflict proceedings. The Examiner has exceeded his statutory powers and erred in deciding who was the first inventor based on an assumption.

In support of the applicant's position, the Board is referred to the case of RCA v Philco Corp. (Delaware) (1966), 32 Fox Pat. c. 99, affg (1965), 29 Fox Pat. C. 97 where the court held that virtually identical claims from the same application which were not placed in conflict were not to subject to the provisions of Section 45(8). The Supreme Court of Canada affirmed the decision of the trial judge who stated at page 119:

"Here again it is quite clear that the "claims in conflict" which are to be rejected or allowed are those which were the subject matter of action under earlier subsections [of the conflict provisions] and with which the Commissioner has dealt with under subsection (7) [emphasis added]."

As is apparent from page 102 of the Supreme Court decision, the court unanimously agreed with the Exchequer Court President's statement:

"I am of the opinion that proceedings under Section 45(8) are restricted to a determination of the respective rights of the parties in respect of the subject matter of the claims put into conflict by the Commissioner....I cannot read subsection (8) as applying to anything except the claims that have been dealt with pursuant to subsections (3) to (7) inclusive."

The Board is respectfully reminded of the following facts:

- (a) the Examiner raised double patenting objections in respect of Serial Nos. 401,967 and 407,909 as early as 1984, before conflict proceedings were initiated;
- (b) the applicant has always viewed applications 401,967 and 407,909 as two separate applications, each reciting claims directed to differing inventions;

- (c) the Examiner has been fully aware of both of the present and 401' applications prior to the commencement of conflict proceedings with Hall. For whatever reasons, the Examiner decided not to place the present claims into conflict with the Hall and 401' applications at the same time;
- (d) at all times the applicant fully expected the Examiner to declare a conflict between the present application and Hall;
- (e) if conflict is not declared a Re Fry situation arises and the claim in this application must issue.

The applicant submits that the present claims recite on subject matter which is not presented in the applicant's 401' application. As the present claims recite on subject matter which was not the presented in the previous conflict proceedings, there is no basis for the Examiner's rejection of the claims based on the outcome of said conflict.

The applicant submits that the recitals of a fibre product having "loft which is resistant to compression, yet sufficiently resilient and has sufficient thickness to assist in preventing the user of the mattress from feeling the fibre product and the foam material through the top sheet" in each of the claims is novel as to patentably distinguish over all the prior art.

The applicant respectfully submits that the Examiner is incorrect in his conclusions, and further, that the Examiner has concluded the "loft" was well known without any documentary support whatsoever.

The Board is referred to the 1974 Edition of the Webster's dictionary, wherein the definition of "loft" makes no reference to a property of a fibre product. This is contrary to the Examiner's findings. For the Board's reference, a photocopy of a relevant Webster's Dictionary cover and page is attached as Appendix "B".

The Board is respectfully reminded that unlike the 401' claims, each of the claims of the present case are specifically directed to a fiber product having loft which is sufficiently thick and resilient to prevent the user of a waterbed mattress from feeling the fiber product. By this recital the applicant has positively claimed a preferred damping structure. It is not merely enough that loft be present in the fiber product to fall within the scope of the present claims.

The Board is requested to affirm the applicant's position that the disclosure, claims and drawings of the applicant's abandoned application do not teach the invention as presently claimed and are not a citable reference for obviousness or novelty where there has been no disclosure to the public.

As such, it is impossible and improper for the Examiner to conclude that the present invention was known by any other on the facts before him. The Board is requested to overturn the Examiner's decision in the absence of proper references and allow the claims.

It is the applicant's position that the present application recites additional features as noted above and which constitute an improvement over the damping structure of Hall. Canadian patent practice permits that an improvement in a product may constitute an invention and may be patented.

Claim 1 of the present application reads:

For use with a waterbed mattress for damping wave action in the mattress, a damping structure having a specific gravity less than 1, extending under a substantial portion of the undersurface of a top sheet of the waterbed mattress and consisting of closed-cell foam material carrying fiber product with loft on the surface of the closed-cell foam material nearest the undersurface of the top sheet to cause the damping structure to lie below the top sheet of the mattress with the fiber product closest to the undersurface of the top sheet of the mattress, said fiber product with loft being resistant to compression yet sufficiently resilient and of a sufficient thickness to assist in preventing a user of the mattress from feeling the fiber product and the foam material through the top sheet.

The other claims, although defining minor variations, are directed to essentially the same subject matter as that of claim 1.

The issue before the Board is whether the invention defined and claimed in the present application is the same as that defined and claimed in the applicant's earlier application 401,967.

Claim 1 of application 401,967, which was also conflict claim C1 of the conflict between that application and application 388,747 reads as follows:

For use with a waterbed mattress for damping wave action in the mattress, a damping structure having a specific gravity slightly less than 1, extending under a substantial portion of the undersurface of the top sheet, of the waterbed mattress and consisting of close-cell foam material, carrying unwoven or loosely woven fiber product on the surface of the closed-cell foam material nearest the undersurface of the top sheet, to cause the damping structure to lie below the top surface of the mattress with the fiber product closest to the undersurface of the top sheet of the mattress.

It is apparent from a comparison of these two claims that the only difference between them is the inclusion in the present application of the requirement that the fiber product have loft.

Loft is defined by Webster's Third New International Dictionary (1968) as: "the resilience of textile fibers esp. wool". Application 401,967 uses a damping structure which includes a fiber product. Since fiber products have resilience, and since resilience, according to Webster's Dictionary, is synonymous with loft, the product has loft.

In application 401,967, there are several examples of the fiber products that can be used to obtain satisfactory results. These include 6 denier and 18 denier blend of polyester fiber with a vinyl acetate binder or 100% polyester fiber, 40 denier DACRON fiber having a surface gravity of about 1.2 to 1.5 with an acrylic adhesive or 40 denier DACRON HOLLOFIL (t.m.) fiber with an acrylic adhesive. The Applicant uses exactly the same materials to obtain satisfactory results in the present application. If there is loft in the material of the present damping structure there must be loft in the material in the 401,967 application. The only difference between these two applications is that the Applicant specifically sets out an inherent physical property of the material in this application but has not done so in the earlier application. The applicant contends that since there is no reference to loft being a property of fiber products in the 1974 Edition of the Webster's Dictionary, this property is not well-known. This contention is not well founded. The absence of a definition in a dictionary has nothing to do with the physical properties of fiber products.

Conflict proceedings were followed between the Applicant's earlier application 401,967 and the Hall application 388,747. During the course of these proceedings, both applicants were given an opportunity to establish the date on which the invention claimed in the applications was made. In examining the evidence submitted by the two applicants, the Commissioner of Patents determined that the inventor named in application 388,747 had reduced the invention to a definite and practical shape by June 25, 1980. The date of conception which was awarded to the

Applicant was April 30, 1981. Since this date is clearly after the date accorded to the applicant of the Hall application, the Commissioner awarded the subject matter to Hall.

The Board now has before it a second application filed by the same applicant, naming the same inventor and disclosing and claiming the same invention. Clearly, the date of invention in this application must be the same as for the earlier application. It cannot be otherwise. Therefore, the date of conception of the subject matter claimed in the instant application is April 30, 1981. This date, as was stated above, is after the date that the inventor named in the Hall application had reduced the invention to a definite and practical shape.

The Applicant alleges that the Examiner must declare a conflict between this application and the Hall application. The Board does not agree. The instant application was filed under the terms of the Patent Act which was in force before October 1, 1989. Under that Act, patents were granted on a "first-to-invent" basis. Section 27(1)(a) of the Patent Act sets out that principle.

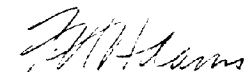
Section 27(1)(a) of the Patent Act reads:

..... Any inventor or legal representative
of an inventor of an invention that was
 (a) not known or used by any other
 person before he invented it
may obtain a patent

When two or more applications claim or could claim the same invention, the Patent Office has a responsibility to determine which inventor was the first and to grant the patent according to that determination. Section 43 of the Patent Act sets out the method to be followed when determining the first inventor. However, in the present situation, the first inventor is already known.

In view of this, the Applicant is clearly not the first inventor of this invention because the invention was known or used by another person before the Applicant invented it and the Applicant is not entitled to a patent for that invention.

In summary, the Board recommends that the refusal of the application be affirmed by virtue of the fact that the invention was known or used by another person before the Applicant invented it.



F.H. Adams
Chairman
Patent Appeal Board

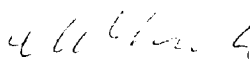


M. Wilson
Member
Patent Appeal Board



S. Schwartz
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 4th day of February 1993