

Commissioner's Decision #1254  
Décision du commissaire #1254

TOPIC: A-40, F-00  
SUJET: A-40, F-00

Application No: 2,045,105 (Class IPC A01K-001/015)  
Demande No: 2,045,105 (Classe IPC A01K-001/015)

## COMMISSIONER'S DECISION SUMMARY

C.D.            1254            App'n 2,045,105

Application filed after foreign patent issued

The examiner rejected this application on the basis that the applicant's United States patent for the same invention had issued before the filing date of the Canadian application, contrary to Subsection 27(2) of the Patent Act which was in force when the application was filed. The Board agreed with the examiner.

The application was refused by the Commissioner of Patents.

IN THE CANADIAN PATENT OFFICE

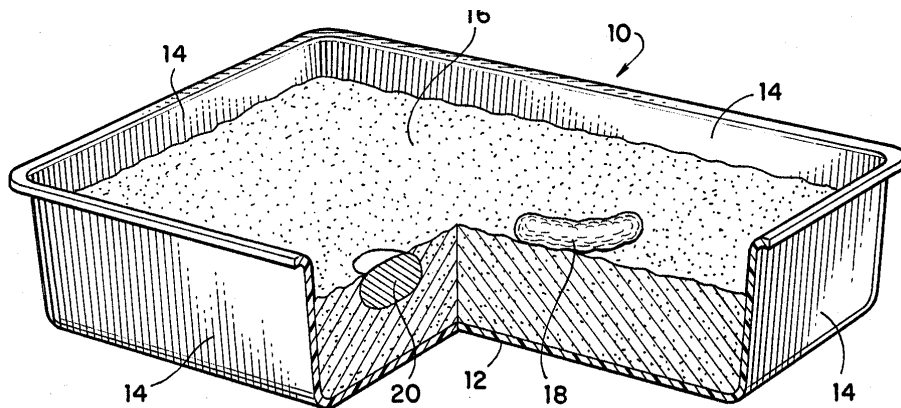
DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,045,105 having been rejected under Subsection 30(4) of the *Patent Rules*, 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 patent application number 2,045,105 (IPC A01K-001/015) which was filed on June 20, 1991 by the American Colloid Company. The inventor is John Hughes and the application is entitled "Animal Dross Absorbent and Method". The Examiner in charge issued the Final Action refusing the application on July 25, 1997. At the Applicant's request the Patent Appeal Board, comprised of Mr. Peter Davies, Chairman and Mr. Murray Wilson, Member, conducted a hearing June 27, 2001, at which Mr. Solomon Gold and Mr James Baker of the firm of Smart and Biggar represented the Applicant. Mr Don Eisenhower, an employee of the Applicant was also present. Ms Shirley Arpin represented the Patent Office.



The application is directed to a litter box, a composition which is used to absorb animal dross when placed in a litter box and a method of removing liquid animal dross from a litter box.

Figure 1 of the application shows a litter box containing the absorbent composition.

In the Final Action, the Examiner cited the following prior art:

United States patent

5,000,115      March 19, 1991      Hughes      filed January 13, 1989

In her Final Action the Examiner stated:

This application does not comply with Subsection 27(2) of the Patent Act, as it read immediately before October 1, 1996. The United States patent issued on March 19, 1991, which is prior to the Canadian filing date for the same invention. Further, the Canadian application was not filed within twelve months of the first foreign filing on January 13, 1989 in the United States for the same invention.

Claims 1 to 20 are directed to the same invention as the above cited U.S. Patent.

....

In USP 5,000,115, we find claims that are directed to a litter box, a litter box absorbent composition and method claims. The broad claims include the use of absorbent compositions comprising particles of a water-swellaable bentonite clay having a particle size of from about 50 microns to about 3350 microns which are capable of agglomeration upon wetting into a mass of sufficient size and a sufficient cohesive strength for physical removal.

In column 5 lines 62 to 66 of this patent, it is stated that the water-swellaable clay can be sodium bentonite. In column 6 lines 60-62, it reads that the water-swellaable clay is present in an amount of at least 65% by weight of the composition. We also find this feature in claim 6 of the patent. In claim 4, we find that the fine particles have a particle size ranging from 50 to 600 microns.

In its reply of January 26, 1998, the Applicant stated (in part):

The Examiner has rejected claims 1 to 20 under Section 27(2) of the Patent Act on the grounds that the claims are directed to the same invention as the invention of applicant's own United

States Patent No. 5,000,115.

....

The section refers to applying in Canada for Aa patent for an invention for which application for patent has been made in any other country@ and says that the applicant Ais not entitled to obtain in Canada a patent for that invention@ unless two conditions are met. The two conditions are set forth in parts (a) and (b). Part (a) refers to issue of a patent Afor the same invention@ and part (b) refers to the filing of an application Afor patent for that invention@. Therefore, the criterion is whether the application is for a patent for the same invention. The section is not concerned with the presence or absence of inventiveness, but whether the invention is the same. The section deals with a very special case of novelty. There is nothing in the section which justifies any arguments based on lack of invention or obviousness. Therefore, applicant respectfully submits that the only question under Section 27(2) should be whether this application is directed to the same invention as the invention of the US Patent.

To resolve the question of whether this is an application for the same invention, applicant respectfully submits that one must look to the claims. It is the claims which define the invention in an application or patent. The claims define the scope. It is well-established law that, to determine the scope of a claim, it is not permissible to consult the disclosure unless the language of the claim itself is unclear. Therefore, applicant respectfully submits that the only issue to be decided under Section 27(2) is whether the scope of the claims of the United States Patent is the same as the scope of the present claims. It is respectfully submitted that the scope of the claims of these two documents is clearly different.

Both the United States patent and the present application are directed to kitty litters and compositions for such kitty litters. Since both inventions stem from the same inventor, it is not surprising that they share many common features. However, none of the claims of the United States patent recite sodium bentonite. In contrast, all of the claims in the present Canadian application require sodium bentonite. Applicant respectfully submits that this difference should be the end of the matter. The only question should be: are the claims the same, are they of the same scope. Clearly, the claims are not the same.

In Xerox of Canada Ltd. v IBM Canada Ltd. 33C.P.R. (2d) 24, the Federal Court considered the question of Prior Grant or Double Patenting. This question is concerned with a comparison of the scope of claims of two documents and thus presents a question similar to the question to be resolved as in the present case. At pages 57 and 58, the court adopted with approval the comment of Harold G. Fox Q.C. in his editorial on the case Lovell Manufacturing Co. et al v. Beatty Bros. Ltd. which comment included the following statement:

ABut for this purpose the subject-matter of the two grants must be identical. A subsequent claim cannot be invalidated on the ground of prior claiming unless the two claims are precisely coterminous.@

None of the claims of the United States patent are directed to a kitty litter composition in which sodium bentonite is required. In fact, none of the United States claims even mentions sodium bentonite. This difference alone should leave no room for argument. The claims are clearly not Aprecisely coterminous@.

During the oral hearing before the Board, Mr Gold advanced three separate arguments in favour of his client=s position. These arguments are summarized as follows:

1. Subsection 27(2) of the *Patent Act* may not apply in this case because the cited United States patent issued after the convention priority date of the instant application and recent court decisions have indicated that it is the priority date which should be considered;
2. The instant application is not related to the same invention as the United States patent because the claims of the two are not co-terminus; and
3. The invention disclosed and claimed in the instant application is an improvement over the invention claimed in the United States patent.

Subsection 27(2) of the *Patent Act*, as is read immediately before October 1, 1996, states:

Any inventor or legal representative of an inventor who applies in Canada for a patent for an invention for which application for patent has been made in any other country by that inventor or his legal representative before the filing of the application in Canada is not entitled to obtain in Canada a patent for that invention unless his application in Canada is filed, either

(a) before the issue of any patent to that inventor or his legal representative for the same invention in any other country, or

(b) if a patent has issued in any other country, within twelve months after the filing of the first application by that inventor or his legal representative for patent for that invention in any other country.

Claim 1 of the instant application reads:

A litter box comprising a water-impermeable receptacle having

disposed therein an absorbent composition capable of agglomerating upon wetting into a mass of sufficient size and of sufficient cohesive strength for physical removal of the agglomerated mass from the litter box after drying at room temperature for a period of about 1 hour to about 24 hours, said absorbent composition comprising at least 65% by weight particles of non-compacted sodium bentonite clay having at particle size distribution ranging from about 50 microns to about 3350 microns that includes a sufficient amount of fine particles for agglomeration of the absorbent composition into said mass upon wetting wherein the fine particles have a particle size ranging from about 50 microns to about 600 microns.

Claim 1 of United States patent 5,000,115 reads:

A litter box comprising a water-impermeable receptacle having disposed therein an absorbent composition capable of agglomerating upon wetting into a mass of sufficient size and of sufficient cohesive strength for physical removal of the agglomerated mass from the litter box, said absorbent composition comprising particles of a water-swellable bentonite clay having a particle size ranging from about 50 microns to about 3350 microns, and having a sufficient amount of fine particles such that upon wetting, a substantial quantity of the clay will agglomerate.

The Applicant=s first argument is based on a decision of the Federal Court in *Bayer AG v. Apotex* 84 C.P.R.(3d) 23. In that decision, Gibson J. stated at page 38:

[55] ..... in light of my conclusion regarding the interpretation of subsection 28(2) of the Act, it is not necessary that I consider this question. However, in very brief summary, were I to do so, I am satisfied that subsection 28(2) and subsection 29(1) should be read together in such a way that the references to Ailing@ of an application in Canada in subsection 28(2) are not simply to the actual filing but to any effective or priority filing date to which the applicant is entitled by virtue of subsection 29(1).....

The Board would observe that, in this decision, the court was comparing subsections 28(2) and 29(1) of the *Patent Act* as it read before October 1, 1989. In the amendments to the *Patent Act* that came into force on that date, subsection 28(2) became subsection 27(2) while subsection 29(1) was repealed and replaced by section 28.4.

Subsection 27(2) of the Act operates in conjunction with Section 11. Section 11 allows any person to ask the Commissioner if there is pending in the Patent Office an application for the same invention as in a patent granted in another country. If the answer to that



question is negative, the person can be certain that that invention cannot be patented in Canada because of the provisions of subsection 27(2) .

Furthermore, Canada is obliged, because of its adherence to the *Paris Convention for the Protection of Industrial Property 1883 as revised*, to permit an applicant to file an application in Canada up to 12 months after filing a priority application in another convention country. This obligation can conflict with the provisions of paragraph 27(2) (a) but the conflict is resolved by paragraph 27(2) (b) which allows for the filing of a patent application in Canada even after the grant of a patent for the same invention in another country, provided that the Canadian application is filed within twelve months after the filing of the first patent application for that invention in any other country.

If the interpretation of subsection 27(2) contained in *Bayer AG v Apotex* were correct (the filing date mentioned is the priority date), then conditions which require the provisions of paragraph 27(2) (b) will never arise because a patent cannot issue before its priority filing date. The Board, therefore, concludes that that interpretation is incorrect and that the filing date referred to in subsection 27(2) is the actual filing date in Canada, in this case June 20, 1991.

In any event, the Board also notes that this passage from the judgment of Gibson J. is *obiter dicta*.

To support its second argument, the Applicant has directed the Board=s attention to *Xerox of Canada Ltd. v. IBM Canada Ltd.*, 33 C.P.R. (2d) 24, especially the paragraph bridging pages 57 and 58, in which the Court examined the question of invalidating a Canadian patent on the basis of prior grant of another Canadian patent or double patenting.

In the present situation, the application is not being refused because it claims the same invention as a prior Canadian patent, but because it is an application Afor the same invention@ for which a patent has been obtained by the same inventor in another country. It is therefore necessary to study both the claims and the disclosure of each document to determine if the United States patent and the instant

application are directed to the same invention. The claims in the application define the limits of the monopoly but the specification describes the invention so it is necessary to first consider what is the invention that is described and then look at the limits that the claims place on the invention that has been described.

In *Refrigerating Equipment Limited vs W. A. Drummond and Waltham System Incorporated* (1930) Ex. C. R. 154, McLean J. commented on the meaning of the subsection 27(2) (at that time numbered 8(2)) of the *Patent Act* as follows:

The invention here is described as a method of refrigeration; it is to all intents and purposes the same as the patent in suit. Yet it is not exactly the same, the language of the latter varies somewhat as also do the drawings, and slight structural changes in the means of applying the method, are suggested. The application for this patent was made in the United States on December 7, 1923. The plaintiff contends that the patent in suit is essentially the same as the United States patent issued on November 1927 upon this application, and that inasmuch as the Canadian application was not made within twelve months from the date of the United States application that the patent is therefore void under Section 8(2) of the *Patent Act*. While I agree that both patents virtually describe the same subject matter, yet, they differ in the respects I have already mentioned. I do not think that the application for patent in suit can be treated as a convention application. In that case, the application must be for the same invention as is applied for abroad, and the claims must not include anything not comprised in the application made abroad. No modification or enlargement however slight, is possible as it then clearly would not be for the invention applied for abroad. I think therefore that this contention of the plaintiff fails, and that the patent in suit cannot be voided upon that ground.

This decision points out that there were material differences between the device described in the United States and the device described in Canada. It was not merely an exercise in comparing the two sets of claims, which is what the Applicant is urging the Board to do in the instant application. Mr. Justice Maclean considered the real invention as described and illustrated in the specifications. When he found that there were material differences between the two devices, which differences caused structural changes in the ways of applying the method, he did not find a statutory bar. However, there is no suggestion that a statutory bar under subsection 27(2) exists only if the cases have identical claims.

In assessing the invention, the application and the United States patent describe and claim a litter box and material which can be used in the litter box to absorb animal waste. In both documents, the material is comprised of a composition of at least 65% by weight of bentonite clay having a particle size in the range of from 50 to 3,350 microns, with the clay fines in both being in the range of from 50 microns to 600 microns.

The first point at issue is the choice of bentonite clay. In the U.S. patent it is called Aa water-swellaable bentonite clay@, the disclosure at column 5 lines 58 *et seq* stating that such a clay is selected Afrom the group consisting of sodium bentonite, potassium bentonite, lithium bentonite, calcium bentonite and magnesium bentonite; or combinations thereof@. In the instant application, the second sentence reads Amore particularly, the present invention relates to a composition containing a water- swellaable bentonite clay such as sodium bentonite and/or calcium bentonite@. The Board can only conclude that the Awater- swellaable bentonite clay@ of the patent and the Asodium bentonite clay@ of the application are both references to sodium bentonite clay.

The second point at issue concerns the word Anon-compacted@ found in the claims of the application and not found in the claims of the patent. Apparently, in the manufacturing of some types of animal litter, fine particle of material are compressed to form larger particles. This material is described as compacted. The material of the instant application is non-compacted. A careful review of the U.S. patent fails to reveal any mention of compacted or non-compacted. Because compaction requires that a specific action be taken and non-compaction requires no action, the Board concludes that the clay particles in the U.S. patent are non-compacted. The Board is therefore not persuaded that the use of the word Anon-compacted@ in the application represents a material difference between the two especially after concluding that the clay used in the patent was also non-compacted.

This leads the Board to consider the Applicant=s third argument, that the invention disclosed and claimed in the instant application is an

improvement over the invention claimed in the United States patent.

Nowhere in the application does the Applicant state that the use of Anon-compacted sodium bentonite clay@ is an improvement over that which is disclosed in the U.S. patent. The instant disclosure indicates that the purpose of the alleged invention is to provide a water-swellable bentonite clay that can effectively absorb animal dross and simultaneously agglomerate into a large stable mass that can be separated from the unwetted particles and removed from the litter box, even after partial or complete drying of the clay, without sticking to the animal=s paws or fur.

In the application, the Applicant gives two examples of embodiments of the invention. In the first example, 454 grams of non-compacted sodium bentonite clay with a particle size in the range of 600 microns to 3,350 microns was used in a house that included 2 cats.

Sufficiently large and stable masses for at least daily physical removal were obtained. The litter box was free of offending odours for 14 days. The Applicant also gives details of a comparison in the performance of this material when compared to that of a compacted clay with a particle size in the range of 710 microns to 4,000 microns which had been compacted into 2 inch pellets following the disclosure of U.S. patent 4,657,881 to Crampton. The non-compacted clay of the instant application demonstrated a much lower tendency to stick to animal paws or fur.

In the second embodiment, 454 grams of sodium bentonite clays and calcium bentonite clay with a particle size in the range of 600 microns to 3,350 microns was used in a house that included 2 cats. The bentonite clays agglomerated into sufficiently large and stable masses to permit daily removal. Again, the litter box was free of offending odours for 14 days. This mixture of two types of clay demonstrated an enhanced capability of dispersing in water so that an agglomerate could be disposed of in a household toilet. This second embodiment is not claimed in the instant application.

During the oral hearing, the Applicant placed considerable emphasis on the fact that the material being claimed is a non-compacted sodium bentonite clay which has the characteristic of being non-adhering to

the paws or fur of animals. This feature was described as being a non-obvious, unexpected and surprising improvement which was not hinted at in the United States patent.

The Board is not convinced. The comparison made was against compacted 2 inch pellets of the Crampton patent and not the invention of the U.S. patent under consideration.

Further, the fact that the sodium bentonite clay of the instant application does not adhere to animal fur is an inherent characteristic of the material and was present in the material of the United States patent, despite not being specifically mentioned. It cannot be considered an improvement over the teachings of U.S. patent 5,000,115.

The Board has looked for material differences between the invention described in Canada and the invention described in the United States and has found none. The Applicant has attempted to obtain a patent in Canada which claims one specific clay from a group of clays for which a patent was obtained in the United States. Simply emphasizing inherent properties of that specific clay does not constitute invention and does not permit the Applicant to avoid the requirement of subsection 27(2) of the *Patent Act*.

The Board also notes with interest the prosecution of the same application before the U.S. Patent and Trademarks Office. The Applicant filed its original application on January 13, 1989, this issued as U.S. patent 5,000,115 on March 19, 1991 as noted above. The original application was divided on October 18, 1989 and a continuation-in-part of this divisional was filed on July 16, 1990, this application is the equivalent of the instant application in Canada. This continuation-in-part application issued as U.S. patent 5,129,365 on July 14, 1992. Claim 1 of this patent reads as follows  
:

A litter box comprising a water impermeable receptacle having disposed therein an absorbent composition capable of

agglomerating upon wetting into a mass of sufficient size and of sufficient cohesive strength for physical removal of the agglomerated mass from the litter box without substantial adherence to the animal, said absorbent composition, consisting essentially of non-compacted particles of a water-swellaable bentonite clay.

It is noted that the clay is defined as a Non-compacted and a water-swellaable bentonite while the claim refers to the non-adherence feature, however there is no restriction to a sodium bentonite clay. Furthermore, the patent bears a disclaimer to that portion of its term subsequent to March 19, 2008 to avoid double patenting with U.S. patent 5,000,115 whose term is set to expire on March 19, 2008.

Accordingly, the Board recommends that the Examiner's refusal of the application in the Final Action be affirmed.

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Peter J. Davies  
Chairman  
Patent Appeal Board

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Murray Wilson  
Member

I have reviewed the prosecution of this application and concur with the reasoning and findings of the Board. Accordingly, I refuse to grant a patent on the application. Under the provisions of Section 41 of the Patent Act the Applicant has six (6) months within which

to appeal this decision to the Federal Court of Canada.

David Tobin  
Commissioner of Patents

Dated at Hull, Quebec  
this 16 day of August, 2002