

Commissioner's Decision # 1271
Décision du Commissaire # 1271

TOPIC: O
SUJET: O

Application No: 2,280,346
Demande No: 2,280,346

COMMISSIONER'S DECISION SUMMARY

C.D.1271 App'n 2,280,346

Obviousness

The examiner rejected this application on the basis that the invention claimed was obvious at the claim date, over cited prior art consisting of three United States patents. The Board found that the applicant was claiming an invention which was obvious.

The application was refused by the Commissioner of Patents

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application 2,280,346 having been rejected under Rule 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:

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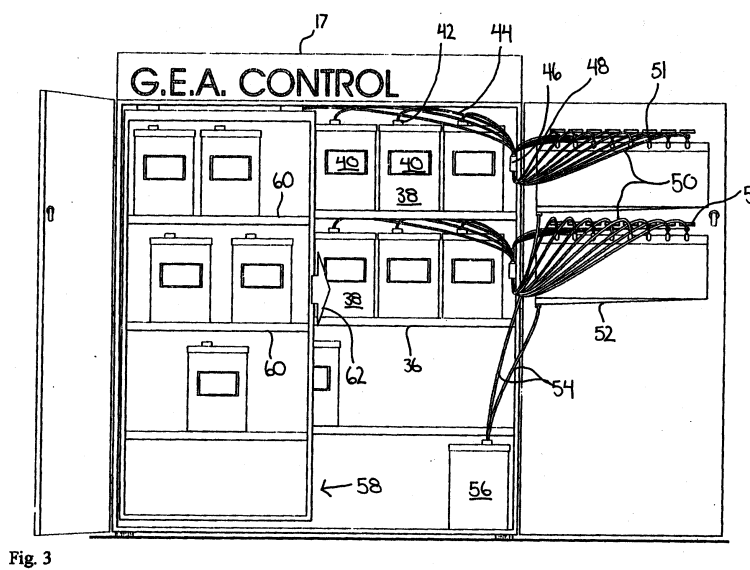
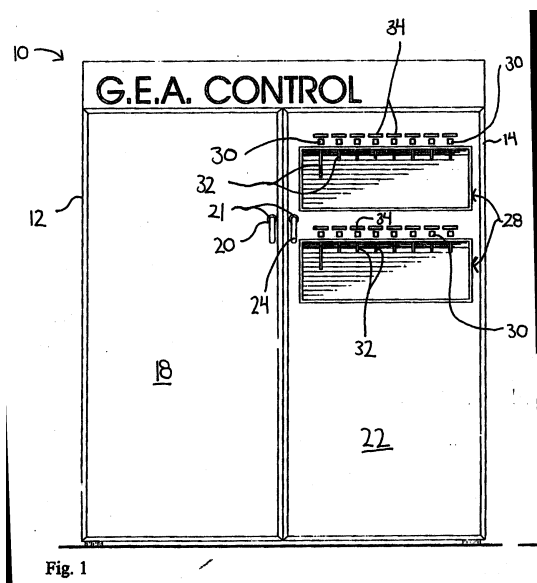
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This decision deals with the Applicant's request for a review by the Commissioner of Patents of the Examiner's Final Action dated April 30, 2004, on application 2,280,346 filed on August 17, 1999 and entitled "DISPENSER APPARATUS". The inventor/applicant is Mario Dion.

A hearing before the Patent Appeal Board was held on May 18, 2005. Appearing on behalf of the Applicant was Mr Eric Fincham, Patent Agent for the applicant. Representing the Patent Office were Mr Mazen Hijazi, the Examiner in charge of the application and Mr Claude Mathieu, Section Head.

The application relates to an apparatus which is used in car dealerships to store and dispense several different types of cleaning chemicals which are contained in bulk containers.

Figure 1 is a front elevation of the dispensing apparatus and figure 3 is a front elevation of the dispensing apparatus with the front doors open to show the interior.



The apparatus comprises an enclosed cabinet which has front doors 18 and 22. Inside the cabinet are shelves 36 which support bulk containers 38, each of which has a dispensing outlet 42. Each conduit 44 is placed in an outlet 42 and is connected to an electric motor 46 which pumps the liquid from one of the containers, through conduit 44 to dispensing conduit 32.

There are 12 claims in the application, with claim 1 being an independent claim directed to an apparatus and claim 10 being an independent claim directed to a method of controlling costs and inventory in a service department. Claims 2 to 9 depend on claim 1 and claims 11 and 12 depend on claim 10.

Claims 1 and 10 read as follows:

1. In an automobile dealership having a service department and wherein there are a plurality of flowable products in bulk containers for use within the service department, the improvement comprising a storage and dispensing device, said storage and dispensing device comprising:
 - a cabinet having a plurality of shelves therein, said bulk containers being placed within said cabinet on said shelves;
 - a plurality of dispensing outlets located in a wall of said cabinet;
 - a plurality of individual pumping means;
 - first conduit means extending between each bulk container and a respective one of said pumping means; and
 - second conduit means extending between each one of said pumping means and a respective outlet.
10. A method of controlling costs and inventory in a service department of an automobile dealership wherein a plurality of flowable products in bulk containers are used for servicing a vehicle, the method comprising the steps of:
 - installing a cabinet having a plurality of shelves therein, for receiving said bulk containers, a plurality of dispensing outlets being located in a wall of said cabinet, a plurality of individual pumping means, first conduit means extending between each bulk container and a respective one of said pumping means and second conduit means extending between each one of said pumping means and a respective dispensing outlet;
 - placing said bulk containers on said shelves and restricting access to said bulk containers; and
 - permitting the dispensing of individual predetermined portions of said products from said bulk containers.

On April 30, 2004 the Examiner issued a Final Action in which he rejected all of the claims and the

whole application as being obvious over cited prior art.

In the Final Action, the Examiner cited the following United States patents:

4,830,223	May 16, 1989	Priest
5,988,451	November 23, 1999	Hanna
4,856,676	August 15, 1989	Emody

Patent 4,830,223 shows a drinking water dispensing system which comprises a cabinet in which is stored a water container. Water is drawn from the container through an outlet tube by a pump and it is delivered from the pump to a dispensing location by a second tube.

Patent 5,988,451 shows a system which is adapted to dispense cleansers such as liquid soap in a wash room. The system is contained in a cabinet and includes a bulk reservoir of soap, a conduit which carries soap from the reservoir to the inlet of a pump and a soap dispenser which dispenses soap which has been pumped by the pump.

Patent 4,856,676 shows a juice dispenser. A separate container for each type of juice concentrate is stored in a refrigerated cabinet. Concentrate is dispensed through a tube from one of the containers, is mixed with water and is dispensed at a dispensing location.

In his Final Action, the Examiner had the following to say about obviousness:

The claims on file do not comply with Section 28.3 of the Patent Act. The subject matter of these claims would have been obvious on the claim date to a person skilled in the art or science to which they pertain having regard to Priest or Hanna and in light of the common general knowledge with regard to Emody and in the art. The aforementioned cited references disclose the essential characteristics of the claimed device as set forth in the defective claims: A dispensing device comprising a cabinet, a plurality of dispensing outlets, a plurality of pumping means, first conduit means and second conduit means, all of which are taught by Priest or Hanna with regard to the common general knowledge taught by Emody and in the art. Furthermore, any minor differences between the aforementioned cited references and the instant application are inconsequential and do not constitute a patentable distinction from the prior art.

Applicant's Arguments

The applicant argued in the correspondence dated March 25, 2004 that the invention in the instant application is related to an improvement in an automobile dealership and that none of the cited references are related to or mention anything about an automobile dealership. Furthermore, the applicant argued that the claims in the

instant application are directed towards a “new purpose which was well known before, but for a different purpose”, which makes them “valid provided that the new application of the old matter is quite new and distinct from what was used before”.

Although none of the aforementioned cited references mention anything about an automobile dealership. A person skilled in the art or science to which they pertain would be led to the invention in the instant application. The instant application as well as the aforementioned cited references are all classified under the International Classification B67D, which is directed to dispensing, delivering, or transferring liquids. A person skilled in the art or science to which the instant application pertain would be led easily to the instant application in light of the aforementioned cited references regardless of the environment where the invention is applicable. The aforementioned cited references disclose the essential characteristics of the claimed device in the instant application.

In its reply to the Final Action, the Applicant stated, in part:

The Examiner has dismissed Applicant’s previous argument based on the classification of the application and the statement that “a person skilled in the art and science to which the instant application pertains (sic) would be led easily to the instant application in light of the aforementioned cited references regardless of the environment where the invention is applicable”.

The above statement is believed to be totally contrary to what is established in the Canadian Jurisprudence. The discussion below will highlight several of the decisions which are totally opposed to the Examiner’s line of reasoning.

In the case of patents that have as their subject matter a new use of an old apparatus, process or materials, the doctrine of analagous use establishes the two following propositions that were first enunciated by Lindley L.J. in *Gadd and Mason v. The mayor of Manchester: (1892), 9R.P.C. 516 at 524.....*

(1) if the new use is the result of no additional ingenuity in overcoming fresh difficulties but is merely analogous to the old use the patent is bad and cannot be supported.....

(2) if the new use involves practical difficulties that the patentee has been the first to see and overcome by some ingenuity of his own, the patent is valid.....

These two principles were commented upon by Maclean J. In *Belding-Corticelli Ltd et al v. Kaufman*: “*If the alleged new use so nearly resembles the other use to which the invention was applied, or known to be applicable, that it might have been suggested by them to persons skilled in the art, the new use is regarded as resulting from an exercise of imitative not the creative faculties, and hence is not an invention in which the discoverer can have an exclusive right. If, on the other hand, the new use is so unlike in its essential character to the preceding ones that it required an exercise of inventive skill to produce it, then the use is a new invention and is patentable.*” [1938]Ex. C.R. 152 at 160; [1940] S.C.R. 388; see also *Acetylene Illuminating Co. V. United Alkali XCo. Ltd (1905), 22 R.P.C. 145 at 155, per Lord Davey*: “*You cannot have a patent for an new use of an old machine or process unless there be some novelty or invention in the adaptation of the old process to the new use, or the overcoming of some difficulty which lay in the way of such application. One*

test which is often put as to whether such an application of an old process would be good subject matter for a patent, is whether it lies in the track of the old use or not.”

The above is believed to be directly applicable to the present case under consideration. The prior art cited by the Examiner relates to a water delivery system and in one of the patents, to a dispenser for juice concentrate. Claims 1 to 9 of the instant invention are directed to an improvement in an automobile dealership which has a service department. The claims are clearly restricted to a specific environment and do not attempt to claim any dispenser per se.

The restrictions of the claims to the improvement are believed to clearly differentiate over the prior art. As set forth above, it does not fall within the first proposition wherein the use is merely analogous to the old use. Applicant cannot see any comparison between dispensing juices or water and the improvement defined in the service department of an automobile dealership. In other words, the essence of the decisions set forth above are that the must [sic] uses must be so nearly resemble each other that the use would be regarded as analogous to previous uses.

Thus, it is being held that where the new use is different in operation and different in purpose it is not analogous to the old use.....

The Applicant also submitted a letter of support from Mr Ronald Spinelli who is General Manager of the Spinelli Group. This organization operates 5 different car dealerships in the Montreal area. In his letter, Mr Spinelli outlines various problems that are encountered in the automobile detailing business and how the “GEA CONTROL” is a cost efficient tool that overcame those problems.

This letter caused some confusion because Mr Spinelli refers specifically to the use of “a product distribution vending machine” in an automobile detailing centre. As the Board understands the term “vending machine”, it describes a self-service machine which dispenses a unit of a product after a coin or token has been inserted into it. This is not what is shown in the instant application so it is not clear if Mr Spinelli is referring to the same device. Also, the application is related to the use of a dispensing device in the specific location of an automobile service department but Mr Spinelli refers to an automobile detailing centre. While these two locations may be in the same area of an automobile dealership, they are not the same. As a result, the Board did not consider this letter in making its decision.

After studying the positions of the Applicant and the Examiner, the Board concludes that there is no disagreement between the parties that the dispensing device *per se* is not the inventive feature of this application. The Examiner has cited prior art which shows that very similar dispensing devices are known. At the hearing, Mr Fincham stated that the device itself is probably known and that it is the environment that is the invention.

The Applicant has included a quote from *Fox, Canadian Patent Law And Practice, Fourth Edition, Carswell, 1969* which sets out the requirements for patentability in situations of a new use of an old apparatus, processes or materials. In order to be patentable, the new use must have presented some difficulties which required some ingenuity to overcome. One of the leading cases which deals with the new use of an old device is *Canadian General Electric Co. Ltd. V. Fada Radio Ltd. (1930), 47 R.P.C., 69*. That case concerned the validity of a patent which was directed to an apparatus and method for tuning a radio in which a vacuum tube was used in a tuned circuit. Lord Warrington of Clyffe, speaking for the Judicial Committee of the Privy Council had the following to say at page 90 of that decision:

It is true that the fact that increased selectivity was apt to result in a diminution of signal strength had been realized by others, and certain devices had been suggested to overcome it, for example, the employment of a relay in a mechanical or accoustic form by *Lorenz*. For this purpose, *Alexanderson* suggested the use of the vacuum tube for coupling the several circuits together at each relay. In their Lordships' opinion, following that of Mr. Justice Maclean, and assuming that for this purpose that *Alexanderson's* suggestion had not been anticipated, the assembling by *Alexanderson* in one device of the instrumentalities which furnish means for providing selectivity, progressively improving from circuit to circuit, and at the same time preserving the signal strength, displayed sufficient invention to support his Patent. It is true that the vacuum tube which in *Alexanderson's* invention performs the function of keeping up the signal strength, was not itself new, but the particular use of it for the purpose described in combination with the other elements of the system, and producing the advantageous result, is, in their Lordships' opinion, a sufficient element of novelty to support the Patent. It may be only a small step, but it is a step forward, and that is all that is necessary so far as subject-matter is concerned.

In that patent, a vacuum tube, which was a well known device and had been used previously in other applications, was used for the first time to couple circuits together. This new use of an old device was found to be sufficient to support a patent.

In the instant application, the Applicant also asserts that the invention lies in a new use for an old device. In this case, the alleged new use of the dispensing apparatus is in the service department of an automobile dealership. However, unlike the use of a vacuum tube in a new part of an electrical circuit, where it carries out a new function and achieves a new result, the dispensing device of the instant application operates in the same way as previous dispensing devices and achieves the same result; controlled release of a flowable product from a bulk container.

The Applicant has also stated that an inventive feature set out in the application is the use of the dispensing device in the specific environment of an automobile dealership service department. This could only be a patentable concept, if the inventor had demonstrated that, in adapting the old device to

use in the new environment, some difficulties had to be overcome. The Board has conducted a careful review of the application and has found no indication that the inventor encountered any difficulties in commencing use of the dispensing device in an automobile dealership service department.

As a result of this analysis, the Board concludes that apparatus claims 1 to 9 are obvious in view of the prior art cited by the Examiner.

With respect to method claims 10 to 12, the preamble to these claims sets out that the method being claimed is one which controls costs and inventory. However, the method which is set out in these claims merely recites the steps of installing and using the dispensing device which is claimed in apparatus claims 1 to 9. One incidental result of using a dispensing device of the type shown in the prior art and in this application may be that there is less of the products being wasted so costs are reduced. However, an unsupported claim to a method of achieving cost savings cannot be used to justify patentability. As a result, the Board has concluded that method claims 10 to 12 also lack patentable subject matter.

In summary, the Board has concluded that all of the claims of the application and the application itself are obvious in view of the prior art which was cited by the Examiner.

The claims on file do not comply with Section 28.3 of the Patent Act. The subject matter of these claims would have been obvious on the claim date to a person skilled in the art or science to which they pertain having regard to the references cited by the Examiner.

The Board therefore recommends that the Examiner's rejection of the application be affirmed

Michael Gillen
Chairman

John Cavar
Member

M. Wilson
Member

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.

David Tobin

Commissioner of Patents

Dated at Gatineau, Quebec

this 4th day of December, 2006