

Commissioner=s Decision #1297
D cision de la Commissaire #1297

TOPICS: L00, L51, L52
SUJETS: L00, L51, L52

Patent No : 2,062,732
Brevet n  : 2,062,732

COMMISSIONER'S DECISION SUMMARY

C.D. 1297

Patent No. 2,062,732

The patentee submitted two applications for reissue in relation to a patent concerned with mutant protease enzymes for use in detergent compositions. The Patentee sought to have the patent reissued on the basis that it was defective or inoperative by reason of the failure to include claims directed to numerous embodiments and aspects not covered in either the issued patent or in a divisional application B which the patentee's agent did not file despite being instructed to do so. The applications for reissue were forwarded to the Patent Appeal Board from the Reissue Board principally due to a lack of evidence that the intent of the Patentee was not fulfilled by the issued patent.

Not being satisfied that either application established that an error had occurred which led to the original intention of the patentee not being fulfilled, the Patent Appeal Board recommended that the Commissioner refuse both applications for reissue.

The Commissioner agreed with the Board=s recommendation and both applications for reissue were refused.

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Two applications for reissue of Patent number 2,062,732 having been considered to be non-compliant with subsection 47(1) of the *Patent Act*, have been reviewed. The applications for reissue have been considered by the Patent Appeal Board and by the Commissioner of Patents. The findings of the Board and the decision of the Commissioner are as follows:

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INTRODUCTION

- [1] This decision deals with a review by the Commissioner of Patents of the findings of the Reissue Board in respect of two applications for reissue in relation to Patent No. 2,062,732 entitled AA MUTATED SUBTILISIN PROTEASE.® The patentee is Novo Nordisk A/S; Novozymes A/S.
- [2] The patent generally relates to mutated subtilisin protease enzymes with different charge properties over those of the non-mutated enzyme. The enzymes are said to have improved wash performance in comparison to non-mutated enzymes and are therefore more suitable for use in detergent compositions.

BACKGROUND

- [3] The subject patent issued on May 23, 2000 and a first application for reissue was filed on June 9, 2003. A Preliminary amendment® to the new claims sought through the reissue application was submitted by the patentee on January 9, 2004. In a letter to the patentee dated March 5, 2004, the Office considered the first application for reissue to be unacceptable under ss. 47(1) of the *Patent Act*. The Patentee responded with further submissions which were received in the Office on September 8, 2004. The patentee's submissions were not considered convincing so a second letter dated October 10, 2006 was issued by the Office from the Reissue Board (hereafter the RIB®; a group existing within Patent Examination comprised of senior patent examiners which was constituted after the issuance of the first Office letter and which was newly charged with performing reviews of applications for reissue). The patentee responded to the RIB letter on October 10, 2007.
- [4] A second application for reissue was filed on May 25, 2004 (May 23 and 24, 2004 both being *dies non*). The second application for reissue was also considered by the RIB to be unacceptable and the patentee was so informed in a letter dated October 25, 2006, to which the patentee responded on October 25, 2007.
- [5] The RIB, having maintained their positions that neither application is acceptable, referred both applications for reissue to the Patent Appeal Board for final review. Both applications for reissue will be dealt with in the present decision.

[6] The patentee was invited by the Board to present additional submissions at a hearing but declined to do so. Accordingly the Board must consider whether either application for reissue is compliant with subsection 47(1) of the *Patent Act* based on the record as it now stands.

REISSUE: LEGAL PRINCIPLES

[7] Subsection 47(1) of the *Patent Act* states the following:

Whenever any patent is deemed defective or inoperative by reason of insufficient description and specification, or by reason of the patentee=s claiming more or less than he had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention, the Commissioner may, on the surrender of the patent within four years from its date and the payment of a further prescribed fee, cause a new patent, in accordance with an amended description and specification made by the patentee, to be issued to him for the same invention for the then unexpired term for which the original patent was granted.

[8] Therefore there are several requirements to be met even before the Commissioner may exercise her discretion to cause a new patent to reissue under ss. 47(1), namely: a) that it be defective or inoperative by reason of insufficient description and specification, or by reason of the patentee=s claiming more or less than he had a right to claim as new; b) that the error, or defect, arose from inadvertence, accident, or mistake, without any fraudulent or deceptive intention; c) that the patentee surrender the patent within four years from its date and pay a fee; and d) that the reissued patent be directed to the same invention as the original patent.

[9] In *Re Application for Reissue by Leurdijk* (2009), Commissioner's Decision No. 1289, the Board provided an overview of the relevant case law concerning reissue and set out a number of basic principles which are helpful in the present review:

- (1) In order to exercise the discretion in granting a reissue, the Commissioner must be satisfied that the patent is defective or inoperative and that the defect (or error as it is in ss. 47(1)), arose through inadvertence, accident or mistake.
- (2) The defect is limited to one of insufficient description or specification, or the

patentee having claimed more or less than he had a right to claim as new.

- (3) In determining whether a patent is defective or inoperative, it must be established by the person requesting reissue, that the issued patent does not express the original intention of the patentee.
- (4) Objective evidence is necessary in order to establish such intention.
- (5) The invention claimed by reissue must find support in the original patent (i.e. be directed to the same invention).

THE FIRST APPLICATION FOR REISSUE

Parts 3, 4 and 5 of the First Application for Reissue

- [10] Parts 3, 4 and 5 of an application for reissue require careful consideration.
- [11] In part 3 of the first application for reissue, the patentee simply states that the respects in which the patent is deemed defective or inoperative are ~~A~~by reason of the patentee claiming more or less than patentee had a right to claim.@
- [12] In part 4 the patentee indicates that various subtilisin mutations are listed throughout the original specification as filed, that the originally filed claims included recitations of these various modified/mutated subtilisin enzymes and that they therefore constitute various embodiments of the invention. The patentee goes on to assert that the error which gave rise to the defective or inoperative patent arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention, in the following manner:

In prosecuting the '732 application, the patentee's patent agent erred in failing to fully appreciate and consider all embodiments of the subject invention that the patentee intended to pursue.

...

[t]he patentee's patent agent filed a response to the [first] office action by amending the claims of the '732 application to correspond with those issued in one of the US cases corresponding to the '732 application, namely US patent number 5,665,587, issued on September 9 1997. However, the patent agent erred in failing to follow the patentee's instructions to seek protection for other embodiments of the subject invention with additional claims. In so doing, the patent agent erred in failing to consider and include claims to aspects of the invention that the patentee intended to claim

and that the patentee had a right to claim. The claims that were inadvertently and erroneously omitted by the patent agent were successfully prosecuted by the patentee in the United States.

...

The claims being sought by this petition for reissue comprise claims 51 - 396, which correspond with the claims that were allowed in the corresponding US Continuation applications. The patentee's intention to claim the subject matter of new claims 51 - 396 is clearly evident in the disclosure of the '732 application, for example on pages 21 - 24 and 27 - 30, and in the originally filed claims, specifically claims 1, 2, 5 and 6.

[13] Part 4 also includes details of several subsets of particular embodiments, particularly modified mutant enzymes, and detergent compositions, all of which are now claimed in the newly submitted specification but which the patent agent allegedly neglected to submit during prosecution of the application.

[14] In explaining the events that led to the application for reissue, the patentee had the following to say in part 5 of the application:

a) In reviewing the case files relating to the series of filings corresponding to the '732 patent, the patentee noted that the patent agent in Canada had only included a subset of claims desired by the patentee and requested clarification from the patentee's patent agent.

b) On June 20, 2001, the patentee was advised by the patent agent that, due to inadvertence, accident, or mistake, certain claims desired by the patentee were not pursued in the '732 application.

c) Subsequently, on July 17, 2002, the patentee was advised by the patent agent that a reissue application may be filed to claim the subject matter that the patent agent failed to include during prosecution of the '732 application.

[15] On January 9, 2004 the patentee submitted Preliminary amendments to the reissue claims.

The Office Letter of March 5, 2004 and the Patentee's Response

[16] The first letter from the examiner then responsible for considering the first application for

reissue indicated that the application did not meet the requirements of ss. 47(1) of the Act for the following reasons:

(i) the patentee has reasserted claims deliberately cancelled during prosecution in order to overcome an objection made by the examiner in an office action;

(ii) the claims now being sought are broader in scope than those presently found in the issued patent; and

(iii) the application for reissue fails to establish that it was the patentee=s intent to claim the subject matter of the reissue claims.

[17] It also appeared to the examiner that the reissue claims corresponded to claims found in two corresponding United States patents which issued long after the patentee received the Notice of Allowance in respect of the original Canadian patent. The examiner further noted that: certain reissue claims corresponded to claims found in another co-pending Canadian application which has gone abandoned; that the patentee has not provided evidence of intent in the form of correspondence indicating the patentee=s instructions to the Canadian agent; and that the patentee has not provided evidence of the circumstances under which the patentee obtained knowledge of the agent=s mistake. Finally, the examiner indicated that the January 9, 2004 claim amendments could not be considered since only corrections of typographical errors are permitted in reissue applications.

[18] The Office received submissions from the patentee on September 8, 2004 and was provided with copies of correspondence between the patentee and the agent dated June 20, 2001, June 8, 1999 and June 8, 2001. The patentee pointed out that the June 8, 1999 correspondence instructed the agent to file a divisional application Acovering subject matter not covered by the claims now being filed [in response to the Office action].@ The June 8, 2001 correspondence is an enquiry from the patentee asking whether a divisional application was ever filed as per their instructions. In the June 20, 2001 correspondence the agent advises that, in fact, no divisional application was ever filed and describes the failure to file the divisional application as a regrettable oversight missed during the urgency to reply to the Office action.

The Second Office Letter from the RIB and the Patentee=s Response

[19] On October 10, 2006 the RIB, having taken over the matter, issued a second Office letter and maintained that the application for reissue was still not acceptable.

- [20] Regarding part 3 of the application, the RIB principally maintained that the failure to file a divisional application is not an error in respect of the issued patent and therefore cannot be a mistake, as recognized under ss. 47(1), in respect of that same issued patent. The RIB also noted that the abandonment of the co-pending application cast doubt on the patentee's alleged intent to ever claim certain subject matter also found in the co-pending application and now claimed as such in the application for reissue. Finally, the RIB contended that the reassertion of claims deliberately cancelled during prosecution is unacceptable.
- [21] Regarding part 4 of the application for reissue, the RIB acknowledged that evidence in the form of correspondence between the patentee and the agent did seem to establish that something had indeed gone awry. That something apparently was the failure to pursue an alternate avenue of protection by a divisional application for subject matter not covered by the issued Canadian patent but which did eventually issue in two other United States patents. The RIB pointed out that the correspondence of June 8, 1999 did not explicitly and specifically indicate what subject matter was to be filed in the divisional application; that is, on June 8, 1999 the relationship between the unprotected subject matter which the patentee gave instructions to file in the divisional application and the claims as they now appear in the application for reissue was unclear.
- [22] Part 5 of the application for reissue was considered to be acceptable since the correspondence did establish the manner in which the knowledge of the new facts giving rise to the application for reissue were obtained by the patentee.
- [23] On October 10, 2007 the patentee replied to the letter from the RIB. Regarding the abandonment of the co-pending application containing some of the claims (detergent claims) now sought by something said by the RIB to cast doubt on the patentee's intent to claim that particular subject matter the patentee pointed out that co-pending Canadian application 2,034,486 was owned by Unilever PLC, and not by the patentee. As such, the patentee submitted that any failure to pursue the detergent claims in the '486 application should therefore bear no relevance to any determination that the patentee had sufficient protection, nor should any doubt be cast on the intent of the patentee based on the fate of the '486 application.
- [24] Further, the patentee maintained that their intentions were clearly expressed in the email to the agent wherein instructions were given to file a divisional application for subject matter that, at the very least, consisted of the subject matter of claims cancelled after the first and only Office action. The patentee notes that these claims were clearly included in the application prior to their cancellation, something indicating clear evidence of intent to

seek patent protection for the subject matter of those claims. This additional subject matter having been described in the patent specification ought to form the basis for a legitimate reissue application since an error or omission arose during prosecution resulting in the patentee claiming less than he had a right to claim. The patentee also stated that:

We submit that it is clear from the evidence of record that the patentee intended to seek a patent for subject matter not included in the amended claim set. We further submit that the evidence leads to the conclusion that, at a minimum, the patentee would not have agreed to the removal of any subject matter from the claims as filed had it known that its clear instruction to its agent to file a divisional application would not have been heeded. Accordingly, we submit that the '732 patent does not accurately express the intention of the patentee with respect to the scope of the claims which were ultimately included in the issued patent.

THE FIRST APPLICATION FOR REISSUE: ANALYSIS

- [25] We do not agree that the patent is defective since it claims less than the patentee had a right to claim. The patentee has argued that, through the application for reissue, he now and always had the right to claim the subject matter defined in claims cancelled after the first and only Office action and that this constitutes claiming A less than@ he had a right to. However, the record establishes that subject matter of the reissue claims was cancelled after the issuance of an Office action. This means that this subject matter was effectively abandoned in the then pending application, apparently in the interest of advancing prosecution in view of cited prior art and other objections so as to obtain a patent. This does not necessarily mean that the subsequently issued patent is defective or inoperative, it can simply mean that the patent was prosecuted by both the Office and the patentee in an expedient manner.
- [26] Though there may have been an error committed on behalf of the agent in not following the patentee=s instructions to file a divisional application, we do not characterize this as an error committed in respect of the subject patent itself.
- [27] If the patentee intended to retain rights to the cancelled subject matter, the most prudent approach would not have been to cancel claims and/or defer determination of patentability through the later filing of a divisional application. In this regard we note that no unity of invention objection was raised during the prosecution of the patent. The patentee=s intent to file a divisional application was therefore a voluntary decision. Moreover, while it appears that there was a general intention to obtain protection for subject matter not

covered in the issued patent, there clearly was no intention to retain the subject matter of the reissue application in the patent since it was deliberately cancelled during prosecution by the Canadian agent on instruction from the patentee. Reassertion of claims deliberately cancelled during prosecution in order to obtain a patent is not a valid reason for reissue (*Re Application for Reissue by Wahpeton Canvas Co.* (1989), 31 C.P.R. (3d) 434, Commissioner's Decision No. 1147). Though there may have been an error committed in not filing a divisional application, once again, we fail to see how the cancellation of the claims can be characterized as an error committed against the patentee's intent in respect of the original patent.

[28] We note that the RIB has pointed to the fact that the co-pending application (application 2,034,486; filed on the same day as the subject patent) was abandoned before the issuance of the subject patent and has alleged that this constitutes a dedication to the public of certain subject matter (i.e. claims to detergents). From this the RIB has drawn the negative inference that the patentee never intended to seek protection for the abandoned subject matter. The patentee has pointed out that the owner of the co-pending application was Unilever PLC and not the present patentee and has argued that the existence of the co-pending application is an irrelevant consideration in the present context. On this point we agree with the patentee.

[29] The abandonment of subject matter in a co-pending application B even if the co-pending application is owned by the same entity as that of another application or patent B does not necessarily mean that it was the intent of that owner to forever dedicate that subject matter to the public. It can mean that the owner chose not to simultaneously prosecute two applications with the same, similar, or overlapping subject matter. Therefore we see the abandonment of the co-pending application as a neutral fact which need not be considered; especially given that Office records indicate that the inventors of the co-pending application did indeed assign their rights to the invention to Unilever PLC, something which indicates that it was not the owner of the present patent who relinquished their rights to the subject matter of the co-pending application. As stated above, what is more important is the fact that the subject matter B which the patentee may rightfully have wished to pursue in their own application B was later deliberately cancelled during the prosecution of their application.

[30] Regarding the particular nature of the subject matter cancelled, we agree with the view of the RIB that it is not possible to accurately correlate the subject matter that was to be filed in the divisional application with the subject matter that we now find in the reissue application. The patentee's instructions to the agent in the email of June 8, 1999 were as follows:

At the same time we would like you to file a divisional application covering subject matter not covered by the claims now being filed [and which subsequently issued to patent].

- [31] Based on this statement in the email it may be reasonable to argue that the cancelled subject matter and the subject matter to be filed in the divisional application were the same; however, there is no reason to immediately conclude that the Asubject matter not covered by the claims now being filed@ is the necessarily the same subject matter which was cancelled and which is now included in the application for reissue. There is no clear indication in the email that it was the patentee=s intent to file the cancelled claims in a divisional application. Therefore, even in respect of the never-filed divisional application, the patentee=s intent cannot be discerned on an objective basis.
- [32] For all the reasons given above we find that the first application for reissue is improper and does not meet the requirements of ss. 47(1) of the Act.

THE SECOND APPLICATION FOR REISSUE

- [33] The second application for reissue was filed on May 25, 2004. The second application for reissue was also considered by the RIB to be unacceptable and the patentee was so informed in a letter dated October 25, 2006, to which the patentee responded on October 25, 2007.
- [34] The information set out in parts 3, 4 and 5 of the second reissue application are understandably similar to those set out in the first application for reissue. However, the second application further elaborates on the manner in which the error in not filing the divisional application to cover certain embodiments occurred and it details the patentee=s filing strategies in other jurisdictions in which the patentee did file either divisional applications (in the case of Europe) or continuation applications (in the case of the United States) for the same subject matter now sought in Canada through reissue.
- [35] Attached to the second application are copies of correspondence between the patentee and their Canadian patent agent. These copies provide a more complete picture of the dialogue between the patentee and the agent beginning with the prosecution of the subject patent and ending with correspondence related to the provisions of ss. 47(1) of the Act and how it might be used to address the patentee=s needs viz. unclaimed subject matter not covered in the never-filed divisional application. Notably in exhibit AG@ the patentee asks of the agent Awhether there is any Canadian procedure equivalent to reissue in the US, which

would enable us to get broader claims@ to which the agent replies, according to exhibit AH@, that section 47 of the Act does provide for the reissue of a Canadian patent.

[36] After considering the second application, the RIB determined that it too was not a proper reissue application. They pointed out that part 3 of the second application provided scant details of the manner in which the patent was deemed defective or inoperative. Other reasons paralleled those outlined in the RIB=s letter in respect of the first application; namely, the patentee=s failure to correlate the subject matter not covered in the issued patent with that sought in the claims of the never-filed divisional application. They further pointed out that divisional practice in Canada is different than continuation practice in the United States and that there were opposition proceedings in respect of corresponding European divisional applications.

[37] In response to the RIB letter the patentee argued along the same lines as before.

THE SECOND APPLICATION FOR REISSUE: ANALYSIS

[38] We have carefully reviewed the second application for reissue, the RIB=s comments and the patentee=s response and find that the reasons set out above in respect of the first application for reissue to be equally applicable in respect of the second application. We are unable to find a material difference in the second application that would move us away from our previous findings. We therefore conclude that the second application for reissue is also not proper for the same reasons stated above. Beyond what has been said above in respect of the first application, we would add three additional comments.

[39] One additional thing which merits comment is the patentee=s reliance on their filing strategies followed in other jurisdictions as a reason for a valid reissue in Canada. In the second application the patentee states:

The filing of a Continuation application is common in US practice for obtaining comprehensive patent protection for an invention in the most expeditious manner by allowing claims not in dispute to be issued while prosecuting objected claims in a Continuation application with, where necessary, further submissions to the examiner. The patentee sought to pursue a similar strategy in Canada by means of filing a divisional application and, therefore, instructed [the Canadian agent] to proceed in doing so. The patentee had pursued the same strategy before the European Patent Office by initially filing a first application, identified as publication number

EP 0479870, which was filed on June 26, 1990, and subsequently filing a Divisional application, identified as publication number EP 0945502, which was filed on February 9, 1999, for subject matter disclosed but not claimed in the previous application. In the US, European, and Canadian cases, it was the patentee's intent to protect all embodiments of the invention disclosed in the original filing corresponding to the '732 Application. The patentee took all necessary actions in these jurisdictions to ensure that this intent was implemented. These actions were taken in the European and US cases. However, due to inadvertence or mistake and with no fraudulent intent, the patentee's instructions to take similar action in Canada was not followed by [the Canadian agent].

[40] However, arguing that the reissue application is valid based on the fact that the patentee did obtain protection in the United States for the other claims by using a different filing strategy does not change the fact that the claims were cancelled from the original Canadian patent application by the Canadian agent acting on direct instructions from the patentee.

[41] Our second comment concerns exhibit AG@ wherein the patentee has indicated that reissue is sought so as to Aenable us to get broader claims.@ The examiner pointed out in respect of the first application that the reassertion of broader claims deliberately cancelled during prosecution in order to obtain a patent is not a valid reason for reissue and we agree (*Re Application for Reissue by Dennison Manufacturing Co.* (1981), Commissioner's Decision No. 906). Of course, if it can later be proven that it was not in fact the intent of the patentee to cancel such claims, then reissue may be available. However, in this case it has not been proven that it was not the patentee=s intention to cancel the claims.

[42] Our last comment concerns a statement made in the patentee=s response of October 25, 2007:

Had the patentee understood that the additional patentable subject matter of the >732 patent would not be protected in a divisional application, as it had instructed, it would not have authorized the deletion of additional subject matter.

[43] While it may be true in the patentee=s mind that the deletion of additional subject matter would never have been authorized, there is no objective evidence on record that would support that assertion. The patentee=s instructions to replace certain claims with those found in a corresponding United States patent during prosecution of the issued patent are

manifest in the email of June 8, 1999. Taken on its face, the email simply provides two instructions: the first to replace certain claims in the issued patent; and the second to file a divisional application covering subject matter not covered by the claims in the issued patent.

- [44] Although it appears that it was generally the patentee=s intention to protect subject matter not covered in the issued patent, the email of June 8, 1999 makes it clear that it was not the patentee=s intention to maintain the cancelled subject matter in the then pending application. Given all of the above, we are of the opinion that the intent of the patentee was completely fulfilled in the issued patent and the failure to protect other subject matter in a divisional application is not an error which can be remedied by section 47 of the Act.

CONCLUSIONS

- [45] Given that we are not convinced that all of the requirements of ss. 47(1) have been met in either application we must conclude that neither application is acceptable.

RECOMMENDATION

- [46] Accordingly, the Board recommends that the Commissioner refuse to grant a new patent based on either one of these two applications for reissue.

Ed MacLaurin
Member

Paul Fitzner
Member

Stephen MacNeil
Member

COMMISSIONER=S DECISION

- [47] I concur with the findings and the recommendation of the Patent Appeal Board that the two applications for reissue be refused. Accordingly, I refuse to grant a new patent based on either one of these two applications for reissue. Under section 41 of the *Patent Act*, the Patentee has six months within which to appeal my decision to the Federal Court of Canada.

Mary Carman
Commissioner of Patents

Dated at Gatineau, Quebec,
this 11th day of December, 2009