

Commissioner=s Decision #1293
D cision de la Commissaire #1293

TOPICS: A11
SUJETS: A11

Application No : 2,159,968
Demande no: 2,159,968

COMMISSIONER'S DECISION SUMMARY

C.D. 1293

App'n No. 2,159,968

The application relates generally to devices used to protect vehicles from damage caused by minor impacts. In particular, it relates to a bumper which would replace an original vehicle bumper, but be more resistant to damage.

The Examiner rejected the application solely on the grounds that amendments made to the specification (particularly claims 1 and 5) contained new matter, which would contravene subsection 38.2(2) of the *Patent Act*. Other objections which had been raised earlier in the prosecution were held in abeyance pending resolution of the new matter issue. The Board found that the amendments made by the Applicant were to be reasonably inferred from the original specification. Accordingly the Board recommended that the Examiner's rejection be reversed and that the application be returned to the Examiner to address any outstanding defects which had been held in abeyance.

The Commissioner agreed with the Board's recommendation and the application was returned to the Examiner to address any outstanding defects.

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,159,968 having been rejected under Subsection 30(4) of the *Patent Rules*, the Final Action of the Examiner has been reviewed. The rejection has 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:

Agent for the Applicant

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INTRODUCTION

- [1] This decision deals with a review by the Commissioner of Patents of the Examiner=s Final Action on patent application no. 2,159,968 entitled APROTECTIVE MEMBER FOR A VEHICLE@. The Applicants are Robert William Bartley, Ann Marie Bartley and Rex Ian McKinnon, together as Trustees of the RWB Trust.
- [2] The application relates to devices used to protect vehicles from damage caused by minor impacts. In particular, it relates to a replacement bumper which would replace the original vehicle bumper. This replacement bumper would be more resistant to damage than the original. Various embodiments are disclosed as to the form of such a bumper including those where the bumper includes apertures for lights, cutouts for towhooks, and extensions which form a frame above the bumper to protect the front end of a truck. Figure 1 of the application, below, is illustrative of such a bumper.

BACKGROUND

(a) Prosecution History

[3] The subject application was filed on October 5, 1995 and was granted Special Order status shortly after the Applicant made a request for examination on August 27, 2002. The application was eventually rejected by the Examiner on July 30, 2007 based on the grounds that the specification (claims 1 and 5) contain new matter which would contravene subsection 38.2(2) of the *Patent Act*. This case is somewhat unusual in that prior to an office action dated March 22, 2006, the Examiner had outlined other objections under anticipation, obviousness, and indefiniteness. In the action of March 22, 2006, the Examiner even suggested that patentable subject matter might be an issue. However, upon viewing the amendments of February 1, 2006 as adding new matter, the Examiner issued a subsequent action and Final Action which only included the new matter objections based on ss. 38.2(2). The Examiner maintained the ss. 38.2(2) objections in a Summary of Reasons to the Patent Appeal Board, which was forwarded to the Applicant on November 28, 2008. Upon a preliminary review of the case by the Board, it was not clear to us, based on the record, what the status was of the previous objections made by the Examiner. The Examiner informed the Board that the other objections had been held in abeyance pending resolution of the new matter issue.

[4] Based on the prosecution record, especially the Applicant=s response to the Final Action where it was stated:

In the Final Action, the Examiner has withdrawn all prior art and non-statutory subject matter objections and bases his remaining objections on lack of support in the disclosure for

we did not believe that the Applicant understood that there were still other possible and outstanding objections based on novelty, obviousness, etc., which would need to be dealt with after this review by the Commissioner.

- [5] The Applicant was therefore contacted by the Board and confirmed that they were not aware of the possibility of further objections. In order to attempt to clarify the situation, the Examiner was asked to provide a memo to the Board to outline his position. This memo, which was forwarded to the Applicant on January 23, 2009, indicated that indeed the Examiner believed that upon completion of the review by the Commissioner, there would still be other objections to be applied, including the possibility of additional prior art. In view of this, the Board felt it necessary to act on this case as soon as possible.

(b) Findings

- [6] After a preliminary review of the Examiner=s objections under ss. 38.2(2), and the Applicant=s responses thereto, it was clear that the rejection of the application was not justified. The Applicant was informed on February 6, 2009 that neither further submissions nor a hearing was necessary. The following discussion outlines our reasons for recommending that the Examiner=s rejection be reversed.

(c) The Issue

- [7] The sole issue to be reviewed is:

Does the specification (claims 1 and 5) as amended by the Applicant in the letter of February 1, 2006 contain new matter which would contravene subsection 38.2(2) of the *Patent Act*?

DO THE AMENDED CLAIMS CONTAIN NEW MATTER?

- [8] The claims as presented in the Applicant=s response of February 1, 2006 are as follows:

1. A protective member for a vehicle, said vehicle having a front end shape defined in part by an original vehicle bumper, said protective member including a replacement bumper member shaped substantially the same as the original vehicle bumper but formed from substantially heavier gauge material to provide enhanced resistance to deformation.
2. The protective member of claim 1 further including a plurality of interconnected elements secured to the replacement bumper to form a protective frame above the replacement bumper when the replacement bumper is secured to the vehicle.
3. The protective member of claim 1 or 2 wherein the replacement bumper includes apertures registering with indicator lights on the vehicle to allow the indicator lights to beam therethrough.
4. The protective member of claim 1, 2 or 3 wherein at least the replacement bumper is formed of a metal alloy.

5. The protective member of claim 4 wherein the metal alloy contains at least one of steel and aluminum.
6. The protective member of claim 5 wherein the alloy has a thickness of at least 8 mm.

[9] For comparison purposes, the claims which were on file prior to the new matter objection are reproduced below:

1. A protective member for a vehicle in the form of a vehicle having a front end having a shape defined in part by an original vehicle bumper, said protective member being a replacement bumper contoured to match the shape of the front end of the vehicle and being stronger than the original vehicle bumper.
2. The protective member of claim 1 further including a plurality of interconnected elements secured to the replacement bumper to form a protective frame above the replacement bumper when the replacement bumper is secured to the vehicle.
3. The protective member of claim 1 or 2 wherein the replacement bumper includes apertures registering with indicator lights on the vehicle to allow the indicator lights to beam therethrough.
4. The protective member of claim 1, 2 or 3 wherein at least the replacement bumper is formed of steel or another alloy.
5. The protective member of claim 4 wherein the alloy has a thickness of at least 8 mm.

[10] The description and drawings portions of the application have not changed since they were filed.

The Examiner's Position

[11] In the Final Action the Examiner outlined his objections to the claims, in part, as follows:

Examiner's report of March 22, 2006 stated that amended claim 1 does not comply with section 38.2 of the Patent Act because: A...shaped substantially the same as the original bumper ...@ cannot be reasonably inferred from the specification or drawings as originally filed. The applicant states that support exists by directing the examiner to page 2 where Figure 1 is described: >Figure 1 -shows a protective bumper in the form of a replacement and strengthened vehicle bumper.= Applicant further states at paragraph 3 in his latest response: AFor the bumper to be a replacement bumper it must look like the original bumper.@ (emphasis added). Yet, Coiner (U.S. Patent 5,364,142) discloses a replacement bumper, and by using the same rationale must look like the original bumper; however, in the applicant's response dated February 1, 2006 states: ACoiner makes no mention anywhere to incorporate the ornamental aspects of the original bumper in the replacement structure.@....

Amended claim 1 does not comply with section 38.2 of the Patent Act because:

A... formed from substantially heavier gauge material to provide enhanced resistance to deformation ...@ cannot be reasonably inferred from the specification or drawings as originally filed. The applicant responds by stating that a patent is directed at one skilled in the art, and AOne skilled in the art of vehicle bumpers would realize that 12 mm (approximately 2 inch) is heavier by at least a factor of 3 than a conventional truck bumper.@ Once again, the onus is on the applicant to describe and claim their invention. The statement by the applicant above does not appear anywhere in the specification or drawings as originally filed and therefore, the applicant=s argument is not persuasive.

Amended claim 5 does not comply with section 38.2 of the Patent Act because:

A... where the metal alloy contains at least one of steel and aluminum ...@ cannot be reasonably inferred from the specification or drawings as originally filed.

The applicant responds by stating that a patent is directed at one skilled in the art, and ACertainly in the automotive industry, the expression >alloy= and more particularly >light weight alloy= is synonymous with aluminum. Examples include such things as >alloy wheels=.@

The word >alloy= is defined by the Oxford Concise English Dictionary as:

Aa metal made by combining two or more metallic elements ...@

The word >aluminum= does not appear anywhere in the specification as originally filed. Furthermore, the contention that >alloy= is synonymous with aluminum is unfounded, for example, magnesium is also an element used in light weight alloy wheels. Therefore, the applicant=s argument is not persuasive.

[12] To summarize, based on the Examiner=s objections, the contentious portions of the claims are the following:

In claim 1

(1) *Ashaped substantially the same as the original bumper*@, which relates to the shape of the replacement bumper,

(2) *Aformed from substantially heavier gauge material to provide enhanced resistance to deformation*@, which relates to the thickness of the material used in forming the bumper, and

In claim 5

(3) *Awherein the metal alloy contains at least one of steel and aluminum*@, which relates to the material which may be used in forming the bumper, with the Examiner contending that Aaluminum@ as a possible component of the alloy is new matter.

The Applicant=s Position

[13] In the response of January 29, 2008 to the Final Action, the Applicant quotes several court

cases in support of the contention that the disclosure and claims must be interpreted from the point of view of the skilled person. However, we note that the cases cited do not specifically relate to the issue of new matter and how it is to be assessed. The Applicant also submitted affidavits from Mark McCarthy, Managing Director of McCarthy Transport, and Nigel Bruce Randall, an expert in design/manufacture and installation of automotive components (particularly trucks) and an engineer designing automobile or truck body parts for 21 years. We will discuss these affidavits later in our analysis.

- [14] The Applicant further made reference to the previous submissions of January 10, 2007, where arguments were presented as to the propriety of the amended claim language objected to by the Examiner. With respect to claim 1, the Applicant stated, in part, that:

Applicant respectfully directs the Examiner to page 2 where Figure 1 is described as showing A...a protective member in the form of a strengthened replacement bumper...@. For the bumper to be a replacement bumper it must look like the original bumper.

The Examiner further quotes from page 3 of the description: ABumper 1 is molded to the shape of the lower front end of a truck 2 and matches the body lines of the truck@. From this, the Examiner concludes that the shape of the original bumper compared to the replacement bumper is not disclosed.

With respect, contrary to the Examiner=s suggestion, the cited passage supports Applicant=s assertion. Quite clearly, the body lines of a truck are in part defined by the original bumper on the truck. Accordingly it stands to reason that for the replacement bumper to match the original body lines of the truck, the bumper must match the original bumper shape. In other words, the bumper must be A...shaped substantially the same as the original bumper...@.

- [15] The Applicant further stated, in relation to the thickness issue:

Applicant respectfully reminds the Examiner that a patent is directed at one skilled in the art. One skilled in the art of vehicle bumpers would realize that 12 mm (approximately 2 inch) is heavier by at least a factor of 3 than a conventional truck bumper. A conventional truck bumper is typically pressed from steel sheet. In contrast, 12 mm thicknesses would be in the realm of plate rather than sheet. Furthermore, moldability rather than pressing is the preferred manufacturing process which is inconsistent with conventional thicknesses and consistent with greater thicknesses.

- [16] With respect to the issue of aluminum as a component of the alloy, the Applicant had the following to say:

The Examiner states that there is no support for the use of aluminum in the description as originally filed. Once again, a patent (or application therefor) is directed at a person skilled in the art. Certainly in the automotive industry, the expression Aalloy@ and more particularly Alight weight alloy@ is synonymous with aluminum. Examples include such things as Aalloy wheels@.

- [17] Before reviewing this case on its merits, we turn to a review of the case law relating to the issue of new matter under s. 38.2 of the *Patent Act*.

New Matter: Legal Principles

- [18] Section 38.2 of the *Patent Act* sets forth the conditions under which amendments may be made to the specification and drawings of a patent application:

Amendments to specifications and drawings

38.2 (1) Subject to subsections (2) and (3) and the regulations, the specification and any drawings furnished as part of an application for a patent in Canada may be amended before the patent is issued.

Restriction on amendments to specifications

(2) The specification may not be amended to describe matter not reasonably to be inferred from the specification or drawings as originally filed, except in so far as it is admitted in the specification that the matter is prior art with respect to the application.

Restriction on amendments to drawings

(3) Drawings may not be amended to add matter not reasonably to be inferred from the specification or drawings as originally filed, except in so far as it is admitted in the specification that the matter is prior art with respect to the application.

- [19] A recent discussion of this section was provided in *Re Martin Reesink Patent Application No. 2,207,986* (2008), 68 C.P.R. (4th) 141 (P.A.B. and Commissioner of Patents):

The reason underlying the restriction against new matter is that the filing date of an application is a critical date insofar as it is the relevant date for utility of a claimed invention, as well as the requirements of novelty and non-obviousness (excluding situations where there is a claim for priority based upon an earlier filed application, as there is no such claim in the present instance). And since the specification must be objectively assessed for compliance with the patentability requirements as of the filing date of the

application, it would be unfair to the public to permit amendments to an application after this date which add matter not suggested by the specification and drawings as they appeared on the filing date. To allow such a practice would inevitably lead to the result in some cases of a claimed invention that, based on an objective assessment of the specification on the filing date, lacked novelty, being considered as novel in view of subsequently added subject matter.

As in that case, there is no claim to priority here.

- [20] We are not aware of any guidance from the Canadian courts which speaks directly to the issue of new matter in a patent application or patent. However, as pointed out in the *Reesink* decision above, there have been decisions of the Commissioner of Patents on this point. In *Re Application No. 315,073* (1981), C.D. No. 904 (P.A.B. and Commissioner of Patents), it was stated in relation to rule 52 (now s. 38.2):

The rule poses the following question: under what conditions should the reasonable inference be made and by whom shall it be made? The clear answer to this question is: the man skilled in the art at the time the application was filed.

- [21] The assessment as to the presence of new matter, therefore, in light of the above statements, requires a comparison of the pending specification and drawings with those of the originally filed application, and a determination as to whether the subject matter of the amendments is that which would have been reasonably inferred from the original specification or drawings by the person skilled in the art at the time of filing.

- [22] In the United Kingdom, a very similar provision as to Anew matter@ exists in section 76(2) of the *Patents Act 1977*:

No amendment of an application for a patent shall be allowed under section 15A(6), 18(3) or 19(1) if it results in the application disclosing matter extending beyond that disclosed in the application as filed.

- [23] In a very recent decision, Jacob L.J., in *Corus UK Ltd v. Qual-Chem Ltd*, [2008] EWCA Civ 1177, reiterated his succinct view of added subject matter put forth in *Richardson-Vicks Patent* [1995] R.P.C. 568 at 576:

... the test of added matter is whether a skilled man would, upon looking at the amended specification, learn anything about the invention which he could not

learn from the unamended specification.

and then further stated:

So what we have to do is to ascertain what is disclosed explicitly and implicitly in the AA@ specification. This must be done without hindsight, i.e. without knowing the result being sought. The same exercise must be performed on the AC@ specification. We are looking to see whether there is an extension of subject matter.

[24] Determining what is disclosed Aexplicitly and implicitly@ is consistent with an earlier test established by Aldous J. in *Bonzel v. Intervention Ltd*, [1991] R.P.C. 553 at 574, which was quoted with approval by Lord Justice Jacob in the *Corus* case above. In our view, determining what is Aimplicitly@ disclosed is consistent with determining what is Areasonably to be inferred@.

[25] There are a couple of important warnings in Aldous J.'s test outlined in *Bonzel, supra*, which also seem applicable within our own statutory scheme, i.e. s. 38.2 (our emphasis added):

...it is appropriate to consider what has been disclosed both explicitly and implicitly. Thus the addition of a reference to that which the skilled person would take for granted does not matter: *DSM NV=s Patent* [2001] R.P.C. 25 at [195] - [202]. On the other hand, it is to be emphasized that this is not an obviousness test. A patentee is not permitted to add matter by amendment which would have been obvious to the skilled person from the application....

... it is important to avoid hindsight. Care must be taken to consider the disclosure of the application through the eyes of a skilled person who has not seen the amended specification and consequently does not know what he is looking for. This is particularly important where the subject matter is said to be implicitly disclosed in the original specification.

[26] The first warning limits the addition of matter to that which is explicitly or implicitly disclosed. In that respect everything that is common general knowledge to the person skilled in the art would not be implicitly disclosed by an application, nor would everything considered obvious by some mosaic of references. The second warning is wise advice, as one may inappropriately strain the original disclosure in an effort to find the added matter within it.

[27] In addition, although the above guidance specifies that it must be ascertained what is disclosed both explicitly and implicitly in each specification, just as in claim construction,

the analysis should be focussed on the points at issue or Awhere the shoe pinches@ (See *Laboratoires Servier v. Apotex* (2008), 67 C.P.R. (4th) 241 at para. 98, quoting Hughes J. in *Shire Biochem Inc. v. Canada (Minister of Health)* (2008), 67 C.P.R. (4th) 94 at para. 21).

Analysis

[28] In the present case, it appears that there is no debate on whether or not the amended passages are explicitly disclosed. They are not. Therefore it must be determined whether they were to be reasonably inferred or Aimplicit@ from the original specification or drawings. It is not necessary to review the whole amended specification since the Applicant and the Examiner are only debating the propriety of the three amended passages. What was to be inferred from the drawings is not at issue either. Therefore we now look to the original specification to ascertain what was implicit in it.

[29] In the ASUMMARY OF THE INVENTION@ the Applicant outlines the invention in broad terms as follows:

According to an aspect of the invention there is provided a device for protecting a vehicle comprising a protective member spanning a section of the vehicle, and mounting means to mount the protective member to the vehicle.

It will be appreciated the invention has particular advantage when installed on vehicles used in environments where minor impacts to a vehicle are more frequent than in normal driving environments. These environments include off-road places such as farms and forests.

[30] In relation to the embodiment where the protective member is a bumper, the application states (our emphasis added):

Preferably the protective member is adapted to replace an existing bumper of a vehicle or is ancillary to the bumper of the vehicle.

Preferably the protective member is formed of a durable material such as steel or an alloy. Preferably the protective member is formed of 12 mm alloy.

[31] What the invention entails is fairly broadly presented in the above passages. However, it is clear that in a preferred embodiment, the bumper is a replacement bumper and that it is formed of a material such as Asteel or an alloy@. We would point out that in fact steel itself is actually an alloy, however, we understand that it would have been clear to the skilled person that the Applicant intended possible use of an alloy other than steel. Also, the fact that the Applicant specified A12 mm alloy@ is significant. We appreciate the

unusual thickness this represents for a metal bumper, and the associated weight of such a bumper were it to be formed of steel, for example.

[32] In the ABRIEF DESCRIPTION OF THE DRAWINGS@, the Applicant describes Figure 1 as showing Aa protective member in the form of a replacement and strengthened vehicle bumper@. The person skilled in the art is here further informed that the bumper is stronger than the original, which is in line with the goal of protecting a vehicle from damage caused by minor impacts.

[33] With respect to the ADETAILED DESCRIPTION OF PREFERRED EMBODIMENTS@, the following passage is of particular relevance (our emphasis added):

Referring now to the drawings, figure 1 shows a protective member in the form of an upgraded and strengthened vehicle bumper 1. Bumper 1 is moulded to the shape of the lower front end of a truck 2 and matches the body lines of the truck 2. In this example the bumper 1 is designed to replace the original bumper on the truck 2. The bumper 1 is made of a strong and durable material such as an alloy or steel. Preferably the bumper 1 is constructed of 12 mm alloy because of its lightness, strength, and its mouldability.

[34] The latter highlighted portion indicates that the 12 mm alloy mentioned earlier is to be selected based on its Alightness, strength, and its mouldability@. Although the application does not mention a particular alloy, other than steel, passages such as this provide direction to the skilled person in selecting an appropriate material. The former highlighted passage relates to the first contested amendment to claim 1, which we will now address.

(1) Ashaped substantially the same as the original bumper@

[35] As noted above, the description makes reference to the protective member as Aadapted to replace an existing bumper@, and that, as a preferred embodiment, it can be Amoulded to the shape of the lower front end of a truck 2 and matches the body lines of the truck 2@. In their submissions of January 10, 2007, the Applicant stated in part, that (our emphasis added):

For the bumper to be a replacement bumper it must look like the original bumper....

Quite clearly, the body lines of a truck are in part defined by the original bumper on the truck. Accordingly it stands to reason that for the replacement bumper to match the original body lines of the truck, the bumper must match the original bumper shape.

[36] While we believe *Amust@* may be too strong a word, we also believe that the skilled person would appreciate from the description that in forming the replacement bumper it would presumably look very much like the original if it was to match the body lines of a truck, as an original bumper would have. However, we do not see the invention as limited to an embodiment where the bumper matches the body lines of a truck. This is merely a preferred embodiment and, as noted in the description at page 3, is not determinative of the scope of the invention. In any case, we do believe that it was to be reasonably inferred that the bumper may be *Ashaped* substantially the same as the original bumper@ based on the cited passages from the original description. Contrary to what is stated in the Final Action, we believe the Applicant has sufficiently related the shape of the original bumper with the replacement bumper in order to justify the addition of such a phrase.

[37] In the affidavit of Mark McCarthy, he states:

... it is very important to have any add-on accessories looking professional and portraying a similar look as the O.E. equipment. When we have a new model truck arrive in the fleet, we will communicate with the manufacturer and endorse the validity of having the replacement bumper blend with the body lines.

[38] While this statement is supportive of the Applicant=s position, it is not clear evidence as to what would have been common practice at the filing date of the pending application, more than ten years ago. Nonetheless, it is accepted that when the application states that the protective member is to replace the original bumper and match the truck=s body lines, it will look much like the original.

[39] The affidavit of Nigel Bruce Randall, an engineer designing automobile or truck body parts for 21 years further supports the Applicant=s position. He states:

9. Any vehicle has a shape. The shape is defined by the *Abody lines@* which is the outer contour of the panels which make up the body. A bumper is one of the body panels which defines the shape and in particular defines the shape of the lower front end of a truck. If the bumper weren=t the same as the original, its substitution for the original wouldn=t match the body lines of the truck.

10. The Examiner seems to be of the view that any *Areplacement for@* a bumper is the same as a *Areplacement bumper@*. Not only is this incorrect but it clearly contravenes the requirements set out on lines 14 and 15 quoted above, namely that: *ABumper 1 is moulded to the shape of the lower front end of a truck 2 and matches the body lines of the truck 2"*.

11. If the replacement weren=t similar in shape it couldn=t be considered as *A... moulded to the shape of the lower front end of a truck and matches the body lines*

of the truck

- [40] Mr. Randall=s statements make sense to us and reinforce our own views of the application. We therefore conclude that the phrase *Ashaped substantially the same as the original bumper* was to be reasonably inferred from the original specification.

(2) Aformed from substantially heavier gauge material to provide enhanced resistance to deformation

- [41] We noted above that the description specifies a bumper preferably formed of *A12 mm alloy* because of its lightness, strength and mouldability. The description also refers to a *Areplacement and strengthened vehicle bumper*. A *Astrengthened* bumper would, no doubt, provide *Aenhanced resistance to deformation*. We believe that one evident way to strengthen a metal bumper to a person skilled in the art would have been to make it thicker (i.e. of a heavier gauge), although this would not have been the only way. A different material may also have provided the same result. Regarding the 12 mm thickness, we realize that 12 mm would not have been a normal thickness for a bumper, and as the Applicant stated in their submissions of January 10, 2007, is more *Ain the realm of plate rather than sheet*.

- [42] In the Final Action, the Examiner contested the Applicant=s assertion that 12 mm was much heavier than a conventional bumper to a person skilled in the art by arguing that this did not appear in the specification or drawings. However, this is not the test. What is important is how the specification and drawings would have been viewed by the person skilled in the art and what they would have considered to have been reasonably inferred from them.

- [43] In the affidavit of Nigel Bruce Randall he states:

12. Generally bumpers are made by bending or pressing steel sheet of approximately 2-3 mm in thickness.

13. The specification as cited above states that preferably the *A...bumper 1 is constructed of 12 mm alloy because of its lightness, strength and its mouldability*. The specification also states that the bumper is *Aupgraded and strengthened* (page 3, line 14).

14. 12 mm is considerably thicker than a typical original truck bumper by a factor of 2. The original would not be moulded. Quite clearly therefore the specification not only *Ainfers* but teaches a thicker than original bumper as an *Aupgraded and strengthened vehicle bumper*. A *Astrengthened* requires

enhanced resistance to deformation as compared to the original bumper.

Therefore the specification teaches a bumper substantially of the same shape but thicker (i.e. heavier gauge) and accordingly stronger and more resistant to deformation (enhanced resistance to deformation).

- [44] We would agree, based on the specification of a 12 mm alloy for the bumper and the fact that it was to be strengthened, that a bumper formed from substantially heavier gauge material to provide enhanced resistance to deformation was a characteristic to be reasonably inferred from the original specification.

(3) *Wherein the metal alloy contains at least one of steel and aluminum*

[45] To reiterate, the specification states that the bumper is to be formed of steel or an alloy and that 12 mm alloy is appropriate because of its lightness, strength and mouldability. In his affidavit, Mark McCarthy states:

Throughout my entire life I have used the word "Alloy" which is simply another expression of "Alloy" and being short for aluminum. This is not just an industry abbreviation, but is the accepted phrase being used by every industry.

[46] Nigel Bruce Randall in his affidavit states:

15. To me, as a person knowledgeable in automotive terminology, the expression "Lightweight alloy" in reference to automotive parts typically refers to aluminum. While some lightweight automotive components are made from magnesium, this is not a commonly used metal except in racing applications because of challenges associated with its forming, cost and fire (magnesium burns intensely). Nevertheless I would accept that "Lightweight alloy" could also refer to magnesium in automotive applications. Accordingly the expression means at least one of aluminum and magnesium.

16. In view of the above, the sentence on page 3 at lines 17 and 18 which reads *Preferably the bumper is constructed of 12 mm alloy because of its lightness, strength, and its mouldability is clearly a reference to aluminum. Steel would be excluded by reference to Lightness and mouldability*. Conventional practice in forming steel bumpers is pressing and not moulding. Furthermore the 12 mm thickness would be exceptionally heavy were steel and material being used.

17. The fact that the word "Alloy" is generally synonymous with aluminum in automotive applications as evidenced by its common usage in automotive applications to refer to aluminum parts. By way of example, attached are Exhibits showing instances of the use of "Alloy" to refer to parts made from aluminum.

[47] While the mentioned Exhibits are not useful, as they are too recent to illustrate the meaning of the term "Alloy" in 1995, Mr. Randall's statement, along with Mr. McCarthy's, are useful, and we have no reason to doubt their validity. We agree that the skilled person would take the description as implying the use of aluminum in forming a bumper of the preferred thickness. The Examiner's reasons in the Final Action as to why the term "aluminum" is not to be reasonably inferred from the original specification, are that the word was not present and that "Alloy" is not synonymous with "aluminum". With respect to the first reason, it is not necessary that it be explicitly mentioned in the

specification. With respect to the second, it is not necessary that Aalloy@ be synonymous with Aaluminum@(or more properly, Aaluminum alloy@), only that the skilled person would understand from a reading of the original specification that an aluminum alloy would be a suitable alloy to meet the Applicant=s requirements of lightness, strength and mouldability.

[48] In view of the above, we conclude that the phrase Awherein the metal alloy contains at least one of steel and aluminum@ was to be reasonably inferred from the original specification.

RECOMMENDATION

[49] In summary, the Board recommends that:

the Examiner=s rejection of claims 1-6 of the specification as containing new matter be reversed, and that the application be returned to the Examiner to address any outstanding defects which have been held in abeyance pending resolution of the new matter issue.

Stephen MacNeil
Member

Paul Fitzer
Member

Ed MacLaurin
Member

[50] I concur with the findings and recommendation of the Patent Appeal Board that the Examiner=s rejection of the claims be reversed, and return the application to the Examiner for consideration of any outstanding defects which have been held in abeyance pending resolution of the new matter issue. As this application was granted Special Order status in 2002, any subsequent action by the Examiner, including actions in response to amendments by the Applicant, should be taken within the usual 30 working day period.

Mary Carman
Commissioner of Patents

Dated at Gatineau, Quebec,
this 17 day of June, 2009