

Commissioner=s Decision #1279

Décision du Commissaire #1279

TOPIC: L31, L35, L36, L41, L51

SUJECT: L31, L35, L36, L41, L51

Application No : 2,235,452

Demand no : 2,235,452

COMMISSIONER'S DECISION SUMMARY

C.D.1279 Application 2,235,452

Reissue Acceptability

The Examiner rejected an application for reissue under Section 47(1) of the Patent Act, on the ground that the original patent was not defective by reason of the patentee claiming less than he had a right to claim as new.

The application for reissue was refused by the Commissioner of Patents.

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

An application for reissue was submitted on 08 September 2000 for patent number 2,235,452, which was rejected by the examiner under Section 47(1) of the Patent Act. The patentee asked that the rejection be 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

Peter S. Milne

GOWLING, LAFLEUR HENDERSON LLP

Suite 4900, Commerce Court West

TORONTO, Ontario

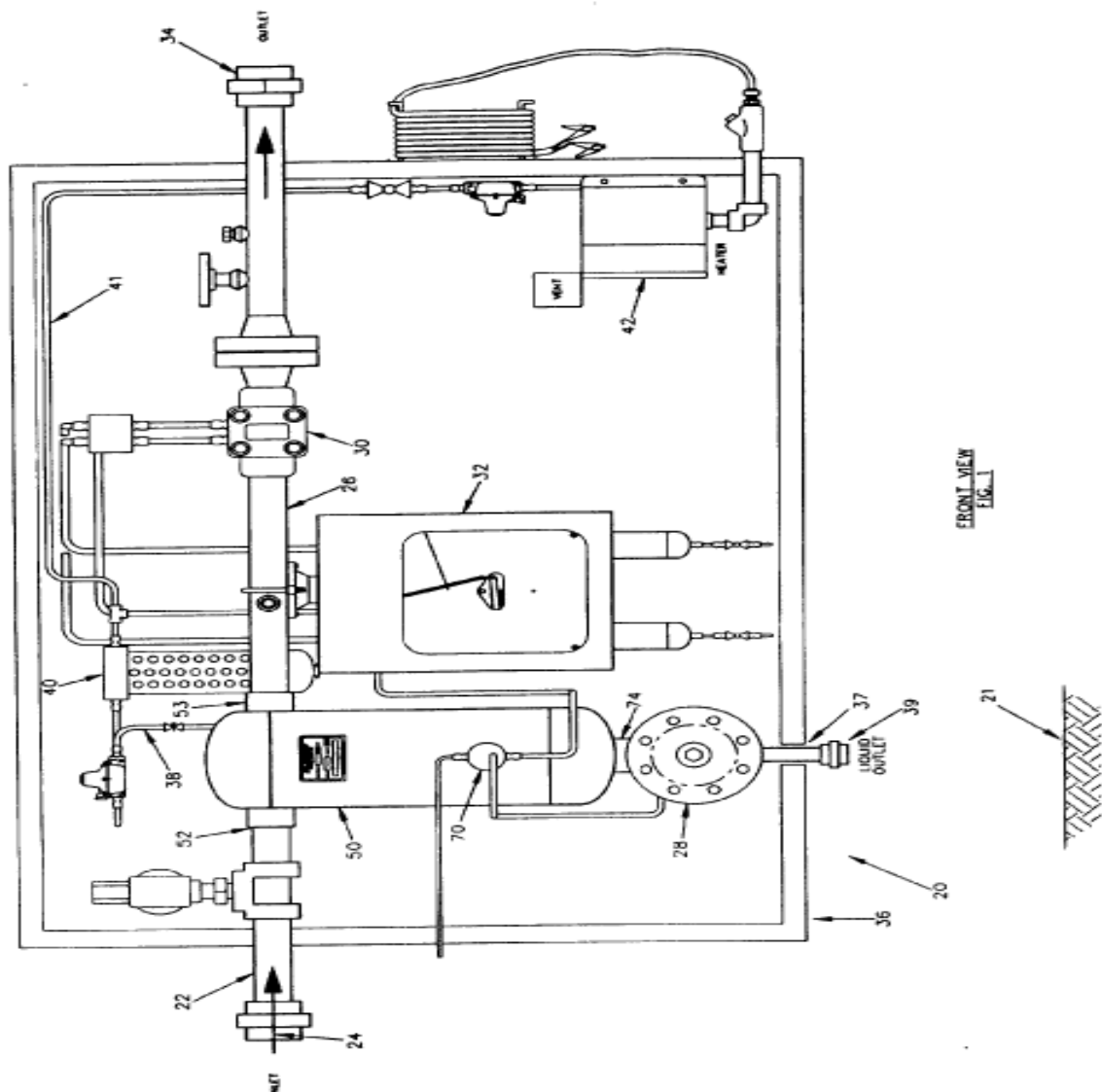
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This decision deals with a request that the Commissioner of Patents review the Examiner's rejection of an application for reissue on patent number 2,235,452. The patent was granted on 21 December 1999 and is entitled A WELLHEAD SEPARATION SYSTEM®. The patentee is Craig Nykyforuk and his representative is GOWLING LAFLEUR HENDERSON LLP. An application for reissue was submitted on 08 September 2000. The Examiner in charge rejected the petition for reissue in a letter dated 12 February 2002.

At the patentee's request, the Patent Appeal Board conducted a hearing on 09 March 2005 at 10:30 a.m., at which time the patentee was represented by Peter Milne and Anna Wilkinson of GOWLING LAFLEUR HENDERSON LLP. The inventor, Craig Nykyforuk was also present at the hearing. The Patent Office was represented by Benoit Bourgon.

BACKGROUND

The invention relates to a system for removing liquid from a gas stream exiting a natural gas wellhead, as shown in Figure 1 below. The system has an inlet pipe string (22) communicating with the wellhead for delivering the gas stream. An elongate, generally cylindrical gas-liquid separator (50) has an inlet (52) communicating with the inlet pipe string for receiving the gas stream therein. The separator separates the liquid from the gas stream to provide a dried gas stream and temporarily stores a pre-set volume of the liquid. The separator includes a disengaging chamber (54) in fluid communication with the inlet for changing the velocity of the incoming gas stream, and at least one baffle element (56) in the disengaging chamber for engaging the gas stream to urge the liquid to coalesce thereon and fall by gravity toward one end of the separator. A separator outlet (53) releases the dried gas stream to an outlet pipe string (26) for transporting the dried gas stream to a gas distribution network. An insulated enclosure (36) houses the separator and at least a portion of the inlet and outlet pipe strings.



THE REISSUE APPLICATION

Petition

The patentee believes the patent is defective or inoperative due to the restrictive limitations included in the original set of claims, stating in part:

The error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention, in the following manner:

There was failure to claim as broad a scope of protection as the applicant/patentee was entitled to at the time of filing the application which gave rise to the above patent.

The knowledge of the new facts giving rise to the application were obtained by the patentee in early 2000 in the following manner:

The patentee, being aware of the nature of his invention, sought to construe the claims in the context of industry activities taking place in Canada. It became apparent to the patentee at that time that his existing set of claims did not adequately claim his invention as he knew it.

The enclosed specification has been amended in the following respect:

Claims 15 and 16 have been amended to more clearly recite the feature of the separator body being at least partially supported above ground on at least one of the pipe strings.

New claims 31-37 have been added which are supported by the original description, and more clearly recite the feature of the separator being at least partially supported on the pipe strings.

In the issued patent, independent claim 15 (dated 1999-07-09) is as follows:

15. An apparatus for separating liquid from a gas stream to provide a dried gas stream for a natural gas pipeline wherein an inlet pipe string communicates with a natural gas well for transporting said gas stream therefrom, said apparatus comprising:

an elongate, generally cylindrical body having an inlet communicating with said inlet pipe string

for receiving said gas stream,

a disengaging chamber in fluid communication with said inlet for changing the velocity of said

gas stream,

at least one baffle element in said disengaging chamber for engaging said gas stream to urge

said liquid to coalesce thereon and fall by gravity toward one end of the body to provide

said dried gas stream,

an outlet in communication with said disengaging chamber for releasing said dried gas stream

from said body to said natural gas pipeline;

wherein said body further includes a down comer element for engaging said falling liquid from

said at least one baffle member.

Claims to be reissued

Amended claim 15 sought for reissue, is as follows [emphasis added denotes the changes proposed in comparison to issued claim 15]:

15. An above-ground apparatus for separating liquid from a gas stream to provide a dried gas stream for a natural gas pipeline wherein an inlet pipe string communicates with a natural gas well for transporting said gas stream therefrom, said apparatus comprising:

an elongate, generally cylindrical body having an inlet communicating with said inlet pipe string

for receiving said gas stream;

a disengaging chamber in fluid communication with said inlet for changing the velocity of said

gas stream;

at least one baffle element in said disengaging chamber for engaging said gas stream to urge

said liquid to coalesce thereon and fall by gravity toward one end of the body to provide

said dried gas stream;

a down comer element for engaging said falling liquid from said at least one baffle member;

an outlet in communication with said disengaging chamber for releasing said dried gas stream

from said body to an outlet pipe string in communication with said natural gas pipeline;

wherein said body is at least partially supported above-ground on at least one of said inlet and

outlet pipe strings.

Claim 16 adds the limitation of the plate member being supported from a closed end of said cylindrical body.

New claim 31 is directed to a compact system for removing liquid, and is similar to issued claim 1 in all respects except that it excludes the generally cylindrical characteristic of the separator, it specifies the separator being at least partially supported on said inlet and outlet pipe strings, and it does not specify an opening in the enclosure for permitting liquid to exit the separator and enclosure.

New claim 32 is directed to substantially self-supporting compact system for removing liquid, similar to issued claim 1 in all respects except that it specifies the separator and said portion of said inlet and outlet pipe strings within said enclosure are at least partially supported on said inlet and outlet pipe strings outside said enclosure, and it does not specify an opening in the enclosure for permitting liquid to exit the separator and enclosure.

New claim 33 is similar to issued claim 1 in most respects, except it adds the limitations of having an above ground temperature insulated enclosure, a heater for heating said enclosure, a gas metering device within said enclosure, a gas volume recording device within said enclosure, and specifies these units are at least partially supported by said inlet and outlet pipe strings.

New claim 34 is dependant upon claim 33 and incorporates a fuel gas dryer.

New claim 35 is similar to claim 1 in all respects except that it specifies "at least a portion of said system is at least partially supported on said inlet and outlet pipe strings".

New claim 36 is directed to a compact system for removing liquid, and is similar to issued claim 1 in all respects except that it excludes the "generally cylindrical" characteristic of the separator, it specifies the "separator is at least partially supported on said inlet and outlet pipe strings", and it does not specify an enclosure.

New claim 37 is similar to claim 36 except that the separator is stated as being fully supported on said inlet and outlet pipe strings.

SECTION 47(1): REISSUE ACCEPTABILITY

The Commissioner may cause a new patent to be issued, upon surrender of a patent, if the requirements of Section 47(1) of the *Patent Act* are met.

The Examiner's Position

In the letter dated 12 February 2002, the Examiner analysed the requirements for part 3 of the petition, stating in part:

In the petition for reissue, at paragraph 3, the applicant states that: "the respects in which the

patent is deemed defective or inoperative are the restrictive limitations included in the original set of claims". The patent is not considered to be defective or inoperative because of the restrictive limitations included in the original set of claims since the original set of claims is of the same scope as the original specification.

In the original patent 2,235,452, the disclosure fails to disclose the separator body being at least partially supported above ground on at least one of the pipe strings. The original patent clearly specifies that the separator is fully supported on the pipe strings. On page 3, the applicant states that the enclosure is "elevated above a ground surface and supported on said inlet and outlet pipe strings", on page 9 the applicant states that the "enclosure 36 is elevated above the ground surface 21 and is fully supported on the inlet pipe 22 and the outlet pipe 26" and on page 12, the applicant states that "the system and enclosure therefor is itself compact and lightweight so that it may be advantageously located near the wellhead and elevated above ground level without the need for any special supports".

The Examiner considered the patentee's submission under part 4 of the petition, stating in part:

In the petition for reissue, at paragraph 4, the applicant only states that there was failure to claim as broad a scope of protection as the applicant was entitled to at the time of filing the application. The item 4 is incorrect because the applicant did not explain in which manner the error arose, the applicant only states the results of the error, i.e. there was a failure to claim as broad a scope of protection as the applicant was entitled to at the time of filing the application.

Furthermore, the petition does not indicate that there was an "intention" to disclose a separator partially supported. There is no evidence to show that the applicant intended to disclose and claim a separator body partially supported on the pipe strings in the original patent. In fact, if the separator body is only partially supported on the pipe strings, an additional support would be needed to support the separator body above ground. The disclosure of the original patent teaches away from such an additional support by stating that "the system and enclosure therefor is itself compact and lightweight so that it may be advantageously located near the wellhead and elevated

above ground level without the need for any special supports, which is particularly suitable in cold climates" (page 12, lines 22-24). The applicant also mentioned on page 3 that the enclosure is "elevated above a ground surface and supported on said inlet and outlet pipe strings" and on page 9, the applicant states that the "enclosure 36 is elevated above the ground surface 21 and is fully supported on the inlet pipe 22 and the outlet pipe 26"

The Patentee=s Response

In the response dated 10 May 2002, the patentee stated:

As set out on page 2 in the first paragraph of the summary of the invention, the separator of the present invention is conducive to a uniquely efficient and compact design. The improved efficiency is realizable regardless of how the separator is mounted. The self-supporting mounting is an advantage of the improved design and not a restriction to the design.

Prior art units were heavy and had to be supported on the ground. It would be apparent to anyone remotely skilled in such structures that the present unit could similarly be mounted on the ground however, this is not a requirement and that less than total support is therefore feasible with the new design. No skilled person reading the disclosure would consider the degree of support to be a limiting factor. Accordingly, for this reason and for reasons more specifically set out below, Applicant respectfully submits that the expression "at least partially supported" is clearly within the scope of the original disclosure.

In response to the Examiner=s reference to page 9 of the description, where it is stated that the enclosure 36 is ~~A~~fully supported on the inlet pipe 22 and the outlet pipe 28", the patentee

argued that the description should not be given a restrictive interpretation, and stated:

Does the Examiner suggest that if one were for example to extend a piece of wire between the enclosure and the underlying ground surface, with an ability to support one ounce of weight that somehow this should clearly be outside of the scope of invention and the claims in the present case? Surely such a conclusion would be unreasonable. Nevertheless such a conclusion would flow from the Examiner's interpretation of the disclosure in the present case.

Further support for Applicant's position is found in the paragraph commencing at line 17 on page 12, a portion of which has been quoted by the Examiner and which in its entirety reads as follows:

"The separator of the present invention is designed based on the view that the gas from the wellhead requires more space for liquid collection than space for liquid separation. Unlike prior separator systems, the present separator combines multiple changes in gas stream direction and velocity, as well as centrifugal force (In the second embodiment), to achieve efficient separation of liquids from the gas stream in a compact space. Hence, the system and enclosure therefor is itself compact and lightweight so that it may be advantageously located near the wellhead and elevated above ground level without the need for any special supports, which is particularly suitable in cold climates.@"

The expression "may be advantageously" clearly suggests that this is a preference and not a requirement and persons skilled in such structures would readily appreciate this to be the case. For this to be a desirable option (i.e. Advantageous@) suggests that the alternative, namely support or partial support are also viable alternatives.

Hearing

At the hearing on 09 March 2005, Mr. Milne stated that the inventor, Craig Nykyforuk, was inexperienced in the complex language used in patents, and did not fully understand the

limitations imposed by claim language. He also stated that the agent who prosecuted the original application made a mistake in the language of the claims when he claimed the enclosure as being supported only on the inlet and outlet pipe strings. Mr. Nykyforuk discussed his lack of understanding of patent language at the time the patent issued. Mr. Milne referred to portions of the description and maintained his position that no skilled person reading it would understand the invention was limited in the manner of support using only the inlet and outlet pipe strings. An affidavit signed by Craig Nykyforuk was submitted outlining the events leading up to the application for reissue. Mr. Milne also provided a summary of the changes made to the issued claims by way of the application for reissue.

Guidance from the Courts on reissue

Section 47(1) of the *Patent Act* states that 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.

With respect to the error, the mere allegation of an error is not evidence of the error (*Paul Moore Co. Ltd. v. Commissioner of Patents*, 46 C.P.R. (2d) 5 at 10). Rather, the circumstances that transpired and how they resulted in an outcome that was different from the original intent of the patentee must be set out. Objective evidence is required to demonstrate the error.

The meaning of mistake was clarified in *Farbwerke Hoechst Aktiengesellschaft Vormals Meister Lucius & Bruning V. Commissioner of Patents*, [1966], 50 C.P.R. 220 at 254, where it is stated:

..the word "mistake" means that a written instrument does not accord with the true intention of the party who prepared it. A person relying upon a mistake under s. 50 [now s.47] would have to establish that the patent which was issued did not accurately express the inventor's intention with respect to the description or specification of the invention or with respect to the scope of the claims which he made.

As set out in *Northern Electric Company Limited v. Photo Sound Corp.*, [1936] S.C.R. 649 at 652, it is only in respect of inadvertence, accident or mistake affecting the sufficiency of the description or specification, that the statute contemplates relief. A reissue may not occur if the patent completely fulfills the intention of the applicant, and there is no insufficiency of description nor specification, for the applicant's purpose. In *Northern Electric* the Court stated:

The statute does not contemplate a case in which an inventor has failed to claim protection in respect of something he has invented but failed to describe or specify adequately because he did not know or believe that what he had done constituted invention in the sense of the patent law and, consequently, had no intention of describing or specifying or claiming it in his original patent.

Northern Electric (supra) also established that even though the subject matter of an amendment can be found by implication in the specification of the original patent when read with the drawings, this is not evidence of an original intent to claim differently. When it comes to demonstrating an intention to claim differently, as established in *Mobil Oil Corp. et al. v. Hercules Canada Inc.*, [1994] 57 C.P.R. (3d) 489 at 498, reversed on other grounds, [1995] 63 C.P.R. (3d) 473 at 499, the onus is on the patentee to demonstrate his or her intent to the Commissioner.

Analysis: Defects and Inoperability (petition part 3)

The patentee considers his patent is defective or inoperative by not claiming as broad a scope of protection as the patentee was entitled to receive. The remedy the patentee seeks in the petition is to claim the separator as being at least partially supported by the pipe strings. New claim 15 states the provision of @at least partially supported above ground on at least one of the pipe strings@. New claims 31-36 add a similar limitation while new claim 37 recites full support on the inlet and outlet pipe strings.

As pointed out under the summary of the claims to be reissued, the submitted claims incorporate several other changes to the claims. The preamble of claim 15 now refers to @An above ground apparatus@ instead of @An apparatus@. Claim 15 also adds releasing said dried gas stream @to an outlet pipe string in communication@ with said natural gas pipeline. New claims 31 to 37 contain several other changes, when compared to claim 1. In particular, claims 31, 32, 35, 36 and 37 appear to seek different scopes of protection by excluding or adding certain limitations, which are not related to having full or at least partial support on inlet and outlet pipe strings.

There is no explanation in the petition as to which defects or inoperative aspects of the issued patent are remedied by these additional provisions in the claims. Further, the patentee=s letter dated 10 May 2002 does not add anything of substance to justify the changes to claim 16, and claims 31 to 37. Part 3 of the petition is therefore deficient in these respects.

**Analysis: Circumstances of the Error (petition part 4) and
Discovery of the Error (petition part 5)**

In these sections of the petition, it is stated only that the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention by there being a failure to claim as broad a scope of protection as the applicant was entitled to at the time of filing the application. However, the fact that everything in the amendments is supported in the specification, is not sufficient evidence of an original intent to claim differently (*Northern Electric, supra*).

In the affidavit provided to the Board, the inventor describes in parts 21-25 how the knowledge of the new facts came about as a result of analysis in the first half of 2000 to determine if the claims of the issued patent covered competitive products. While this event may have brought the error to the inventor=s attention, it alone does not show evidence of intent. Objective evidence is needed to establish the facts supporting an original intent to claim differently, the facts or events having transpired during the prosecution and development of the application up to its issue to patent. The Board has not been persuaded that any facts supporting an intent to claim differently were evident before the time of patent issue.

Analysis: Intention to claim

Even though the petition itself provides very little evidence to assess the patentee=s original intent, for the sake of completeness, the Board has considered the patentee=s statements about his intent.

At the hearing, the patentee argued that there was never any intent to limit the claims to the particular manner of support using only the pipe strings. The patentee argued that the excerpt on page 9 (lines 17-18), pointed out by the Examiner, which states the enclosure is fully supported on the inlet and outlet pipes, is only an illustrative embodiment and does not imply

intent to claim only that manner of support. The patentee stated that the self-supporting mounting is an advantage, rather than a limitation.

In describing the enclosure on page 12 (lines 22-24) of the originally filed description, it is stated (emphasis added):

“Hence, the system and enclosure therefor is itself compact and lightweight so that it may be advantageously located near the wellhead and elevated above ground level without the need for any special supports”

It is clear that the patentee intended that the enclosure should be “elevated above ground level”. The Board considers that the expression “without the need for any special supports”, when given its clear and unambiguous meaning, implies that the use of special supports is optional, and unnecessary to carry out the invention. The Board agrees with the patentee’s contention that the self-supporting feature is an advantage of the invention. The Board can see no technical requirement to avoid special supports when carrying out the invention, as long as the enclosure is elevated above the ground level.

However, the question remains as to whether this expression gives evidence of a mistake in the patent and intent to claim differently. The Board notes that the remedy sought by inserting “at least partially supported” in the claims does not correlate precisely with the intent conveyed by “elevated above ground level without the need for any special supports”.

If the patent fulfills the original intent of the patentee, and there is no insufficiency of description nor specification, then a reissue cannot succeed (*Northern Electric Company Limited v. Photo*

Sound Corp., [1936] S.C.R. 649 at 653).

Even if the patentee did not intend to be limited by the self-supporting feature, the Board does not agree that this proves an intent to claim the separator being "at least partially supported". Claim 15, as issued, does not limit the patentee to any particular manner of support. Therefore, when claim 15 is given a proper and purposive construction when reading the description, the particular manner of support that the patentee believes is evident from the specification, should emerge. It is not proper for the Board to presume that claim 15 will be given a narrow construction regarding the manner of support in justifying a defective or inoperable patent. The outcome of such an exercise (i.e. construing the issued claims) must be established by the courts.

Although issued claim 15 is silent on the support of the separator body, the Board is not persuaded that the original intent of the patentee was not achieved. There is no evidence of an intent to claim an apparatus wherein the separator body is "at least partially supported above ground on at least one of said inlet and outlet pipe strings". The courts have held that demonstrating an original intent to claim differently than the issued claims is necessary to be successful in an application for reissue.

The patentee also states that any skilled person would realize that less than total support is feasible. However, there is no other manner of support described other than support on the pipe strings. It is not possible for an application for reissue to introduce subject matter that could not be added during prosecution. Therefore, an amendment to the claims to recite "a partial support" which implies a manner of support that has not been described, cannot be permitted under reissue. Under Section 47(1) of the Patent Act, the reissued patent must

be directed to the same invention.

The Board has considered the patentee's arguments that the self-supporting mounting is an advantage of the invention, and not a restriction to the design, and that no skilled person reading the disclosure would consider the degree of support to be limiting factor.

Again, whether or not the patentee's issued claims may be construed or purposively constructed to include the situation where the separator has partial support, cannot provide the sole basis for a reissue. A demonstration of the original intent of the patentee to obtain different claims is necessary to justify a reissue.

Findings: Reissue Acceptability

The petition only explains the changes made regarding the manner of support of the separator. There are additional changes to the claims for which no explanations are found in the petition to show that there was an original intent to obtain these claims. Based on the information provided in the petition, at the hearing, and in the inventors affidavit, the only available explanation for the changes to claims 15 and 16, and the addition of claims 31 to 37 is that the patented claims were not broad enough, and the patentee became aware of this in the context of industry activities taking place in Canada. As outlined in *Northern Electric Company Limited v. Photo Sound Corp.*, [1936] S.C.R. 649 at 652, mere support in the specification for unclaimed subject matter is insufficient to show an original intent to claim that subject matter.

The amendments to claims 15 and 16 and the addition of claims 31 to 37 must be for the purpose of claiming subject matter which was intended to be claimed in the original patent. Evidence must be adduced to show that the description or specification was insufficient to give effect to the intent of the patentee. The mere allegation of an error is not evidence of the error (*Paul Moore Co. Ltd. v. Commissioner of Patents*, 46 C.P.R. (2d) 5 at 10). A statement of the error and the facts supporting a conclusion that an error was made, are required. The circumstances that transpired and how they resulted in an outcome that was different from the original intent of the patentee must be set out.

At the hearing, the patentee stated that the prosecuting agent made an error in the language of the claims. However, no objective evidence by way of affidavit or letters that corroborate this information has been supplied. As established in *Mobil Oil Corp. et al. v. Hercules Canada Inc.*, [1994] 57 C.P.R. (3d) 489 at 498, reversed on other grounds, [1995] 63 C.P.R. (3d) 473 at 499, the onus is on the patentee to demonstrate his or her intent to the Commissioner.

No objective evidence has been provided to demonstrate an original intent to claim differently. The Board finds that the petition is deficient in these respects, and this application for reissue does not satisfy the requirements of Section 47(1) of the Patent Act.

Recommendation

The courts have held that demonstrating an original intent to claim differently than the issued claims is necessary to be successful in an application for reissue. The Board is unable to conclude that the patent is defective or inoperative for not claiming the separator as being at least partially supported by the pipe strings.

The Board finds that the information provided in parts 3, 4, and 5 of the petition is insufficient to justify this application for reissue under Section 47(1) of the Patent Act.

The Board recommends that this application for reissue be refused.

M. Gillen

M. Wilson

Member

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.

Mary Carman

Commissioner of Patents

Dated at Gatineau, Quebec,

this 6th day of September, 2007