

Commissioner=s Decision #1289

Décision de la Commissaire #1289

TOPICS: L04, L31, L32, L34, L38, L51, L54

SUJETS: L04, L31, L32, L34, L38, L51, L54

Patent No : 2,200,422

Brevet no : 2,200,422

COMMISSIONER'S DECISION SUMMARY

C.D. 1289

Patent No. 2,200,422

The application for reissue related to a storage track system on which household articles could be stored. The Patentee sought to have the patent reissued on the basis that it was defective or inoperative by reason of the failure to include dependent claims concerning various specific bracket attachments that work with the system, and dependent claims concerning the specific use of apertures formed in a groove on the lower portion of the track to secure the brackets to the track. The application for reissue was forwarded to the Patent Appeal Board from the Reissue Board due to a lack of evidence that the intent of the Patentee was not fulfilled by the issued patent, and due to inconsistencies between the alleged defects and amendments proposed to the description and claims.

The Patent Appeal Board recommended that the application for reissue be refused, not being satisfied that an error had occurred which led to the original intention of the inventor/applicant

not being fulfilled. The Board also agreed with the Reissue Board=s assessment that certain amendments to the description and claims were improper as they did not relate to the alleged defects in the patent.

The Commissioner agreed with the Board=s recommendation and the application for reissue was refused.

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

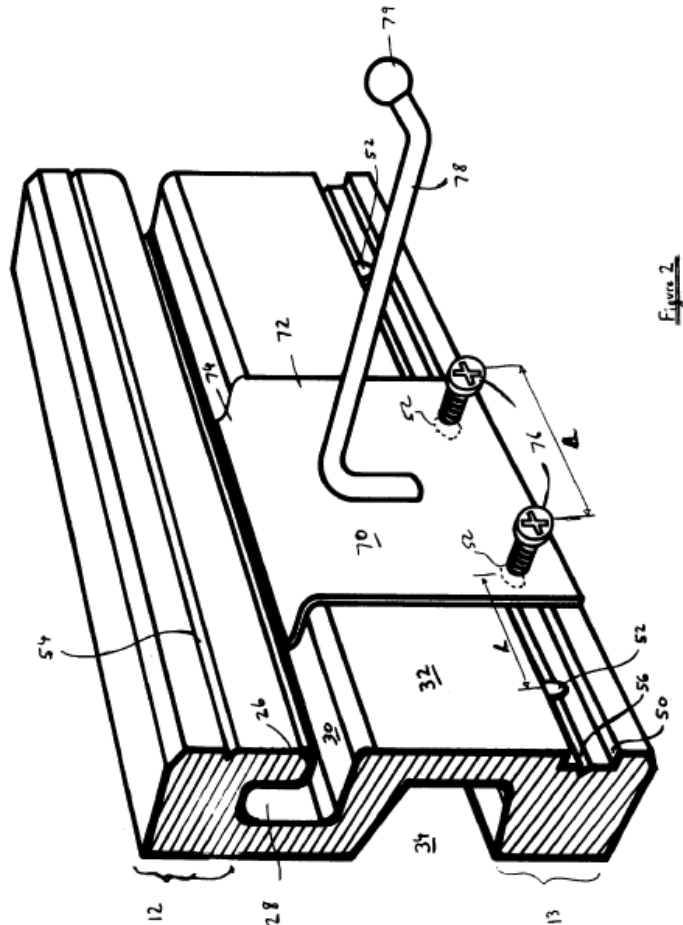
An application for reissue of Patent number 2,200,422 having been considered non-compliant with subsection 47(1) of the *Patent Act*, the application has been reviewed. The application for reissue has been considered by the Patent Appeal Board and by the Commissioner of Patents. The findings of the Board 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 opinion of the Reissue Board with respect to an application for reissue of Patent No. 2,200,422, entitled *ASTORAGE TRACK SYSTEM*®. The Patentee and inventor is Jan B. Leurdijk.
- [2] The patent generally relates to a storage track system on which household articles can be stored. The system includes a track element mountable to a wall in which is formed a groove. In the groove can be mounted the top portion of a hanger bracket or the like on which articles can be suspended. The bottom of the bracket is secured to the lower portion of the track by some means of engaging a second groove formed in the lower portion of the track. Figure 2 of the patent illustrates one embodiment of the invention:



BACKGROUND

- [3] The subject patent issued on May 7, 2002 and the present application for reissue was filed on May 8, 2006 (May 7, 2006 being a *dies non*). In a letter dated February 2, 2007, the Reissue Board (hereafter *Athe RIB*®), which is a group existing within Patent Examination

comprised of Senior Patent Examiners charged with performing the initial review of applications for reissue, considered the application for reissue to be unacceptable under ss. 47(1) of the *Patent Act*. The Patentee responded with further submissions on May 1, 2007. Despite these submissions, the case was forwarded to the Patent Appeal Board (hereafter the Board) and in the Summary of Reasons submitted to the Board, which was forwarded to the Patentee on January 9, 2008, the RIB maintained their position that the application for reissue is not acceptable.

- [4] In response to the Patentee's request for an oral hearing, a hearing was held via teleconference on June 11, 2008 at which time the Patentee was represented by Mr. J. Jay Haugen of the firm Parlee McLaws LLP. The Patent Office was represented by Mr. David Green of the RIB, while the other members of the RIB, Ms. Sophie Beaudoin, Mr. Mark Janczarski, Mr. Jason Fisher, and Mr. Stephen Decker were present as observers. Prior to the hearing, on June 3, 2008, Mr. Haugen, on the Patentee's behalf, provided the Board with written submissions in which amendments were proposed to the description and claims that were previously part of the application for reissue. These submissions were the focus of the presentations made at the oral hearing. In our later analysis we will focus on the proposed description and claims as they exist in the submissions before the Board. The earlier submissions will however, be important from the point of view of the alleged defects and the evidence submitted in association therewith.

ISSUE

- [5] The sole issue to be decided is:

Does the application for reissue comply with subsection 47(1) of the *Patent Act*?

REISSUE: LEGAL PRINCIPLES

- [6] Section 47(1) of the *Patent Act* sets out the conditions under which a reissued patent may be granted:

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.

[7] There are several requirements to be met before a patent can be reissued 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.

[8] The first of these is that the patent must be Adefective 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@. In *Northern Electric Co. v. Photo Sound Corp.* [1936] S.C.R. 649, Duff C. J., in reference to this portion of the statute, stated:

At the lowest, the statute must contemplate some kind of reasonable ground for apprehension on the part of the original patentee that the patent is defective in the sense of that section. It would, in my opinion, be an abuse of this language to apply it to a case in which it is obvious that a patent completely fulfills the intention of the applicant, where there is plainly neither insufficiency of description nor specification, for the purpose which the applicant had in view.

[9] From the above, a patent could only be Adefective or inoperative@ if it did not fulfill the intention of the applicant. Further, the defect must be a defect in relation to Ainsufficient description and specification@. The specification includes the claims and it would therefore be possible to claim by reissue something which was not previously claimed even though the patentee did not claim Amore or less than he had a right to claim as new@.

[10] The statute also specifies that such a defect or Aerror@ must have arisen as a result of Ainadvertence, accident or mistake, without any fraudulent or deceptive intention@. As Duff C. J. observed in *Northern Electric, supra*:

These conditions necessarily imply that the inadvertence, accident or mistake must be inadvertence, accident or mistake affecting the sufficiency of the description or specification in the original patent, and it is only in respect of such inadvertence, accident or mistake that the statute contemplates relief.

[11] In relation to what constitutes Ainadvertence, accident or mistake@, Duff C. J. stated in *Northern Electric, supra* (our emphasis added):

the inadvertence, accident or mistake in respect of the sufficiency of description

or specification must constitute a defect in the patent in the sense that it fails adequately to give effect to the intention of the applicant.

- [12] As highlighted in the passage above, it is what was intended by the applicant which is paramount. The inadvertence, accident or mistake, in whatever form or by whomever, must have led to a result that was other than what the inventor/applicant intended. In *Farbwerke Hoechst Aktiengesellschaft Vormals Meister Lucius & Bruning v. Commissioner of Patents* (1966), 50 C.P.R. 220 at 254 (S.C.C.), the importance of the inventor/applicant's intention was reiterated:

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.

- [13] Given that one must establish that the patent does not reflect the inventor's original intention, the question arises as to what is necessary to substantiate such a claim. To prove that there was some inadvertence, accident or mistake obviously the person seeking reissue would have to outline the events which led to the erroneous result. But what may be considered in determining what was the intent of the inventor? In *Northern Electric, supra* Duff C. J. made it clear that evidence is needed to prove what was intended when he stated:

It is also very clear on the material before us that in the proceedings before the Commissioner leading up to the grant of the reissue patent no evidence was adduced to show that the specifications, the description or the claims of the original patent were insufficient to give effect to the intention of [the inventor]. Still less was there any evidence adduced to show that [the inventor] had failed to describe or to specify sufficiently the invention in respect of which he was claiming protection by reason of inadvertence, accident or mistake. Nor indeed is there any allegation to that effect.

- [14] The last portion of the above quotation makes reference to an allegation of a defect or error. Whether or not such an allegation would suffice was commented on in *Paul Moore Co. Ltd. v. Commissioner of Patents* (1979), 46 C.P.R. (2d) 5 at 10 (F.C.A.):

The mere allegation made by the applicant that his agent had made an error is not evidence of that error or at least is not evidence from which the Commissioner or this court could conclude that an error had in fact been committed in the drafting of the claims.

- [15] So the party seeking reissue must provide some sort of evidence to prove that the prosecution of a patent application resulted in something other than what was intended. The scope of such evidence was discussed in *Mobil Oil Corp. et al. v. Hercules Canada Inc.* (1994), 57 C.P.R. (3d) 488 at 499 (F.C.T.D), rev=d on other grounds (1995), 63 C.P.R. (3d) 473 (F.C.A.) (our emphasis added):

The intention of the inventors must be derived from the objective evidence, such as the text of the patents and not from the subjective evidence of the inventors themselves: AT&T, *supra*, at p. 257. The U.S. patent naming Messrs. All and Duncan as inventors was issued with claims 4 to 7 inclusive in the specification. This, in my opinion, properly represents the intention of the inventors, namely, that these claims were intended to be included and, reading those claims purposively, that some slip agent was allowed to be present in the film, so long as it did not affect the adhesion of the film substrate to the metallized coating. Accordingly, the original Canadian patent application was deficient in that claims corresponding to claims 4 to 7 inclusive of the U.S. Patent were not included.

- [16] As stated above, objective evidence, such as the text of the patent, or evidence of what was done in other jurisdictions, as opposed to subjective evidence, may indicate that a patent is defective in that it does not represent the intention of the applicant. This view was supported by the Federal Court of Appeal in relation to the above cited case at p. 481:

The trial judge was quite conscious of the limitations to which his inquiry into the intended scope of the original patent was subject. He was sensitive to the fact that he needed objective evidence and support in the text of the patent itself.

- [17] Once a patent is issued, it must be presumed that the inventor=s/applicant=s intent has been fulfilled, a presumption which must be rebutted in order to obtain relief under s. 47 of the *Patent Act*. In *Northern Electric, supra*, Duff C.J. highlighted this notion in referring to the patent at issue in that case:

There is, of course, a presumption, which is a presumption of law, that [the inventor], in signing these documents, knew the nature of their contents.

.....

We must proceed upon the view, in the absence of some evidence to the contrary, that [the inventor] knew the contents of the documents I am now about to discuss and that he knew the effect of them in accordance with their proper construction.

- [18] There may be a strong such presumption, depending on the level of experience of the inventor with the patent system. For example, in *Northern Electric, supra*, there was a strong presumption that the inventor knew the effects of his patent, based on his extensive experience as an inventor who was accustomed to framing specifications. On the other hand in *See Curl-Master Manufacturing Co. Ltd. v. Atlas Brush Ltd.* (1967), 52 C.P.R. 51

(S.C.C.), an inexperienced inventor was able to convince the court that his patent agent did not protect the invention that he had actually made.

- [19] Section 47 requires that the patent to be reissued be surrendered within four years of its date (issue date). This requirement relates to the period within which the application for reissue must be filed (See *Curl-Master, supra* at pg. 74).
- [20] Once the requirements discussed above have been complied with, the Commissioner may grant 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 granted⁶. The requirement that the new patent be directed to the same invention was also commented on by Duff C. J. in *Northern Electric, supra*, in response to a suggestion that what was sought by reissue was to be found in the specification (including the drawing). He had the following to say (our emphasis added):

The argument involves, of course, the proposition that it is sufficient, in order to obtain relief under the statute, to show that the drawing in the original patent exhibits a device in respect of which the patentee might have claimed protection if he had asked for it and sufficiently disclosed the nature of the invention. This of course, is to discard the parts of the statute that I have been emphasizing, which make it very plain that the design of the statute is to afford relief only in respect of an invention clearly conceived as such, for which the original patentee intended to claim protection, but in respect of which, through the causes defined by the statute, there is insufficient description or specification. Identity of invention is only one of the conditions of the statute.

- [21] From this we may take that the requirement as to same invention⁶ requires that the subject matter sought by reissue be disclosed in the original patent. An invention that has not been disclosed may not be claimed (e.g. new matter). It is also evident from the above passage that mere support for a claim sought by reissue is not sufficient. The person seeking reissue must also prove that what is now claimed was intended to be protected.
- [22] In *Mobil Oil, supra*, Wetston J. referred to the same invention⁶ requirement in the same manner when he stated:

Section 47 allows for amendments to amend the claims to match the inventor's intention. Given that, the claims of the reissue patent and the original patent will be different. A requirement of the same invention⁶ necessitates that the amended claims must be for an invention as disclosed in the original patent specification, although somewhat imperfectly.

- [23] The drawings may also be referred to in order to find support for an invention which is

sought to be protected by reissue (See *Curl-Master, supra*, at page 71).

- [24] Once the requirements of s. 47 are met, the Commissioner may cause a new patent to be issued. It is important to note that the granting of a reissue is discretionary, however such discretion may only be exercised if the requirements of the statute are met. In *Bergeon v. DeKermor Electric Heating Co.* [1927] Ex.C.R. 181, Audette J. stated:

The Commissioner of Patents was given jurisdiction to grant a reissue only in the cases provided for by the statute, - the present case does not come within the ambit of the statute, - therefore the Commissioner had no jurisdiction to grant a reissue under the circumstances of the present case.

- [25] Similarly, in *Farbwerke Hoechst, supra*, the Supreme Court, in comparing the American statute with the Canadian one, stated:

[T]he American statute requires the Commissioner to reissue a patent, in the events defined, even in cases where the initial patent is invalid. The Canadian Act creates a discretion, and only in cases where the initial patent is deemed defective or inoperative.

- [26] Who bears the burden of proof with respect to an application for reissue was addressed in *Paul Moore v. Commissioner of Patents, supra*:

When an application is made for reissue of a patent under s. 50, the Commissioner may not grant the application unless he is satisfied that there is a defect in the patent which arose from inadvertence, accident or mistake. If he is not satisfied of those facts, he must reject the application; he does not have to be positively persuaded that there was no inadvertence, accident or mistake.

- [27] In other words, upon filing an application for reissue, the onus is on the patentee to establish that the application comes within the provisions of the statute, failing which the application must be refused by the Commissioner.

- [28] Given the retroactive effects of reissue under subsection 47(2), it is important that each application be carefully reviewed. In *Northern Electric, supra*, Duff C. J. pointed to this aspect:

It is to be noted that the section is retroactive in an important aspect. The amendment speaks from the date of the original patent as regards causes of action arising after the date of the new patent. Even on the strictest construction, a serious injustice may arise from the operation of this provision where people have made arrangements and expended money on the faith of the specification in the patent between the date of the original patent and of the re-issue patent, a period

which in this case extended to five years. It is our duty, I think, in the circumstances, not to extend the language of the section beyond cases clearly within its intendment.

[29] In *Creations 2000 Inc. v. Canpar Industrial Products Ltd.* (1988), 22 C.P.R. (3d) 389 (F.C.T.D.), Dubé J. expressed a similar sentiment:

Given the prejudice that the reissue of a patent might cause because of its retrospective effects, the grounds which justify such a reissue should be narrowly interpreted and the conditions provided in the abovementioned subsection should be scrupulously respected.

[30] The following basic overriding principles, which we take from the discussion above, may be helpful in reviewing such applications. However, we recognize that these may not be the only considerations which may be applicable in a given case.

- (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 s. 47), 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 inventor/applicant.
- (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 APPLICATION FOR REISSUE

[31] It is first necessary to review the grounds upon which the Patentee considers the patent to be defective. In part 3 of the application for reissue, the defects are outlined in the following manner:

The respects in which the patent is deemed defective or inoperative are that additional embodiments of the invention, which are covered by the broad independent claims, are not specifically claimed. Claims 1 and 25 of the patent describe a storage system with a track member having a lower groove and at least one hanger bracket with a lower portion adapted to engage the lower groove. Claim 1 sets forth one embodiment of the invention whereas claim 25 sets forth a broad description of the invention. Claims 13 to 20, which depend on claim 1, set out a series of various bracket attachments that work with the system. There

are no analogous series of claims for the bracket attachments that depend on claim 25. In addition, claims 22, 25 and 28 include a broad limitation that the groove on the integral lower portion is adapted to securely retain a hanger bracket to the track member. An embodiment of the invention, as disclosed in the specification as originally filed, includes apertures formed in the groove at predetermined locations in an integral lower portion to facilitate the securing of one or more brackets to the track member is not specifically claimed.

[32] Therefore, the Patentee alleges that there are two main defects in the application, namely:

- (1) there is no set of claims dependent on claim 25, which would be equivalent to dependent claims 13 to 20, and
- (2) there are no claims dependent on claims 22, 25, and 28 which specifically claim an embodiment which includes apertures formed in the groove at predetermined locations in an integral lower portion to facilitate the securing of one or more brackets to the track member.

[33] In support of this claim, the Patentee alleges that the error occurred in the following manner:

[I]n the prototype of the invention made by the Patentee and as disclosed to the Patentee's patent agent in the course of preparing the patent application, a hanger bracket was securely retained to a track member using a fastener passing through an opening in the bracket to engage an aperture in a lower groove on the track member as a means to keep the bracket from lifting up and/or away from the track member when articles are placed or removed from the bracket. This was done solely as a matter of convenience. The Patentee was aware that the invention would work equally well if the hanger bracket was adapted to engage the lower groove on the track member without using a fastener. However, the Patentee mistakenly failed to inform his patent agent that the use of apertures in the lower groove and fasteners through openings in the brackets to engage the apertures was not the only manner in which brackets can engage the track members and that it was not an important or necessary feature of the invention. The Patentee did not understand that his patent application and the limited number of claims that were prosecuted might limit the scope of his patent in a manner that he did not intend.

[34] Our initial impression upon reviewing this passage is that the allegations made in the above quotation do not appear to be consistent with the defects identified earlier. Indeed, if the Patentee was concerned that the scope of the patent might be too narrow, and that apertures and fasteners in the lower groove were unnecessary, then we do not see why the claims are allegedly defective by failure to claim these more limited embodiments. It is also noted that claims 22, 25, and 28 of the issued patent are not limited to any type of particular engagement with the lower groove.

[35] In setting out the events leading to the application for reissue, the Patentee had the following to say in part 5 of the petition:

The knowledge of the new facts giving rise to the application were obtained by the Patentee on or about September, 2000 in the following manner: the Patentee became aware of a third party's storage track system being sold in major retailers in Canada. As a result of the third party's activities, the Patentee had sought and received advanced examination of his application at that time which resulted in the patent issuing on May 7, 2002. Since the issue of the patent, the Patentee has been able to inspect the third party's storage track system in greater detail. The Patentee has observed that it is essentially the same as his storage track system in that it employs a lower groove on the track member that is engaged by a hanger bracket. Upon asking his patent agent whether the third party's storage track system would infringe his patent, he was advised that while independent claims 22, 25 and 28 of his patent are broad enough to cover alternate embodiments of his invention including the third party's storage track system, the patent did not include claims narrower in scope that specifically cover the bracket attachments sold by the third party in Canada.

[36] The above passage leads us to concerns similar to those we previously expressed in relation to the circumstances surrounding the error. Namely, the problem identified seems to be that despite the presence of broad claims covering a potential infringer's product, there are no claims to more limited embodiments which more closely resemble the infringing product. However, this problem does not appear to be one which arose due to the intent of the inventor not being fulfilled during the prosecution of the patent.

[37] Looking only at the initial application for reissue itself and the issued claims, as discussed above, it is not clear to us, based on the proposed defects and discussion of the intent of the Patentee, that what was obtained by patent was something other than what was intended. There is no evidence at this stage that there was ever an intent to include the narrower dependent claims which are proposed by reissue. In fact, as noted earlier and in relation to part 5 of the application, the inventor seemed more concerned that the scope of the patent might be too narrow. We would also note that the failure of a patent to catch a potential infringing product could not be a valid reason for reissue. However, if as a result of the

recognition of a competitor=s product, a true error as contemplated by s. 47 is discovered, then this might be made the subject of an application for reissue.

- [38] With the application for reissue, the Patentee also submitted proposed amendments to the description and claims. We will address the appropriateness of the amended description and claims later in this document with a focus on the proposed amendments presently pending before the Board.

VIEWS OF THE REISSUE BOARD

- [39] In the letter of February 2, 2007, the RIB identified the defects claimed by the Patentee, which generally accord with our own views, as stated previously. In addition, the RIB was unable to find any evidence pointing to an intention to obtain protection within the original patent, which would accord with the defects identified by the Patentee.

- [40] As part of the letter, the RIB pointed to examples of evidence which might support an application for reissue, namely:

- § originally filed claims inadvertently omitted, whether in the same application or another;
- § claims filed or issued in equivalent foreign patents/applications;
- § communications between inventors and/or agents clearly showing the inventor=s intent;
- § demonstration models of claimed devices; and/or
- § any other evidence as may be available.

- [41] We consider it necessary to comment on the above passage which attempts to set out examples of some types of evidence that might justify an application for reissue. On the first point, we must comment that it is not clear how claims which were inadvertently omitted from another application would justify amending a particular patent, as there must have been some error in the prosecution of the patent at issue in order to justify the grant of a reissued patent. It also must be remembered that an allegation that originally filed claims were inadvertently omitted must be proven by evidence. As to the second point, as established by the earlier discussion of the jurisprudence, such evidence may establish intent, but it must be remembered that the evidence as a whole must be considered. Other evidence may point away from the same intent with respect to the equivalent Canadian patent. We would point out in relation to the third point that any relevant communications establishing the inventor=s intent should pre-date the issuance of the patent to be of any practical use. Lastly, regarding demonstration models, again, these would have to

pre-date the patent grant in order to be of any use in establishing that the inventor did not obtain protection for what he/she has truly invented.

[42] The RIB also outlined concerns regarding the timing of the discovery of the error and the failure of the Patentee to timely review the competitor=s storage racks. We believe these concerns have been allayed by the Patentee=s response, which we will discuss in the next section, as such concerns neither appeared in the Summary of Reasons to the Board, nor were they brought up at the oral hearing.

[43] In the Summary of Reasons to the Board, the RIB reiterated their findings as to lack of evidence of an error, stating in relation to the Patentee=s allegations:

It is noted that the recited circumstances do not appear to correspond to the defects. The above suggests that the issued claims are too narrow in that they claim >fasteners and openings= where a broader claiming was appropriate - reviewing the recited defects, we do not see any suggestion that the defect requiring correction is that the claims are too narrow by including the >fasteners and openings=.

Beyond this point, there has been no evidence of the Patentee=s intent provided with the application for reissue - whether in regard to the explicitly recited defects, or, the further implied defect in Part 4 of the application for Reissue. Furthermore, the Reissue Board reviewed the Canadian and corresponding United States prosecutions in an effort to locate evidence of intent but reported that none was apparent.

[44] In response to a Statutory Declaration from Mr. Leurdijk, the inventor and Patentee, outlining his views on what was intended, the RIB was of the following opinion:

It would seem that the Patentee=s intent to claim broadly was already reflected in the claims, thus no defect related to an unduly restrictive >apertures intended for fasteners= embodiment is present. But, as already stated - this is not even a defect according to Part 3 of the application for reissue.

[45] To clarify the last point in the above passage, the defects identified in the application were that specific narrower embodiments were not claimed.

[46] At the hearing, the RIB, represented by Mr. David Green, reiterated the apparent lack of evidence of the inventor=s intent which would point to a defect in the patent. The RIB also highlighted the fact that mere support in the patent is not sufficient to justify reissue, putting forward the argument that all patents issue with subject matter which is not claimed. We find logic in such an argument, in addition to what we have taken from the

case law earlier, since if mere support was sufficient then every patent would be capable of reissue. However, this would entail ignoring the other requirements of s. 47 of the *Patent Act*. The RIB also commented on the additional evidence of the Patentee and found it insufficient to establish that an error within the meaning of the statute had occurred. We will now turn to a review of the additional submissions on behalf of the Patentee.

THE PATENTEE=S SUBMISSIONS

- [47] Included in a letter dated May 1, 2007, was a Statutory Declaration of Jan. B. Leurdijk, the inventor and current patent owner. In this Statutory Declaration, Mr. Leurdijk discusses the circumstances surrounding the development of his invention up to the application for reissue. We will briefly summarize these events.
- [48] According to Mr. Leurdijk, in 1996 he approached a company (Majestic Plastics Ltd.) about manufacturing his invention and entered into a non-compete (and non-disclosure) agreement with them. Eventually an associated manufacturer (Royal Foam Ltd.) decided to manufacture his track system. On or about Nov. 1996, Mr. Leurdijk retained a patent agent named James Nenniger to prepare and file his patent application in Canada and in the United States. Mr. Leurdijk contends that he never made Mr. Nenniger specifically aware that the use of holes and screws to secure the hanger bracket to the lower portion of the track was unnecessary and that other configurations would function in an equivalent manner.
- [49] After commencing sales of this track system, Mr. Leurdijk, after realizing that he lacked the resources needed, approached Royal (the company manufacturing his track) about the possibility of them investing in his product. After being denied, Mr. Leurdijk then sought other investors. The next time Mr. Leurdijk met with Royal representatives he became aware that the company intended to manufacture and market a track system which was remarkably similar to his own. After bringing this to the attention of his patent agent, he was advised that any action against Royal should wait until the issue of the patent. Later Mr. Leurdijk specifically informed his agent of his belief that Royal=s track was functionally equivalent to his own. Mr. Leurdijk eventually lost the investment capital he had secured once the investors learned of the potential infringement of his design. Mr. Leurdijk, upon moving to Alberta, engaged the services of another patent agent, Mr. Ted Yoo, who prosecuted his case to allowance, making amendments to the claims. Mr. Leurdijk in the Statutory Declaration contends that he never made it clear to Mr. Yoo that the functionality of the lower groove to attach the brackets was the important feature and not the particular means of attachment. After issuance of the patent, Mr. Leurdijk found himself unable to pursue the matter further until he engaged the services of Mr. Haugen, his current representative. It was Mr. Haugen who advised him that the patent did not include

all claims that he was entitled to claim and that he could file a reissue application to obtain everything that he was entitled to claim in the original patent application.

[50] The Statutory Declaration of Mr. Leurdijk was accompanied by a copy of a letter dated February 15, 1999, from Mr. Leurdijk to Mr. Nenniger, his former patent agent, discussing his concerns with the activities of Royal and including a sketch comparing the Royal design with his own. Mr. Leurdijk clarified that he believed Royal was infringing his design and that the function of the bottom groove was the same, that is, to keep the accessories in place and prevent them from falling when the stored item is removed from the wall. He indicated that Royal had eliminated the holes in the track at the bottom and had altered the groove along the bottom in order to allow it to secure the hangers without the use of holes.

[51] The above outlined Declaration and accompanying letter identify the concerns of Mr. Leurdijk as being that Royal was using a track system, the lower groove of which performed the same function as in his design, although with different specific means of securing the hanger bracket to the lower groove. It seems clear that Mr. Leurdijk was concerned that his patent application may not cover functionally equivalent designs to that of his holes and screws system. This is consistent with the concerns outlined in the original application for reissue. However, Mr. Leurdijk=s concerns that his patent application may have been too narrow in scope are inconsistent with the defects which are alleged to be present in the patent as issued, namely that narrower embodiments were not claimed in dependent form. Accordingly, we do not see this evidence as adding any further support to the case for reissue.

[52] In the letter of May 1, 2007 itself some comments were made regarding the actions of Mr. Yoo. Specifically, it was stated:

it is respectfully submitted that Mr. Yoo did not fully appreciate the significance of the Patentee=s invention or the Patentee=s intent that it is the function of the lower groove to securely retain the lower portion of a bracket which is important, not the manner in which the bracket is securely retained.

[53] We believe that the evidence does not lead one to such a conclusion. In particular, during prosecution of the patent, it was Mr. Yoo, who, acting on behalf of the Patentee, on March 8, 2001, introduced new claims 22, 25, and 28, which are not limited to any particular means of securing the hanger brackets to the lower portion of the track. These claims later issued in the patent which is now sought to be reissued. The relevant portion of claim 22 is as follows:

... an integral lower portion having a groove adapted for securely retaining a hanger bracket to said track member at said lower portion.

[54] We believe that Mr. Yoo clearly understood, based on his actions, that the manner in which the bracket is securely retained is not essential to the invention. Those actions were to introduce claims intended to cover any means of securing the hanger bracket to the track at the lower portion.

[55] It is also alleged in the Patentee=s letter of May 1, 2007 that it would have been open to Mr. Yoo to add the amendments to the description and claims, as are now proposed, during the prosecution of the patent application. The Patentee also contended at the hearing that the lack of further dependent claims may have been due to the former agents being too focussed on the introduction of broad claims only. Unfortunately, we have no evidence as to what the former agents were thinking, and while it may have been possible to make the amendments to the description and claims at the prosecution stage, Mr. Yoo did not, nor is there any evidence that such was the wish of the inventor and applicant, Mr. Leurdijk. Mr. Leurdijk seems to have relied on the expertise of his patent agent to secure for him broad patent protection, and that seems to be what has happened. Once the patent issues, it is up to the Patentee to prove that an error occurred, which error falls within the meaning of s. 47.

[56] Moving to the Patentee= s later submissions before the Board, dated June 3, 2008, it is worthwhile to note that the Patentee=s summary of the alleged defects identified in the original application for reissue at page 4 are in accordance with our own assessment and that of the RIB.

Aclaim Differentiation@

[57] The Patentee, in the aforementioned submissions before the Board, and at the oral hearing, put forward for the first time an additional argument as to why the patent was defective by reason of failure to include narrower dependent claims. It was founded on the principle of Aclaim differentiation@. We quote from page 4 of the Patentee=s submissions:

While it would not have been possible to add claims or amendments to the description to cover the specific embodiment of the competitors storage track system to the Patentee=s application (as it would be adding new subject matter), it would have been possible to add broad independent claims excluding the apertures and fasteners limitation during the prosecution of the application as well as adding dependent claims that add the specific limitations of the apertures and fasteners in a manner that would have provided proper claim differentiation between the broad independent claims and the narrower dependent claims. This

was not done.

When the Patentee moved to Alberta in 1999 and retained Mr. Yoo as his second patent agent, the Patentee advised Mr. Yoo of what the Patentee knew of the storage track system being manufactured and sold by the competitor. Mr. Yoo amended the claims to include claims 22-28 that would appear to cover embodiments that do not include the limitations of apertures and fasteners but did not include any further dependent claims adding these limitations to claims 22-28. In so doing, the application was still lacking claims that would have provided the proper differentiation between the embodiments. The embodiments of the invention as claimed in claims 22, 25, and 28, when combined with the limitation of apertures and fasteners, are not equivalent to or of the same structure or have the same features of the embodiments of the invention as claimed in claims 1 or 21. Claims 1 and 21, and claims 22, 25 and 28 are all independent claims. The claim construction principle of claim differentiation cannot be applied to these claims, as there is no dependent claim adding a limitation to a more general claim. There are no claims dependent on claims 22-28 to provide the limitation of the apertures and fasteners so as to provide the proper differentiation between embodiments of the invention that omit these limitations and embodiments that include them, embodiments that the Patentee had intended to protect with his patent.

- [58] The basic premise here seems to be that because of the lack of further dependent claims specifying apertures and fasteners, the broader independent claims may be construed as being limited to such an embodiment. We do not see how this could be, given that no such specific means are present in independent claims 22, 25, and 28. Further, these claims clearly omit the limitation of having apertures in the lower groove to facilitate the securing of the hanger brackets, which is present in the other independent claims. While the Patentee contends that Aclaim differentiation@ is only applicable to the relationship between independent and dependent claims, with respect, we cannot see the principle so rigidly. While *Halford v. Seed Hawk Inc.* (2004), 31 C.P.R. (4th) 434 (F.C.), pointed to by the Patentee, dealt with independent and dependent claims, it is worthwhile to note that a dependent claim is merely a shorthand manner of expressing an independent claim. In other words, every dependent claim can be rewritten as an equivalent independent claim. To say that if such were the case, one could not have regard to the differences in claimed features between the various independent claims in order to evaluate their scope, would seem to place too great a weight on the formal manner in which dependent claims are traditionally presented. In fact, in *Halford v. Seed Hawk, supra*, Pelletier J. cited case law from the United States in support of Aclaim differentiation@, in particular a quotation from *Deere & Co. v. International Harvester Co.*, 658 F.2d 1137 was included:

Where some claims are broad and others narrow, the narrow claim limitations cannot be read into the broad whether to avoid invalidity or to escape infringement.

Such language is not limited to the relationship between A-independent@ and Adependent@ claims. In fact in the *Deere & Co.* case, this statement was made in the context of all eighteen claims of the patent, which included several independent claims of varying scope.

- [59] The Patentee, in a communication after the hearing, acknowledged that the principle of claim differentiation was not a new one and had existed in Canadian patent law since at least 1997 (See *Heffco Inc. v. Dreco Energy Services Ltd.* (1997), 73 C.P.R. (3d) 284 (F.C.T.D.)). Therefore such a principle was known at the time the present case was being prosecuted.
- [60] In light of the above, we do not view the principle of claim differentiation as imposing a necessity to amend the patent by adding further dependent claims. Further, other than the able arguments put forth on behalf of the Patentee by his representative, there is no evidence that this principle was related to the defects identified in the application for reissue.
- [61] In the submissions of June 3, 2008 the Patentee again pointed to the idea that the use of apertures and fasteners to engage brackets to track members was not an important or necessary feature of the invention. We would again agree with this given the scope of issued claims 22, 25, and 28. However, given that claims 22, 25, and 28 did issue we fail to see how the inventor=s intent in this regard was not fulfilled.
- [62] It is also alleged in the aforementioned submissions that the patent agents prosecuting the application did not fully appreciate the significance of the information that the Patentee provided to them and failed to claim the invention properly. However, there is no evidence that the former agents acted improperly or not in accordance with the intent of the inventor. In fact, broad protection was secured by Mr. Yoo by an amendment to the claims during prosecution to add independent claims 22, 25, and 28.
- [63] As we noted earlier, there was some dispute about when the Patentee discovered that the alleged error had occurred; however, based on the submissions of June 3, 2008, and the accompanying Statutory Declaration of Mr. Leurdijk, we accept that the Patentee only became aware of the perceived defects after the issuance of the patent and therefore did not prosecute it to issue with full knowledge of the alleged defects. We would note for the record that the Statutory Declaration submitted on June 3, 2008 also included a revised version of the previously submitted letter from Mr. Leurdijk to Mr. Nenniger, to remedy the omission of a page from the earlier version, a page which related to a non-compete agreement between Majestic Plastics and Mr. Leurdijk, a page which has no relevance to the issue at hand, as stated by the Patentee in the submissions.

- [64] At the hearing, Mr. Haugen, the Patentee's representative, expressed his concerns regarding the events that unfolded between Mr. Leurdijk and Royal, his former manufacturer. While we appreciate the position in which Mr. Leurdijk now finds himself, and acknowledge the very able efforts of Mr. Haugen on his behalf, we must adhere to the provisions of the statute, and we are left unconvinced that an error has occurred in this case which falls within s. 47 of the *Patent Act*.
- [65] The evidence which has been put forward, in addition to the content of the patent as issued, would establish that it was Mr. Leurdijk's intent that his claims not be limited to any particular means of attaching the hanger bracket to the lower portion of his track. However, such evidence does not point to the patent being defective by reason of failure to include further dependent claims, as is alleged in the application for reissue. Mr. Leurdijk did obtain broad protection covering any track having a groove adapted for securely retaining a hanger bracket to said track member at said lower portion, as specified in issued claim 22. Accordingly we find no reason to believe that the issued patent does not accord with the intent of Mr. Leurdijk, as can be taken from the objective evidence on the record before us.

THE AMENDMENTS TO THE DESCRIPTION AND CLAIMS

- [66] In the Summary of Reasons submitted to the Board the RIB pointed out that some amendments were made which had no relation to the defects identified. Referring back to s. 47 of the *Patent Act* it states (our emphasis added):

Whenever any patent is deemed defective or inoperative by reason of ... the Commissioner may, on the surrender of the patent ... cause a new patent, in accordance with an amended description and specification made by the patentee, to be issued to him

- [67] We take the phrase "in accordance with an amended description and specification" as meaning that the changes made to the description and specification are in accordance with the defects identified in the patent. In other words, the amendments made to the patent are effected to remedy the alleged defects therein. There would not seem to be a basis for making any further amendments to the issued patent, as any amendment proposed under s. 47 would have to be related to an error in the prosecution of the patent which led to a defect. An application for reissue is not a means by which the prosecution is reopened so that the Patentee can amend the patent as they would during normal prosecution of a patent application. According to Duff C. J. in *Northern Electric, supra*, the statute (our emphasis added):

limits admissible amendments to such as may be necessary to correct any insufficiency of description or specification arising from the error of the patentee in failing adequately to describe or specify an invention in respect of which he intended to apply for protection and arising from inadvertence, accident or mistake.

[68] The Patentee amended the proposed changes to the description and claims in the submissions of June 3, 2008 in response to the concerns of the RIB. However, the changes still contain an amendment to page 9 of the description of the patent. At the hearing the RIB still questioned whether this was proper. In view of our discussion above, we see no basis for amending the description of the issued patent. The description was not identified as being defective in the application for reissue, and therefore may not be amended. Further, in relation to the first identified defect in the application for reissue, we note that the most recent proposed claims contain claims 32-39 which depend on claims 25 or 30. While the reference to claim 25 is in accordance with the first alleged defect, the reference to claim 30 is not. This problem was not present in the claims which were previously before the RIB and was only introduced by the submissions made before the Board. We acknowledge that this issue was not raised at the hearing, but given our views on the other parts of the application for reissue, it would not be determinative of this case.

[69] The RIB in the Summary of Reasons accepted that no new matter was present in the proposed amendments and we would agree with that assessment in light of the proposed claims before the Board, despite the fact that as noted above, we would not permit some of the amendments to be made, as they are not related to the alleged defects. Of course, this point is moot, given the failure of the Patentee to establish that the patent is defective on the grounds provided in the application for reissue.

CONCLUSIONS

[70] To go back to the principles which we outlined previously in relation to reissue, we would summarize our findings as follows. It has not been established to our satisfaction that the patent is defective or inoperative and that the error arose through inadvertence, accident, or mistake. It has not been established to our satisfaction that the issued patent does not reflect the original intention of the inventor/applicant. As we have said, the objective evidence leads us to the belief that it was Mr. Leurdijk=s intent that his claims not be limited to any particular means of attaching the hanger brackets to the lower portion of the track. We fail to see how the patent is defective in this regard given the scope of the issued claims. We also fail to see how the proposed amendments, namely the addition of further dependent claims, would address any defect in relation to the inventor=s intent.

The argument put forward that these additional claims are necessary because of the principle of Aclaim differentiation@ is not persuasive, and in any case there was no evidence submitted that this was ever a consideration. In fact it only arose as an argument in the submissions before the Board. With respect to the issue of Asame invention@, as we have stated, we believe that no new matter is present.

- [71] Given that we are not convinced that all of the requirements of s. 47 have been met we must conclude that the application for reissue is unacceptable.

RECOMMENDATIONS

- [72] Accordingly, the Board recommends that the Commissioner refuse this application for reissue.

Stephen MacNeil
Member

Paul Fitzner
Member

Ed MacLaurin
Member

[73] I concur with the findings and the recommendation of the Patent Appeal Board. Accordingly, I refuse to grant a new patent based on this application 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 13th day of February , 2009