IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application 2,186,076 having been rejected under Rule 30(4) of the Patent Rules, the Applicant asked that the Final Action of the Examiner be reviewed. The rejection has consequently been considered by the Patent Appeal Board and by the Commissioner of Patents. The findings of the Board and the ruling of the Commissioner are as follows:

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Introduction

[1] This decision deals with the Applicant's request for a review by the Commissioner of Patents of the Examiner's Final Action dated November 22, 2001, on application 2,186,076 filed on September 20, 1996 and entitled "BAGGAGE RECEIVING AND HANDLING METHOD AND SYSTEM IN AN AIRPORT". The inventor is Minoru Yamazaki and the applicant is TOYOTA JIDOSHA KABUSHIKI KAISHA.

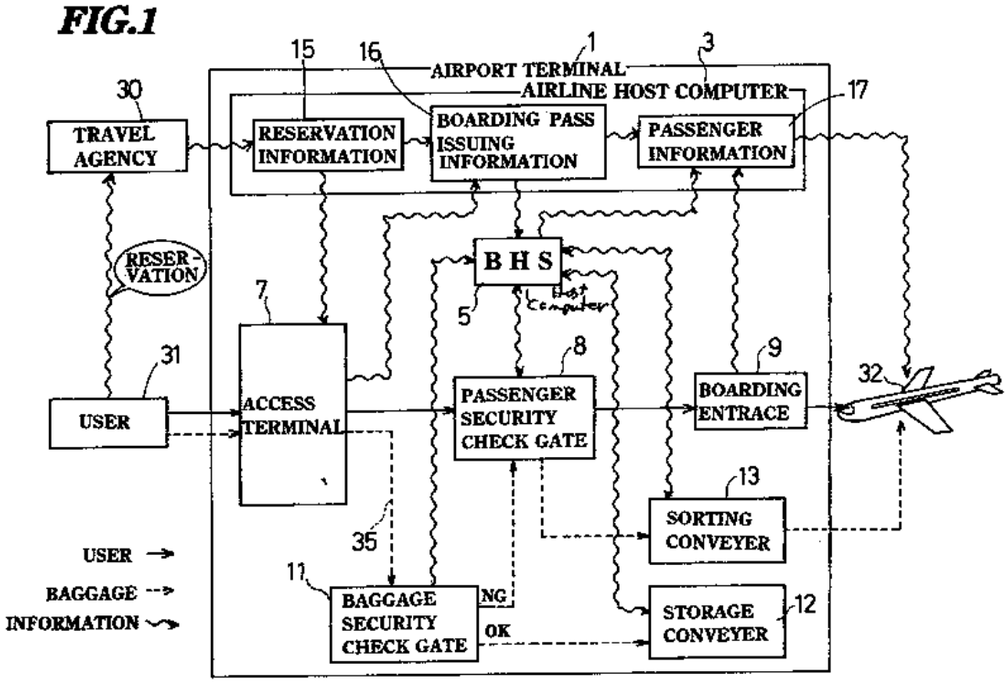
[2] At the Applicant=s request, the Patent Appeal Board, comprised of Mr John Cavar, Mr Andrew Strong and Mr Murray Wilson, conducted a hearing on December 8, 2004. Appearing on behalf of the Applicant was Mr Gary O= Neil, Ms Ikuko Wada and Mr Bruce Morgan from the firm of Gowling Lafleur Henderson LLP, agent for the applicant. Representing the Patent Office were Mr Gilbert Plouffe, the Examiner in charge of the application and Mr Yvan Guay, Section Head. Mr Cavar has since retired from the Public Service and has therefore taken no part in the preparation of this recommendation.

[3] At the hearing, the Applicant submitted a Memorandum of Argument.

Background

[4] The application is related to a method of receiving and handling passenger baggage at

FIG.1



an airport.

[5] Figure 1 shows a general view of an airport baggage processing system which incorporates the receiving and handling method of the application.

[6] When a passenger 31 arrives at an airport terminal 1, he/she must check in at an airline counter or access terminal 7 where information from the airline computer 3 generates identifying information about the passenger, about the passenger=s baggage and information which links the passenger to his/her baggage. The baggage then is moved to an inspection area 11 where it undergoes a security verification. If the baggage is acceptable, it is sorted and loaded onto the airplane 32. If it does not pass the security verification, the passenger is given an opportunity to correct the baggage security problem at the time of undergoing the passenger security check 8. Once the baggage is deemed acceptable, both the passenger and the baggage are allowed onto the airplane.

[7] On November 22, 2001, the Examiner issued a Final Action in which he rejected all of the claims as being obvious over cited prior art and as being indefinite. All of the claims and the application itself were also rejected because they contain non-patentable subject matter.

[8] At the time of the Final Action, there were 15 claims in the application, with claims 1

and 5 being independent claims and claims 2 to 4 depending on claim 1 and claims 6 to 15 depending directly or indirectly on claim 5. Claims 1 and 5 read as follows:

1. An airport baggage receiving and handling method to receive a passenger=s baggage, to identify the baggage and to process the baggage for the passenger=s flight, the method comprising the steps of:
providing identification information to identify the passenger, the baggage and the passenger and the baggage with respect to each other, when the passenger undergoes a check-in procedure;
storing the result of a baggage security check on the baggage;
retrieving the baggage security check result based on the identification information of the passenger at the time of a passenger security check on the passenger;
conveying the baggage security check result to the passenger, and if the baggage security check result is a rejection, permitting the passenger to overcome the rejection; and
forwarding the baggage that has passed the baggage security check to a sorting section.

5. An airport baggage receiving and handling system to receive a passenger=s baggage, to identify the baggage and to process the baggage for the passenger=s flight, the system comprising:
memory means for storing baggage identification information, a baggage security check result and passenger identification information, wherein at least the baggage identification information and the passenger identification information are cross-referenced with each other;
informing means for retrieving the baggage security check result stored in the memory means based on the passenger identification information at the time of a passenger security check, and conveying the baggage security check result to the passenger; and
a sorting section for sorting the baggage that has passed the baggage security check.

[9] On May 22, 2002, the Applicant replied to the Final Action. In this reply, the Applicant cancelled the claims on file and substituted a new set of 14 claims.

[10] Again, claims 1 and 5 are the independent claims and read as follows:

1. An airport baggage receiving and handling method for use in an airport having a passenger security check gate for conducting a security check on passengers and a boarding entrance for boarding passenger check, to receive a passenger=s baggage,

to identify the baggage and to process the baggage for the passenger=s flight, the method comprising the steps of:

providing identification information to identify the passenger, the baggage and the passenger and the baggage with respect to each other, when the passenger undergoes a check-in procedure;

receiving baggage attached with identification information;

conducting a baggage security check for the baggage received in the precedent step and storing a result of the baggage security check on the baggage;

retrieving the baggage security check result based on the identification information of the passenger at the time of a passenger security check on the passenger at the passenger security check gate;

conveying the baggage security check result to the passenger, and if the baggage security check result is a rejection, permitting the passenger to overcome the rejection; and

forwarding the baggage that has passed the baggage security check to a storing section.

5. An airport baggage receiving and handling system for use in an airport having a passenger security check gate for conducting a security check on passengers and a boarding entrance for boarding passenger check, to receive a passenger=s baggage, to identify the baggage and to process the baggage for the passenger=s flight, the system comprising:

identification information providing means for providing information to identify the passenger, the baggage and the passenger and the baggage with respect to each other, when the passenger undergoes a check-in procedure;

baggage identifying information receiving means for receiving baggage identifying information when baggage is received;

baggage security check result receiving means for receiving a result of a baggage security check for the baggage received;

memory means for storing the baggage identification information and passenger identification information provided in the course of identification information providing means, the baggage security check result received by the baggage security check result receiving means, wherein at least the baggage identification information and passenger identification information are cross-referenced with each other;

passenger security check gate means for receiving the passenger identification and the result of a passenger security check when a passenger is received the passenger security check at the passenger security check gate;

informing means for retrieving the baggage security check result stored in the memory means based on the passenger identification information received by the passenger security check gate at the time of the passenger security check at the passenger security check gate, and conveying the baggage security check result to the passenger; and

a sorting section for sorting the baggage whose baggage security check result received by the security check result receiving means is affirmative.

[11] Before dealing with the issues raised in the prosecution, the Board notes that the Final Action was only the second report from the Examiner. It is unusual to make a second office action final because it is very difficult to set out the grounds of rejection in sufficient detail and allow the Applicant to put forth arguments when there has only been one earlier exchange of views. The Applicant made extensive amendments to the application in response to the first report but did not have an opportunity to respond to the Examiner=s assessment of its first amendment. It is not clear why the Examiner felt it was appropriate to make the second report final.

Obviousness

[12] The Examiner=s position

In the Final Action, the Examiner cited the following references:

United States Patents

4,711,994	December 8, 1987	Greenberg
5,051,565	September 24, 1991	Wolfram

[13] The Examiner had the following to say with respect to obviousness:

> Greenberg teaches that both the ticket and baggage claim checks are scanned and read and linked together in the memory of a computer thus identifying the passenger with specific pieces of baggage (column 2, top paragraph). Greenberg also teaches that the baggage of a no-show will not be loaded (column 2, top paragraph) but that the direct and/or indirect search of the baggage would lead to long passenger wait times

(column 1, lines 39 to 48). Greenberg meets all the limitations of the claimed baggage and passenger matching but does not claim the additional baggage security check. Claims 1 to 15 do not comply with section 28.3 of the Patent Act as it would have been obvious on the claim date to a person skilled in the art to incorporate a security check to the airport check-in procedure as conditions warrant, as this additional check does not alter the known process of identifying the passenger with the baggage.

Wolfram meets all of the limitations of the claimed baggage receiving and handling method but differs from claim 1 in that it does not describe the additional baggage security check. It would have been obvious to a person skilled in the art at the claim date that if a baggage security check is essential before boarding a plane then this step can be added to the process of Wolfram at the time of scanning the baggage and transmitting the information to the boarding gate of the plane as this additional step does not alter the known process of identifying the passenger and the baggage and of establishing a link between both at the ticket counter and at the boarding gate.

Claims 2 to 4 add further limitations such as permitting the passenger to overcome baggage rejections at the passenger check-in procedure or at the passenger security check. These limitations do not make the claims patentable. Claims 1 to 4 therefore do not comply with Section 28.3 of the Patent Act in view of Wolfram. It would have been obvious on the claim date to a person skilled in the art to add a security check to the airport check-in procedure if the conditions of the day would require such a step for boarding a plane.

Claims 5 to 15 define an airport baggage receiving and handling system in which at least the baggage ID and the passenger ID are cross-referenced. Wolfram teaches the same passenger-baggage cross-referencing by issuing a pair of labels at the check-in counter (column 3, lines 16 to 22) and at boarding loading the baggage data into CPU (50) for matching the passengers with the baggage (column 4, lines 42 to 50). Wolfram differs from the system claims in that it does not describe the additional baggage security check. Claims 5 to 15 do not comply with Section 28.3 of the Patent Act in view of Wolfram as it would be obvious to a person skilled in the art that if a baggage security check is needed before boarding a plane, the step of storing the baggage security check in the same computer would be added to the process of Wolfram to cross-reference the passenger ID, the baggage ID and the security check result at the time of the passenger security check as this additional check does not alter the known process of identifying the passenger and the baggage.

The Applicant=s response

[14] In its reply, the Applicant had the following to say about the Examiner=s obviousness

rejection:

The present invention is directed to a method and system which is used in an airport having a passenger security check gate and a boarding entrance. The passenger security gate is provided for a security check on passengers. The passenger security check gate is typically used by passengers for several aircrafts departing from several gates. The boarding entrance is provided for a boarding passenger check. Passengers present their boarding passes at the boarding entrance to board their air plane. Typically, passengers are to go thorough (sic) the security check gate well in advance of the boarding time. According to the present invention, as claimed in amended claims 1 to 5, the baggage security check result is retrieved when the passenger is security checked at the passenger security check gate. If there are any problems with his/her baggage, the passenger is prompted to overcome the rejection at this stage. Accordingly, these steps do not delay or interfere with the boarding process of the passengers onto an air plane. Also, all passengers must pass through the security check gate, it is easy to find a passenger whose baggage is rejected at the baggage security check, and there is no need to page or search for passengers whose baggage failed its baggage security check, as described in the first paragraph of page 7 of the description. Baggage which has passed its security check and whose owner has passed the passenger security check can be proceeded for loading onto the aircraft. As indicated in the description on page 9, lines 3-10 AThere is a large possibility that the passenger was subjected to a security check certainly boards a corresponding air plane@, this also minimizes or reduces loading of baggage of Ano show@ passengers on the air plane.

By contrast, Greenberg discloses a method and system that identifies checked baggage of Ano show@ passengers. Greenberg does this by matching baggage claim check code numbers with the list of boarded passengers (column 4, lines 53-55). That is, Greenberg=s method is carried out by comparing the list of passengers boarded on the aircraft and the list of baggage. The list of passengers boarded is made based on the information obtained at the boarding entrance. Accordingly, this comparison cannot be carried out until all passengers are boarded. If any problem is found by this comparison, attending to the problem will delay loading of baggage and/or departure of the aircraft. The Examiner has pointed out that Greenberg discloses that the baggage of a Ano show@ will not be loaded (column 2, lines 16-17). This means that the method of Greenberg may be carried out prior to loading baggage onto the aircraft. However, this does not mean that Greenberg discloses any method or system which identifies baggage of a Ano show@ before passengers board the aircraft. Greenberg does not disclose or suggest any comparison of passenger code and baggage code at a passenger security check gate.

Wolfram discloses a system and method for matching baggage and passengers. Wolfram matches Aall loaded luggage with passengers during boarding@ (column 1, lines 44-45). Coded labels on passengers= boarding passes are scanned at the passenger loading gate or boarding entrance, and stored in a memory of a boarding computer (column 2, lines 3-110. Also code on each luggage tag is scanned by baggage personnel at a container loading station and stored in a handheld computer memory. After baggage loading is completed, the handheld computer is connected to the boarding computer to compare the codes from the loaded luggage and the codes with the boarded passengers codes (column 2, lines 12-31). Similar to Greenberg, this comparison can only be performed after all passengers are boarded the aircraft. Wolfram does not disclose or suggest any comparison of passenger code and baggage code at a passenger security check gate.

The present invention as claimed in the amended claims is not simply adding a baggage security check to a known system. Neither Greenberg nor Wolfram discloses or suggests addition of a baggage security check to their systems. Even if one skilled in the art added a baggage security check to the system of Greenberg or Wolfram, he would obtain a system which could use the baggage security check result Aduring loading@ (Wolfram) or when the baggage claim check code numbers as compared with the list of boarding passengers (Greenberg). In either way, solving any problems with baggage after passengers are boarded interferes with the departure of the aircraft due to limited time available between the time when passengers start boarding and the time when the aircraft is scheduled to departure. Neither Greenberg nor Wolfram discloses or suggests any method or system which provides baggage security check results at the time of a passenger security check on the passenger at a passenger security check gate. Accordingly, even if the person skilled in the art combines those two systems, he would still fail to provide a system or method that allows passengers to solve baggage problems at the security check stage well before boarding their aircraft.

[15] A test for obviousness was set out by the Court in *Beloit Canada Ltd. v. Valmet OY*, 8 C.P.R. (3d), 289 at 294:

> The test for obviousness is not to ask what competent inventors did or would have done to solve the problem. Inventors are by definition inventive. The classic touchstone for obviousness is the technician skilled in the art but having no scintilla of inventiveness or imagination; a paragon of deduction and

> dexterity, wholly devoid of intuition; a triumph of the left hemisphere over the right. The question to be asked is whether this mythical creature (the man in the Clapham omnibus of patent law) would, in the light of the state of the art and of common general knowledge as at the claimed date of invention, have come directly and without difficulty to the solution taught by the patent. It is a very difficult test to satisfy.

Analysis

[16] The patent to Greenberg shows a security system for use with public transport, specifically airlines. The system is designed to prevent the loading of baggage onto an airplane unless the passenger also travels on the same airplane. When a passenger is issued a ticket, it contains a distinctively coded, machine-readable portion. When the passenger presents baggage during a check-in procedure, the baggage is also provided with a distinctively coded, machine readable tag which is affixed to the baggage. Both the passenger=s ticket and the baggage tag are scanned and are associated with each other in the memory of a computer. The ticket is surrendered as the passenger boards the airplane, and the coded portion of the ticket is compared with the corresponding baggage tag and the baggage is loaded onto the airplane. If a passenger does not board the airplane, that passenger=s baggage is not loaded.

[17] The patent to Wolfram is also related to a system which is designed to prevent an airplane from departing if baggage which has been loaded on the airplane belongs to a Ano-show@ passenger. When a passenger arrives at an airport, he/she checks in with the airline, is issued a boarding pass and check-in luggage is tagged and sent to a baggage sorting and loading area. The boarding pass and the luggage tags have

machine readable codes printed on them. The passenger proceeds to the passenger loading gate where the boarding pass is scanned and the luggage is moved to the airplane cargo loading area where the luggage tags are scanned as the luggage is loaded onto the airplane. The codes from the passengers are then compared to the codes from the loaded luggage. If the two sets of scanned codes match, the airplane is ready for departure. If there is a discrepancy, the luggage is located and removed for inspection.

[18] Both Greenberg and Wolfram have developed systems to solve a specific problem associated with airline security; that of preventing baggage from travelling on an airplane when the passenger who checked in that baggage does not board that airplane. At the time these systems were being developed, it was considered to be sufficient to prevent a terrorist from placing unaccompanied luggage containing explosive material on an aircraft because Ait is unlikely he will become a passenger and agree to commit suicide@ (Greenberg, column 1, lines 51-52). Greenberg also suggests that a direct search of all checked baggage would eliminate the danger of explosive material but that this would be very expensive and would lead to excessively long passenger waiting times.

[19] Since the Greenberg and the Wolfram systems were developed, airline security has become more sophisticated and terrorists have adopted new techniques. The direct search of all baggage has become necessary and the instant application is directed to a method and system which seek to alleviate the problem of long waiting times which Greenberg described as being unacceptable.

[20] The Board believes that the instant application is directed to a system and method for

solving a problem which is different from the problem being solved by the inventions shown in the cited prior art. The instant application solves the problem of delays caused by the prior art solutions by a defining new method which combines the features of passenger and baggage security clearance at the time of passenger security check. This allows for any problems in the baggage security results to be rectified by the passenger who owns the baggage much earlier, thus eliminating delays in aircraft departure which occurred with the prior art methods.

[21] Method claims 1 to 4 of the instant application set out a method which includes several steps which are clearly not taught by the cited references. Specifically, neither Greenberg nor Wolfram teach the steps of conducting a baggage security check, retrieving the results of the baggage security check when the passenger is undergoing a passenger security check and permitting the passenger to overcome the results of a failed baggage security check. The Board does not believe that, given the two cited references, a technician of ordinary skill in the art would be lead to Acome directly and without difficulty to the solution taught by the patent@ as required by *Beloit*.

[22] Claims 5 to 14 of the instant application set out a system which includes several elements which are not shown in the cited references. For example, neither Greenberg nor Wolfram shows baggage security check result receiving means or information means for retrieving the baggage security check result at the time of the passenger security check. Instead, Greenberg and Wolfram teach systems concerned with checking baggage after it is loaded, or at a boarding gate position. The Board does not agree with the argument that the combination of these two references would lead directly and without difficulty to the system as defined in claim 5.

Findings - Obviousness

[23] As a result, the Board concludes that the method and system as defined by claims 1 through 14 of the instant application are not obvious under Section 28.3 of the *Patent Act*, in view of the references to Greenberg and Wolfram.

Non-patentable Subject Matter

The Examiner=s position

[24] The Examiner also rejected claims 1 to 4 and claims 5 to 15 as being directed to subject matter which does not fall under the definition of invention contained in Section 2 of the Patent Act.

[25] The Examiner set out his rejection in the following manner:

> Claim 1 defines an airport baggage receiving and handling method in which identifying information is given to the passenger and is attached to the baggage so that after a period of separation the baggage may be reunited with the rightful owner. In addition to this well known baggage receiving and handling method a baggage security check procedure is added to the method.
>
> The baggage receiving and handling method at the airport is known without a security check being performed on either the luggage or the passenger. The addition of the security check has been suggested in the prior art and does not alter the known process of identifying the passenger and the baggage and of establishing a link between them. What has been discovered here is the adaptation of the known method of receiving and handling baggage to a terrorist environment, in which everything must undergo a security check. This procedure does not constitute a new use for performing the known method or a technical innovation as a result of a computer-implemented method but rather a superposition of additional steps which are required in the security procedure to the known airport baggage receiving and handling method.

In *Progressive Games v. Commissioner of Patents, [1999] 3C.P.R. (4th) 526-533,* the court considered a game of playing poker and concluded that the changes in the rules of playing the game is not a new and innovative method of applying skill and knowledge. This rule was first enunciated in *Shell Oil Co. v. Commissioner of Patents, [1982] 2 S.C.R. 536, 67 C.P.R. (2d) 1,* where it was held the definition of art must include a process that is a new and innovative method of applying skill and knowledge.

The addition of the security check to the baggage receiving and handling method at the airport constitutes additional steps which have been added to the known method. Security checks on the baggage are not novel and are performed independently of the provision of identifying the passenger and the baggage and correlating the same. Updating database with security information does not require any particular skill in the conception or implementation but rather a policy at the airport. The described system and method does not describe any new knowledge which has been discovered to perform or implement the extra step. The addition of the security check to the method of receiving and handling baggage at an airport is not an addition to the cumulative wisdom on the subject of airport check-in procedure. Claim 1 does not constitute a new and innovative method of applying skill or knowledge and is therefore not a new and useful art under section 2 of the Patent Act.

Method claims 1 to 4 are not restricted to an automated information gathering system for receiving and handling baggage. For example, claim 1 defines *storing the results of a baggage security check on the baggage* where the ID of the baggage is to be found. The claim does not define storing the data in the memory of a computer. Claims 1 to 4 are not restricted to the implementation of a technical innovation as they do not define a method of manufacture or a technical innovation. All of the steps in the method are performed manually without the interaction of a machine.

Even if claims 1 to 4 were to define the steps of an automated system, the *Patentability Guidelines* of section 16.08.1 of MOPOP state that a computer does not lend patentability to nor subtract from ... a process. Claims 5 to 15 are similarly not patentable.

Applicant=s response

[26] In its Memorandum of Argument, the Applicant had the following comments about non-patentable subject matter:

The Examiner=s rejection under Section 2 of the Patent Act is totally based on the misunderstanding of the invention. The Examiner stated that the procedure of the invention Adoes not constitute a new use for performing the known method or a technical innovation as a result of a computer-implemented method@. The invention involves a new method of retrieving a baggage security check result at the passenger security check gate, based on the identification information of the passenger at the time of a passenger security check to enable efficient handling of rejected baggage and efficient baggage loading onto the airplane. This is a new technical innovation.

The Examiner cited Progressive Games v. Commissioner of Patents, (1999), 3 C.P.R. (4th) 517, stating that Athe court considered a game of playing poker and concluded that the changes in the rules of playing the game is not a new and innovative method of applying skill or knowledge@. Applicant is puzzled why this case is relevant to the present application. Applicant is not claiming any game or rules of playing a game.

In addition, the Examiner cited Shell Oil Co. v. Commissioner of Patents, [1982] 2 S.C.R. 536, 67 C.P.R. (2d) 1, stating that Ait was held that the definition of art must include a process that is a new and innovative method of applying skill or knowledge@.

The method of claim 1 applies the knowledge that all passengers go through the passenger security gate. The method applies skill to involve the steps as recited in claim 1 including retrieving the baggage security check based on the identification information of the passenger at the time of a passenger security check on the passenger at the passenger security check gate. Thus, the method as claimed in claim 1 is a new and innovative method of applying skill or knowledge. Therefore, claim 1 defines the invention that falls within the Aart@ which is statutory subject matter pursuant to section 2 of the Patent Act.

.....

Applicant is not attempting to use the presence of a computer or a computer program to lend patentability to the system as recited in previous claims 5 to 15 (currently claims 5 to 14). What Applicant is claiming in current claims 5-14 is a system that has the elements recited in the claims, including the memory means for storing the baggage security check result and informing means for retrieving the baggage security check result at the time of a passenger security check at the passenger security check gate and conveying the baggage security check result to the passenger.

Therefore, the new airport baggage receiving and handling system as claimed in claims 5 to 14 is a patentable subject matter under Section 2 of the Patent

Act.

[27] Invention is defined in the *Patent Act* in Section 2 as follows:

> invention means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter;

Analysis

[28] The way in which the Examiner has expressed this objection leads the Board to believe that it is based on obviousness rather than on non-statutory subject matter.

[29] The Examiner has cited the decision in *Progressive Games v. Commissioner of Patents, [1999] 3C.P.R. (4th) 526-533* and has used the phase Anot a new and innovative method of applying skill and knowledge@. When this type of phrase is used in an objection, it is possible to be drawn into a discussion of novelty or inventiveness when addressing the issue of statutory subject matter.

[30] The Board does not believe that *Progressive Games* instructs one to test for novelty or inventiveness in order to decide whether something is an art under Section 2 of the Patent Act. A test for inventiveness or novelty has no impact on whether something is non-statutory subject matter, and there is no consideration in *Progressive Games*, of evidence or facts to sway an unimaginative skilled technician, in support of such a proposition. In *Progressive Games*, the Federal Court (Trial Division) found that a new method of playing a card game was not an art or process, and this decision was affirmed by the Federal Court of Appeal. Therefore, the Board does not believe that the findings of *Progressive Games* is pertinent to this case.

[31] The Board shall now turn to the approach for determining the patentability of the subject matter which has been endorsed by the courts. For this, we consider what the Applicant has discovered, or the essence of the claimed subject matter. In considering what has been discovered, both the form of the claim and the substance of the claimed subject matter must meet the requirements of Section 2 of the *Patent Act*.

[32] With regards to form, claim 1 defines an airport baggage handling and receiving method with several associated physical steps. The claim is not a disembodied idea or mathematical formulae, nor does it explicitly define excluded subject matter. Therefore, on its face, the claim meets the requirements of form under Section 2.

[33] Next, we consider the substance or essence of the claimed subject matter. The Board notes that the Examiner in his Final Action also considered this issue. We can summarize the Examiner=s argument in this way - the method of checking in passengers and their baggage is well known and the Applicant has merely added to that method a security check which is also known and which has been mandated by airports and airlines because of modern day terrorist threats. This addition of the mandated baggage check to the well-known check-in process does not require any technical innovation and the check-in process and the security check operate independently of each other, requiring no technical innovation. The Applicant has merely discovered a way of adapting the known method of receiving and handling baggage to a terrorist environment.

[34] However, the Board believes that what the Applicant has actually discovered is a new baggage handling method and not merely adapting a known method to mandated

terrorism rules. With a need to allow all baggage to be verified prior to loading on the aircraft, and thus eliminate unacceptable delays in passenger and baggage processing in a cost effective manner, the discovery was realized to retrieve a baggage security check result at the time of a passenger security check at the passenger check gate, based on the identification information of the passenger, and thus allow any security issues to be resolved at that point. The method combines this discovery with other known baggage handling procedures to overcome the problems of the prior art where full baggage verification is undesirable or unworkable. The steps as defined in claim 1 define a physical, practical solution to a specific technical problem in the field of airport baggage handling. Therefore, the Board is of the opinion that the substance of the claimed subject matter also meets the requirements of Section 2.

[34] Further in the Final Action the Examiner states AMethod claims 1 to 4 are not restricted to an automated information gathering system for receiving and handling baggage. For example, claim 1 defines *storing the results of a baggage security check on the baggage* where the ID of the baggage is to be found.@ A careful reading of the Examiner=s comments on this topic leads the Board to believe that the Examiner may have misunderstood what the Applicant is claiming. Claim 1 actually says that the results of the baggage security check which has been conducted on the baggage are stored. There is no mention of storing these results at a place on the baggage where the baggage ID is located.

[35] Furthermore, with regards to the general statement that the claims are not restricted to an automated information gathering system, the Board is unsure why the Examiner feels that this means that the claims do not define a method which falls under Section 2 of

the Patent Act. There is no requirement that an automated information system or a computer be involved before a method can be considered to be patentable subject matter.

[36] Finally, the Examiner mentions the Patentability Guideline in Section 16.08 of the Manual Of Patent Office Practice which states that a computer does not lend patentability to, or subtract patentability from a process. This is a reference to *Schlumberger Canada Ltd. v Commissioner of Patents, 56 C.P.R. (2d) 204.* In the Schlumberger case, the Court found that it was necessary to analyse the claims to determine exactly what had been invented. The Schlumberger application claimed a Amachine operated method@ and was directed to a system in which data were supplied to a general purpose computer which used a novel algorithm to perform calculations. If those calculations were to be performed by humans, the subject matter would not be patentable. Merely substituting a computer to do those calculations did not alter the fact that the subject matter would not be patentable. A method which consists solely of doing calculations, whether manually or by computer, is not patentable. However, the Board does not believe that Schlumberger is particularly relevant in the instant application as the claimed matter clearly does not pertain to the use of a known computer to perform otherwise unpatentable calculations.

[37] Therefore, the Board considers the method claimed in claims 1 to 4 of the instant application to meet the requirements of patentable subject matter as defined under Section 2 of the Patent Act. With regards to the system claims 5-14, the Examiner did not elaborate on specific objections against these claims, but rather considered them Asimilarly unpatentable@ in light of his arguments to the method claims. However, in view of the same subject matter considerations as discussed for the method claims

above, the Board considers that claims 5-14 define a patentable system claim as required by Section 2 of the Patent Act.

Findings - Subject Matter

[38] For these reasons, the Board finds that the method of claims 1 to 4 falls under the definition of invention in Section 2 of the *Patent Act* .

[39] For the same reasons, the system set out in claims 5 to 14 also falls under the definition of invention in Section 2 of the *Patent Act*.

Indefiniteness

[40] In his Final Action, the Examiner stated the following with respect to indefiniteness:

> Claim 1 is indefinite for failure to define all the steps in the process for performing a security check on the baggage. The step of performing a security check is referred to inferentially by the phrase *storing a result of a baggage security check on the baggage*. The performance of the security check is essential in the method of handling and receiving baggage since without this step the subsequent steps of storing, retrieving and conveying cannot be performed as disclosed. Claim 1 is therefore indefinite and does not comply with Subsection 27(4) of the Patent Act.
>
> Claim 5 is indefinite as the combination is aggregative as claimed. The preamble of the claim purports to define a baggage receiving and handling system but defines only a computer with a readout and memory for storing and correlating customer, baggage and security data and a sorting section. This sorting section is not linked to the computer to define an essential cooperation between a patentable invention. The claim describes a mere list of elements rather than an integrated baggage receiving and handling system.

[41] In response to the Final Action, the Applicant submitted a new set of claims. Amended claim 1 sets out the step of Aconducting a baggage security check for the baggage received@ and amended claim 5 sets the feature of the sorting section which sorts the

security affirmed baggage, said sorting section clearly linked to the other components of the baggage receiving and handling system.

[42] The Board has reviewed these new claims in light of the Examiner=s earlier objections and it believes that the amended claims have overcome the rejection based on indefiniteness. These amendments render the claims clear and explicit.

Findings - Indefiniteness

[43] The Board therefore finds that claims 1 to 14 are explicit and definite.

Recommendations

[44] In summary, the Board recommends that:

(1) the Examiner=s rejections of claims 1-14 as being obvious in view of Greenberg and Wolfram be reversed;

(2) the Examiner=s rejection of claims 1-14 as not complying with Section 2 of the *Patent Act* be reversed;

(3) the Examiner=s rejection of claims 1-14 for being indefinite be reversed; and

(4) the application be returned to the Examiner for further prosecution consistent with these recommendations.

Andrew Strong
Member

M. Wilson
Member

I concur with the recommendation of the Board that the Examiner=s rejection of the application be reversed and that the application be returned to the Examiner for further prosecution consistent with the Board's recommendation.

Mary Carman

Commissioner of Patents

Dated at Gatineau, Quebec

this 26 day of May, 2008