

Commissioner=s Decision # 1333

Décision du Commissaire # 1333

TOPIC: L36, L51, L70

SUJET: L36, L51, L70

Patent No: 2,241,368

Brevet no: 2,241,368

## COMMISSIONER'S DECISION SUMMARY

C.D. 1333

Patent 2,241,368

The patentee submitted an application for reissue for a patent pertaining to improvements in television receivers which provide interactive services to users. The patentee sought to have the patent reissued on the basis that it was defective or inoperative for failing to include additional claims directed to an embodiment not covered in the patent as originally issued. The application for reissue was forwarded to the Patent Appeal Board by the Reissue Board due to a lack of evidence that the intent of the patentee was not fulfilled by the original patent.

The Patent Appeal Board, not being satisfied that an error had occurred which led to the intention of the patentee not being fulfilled by the original patent, recommended that no new patent be issued based on the application for reissue.

*Held:*

The Commissioner of Patents agreed with the Board's recommendation.



IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

An application for reissue of Patent No. 2 241 368, having been considered non-compliant with subsection 47(1) of the *Patent Act*, has been reviewed by the Patent Appeal Board and the Commissioner of Patents. The recommendation 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 of the findings of the Reissue Board (RIB) in respect of an application for reissue of Patent No. 2,241,368, entitled AIMPROVEMENTS IN RECEIVERS FOR TELEVISION SIGNAL.@ The patentee is British Sky Broadcasting Limited, and the inventors are C. Townsend, D. Holliday, R. Crossley, A. Webber, and N. James.
- [2] The subject matter of the patent generally relates to improvements in digital television broadcast receivers which provide interactive services to users. The receiver is adapted to output an interactive image on the television display, and in response to user manipulation of the interactive image the receiver establishes a telecommunications link to a remote site for online interaction between the viewer and the remote site. Online shopping over a television broadcast is a typical application of the invention.
- [3] As noted above, the reissue application was reviewed by the RIB. The RIB is a group of senior examiners tasked with the first phase of reissue examination, namely to ensure that the application for reissue is compliant with the reissue provisions of section 47 of the *Patent Act*. This decision pertains only to this first phase. The second phase, if reached, involves an examination by an examiner in charge of the art, to ensure that the application for reissue is compliant with the other provisions of the Act and Rules.

## Prosecution History

- [4] The original patent issued 17 August 2004, and the application for reissue was filed within the statutory time limit on 15

August 2008. In the application, the patentee asserted that the original patent is defective or inoperative in that the patent claims less than the patentee had a right to claim as new. The application for reissue proposed the inclusion of new claims 49-55.

- [5] The RIB's first response to the patentee (31 August 2009) indicated that the application for reissue was unacceptable as there was no objective evidence of the patentee's intent to claim the subject matter sought by the proposed claims, and therefore, the original patent was not considered defective by the RIB.
- [6] After several additional letters, the RIB determined that an impasse had been reached and referred the matter to the Patent Appeal Board (PAB) with a Summary of Reasons (SOR) dated 21 December 2011. In the SOR, the RIB maintained its earlier contention that the patent was not defective. The SOR was forwarded to the patentee on 21 February 2012, at which time the patentee was presented with an opportunity to be heard.
- [7] The patentee provided a written submission on 13 August 2012 to confirm participation in a hearing, and to summarize the outstanding issues, including submitting an affidavit from the patentee's United Kingdom (UK) agent who was involved in directing the prosecution of the Canadian patent application.
- [8] A hearing was held on 10 September 2012 in the PAB hearing room in Gatineau, QC, before a panel of three PAB members (undersigned). The patentee's representative was Mr. Kevin Carton of Moffat and Company, Ottawa, ON. Members of the RIB were also in attendance.

**Issue**



[9] There is one principle issue before the panel: whether or not the requirements of section 47 of the *Patent Act* have been met by the present reissue application, and in particular whether or not the patentee intended to protect proposed claims 49-55 in the patent.

### **Legal Principles of Reissue**

[10] There are two sections of the *Patent Act* of particular relevance to the present case. First, subsection 47(1) of the *Patent Act* sets out the conditions under which a new patent may be reissued:

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.

[11] Second, subsection 47(3) of the *Patent Act* sets out the conditions for multiple reissue applications to be issued for separate parts of the patented invention:

The Commissioner may entertain separate applications and cause patents to be issued for distinct and separate parts of the invention patented, on payment of the fee for a reissue for each of the reissued patents.

[12] The case law relating to the requirements for reissue under ss. 47(1) was extensively reviewed by the PAB in *Re Application for Reissue by Leurdijk (2009)*, Commissioner=s Decision No. 1289 (hereafter ACD1289@). As noted in CD1289 and again in *Re Application for Reissue by Novozymes (2009)* (hereafter ACD1297@), the granting of a reissued patent is at the discretion of the Commissioner of Patents; however, all of the requirements of ss. 47(1) of the Act must be met before this discretion may be exercised.

[13] The summary of the case law cited in CD1289 results in the following guiding principles which the Commissioner considers pertinent in a review of a reissue application:

i.) In order to exercise the discretion in granting a reissue, the Commissioner must be satisfied that the patent is defective or inoperative due to an error (as it is in subsection 47(1)) that arose through inadvertence, accident or mistake.

ii.) The defect must be 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.

iii.) In determining whether a patent is defective or inoperative, it must be established by the person requesting reissue that the issued patent does not express the original intention of the patentee.

iv.) Objective evidence is necessary in order to establish such intention.

v.) The invention claimed by reissue must find support in the original patent (i.e. be directed to the same invention).

## **Analysis**

*The Application for Reissue (Form 1 of Schedule 1 of the Patent Rules):*

[14] Any review of a reissue application must first consider the patentee's statements made in Schedule I, Form 1 of the *Patent Rules*, and in particular parts 3, 4 and 5. In part 3 of the present application, the patentee states the problem with the original patent:

The respects in which the patent is deemed defective or inoperative are as follows. The patent claims less than the patentee had a right to claim as new. In particular, the applicant had the right to claim, as new, the subject matter of claims 49-55 as set out in the claims of attached application.

[15] Stating that the claims are defective for claiming less than the patentee intended is an acceptable defect that a reissue application may correct. Therefore, part 3 in the present application is acceptable. However, part 4 of Form 1 requires that the patentee explain, to the satisfaction of the Commissioner, how the error arose which led to the original patent being defective or inoperative. Part 4 in the present application states:

The error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention, in the following manner: New claims 49-55 relate to subject matter contained in the equivalent U.S. Patent No. 7,389,253 which issued on June 17, 2008. Therefore, the applicant is confident that if an appropriate amendment had been filed in the Canadian Patent Office during the prosecution of Canadian Patent No. 2,241,368, claims of the scope of claims 49-55 would have issued on such a divisional application. Moreover, claims 14-18, 31 and 32 of US 7,389,253, which correspond to claims 49-55 submitted herewith, have no direct correlation in original claims 1-64 of CA

2,241,368 as originally filed and the failure to have filed such claims or claims of equivalent scope during the prosecution of CA 2,241,368 was a mistake.

[16] The panel notes two significant statements in part 4. First, the patentee states that the proposed reissue claims are related to those in US patent 7,389,253 (AUS=253@ hereafter) which issued in June 2008, significantly after the present Canadian patent issued. Second, the patentee states that had an amendment been filed during the Canadian prosecution, claims of similar scope to the proposed reissue claims would have issued on such a divisional application@. The panel takes this statement to mean that if the United States issued claims (or claims of similar scope) had been submitted as an amendment to the Canadian examiner, they would have resulted in an appropriate divisional application being filed by the patentee, which would have resulted in patent protection for the scope of proposed claims 49-55.

[17] Finally, in part 5 of Form 1, the patentee states how they came to be aware of the error. The discovery date of the error was considered acceptable to the RIB, and is not at issue here.

*Correspondence between the RIB and patentee*

[18] The RIB found the application for reissue unacceptable as the patentee had not established that the patent was intended to protect anything differently than it did upon grant. The RIB also noted that the patentee had failed to explain how the mistake of not filing claims similar to claims 49-55 before the Canadian issue date occurred.

[19] Over the course of several letters with the RIB, the patentee refined the argument as to the nature of the error and how it led to the issued patent being defective. To summarize, the

patentee maintained that the existence of similar claims in US=253, despite issuance after the Canadian patent, was nevertheless sufficient to indicate an intent to claim the additional matter. The mistake had been made in not amending the Canadian application during prosecution or in not filing a divisional, which in either case would have resulted in protection for the scope of proposed claims 49-55. The patentee further proposed that the provisions of ss. 47(3) of the *Patent Act* could offer a mechanism to correct a mistake in these circumstances. The patentee also submitted a proposed amendment to part 4 of Form 1, so as to change the explanation of how the mistake occurred.

*The Summary of Reasons*

[20] The SOR outlines the outstanding issues in view of the final position of the patentee before the RIB. It first addresses the issue of the proposed amendment to the application for reissue Form 1:

As a preliminary matter, the amended Form 1 submitted with the latest correspondence is unacceptable. As pointed out in the letters from the Reissue Board, parts 3 to 5 of Form 1 may not be amended except to correct obvious typographical errors. The proposed amendment of part 4 is not directed to correcting typographical errors; it instead contains an entirely new explanation concerning what the error was and how it happened....Although the amended Form 1 cannot be accepted, the additional explanation itself can be, and has been considered.

[21] The SOR summarizes the circumstances of the error, as understood by the RIB:

When the application for the present patent was filed, it included claims relating to subject matter similar to - but not the same as - that of proposed claims 49 to 55. Those original claims, though, were cancelled (November 7, 2003) in response to the examiner's identification of a lack of unity (May 7, 2003). The patentee states that it had intended to file a divisional of the patent application, containing claims of the scope of proposed claims 49 to 55, but failed to do so, due to an error at the patentee's United Kingdom patent firm. As an alternative explanation, the patentee states that it was a mistake not to include claims 49 to 55 (or claims of equivalent scope) in the present patent before it issued. The patentee points out that claims 49 to 55 are equivalent to those included in US 7 389 253 when it issued on June 17, 2008.

[22] The SOR then elaborates on the substantive reasons as to why the RIB views the application for reissue as unacceptable:

The patentee has not established that the patent was intended to state anything differently than it did upon grant. It is the evidence as a whole that must be considered (*Re Leurdijk's Reissue Application 2 200 422 (2009)*, C.D. 1289 at para. 41 (PAB)), and in this case, there is no objective evidence that the patentee intended the patent to issue with claims 49 to 55. In fact, the stated desire to file a divisional (discussed below) points away from any intent to claim differently in this patent.

Although the proposed claims are similar to claims 46 to 58 originally filed with the patent application, they are not the same. In any case, those claims were cancelled in response to the examiner's identification of a lack of unity.

Deliberately cancelling claims in response to an examiner's requisition signals a lack of intent to include those claims in that patent (*Re Novozymes' Reissue*

*Applications 2 062 732* (2009), C.D. 1297 at paras. 25, 27, 44 (PAB) [*Novozymes*]).

Although claims issued in equivalent foreign patents may help to establish an intent to claim accordingly in Canada, they can only do so if they were submitted to the foreign office before the Canadian patent issued. Although US'253 issued with claims very similar to proposed claims 49 to 55, the claims forming the basis for these issued claims were not submitted to the USPTO until February 8, 2007, well after the Canadian patent issued.

In fact, of the three United States applications related to the Canadian patent and filed before it issued, none included claims like proposed claims 49 to 55 before the Canadian patent issued. The Reissue Board accepts that there may have been a failure to file a divisional following the examiner's requisition. A failure to file a divisional, however, is not the sort of error which may be corrected through reissue (*Novozymes* at paras. 26-27) [CD1297]. The reissue process can only be used to correct errors of expression in a patent; that is, the patent to be corrected by reissue must misstate something, or fail to state something, according to what the patentee originally intended.

[23] The SOR concludes with what has been the consistent position by the RIB throughout the review process:

There is insufficient objective evidence that the patentee originally intended the patent to include claims 49 to 55 and the amended description; the patent is not deemed to be defective or inoperative.

- [24] In considering the points presented in the SOR, the panel first finds that the RIB was correct to reject the attempt to amend the content and facts in part 4 of Form 1. An application for reissue may not be amended other than to correct obvious typographical errors; if the facts presented are incorrect, the only remedy is to file a new application, including any prescribed fees, within 4 years from the issue date of the original patent (*Manual of Patent Office Practice* [MOPOP], 23.03.05). The panel notes that subsequent to the SOR, the patentee has not pursued the proposed amendment to Form 1, and therefore this issue is now moot.
- [25] The SOR also addresses the issue of the deliberate cancellation of similar claims found in the original application (originally filed claims 46-58) in view of the examiner's identification of a lack of unity amongst the claims. Although the panel notes that this line of argument was not explicitly maintained by the patentee, the RIB was correct to reiterate the fact (citing CD1297) that a patentee cannot obtain protection for claims with the same scope as claims deliberately cancelled during prosecution before an examiner.
- [26] As to the error of not including claims 49-55 in the original patent, the RIB reiterates the earlier point that the only evidence of intent from the patentee for this assertion is the later issued US patent (US=253) with similar claims. As noted by the RIB, these claims were introduced into the US office prosecution in February 2007, well after the Canadian issue date. The panel agrees that such evidence does not substantiate the position that similar claims were intended to be part of the



issued Canadian patent in 2004. It is difficult to conclude that the intent of the original patent in Canada in 2004 was not achieved on the basis of evidence that post-dated the critical time by several years. The panel does not accept that simply stating that claims 49-55 would have issued in Canada (if an appropriate amendment had been filed) is sufficient to demonstrate that the intent on the claim date had not been met. The reliance on similar claims in foreign prosecution as objective evidence of intent is not applicable when said claims were submitted to the foreign office long after the Canadian patent issued.

[27] The panel further agrees with the RIB that in consideration of evidence as a whole from prosecution of related foreign applications, none of the three related US patent applications (including the application that issued to US=253) that were filed prior to issuance of the Canadian patent included claims like proposed claims 49-55. Therefore, there is no related foreign prosecution identified by the patentee that provides objective evidence that the patentee intended to protect the matter of the proposed claims in the original patent.

[28] In considering the patentee=s final point that the error was the failure to file a divisional application, the panel agrees with the RIB that a failure to file a divisional application is not a direct error or defect pertaining to the original patent document. Instead, such an error is an error of not filing an application for a second patent. Whether inadvertent or not, the error of not filing a divisional does not provide objective evidence as to the intent the patentee failed to achieve in regard to the original patent that issued.

[29] Considering the responses presented to the patentee in the SOR, the panel agrees with the reasoning therein and finds that there was no objective evidence presented that proposed claims 49-55

were intended to be included in the original Canadian patent. The panel will therefore now consider the additional evidence and arguments submitted by the patentee to the PAB.

*Patentee=s written submission to PAB*

[30] In the pre-hearing letter, the patentee narrowed the remaining issue to focus on the error of not filing a divisional application containing the matter of proposed claims 49-55. In support of this, an affidavit by Mr. James Cross, the patentee=s UK agent, attested to the fact that the error which led to no divisional application having been filed in connection with this application was due to inadvertence. According to the affidavit, Mr. Cross, aware that certain subject matter had been cancelled from the claims, advised the Canadian agent that *Aone or more divisional applications might be filed. However, no instructions to file such a divisional application were given, and the patent issued without a divisional application being filed.* The affidavit repeated the statement that in the normal course of prosecution, claims similar to those of US=253 would have been filed in connection with a divisional application, **since the normal desire would be to ensure that US and Canadian scope of protection were similar for the invention.**

[31] As a preliminary comment, the panel notes that under normal prosecution, evidence in support of any application for reissue (for example, the explanation of the error in part 4 of Form 1) must be presented to the RIB when available. As was addressed by the patentee, certain circumstances hindered the submission of the evidence until this later time. The panel will therefore consider it now.

[32] From the affidavit evidence, the panel can understand that indeed something between the UK and Canadian patent agents did go awry.

It would appear that there was a desire to file a divisional application, in relation to matter cancelled from the original claims, but that for unexplained reasons, no such divisional application was filed within the necessary time limit. As a result, it wasn=t until the claims of US=253 issued that it became apparent similar protection in Canada was not obtained.

[33] However, the panel does not consider this new evidence (by affidavit) provides a convincing argument that the intent for the original patent was not met. While there may have been a general intention to retain and protect the subject matter of the cancelled claims in a divisional application, this fact does not indicate an intent to protect this subject matter within the present patent. A failure to file a divisional does not indicate a failure to obtain the desired scope of the original patent application which is the subject of the present application for reissue. Furthermore, a failure to file a divisional is not the sort of error that is corrected by reissue (CD 1297, at paras. 26, 27, 44). Therefore, the panel fails to see how the affidavit provides objective evidence of the patentee=s intent to claim the matter of claims 49-55 in the original patent. At most, the panel finds that the affidavit provides evidence that a divisional application was not filed for said subject matter.

[34] The patentee, having presented evidence of inadvertence or mistake resulting in the failure to file a divisional, argued that such an error is still a matter for remedy by reissue. As earlier argued in written correspondence with the RIB, the patentee repeats the position that a failure to file a divisional application due to inadvertence can be remedied with ss. 47(3) of the *Patent Act*.

*Patentee=s submission at hearing*

[35] At the hearing, the patentee reiterated the earlier written arguments, with additional clarification as to the proposed remedy and its procedure. Addressing the applicability of ss. 47(3) to the present case, the patentee argued:

i.) That evidence indicates an inadvertent error occurred in not filing for a divisional application that would have resulted in claims of the scope of proposed claims 49-55, as per the affidavit of the UK agent. This shows an intent to have the matter of claims 49-55 protected, supported by the desire for common protection with the US, as represented the US=253 patent;

ii.) That a remedy exists in the *Patent Act* for the reissue of an unfiled divisional by means of the provisions of ss. 47(3). As stated by the patentee, every section of the Act must have meaning. Since ss. 36(1) dictates that a patent is not invalid for containing more than one invention, then the meaning of ss. 47(3) would arguably not be to divide the claims of an issued patent; ergo, the only possible meaning of ss. 47(3) is to accommodate a reissue process in which additional claims, not filed in a divisional application, can be obtained;

iii.) That given ss. 47(3) has meaning in a reissue process, and if we accept that an error occurred, then filing claims similar to US=253 should be permitted under the reissue process, so as to afford the patentee similar protection as in the US; and

iv.) That if the panel accepts points i.) to iii.), then there is no procedural barrier to achieving such a remedy, since:

a) there are no defined limits nor litigated cases for ss. 47(3), and thus no procedural restriction to it being used in this way;

b) the Commissioner has power under section 3 and 4 of *Patent Act* to cause patents to be issued, and if there are no defined limits to doing so, the Office could apply normal divisional procedures to this particular case; and

c) given a) and b) above, the Commissioner of Patents by this decision should direct the patentee to file a new reissue application, with a filing date of the original reissue petition.

[36] As stated during the hearing, the agent for the patentee suggested that in a sense, the full meaning and effect of ss. 47(3) is somewhat unclear, as little jurisprudence exists in relation to this subsection of the Act. A review of several patent and legal databases indicates no recent court cases dealing specifically with ss. 47(3), or its previous version, ss. 50(3).

[37] However, in MOPOP 23.03.01 A Division of a Reissue application@, the Office has addressed its understanding of ss. 47(3):

Under subsection 47(3) of the *Patent Act*, a patentee may file separate applications for reissue in respect of distinct parts of the invention covered by the original patent being reissued. Reissue applications must be filed in the Patent Office within four years from the date of issue of the original patent. The separate reissue applications must all have been filed before the effective date of surrender of the original patent grant, i.e. before the grant of a reissued patent based on any one of them.

The Commissioner will not call for division of a reissue application under subsection 36(2.1) of the *Patent Act* nor will a patentee be permitted to use the provisions of subsection 36(2) of the *Patent Act* during the reissue process under section 47 of the Patent Act.

[38] A reasonable interpretation of the meaning of ss. 47(3) is that should a patentee, when filing a reissue, consider that the reissue claims pertain to more than one invention and thus possibly contravene section 36 of the *Patent Act*, the patentee may instead file separate reissue applications for distinct parts of the invention at that time. This would ensure, for instance, that any lack of unity is addressed at the time of filing the application for reissue. It is not the Office position that ss. 47(3) is a provision to allow by reissue unfiled divisional applications or sets of claims. Furthermore, the second paragraph cited from MOPOP (above) makes it clear that normal procedures for a divisional application are not applicable in a reissue process, contrary to the patentee's position.

[39] In considering the arguments provided by the patentee's oral submission, in view of the Office position on ss. 47(3) outlined in MOPOP above, the panel finds that the patentee has not provided a compelling argument that ss. 47(3) provides a remedy in this case to submit a reissue application for the subject matter of an unfiled divisional application.

[40] More importantly, however, is the fact that the application for any remedy under ss. 47(3) in this case is time barred. It is clear from the provision of section 47 as a whole, and explicit in the MOPOP excerpt above, that any application for reissue must be filed within four (4) years of the issuance of the original patent. Since any application for reissue must comply with all

requirements of ss. 47(1) (see paras [10] and [12]), this would also include all multiple applications for reissue under the auspices of ss. 47(3). Therefore, the panel does not accept the patentee's assertion that there is no procedural barrier to granting the request to use ss. 47(3), as the four year deadline to file multiple applications for reissue has passed. The Commissioner of Patents cannot use his discretion to grant a patentee a remedy which by law is prohibited.

#### Summary

[41] After consideration of the multiple aspects of the patentee's submission in favour of the application for reissue, the panel has found that:

- < the existence of claims of similar scope in US=253 does not provide evidence of intent to include similar claims in the present patent, as these claims were not developed in US prosecution until significantly after the Canadian patent had issued;
- < the additional affidavit evidence provided after the SOR suggests there was a mistake in not filing a divisional application, but does not provide any objective evidence that the intent of the present patent was not achieved; and
- < ss. 47(3) does not provide a remedy to allow for a reissue to include unfiled divisional claims absent the requirements of ss. 47(1) being met, nor does the Commissioner have any discretion to circumvent the 4 year post-issuance deadline to file all reissue applications.

[45] In consideration of the facts and reasons outlined above, the panel finds that the original patent is not inoperative or defective for failing to claim less than the patentee had a right to claim. We do not find any objective evidence that the

patentee intended to protect the subject matter of proposed claims 49-55 in the original patent.



**Recommendation**

[46] The panel has found that the application for reissue does not meet the requirements of subsection 47(1) of the *Patent Act*, as the patent is not inoperative or defective. The patentee has failed to provide sufficient objective evidence that the proposed claims 49-55 were intended to be part of the original patent. Therefore, the panel recommends that no new patent be issued based on this application for reissue.

[47] As a result of this recommendation, the original patent will remain in its original granted form as of 17 August 2004.

Andrew Strong

Member

Ed MacLaurin

Member

Christine Teixeira

Member

**Decision**

[48] I concur with the Patent Appeal Board's finding that the application for reissue of patent no. 2,241,368 does not meet the requirements of subsection 47(1) of the *Patent Act*. Accordingly, I have no authority to grant a new patent based on this application for reissue and refuse to do so.

[49] Under section 41 of the Patent Act, the patentee has six months within which to appeal my decision to the Federal Court of Canada.

Sylvain Laporte  
Commissioner of Patents

Dated at Gatineau, Quebec,  
this 19<sup>th</sup> day of November, 2012