

Commissioner=s Decision #1330

Décision du Commissaire #1330

TOPICS: L04, L40

SUJETS: L04, L40

Patent No: 2,413,004

Brevet no: 2,413,004

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

An application for reissue of Patent No. 2,413,004, having been considered non-compliant with subsection 47(1) of the *Patent Act*, has consequently been reviewed by the Patent Appeal Board and the Commissioner of Patents. The findings of the Board and the decision of the Commissioner are as follows:

Agent for the Applicant

OYEN WIGGS GREEN & MUTALA LLP

The Station

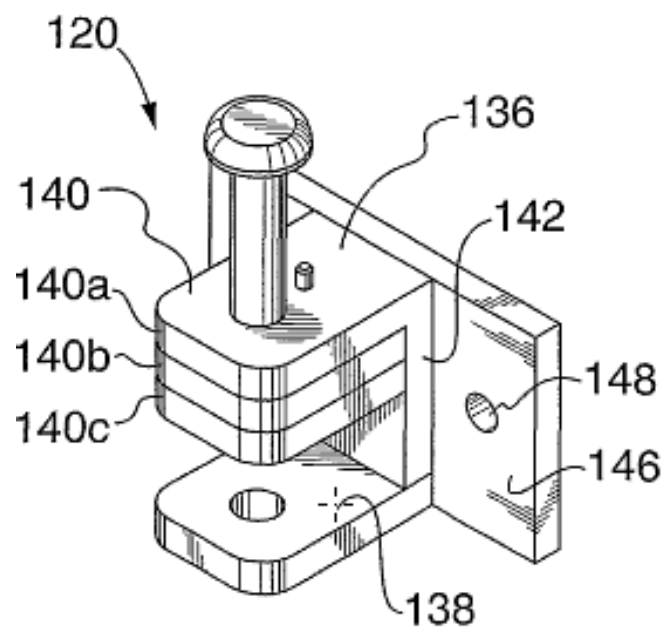
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INTRODUCTION

- [1] This recommendation deals with a review by the Commissioner of Patents of an application for reissue of Patent No. 2,413,004 entitled ASELF-ALIGNING HITCH.® The Patentee and inventor is Ivan Boaler Slatten.
- [2] The present application for reissue is considered to be unacceptable by the Reissue Board (hereafter the RIB®). The RIB is a group existing within the Patent Branch comprised of Senior Patent Examiners charged with performing the initial examination of applications for reissue. At present, the examination of an application for reissue is performed in two phases, the first being an examination of the reissue petition and accompanying documents to ensure that the reasons for reissue are sufficient to justify the changes being made and that the changes are themselves acceptable under the reissue provisions of section 47 of the *Patent Act*. The second phase, if reached, involves an examination to determine if the reissued patent with the amended specification would be compliant with the other provisions of the Act and Rules (e.g., novelty, obviousness, etc.).
- [3] As illustrated by Figure 1, the patent generally relates to a hitch arrangement for a towing vehicle and a trailer vehicle where a tongue housing (12) is secured to a towing vehicle, and a tongue (14) is positioned to move within a throat (23) (not

shown) of the tongue housing. The tongue is prevented from being completely removed from the housing by a trunnion (32). Due to a complementary cam system provided on the housing and on the tongue, once the tongue has been secured to a trailer vehicle, movement of the towing vehicle will cause the tongue to move from an extended misaligned state to a retracted and aligned state as illustrated in Figure 1 below (see Figures 7-10 of the patent for an illustration of the alignment process). A lock pin (80) locks the tongue (14) in place when it reaches full retraction into the housing and proper alignment.

- [4] The tongue is secured to a trailer vehicle via a coupling, which is illustrated in Figure 1 as a clevis (36). The clevis (36) includes a hitch pin (44) insertable through the aperture (48) to secure the trailer vehicle to the towing vehicle, the hitch pin movement being restricted by a biased pin engaging member (94) as shown in Figure 6 of the drawings below.
- [5] As issued, the focus of the independent claims 1, 42 and 43 of the patent is on the self-aligning aspect of the hitch, including the tongue, throat and cam arrangement. The clevis (36) arrangement was only explicitly specified in the dependent claims. By the present application for reissue, the Patentee seeks to add a new set of claims 44-49 directed to a hitch comprising the clevis type coupling itself, independent of the self-aligning aspect. The clevis as an independent unit is illustrated in Figure 16 of the patent reproduced below.

**FIG. 16**

PROSECUTION HISTORY

- [6] Patent No. 2,413,004 was issued on May 11, 2004 and the application for reissue which is the subject of the present review was filed on May 9, 2008. In the reissue petition, the Patentee contends that the patent is defective or inoperative in that it lacks claims protecting the invention specified in claims 21-26 of its US Patent No. 6,286,852, claims which the Patentee submits are supported by the description and drawings of the issued Canadian Patent. The Patentee, as part of the amended specification accompanying the application for reissue, submitted proposed claims 44-49 corresponding to claims 21-26 of its US Patent. The Patentee also sought to correct certain typographical errors in the patent specification by proposed amendments to the description.
- [7] In a letter to the Patentee dated July 23, 2009, the RIB indicated that the application for reissue was unacceptable in that there was no objective evidence of the Patentee's original intent to claim the subject matter sought by proposed claims 44-49, and that the claims sought by reissue were not directed to the same invention as the issued patent. The RIB also indicated that the corrections to typographical errors in the patent specification were unacceptable as they were not related to the manner in which the patent was alleged to be defective.
- [8] In a response dated January 22, 2010, the Patentee removed the typographical corrections to the patent specification and submitted further information relating to the prosecution of patents corresponding to the Canadian case in foreign

jurisdictions. This information was to supplement the Patentee's original contention that the intent to protect the subject matter of proposed claims 44-49 was illustrated by the protection sought and obtained in the US. In relation to the same invention issue, the Patentee contended that the Asame invention's requirement of s. 47(1) of the Act requires that the amended claims be directed to an invention disclosed in the original patent, citing case law in support of the point. The Patentee also suggested that since the US Patent and Trademark Office (USPTO) issued a patent to both types of hitches, the Commissioner should not act in an inconsistent manner.

[9] In a Summary of Reasons (SOR) to the Patent Appeal Board (hereafter the Board), the RIB conceded that the patent is defective in that the Patentee had proven, by objective evidence (i.e., what they sought and obtained protection for in the US) that they intended to protect the subject matter of proposed claims 44-49, but failed to do so. The RIB also conceded that the subject matter of proposed claims 44-49 was supported by the original specification. However, the RIB maintained that the application for reissue was not compliant with s. 47(1) and s. 36(1) of the Act because the new claims were not directed to the Asame invention as the issued patent, for reasons which are addressed later.

[10] The SOR was forwarded to the Patentee with a letter from the Board dated September 20, 2011, in which the Board presented the Patentee with an opportunity to be heard.

[11] In a letter dated December 19, 2011 the Patentee indicated that

there would be no further written submissions and that a hearing was not required. The present review has therefore been conducted based on the written record to date.

LEGAL PRINCIPLES

[12] Subsection 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.

[13] The case law relating to the above provision has recently been reviewed by the Board in *Re Application for Reissue by Leurdijk* (2009), Commissioner's Decision No. 1289 (hereafter ACD1289@) (see also *Re Application for Reissue by Novo Nordisk A/S* (2009), Commissioner's Decision No. 1297, hereafter ACD1297@). As noted in CD1289 and CD1297, the granting of a reissued patent is discretionary, however the requirements of s. 47(1) of the Act must be met before this discretion may be exercised.

[14] For convenient reference the requirements of s. 47(1) are broken down as follows:

(a) that the patent 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.

[15] In the present case the RIB contends that the application for reissue is also non-compliant with s. 36(1) of the Act, which states:

A patent shall be granted for one invention only but in an action or other proceeding a patent shall not be deemed to be invalid by reason only that it has been granted for more than one invention.

ISSUES

[16] As noted above in our discussion of the history of this case, the RIB has accepted that the Patentee intended to file claims of the scope of proposed claims 44-49 as part of the original patent application, based on the protection they sought and obtained in a corresponding US Patent. The evidence submitted in this respect has therefore been taken to prove that the error, or defect, arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention. In addition, since the appropriate fees have been paid, and the application for reissue was filed within four years from the date of issue of the patent (see *Curl-Master Manufacturing Co. Ltd. v. Atlas Brush Ltd.* (1967), 52 C.P.R. 51 (S.C.C.) at page 74), requirements (a), (b), and (c) of s. 47(1) as outlined above have been met.

[17] The only remaining question in relation to s. 47(1) is that of point (d) above, namely whether the proposed reissue claims are

directed to the Asame invention@ as the original patent.

[18] In the SOR, the RIB put forward several reasons why the claims sought to be included in the patent by reissue are unacceptable:

- _ While one requirement of Asame invention@ under s. 47(1) of the Act is support in the original specification (as noted in CD1289), another requirement should be that Asame invention@ require the reissue claims to be directed to the same inventive concept as the issued claims.
- _ The case law indicates that the amended claims sought by reissue cannot define an invention other than an invention which was claimed in the original patent (see *Fuso Electric v. Canadian General Electric*, [1940] 2 D.L.R. 1 (S.C.C.)). The inventor had to have described and claimed the subject matter forming the reissue application in the original patent.
- _ The language of s. 47(1) of the Act suggests that there must be one invention as Athe same invention@ is singular, not plural.
- _ Proposed reissue claims 44-49 are directed to a different inventive concept/invention than issued claims 1-43, contrary to the requirements of s. 36(1) of the Act.
- _ The fact that a corresponding US Patent issued which contained both inventions does not require the Canadian Intellectual Property Office (ACIPO@) to take a position that this is acceptable as well because unity of invention requirements in Canada and the US are different.
- _ The rights of the public would be prejudiced by the reissue

of a patent with an additional invention over that of the original.

[19] We believe that the above points may be addressed by answering the following questions:

Question _: Is the application for reissue non-compliant with s. 47(1) of the Act because the proposed reissue claims are not directed to the A same invention@ as that of the issued patent?

Question _: Is the application for reissue non-compliant with s. 36(1) of the Act?

Question _: Is this a case where the Commissioner should exercise his discretion under s. 47(1) of the Act to not grant the reissue because in this case to grant the reissue would prejudice the public?

Analysis

Question 1: A Same invention@ under s. 47(1) of the Act

[20] As noted above in discussing the applicable legal principles, s. 47(1) requires that a reissued patent be A for the same invention for the then unexpired term for which the original patent was granted.@

[21] 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.), referred to by the Patentee in their response of January 22, 2010 and by the RIB in the SOR, the Court stated that:

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 invention" necessitates that the amended claims must be for an invention as disclosed in the original patent specification, although somewhat imperfectly.

[22] In the SOR the RIB suggested that this passage referred to Aa requirement of same invention@ and that another requirement was that the claims of a reissued patent be directed to the same inventive concept. The Patentee suggested that this passage meant that Asame invention@ be Ainterpreted liberally and not in an overly technical or strict manner.@

[23] *Mobil Oil*, as quoted above, indicates that the amended claims must relate to an invention disclosed in the patent, of course, assuming that the intention of the Patentee to protect such subject matter can be established. Although the RIB contends that there should be a further requirement under s. 47(1) of the Act that the amended claims relate to the same inventive concept as the issued claims, we see no such requirement in view of *Mobil Oil* and in view of the following review of other cases relating to the RIB=s other points in relation to s. 47(1) of the Act.

[24] The RIB suggested that the case law indicates that in order to

obtain a reissue, the inventor had to have described and claimed the subject matter forming the reissue application in the original patent.⁶ In support of this point the RIB pointed to *Fuso Electric*, noted above, and the statement that:

The re-issue is not the grant of a new patent but must be confined to the invention which the inventor attempted to describe and claim in the original patent.

[25] Although the above statement was indeed made by the minority of the Court, it is important to place it in the context of the facts of the case. In the *Fuso Electric* case, a reissue was obtained based on two of the original claims and two new claims, with the rest of the specification being unchanged. Both the majority and minority of the Court recognized that there was no support in the original patent for the features relating to the elimination of glare and withstanding the shocks of commercial handling, features introduced by the new claims of the reissue. In other words, the new claims introduced new matter into the patent. As the majority of the Court stated (material in brackets added):

I have come to the conclusion that [claims 3 and 4] would have been invalid had they been introduced in the patent as originally framed for reasons which I shall mention and, further, that they constitute an attempt to give a new character to Pipkin's invention and that the re-issue patent is invalid accordingly.

[26] Therefore the facts of *Fuso Electric* were such that the subject matter of the new claims was neither described nor claimed (i.e., the Court was not faced with a situation where the subject matter of claims sought by reissue was described but not claimed as in the present case).

[27] In the more recent *Curl-Master* case, the Supreme Court noted that the trial judge used the same reasoning in invalidating the reissued patent as was seen in *Fuso Electric*, above, with respect to the minority opinion therein that the reissue be confined to what was described and claimed in the original patent. The trial judge pointed to a statement of MacLean J. in *Northern Electric Co. et al. v. Photo Sound Corp.* [1936] 2 D.L.R. 711 at pages 723-724, [1936] Ex.C.R. 75, which was very similar to the passage pointed to by the RIB from *Fuso Electric*.

[28] The Supreme Court, in overturning the finding of the trial judge, looked to the drawings in order to find support for the subject matter of the reissue claims. In *Curl-Master* the important features of the reissue claims were neither present in the original claims nor in the description of the invention. In the context of *Curl-Master*, the Supreme Court put the requirements to satisfy s. 50 of the *Patent Act* (now s. 47) as:

whether there was, in relation to patent 554,826, a complete failure to disclose Marchessault's invention, so as to render that patent invalid, as failing to disclose any invention, or whether there was an imperfect description of the appellant's invention which would render the patent defective, but still capable of correction by reissue, if such imperfection resulted from error or mistake.

[29] The above passage focusses on what has been disclosed in the original patent in deciding if a reissue is justified, again of course in conjunction with the requirement that an error or mistake be substantiated.

[30] In *Curl-Master* the significance of the differences between the

claims in the original patent and the reissued claims was not a bar to obtaining a reissue. Broad claim 1, as originally issued, focussed on a curling broom with a stepped configuration of two lengths of fibers. In contrast, broad claim 1 of the reissued patent focussed on the particular method of binding the broom fibers which included a lower loosely stitched binding supported by flexible ties connected to the broom head. The stepped configuration was not a feature of claim 1 of the reissued patent.

[31] *Curl-Master* further illustrates that it is not necessary that an invention claimed in a reissued patent be directed to the same invention described and claimed in the original patent. What matters is whether the invention was disclosed and that the patentee can prove that the failure to claim the invention was the result of inadvertence, accident or mistake.

[32] Subsequent to *Curl-Master*, in *Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd.* (1972), 7 C.P.R. (2d) 198, the Federal Court-Trial Division, in considering the *Curl-Master* case, reiterated the focus on what has been disclosed as the basis for sustaining a reissue. In the Court=s view, the Supreme Court:

merely considers whether a patentable invention is present, although not necessarily described or even claimed because the statement of invention at the beginning of the original patent in *Curl-Master* did not even mention the feature which the Court later found to be the invention on which the reissue patent could be supported.

[33] We also note that in *Burton Parsons*, above, the Patentee=s intent was derived from the protection that was sought in the

US, as in the present case.

[34] While the Court of Appeal reversed the decision of the Trial Division, it was eventually restored by the Supreme Court ([1976] 1 S.C.R. 555). In relation to the validity of the reissue, the Supreme Court stated:

What is important is that the good faith of the inventor is not challenged and it is not seriously disputed that the initial patent disclosed the same invention as the reissued patent.

Conclusions on Asame invention@

[35] The RIB, having accepted that the Patentee intended to claim the subject matter of the claims proposed by the application for reissue and that this subject matter was disclosed by the initial patent, considered that s. 47(1) of the Act also requires, to meet the requirement of Asame invention@, that the inventive concept of the invention sought on reissue must be the same as that of the claims originally issued. We have found from our review of the relevant case law that it is not necessary that the invention sought in an application for reissue relate to the same inventive concept as the issued claims. Furthermore, we have not identified any additional requirements imposed by the Canadian courts in relation to Asame invention@ under s. 47(1) of the Act. This conclusion also applies to the RIB=s point relating to the fact that Asame invention@ is singular in s. 47(1) of the Act.

[36] For the above reasons, we find that the present application for reissue is compliant with the Asame invention@ requirement in

s. 47(1) of the Act. We note that this finding is consistent with the view of Asame invention@ expressed in CD1289 and CD1297, referred to earlier.

Question 2: Compliance with s. 36(1) of the Act

[37] In the SOR submitted to the Board, the RIB emphasized two points in relation to s. 36(1) of the Act: (1) because claims 44-49, introduced in the amended specification, are directed to a different inventive concept than those of issued claims 1-43, the reissue cannot be granted with both sets of claims, and (2) because the unity of invention requirements in Canada and the US are different, CIP0 is not required to take the position the US did in granting a patent to both inventions.

[38] In relation to the first point, as we noted earlier at para. [2], the present process for examination of an application for reissue entails two phases, the first being an examination of the petition for reissue and accompanying documents for compliance with section 47 of the Act, and the second phase being an examination by the appropriate examiner of the amended specification for compliance with the other provisions of the Act and Rules. In light of the scope of the first phase, we find it to be more appropriate that any assessment for compliance with s. 36(1) of the Act be performed by the examiner, in conjunction with the assessment for compliance with the other provisions of the Act and Rules.

[39] In relation to the second point identified above, in the response of January 22, 2010, the Patentee pointed to the

prosecution in the USPTO and the fact that they had allowed a corresponding patent containing both claimed inventions. As pointed out by the RIB in the SOR, practices surrounding unity of invention are not uniform between the USPTO and CIPO. Moreover, the decisions of a foreign office are not binding on CIPO and therefore cannot be conclusive of any unity of invention issue. As recently noted by the Federal Court of Appeal in *Amazon.com v. Canada (Attorney General)*, 2011 FCA 328 at para. 60:

...every jurisdiction has its own patent laws and administrative practices, and they are inconsistent with one another in important respects. The fact that a patent is granted for a particular invention in one or more other jurisdictions cannot determine whether it constitutes patentable subject matter in Canada.

Conclusions on compliance with s. 36(1) of the Act

[40] For the above reasons we find that any assessment for compliance with s. 36(1) of the Act is more appropriately performed by the examiner at the second phase of the examination of the present application for reissue. In performing this assessment, the examiner is not bound by the conclusions reached in another jurisdiction.

Question 3: Discretion under s. 47(1) of the Act

[41] In the SOR the RIB suggested that the rights of the public might be prejudiced by the reissue of a patent to an additional invention not claimed in the original patent.

[42] We note first that in granting a reissue, there is often the potential for a third party who, taking the monopoly to be what it was when the original patent issued, commences operations which later may be deemed to be an infringement of the later reissued patent. This could be the case whenever the scope of protection is broadened by reissue, as is possible under s. 47(1) of the Act. It could also be the case where the invention claimed by reissue is very different from the one claimed in the issued patent, as in the *Curl-Master* case, noted earlier. The potential for a third party being prejudiced by a reissue is therefore not unique to the present situation. Nevertheless, Parliament has provided, by s. 47(1) of the Act, the provision for a Patentee to amend a patent so long as the requirements under that provision are satisfied.

[43] Although there are no cases dealing directly with the factors bearing on the exercise of discretion under s. 47(1) of the Act, similar discretion exists under s. 8 of the Act. In *Repligen Corporation v. Attorney General of Canada*, 2010 FC 1288, the Court recently pointed out that, in relation to the exercise of discretion under s. 8 of the Act to correct a patent, (emphasis in original):

Simply invoking possible third party rights without more would, in my view, fundamentally impair the remedial power Parliament conferred upon the Commissioner to remedy clerical errors. The reason is obvious: in the case of every issued patent the disclosure will have been made; in the case of a patent application, it is open to the public inspection after a certain date. Justice Desjardins in *Bristol-Myers* did not endorse a speculative determination of third party rights. She had hard facts before her which pointed to the likelihood third parties would be affected...

[44] The Court in *Repligen* also pointed out that:

In terms of the exercise of discretionary authority there is another important principle established in administrative law. The exercise of discretionary power must be compatible with and promote the object and purpose of a statute or a statutory provision (see *Delisle v Canada (Attorney General)*, 2006 FC 933 at paras. 129 to 131).

[45] The purpose of s. 47 of the Act was discussed by the Supreme Court of Canada in *Farbwerke Hoechst AG. v. Com=r of Patents*, 50 C.P.R. 220, 33 Fox Pat. C. 99, [1966] S.C.R. 604 in relation to the corresponding American provision. The Court pointed to the decision of the United States Supreme Court in *Mahn v. Harwood* (1884), 112 U.S. 354 at p. 362 where the US Supreme Court stated the purpose of the reissue provision as being:

to provide that kind of relief which courts of equity have always given in cases of clear accident and mistake in the drawing up of written instruments.

[46] In the present case, there are currently no facts before us which would demonstrate that any third party would be adversely affected by the reissue of the patent comprising the additional set of claims. The Patentee has also sufficiently proven that an accident or mistake occurred in the preparation of the patent and has sought to amend the patent to rectify the situation, actions which are consistent with purpose of the reissue provisions noted above. There is therefore no reason for us to recommend in the present case that the Commissioner exercise his discretion to not grant the reissue.

Conclusions on Discretion under s. 47(1) of the Act

[47] For the above reasons we find that in relation to the issue of third party prejudice, there is no evidence at this time which would require the exercise of the Commissioner=s discretion under s. 47(1) of the Act to refuse the application for reissue.

SUMMARY

[48] In view of the above, we find that the present application for reissue is compliant with the Asame invention@ requirement of s. 47(1) of the Act. Additionally, due to the current lack of any facts on the record establishing any prejudice to a third party, we see no reason in the present case to recommend the exercise of discretion in refusing to grant the reissue on that basis.

[49] Further, as an application for reissue is examined in two stages, as noted at paras. [2] and [40], and given that the present case is found to be acceptable in accordance with the first stage of the process, the next step is to have the amended specification examined for compliance with the other provisions of the Act and Rules and whether the Commissioner=s discretion under s. 47(1) of the Act should be exercised in that respect to not reissue the patent.

[50] We note, however, that were new facts in relation to third party prejudice to come to light during the second stage examination process, the exercise of discretion in respect of that issue would need to be reconsidered.

RECOMMENDATION OF THE BOARD

[51] In view of the above findings that the present application for reissue is compliant with the Asame invention@ requirement of s. 47(1) of the *Patent Act* and the finding that there are no facts at this time upon which to base a discretionary decision to not grant the reissue, the Board recommends that the application for reissue be returned to the Patent Branch for examination of the amended specification for compliance with the other provisions of the Act and Rules.

Stephen MacNeil
Member

Andrew Strong
Member

Christine Teixeira
Member

DECISION OF THE COMMISSIONER

[52] I concur with the Patent Appeal Board's findings and their recommendation that the application for reissue be returned to the Patent Branch for examination of the amended specification for compliance with the other provisions of the Act and Rules.

[53] Accordingly, I hereby return the application for reissue to the Patent Branch for examination of the amended specification for compliance with the other provisions of the Act and Rules.

Sylvain Laporte
Commissioner of Patents

Dated at Gatineau, Quebec,
this 17th day of July, 2012