

Commissioner=s Decision #1351

Décision du Commissaire #1351

TOPIC: A11

SUJET: A11

DRAFT

Application No. : 549,227

Demande No. : 549,227

DRAFT

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 549,227 having been rejected under Subsection 30(3) of the *Patent Rules*, has been referred to the Patent Appeal Board for review. The findings of the Board and the ruling of the Commissioner are as follows:

Agent for the Applicant:

Goudreau Gage Dubuc

2000 McGill College Suite 2200

Montreal, Quebec, Canada

H3A 3H3

INTRODUCTION

- [1] This decision concerns a review of the rejection of patent application number 549,227 entitled AICHEMILUMINESCENT ACRIDINIUM SALTS®, filed by the Applicant, Abbott Laboratories.
- [2] In the Final Action, the application was rejected on the ground that the Applicant added Anew® subject matter; that is, the subject matter is not reasonably inferred from the specification or drawings as originally filed, contrary to subsection 181 of the *Patent Rules*.
- [3] The Applicant initially responded to the Final Action with arguments maintaining that the subject matter is reasonably inferred from the original specification. However, after the application had been forwarded to the Patent Appeal Board along with a Summary of Reasons maintaining the rejection, and the time limit to respond to the Final Action had expired, the Applicant volunteered to relinquish the subject matter to advance the application to allowance.
- [4] According to section 31 of the *Patent Rules*, an application that has been rejected cannot be voluntarily amended after the expiry of the time limit to respond to the Final Action. For this reason, the proposed amendments submitted were not entered into the application. However, proposed amendments can form the basis of a formal directive from the Commissioner in accordance with paragraph 31(c) of the *Patent Rules*. The amendments proposed by the Applicant are considered below, but first we will provide a brief summary of the prosecution history to explain how this matter came to be introduced.

PROSECUTION HISTORY

- [5] As the application was filed on October 14, 1987, it is governed by the provisions of the *Patent Act* as it read immediately before October 1, 1989.
- [6] The application entered into conflict proceedings under section 43 of the *Patent Act* in October 1999 with another pending application defining substantially the same invention. However, the

proceedings were terminated when the parties reached an agreement and the Applicant voluntarily withdrew i) the conflict claims, and ii) all claims identified by the Examiner as being not patentably different from those claims.

[7] A series of post-conflict amendments were submitted outlining new claims to the remaining subject matter. All of these new claims were accepted by the Examiner except for a series of claims which eventually took the form of present claims 18-26. The Examiner ultimately rejected the application in a Final Action because the subject matter of those claims, and pages 6J and 6K of the description (statements of support for those claims), is not reasonably inferred from the specification or drawings as originally filed, contrary to subsection 181 of the *Patent Rules*. In response, the Applicant continued to argue the matter was reasonably inferred from the original specification. The Examiner prepared a Summary of Reasons maintaining the rejection of the application, and the matter was referred to the Patent Appeal Board.

[8] In August 2012, the Applicant declined an opportunity to be heard and informed the Commissioner that it did not intend to make further submissions. Moreover, the Applicant stated that it was willing to relinquish the disputed subject matter (claims 18 to 26 and pages 6J and 6K) so that the application could proceed to allowance. The Board invited the Applicant to submit proposed amendments that reflected the cancellation of the disputed subject matter. The Board also pointed out several minor errors which had been identified during our review of the application. The Applicant submitted proposed amendments on August 26, 2013 for the Commissioner's consideration which formally cancelled claims 18 to 26 and pages 6J and 6K of the description, and corrected the minor errors identified by the Board.

DISPOSITION OF THE PRESENT APPLICATION

[9] The panel agrees that the amendments proposed by the Applicant are necessary for compliance with the *Patent Act* and *Rules*. Therefore, the Commissioner has the option of informing the Applicant that the amendments proposed in the correspondence of August 26, 2013 are required under paragraph 31(c) of the *Patent Rules*.

RECOMMENDATION OF THE BOARD

[10] We recommend that the Commissioner:

(1) invite the Applicant to amend the application as proposed in the correspondence of

August 26, 2013 in accordance with paragraph 31(c) of the *Patent Rules*; and

(2) advise the Applicant that: (i) if the amendments proposed on August 26, 2013, and only those amendments, are made within the specified time limit, the outstanding issues will be considered to have been overcome; and, (ii) if the amendments proposed on August 26, 2013, and only those amendments, are not made within the specified time, the application may be refused.

Cara Weir
Member

Mark Couture
Member

Christine Teixeira
Member

DECISION OF THE COMMISSIONER

[11] I agree with the recommendation of the Board. Under paragraph 31(c) of the *Patent Rules*, I invite the Applicant to make the amendments proposed in the correspondence of August 26, 2013 within three months from the date of this decision.

[12] I advise the Applicant that: (i) if the amendments proposed on August 26, 2013, and only those amendments, are made within the time limit outlined above, the outstanding issues will be considered to have been overcome; and, (ii) if the amendments proposed on August 26, 2013, and only those amendments, are not made within the specified time, I intend to refuse the application.

Sylvain Laporte

Commissioner of Patents

Dated at Gatineau, Quebec
this 20th day of September, 2013

