

Commissioner's Decision # 1392
Décision de la Commissaire # 1392

TOPICS: F01, O00
SUJETS: F01, O00

Application No: 2,726,926
Demande no: 2,726,926

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,726,926 having been rejected under subsection 30(3) of the *Patent Rules* (SOR/96-423), has consequently been reviewed in accordance with Paragraph 30(6)(c) of the *Patent Rules*. 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 recommendation deals with a review of the rejection of CA Patent Application Number 2,726,926 entitled “FILM-DISPENSING CASSETTE AND RIMMED BAG FOR WASTE-DISPOSAL UNIT”, filed in Canada on January 7, 2011. The Applicant is ANGELCARE DEVELOPMENT INC. and the inventor is Michel Morand.
- [2] The present application relates to a film dispensing cassette of the type used in waste-disposal units commonly used to dispose of household waste such as diapers and animal litter. Figures 1 and 2 of the application, reproduced below, illustrate the invention. The cassette, which is positioned at the top of a waste-disposal unit, contains within its periphery a packed tubular film. The film is dispensed from the outer edge of the cassette and down through the cassette center as a continuous tube, its free end sealed by a knot so as to form a “bag” as shown in Figure 2, below. Waste may be fed down through the centre of the film cassette, which causes more film to be withdrawn from the cassette outer edge.

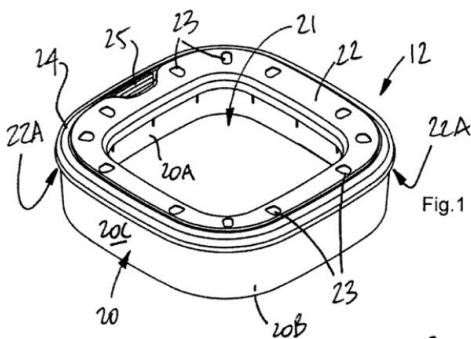


Figure 1

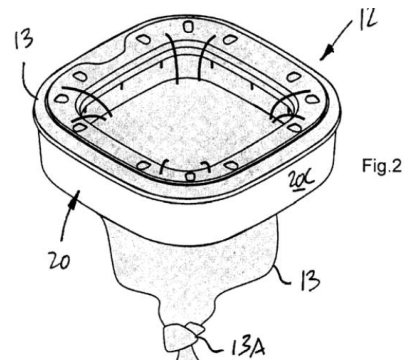


Figure 2

- [3] Figure 1 shows the cassette in a sealed condition before use. As shown in Figures 1 and 2, the cassette is in the form of a rounded square or “squirecle”, which is a preferred shape, in accordance with the present application. The shape of the cassette is the focus of the

present application. According to the Applicant, the shape is chosen so as to increase the amount of film which can be stored by the cassette without drastically increasing the dimensions. In this way, the cassette can be compatible with existing waste-disposal units.

- [4] For the reasons that follow, we recommend that the application be refused on the basis that claims 1-4 and 12 on file lack novelty and that claims 1-13 on file would have been obvious to the person skilled in the art.

PROCEDURAL HISTORY

- [5] The application was rejected by the Examiner in a Final Action dated January 21, 2014 on the ground that the claims were directed to subject matter that would have been obvious, contrary to the requirements of Section 28.3 of the *Patent Act*, RSC 1985, c P-4 (“*Patent Act*”).
- [6] In response, on April 22, 2014 the Applicant submitted minor amendments to the description and introduced a new dependent claim 9. The Applicant also provided further arguments in support of the non-obviousness of the claims.
- [7] The case was forwarded to the Patent Appeal Board on May 8, 2014 with a Summary of Reasons (“SOR”) outlining why the Examiner considered the claims to be non-compliant with Section 28.3 of the *Patent Act*.
- [8] As the amendments submitted in response to the Final Action were found not to resolve the defects identified in the Final Action, the amendments were “considered not to have been made” in accordance with Paragraph 30(6)(b) of the *Patent Rules*. Therefore, in this recommendation, claims 1-13 as addressed in the Final Action will be referred to as the “claims on file” and new claim 9 submitted in response to the Final Action, will be referred to as the “proposed claim.”

[9] The present panel was formed to perform a review of the application under Paragraph 30(6)(c) of the *Patent Rules*. We forwarded the SOR to the Applicant on June 16, 2014. In our letter to the Applicant dated April 15, 2015, in addition to proposing a date for an oral hearing, we set out our preliminary views of the issues relevant to the claims on file and proposed claim 9.

[10] In a letter dated May 20, 2015, the Applicant provided written submissions in relation to claim construction, novelty and non-obviousness.

[11] On September 2, 2015 the Applicant made further written submissions accompanied by physical samples of film-dispensing cassettes (one of a circular outline and one of a squircle outline).

[12] An oral hearing was held via videoconference on September 16, 2015.

ISSUES

[13] In light of the Applicant's submissions of May 20, 2015 and our view of the interpretation of claim 1, as set out below, it is our view that the defect of novelty remains only in relation to claims 1-4 and 12 of the claims on file.

[14] Therefore the issues to be addressed by this recommendation are:

- Do claims 1-4 and 12 on file lack novelty?
- Would claims 1-13 on file have been obvious?

[15] The patentability of proposed claim 9 is considered at the end of this recommendation.

LEGAL PRINCIPLES

Claim Construction

[16] In accordance with *Free World Trust v Électro Santé Inc*, 2000 SCC 66 [*Free World Trust*] essential elements are identified through a purposive construction of the claims done by considering the whole of the disclosure, including the specification and drawings. (see also *Whirlpool Corp v Camco Inc*, 2000 SCC 67 at paras 49(f) and (g) and 52.) In accordance with the *Manual of Patent Office Practice* [MOPOP], Chapter 13.05 (June 2015), available at the CIPO website, the first step of purposive claim construction is to identify the person skilled in the art and their relevant common general knowledge (“CGK”). The next step is to identify the problem addressed by the inventors and the solution put forth in the application. Essential elements can then be identified as those required to achieve the disclosed solution as claimed.

Novelty

[17] Paragraph 28.2(1)(b) of the *Patent Act* sets out the conditions under which a claim may be found to lack novelty in view of a disclosure by a third party:

28.2 (1) The subject-matter defined by a claim in an application for a patent in Canada (the “pending application”) must not have been disclosed

...

(b) before the claim date by a person not mentioned in paragraph (a) in such a manner that the subject-matter became available to the public in Canada or elsewhere.

[18] There are two separate requirements in order to show that a prior art document anticipates a claimed invention: a prior disclosure of the claimed subject matter; and the prior disclosure must enable the claimed subject matter to be practised by a person skilled in the art (*Apotex Inc. v. Sanofi Synthelabo Canada Inc.*, 2008 SCC 61 [*Sanofi*] at paragraphs 24-29).

[19] "Prior disclosure" means that the prior art must disclose subject matter which, if performed, would necessarily result in infringement of the patent. The person skilled in the art looking at the disclosure is "taken to be trying to understand what the author of the description [in the prior patent] meant" (paragraph 32). At this stage, there is no room for trial and error or experimentation by the skilled person. The prior art is simply read "for the purposes of understanding it": see *Sanofi*, at paragraph 25, citing *Synthon B.V. v. SmithKline Beecham plc*, [2006] 1 All E.R. 685, [2005] UKHL 59.

[20] "Enablement" means that the person skilled in the art would have been able to perform the invention without undue burden. The person skilled in the art is assumed to be willing to make trial and error experiments to get it to work: *Sanofi*, at paragraphs 26-27.

Obviousness

[21] Section 28.3 of the *Patent Act* sets out the conditions under which a claim may be found to be obvious:

28.3 The subject-matter defined by a claim in an application for a patent in Canada must be subject-matter that would not have been obvious on the claim date to a person skilled in the art or science to which it pertains, having regard to

(a) information disclosed more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant in such a manner that the information became available to the public in Canada or elsewhere; and

(b) information disclosed before the claim date by a person not mentioned in paragraph (a) in such a manner that the information became available to the public in Canada or elsewhere.

[22] In *Sanofi* at paragraph 67, the Supreme Court of Canada proposed a four-step approach to performing the obviousness assessment:

- (1) (a) Identify the notional "person skilled in the art";
- (b) Identify the relevant common general knowledge of that person;

- (2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
- (3) Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;
- (4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

[23] At step (4), secondary factors such as commercial success may be relevant though they generally bear less weight because they relate to facts arising after the date of the alleged invention (*Novopharm Ltd. v. Janssen-Ortho Inc.*, 2007 FCA 217 at paragraph 25). Although commercial success may in some cases support inventive ingenuity; commercial success may actually be due to marketing skills and features other than the claimed invention. (*Creations 2000 Inc. v Canper Industrial Products Ltd.* (1988), 22 CPR (3d) 389 at 404 (FC), aff'd (1991) 34 CPR (3d) 178 at 183 (FCA)).

ANALYSIS

Claim Construction

[24] The Applicant, in its responses dated May 20, 2015 and September 3, 2015, did not dispute the panel's characterization of the skilled person or the relevant common general knowledge. We therefore set out these points below and apply them in our construction of the claims.

The person skilled in the art

[25] The skilled person is "a person skilled in the art of waste disposal units, in particular those that use film dispensing cassettes."

The relevant common general knowledge

[26] The relevant common general knowledge would have included knowledge of the following:

- The conventional features of waste disposal units which use film dispensing cassettes to contain waste such as diapers and litter
- The conventional cassettes are generally supported at an opening of a bin and dispense tubular film into the inner cavity of the bin
- The free end of the tubular film is closed to define a bag
- Usually an internal mechanism in the waste disposal unit presses the bag shut to prevent the escape of odors
- Refill cassettes are expensive whereby it is desired to increase the tubular film per cassette without drastically increasing its dimensions.

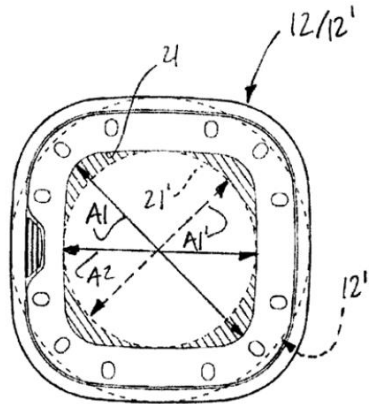
Disputed claim language interpretation

[27] The only point of dispute surrounding claim interpretation revolves around the following passage from claim 1:

an outline of the central opening in a transverse plane of the device having variable diametrical dimensions with a first diameter being of greater dimension than a second diameter, the outline having in the transverse plane of the device two of the first diameter of generally equal dimension and two of the second diameter of generally equal dimension, with the first diameter being the maximum diameter of the outline in the transverse plane, and with the second diameter being the minimum diameter of the outline in the transverse plane.

[28] This passage is relevant because the later applicability of the prior art to the claims depends on the scope of this passage. Our preliminary views on its interpretation are set forth on page 3 of our April 15, 2015 letter. To understand the significance of the passage it is necessary to briefly discuss the relationship of the diameters of the claimed shape.

[29] Figure 9 of the application, below, best illustrates the relationship between the diameters:



[30] It can be seen from Figure 9 of the application that, in comparison to a conventional circular cassette where $A1=A2$, a squircle design where $A1$, the maximum diameter, is greater than $A2$, the minimum diameter ($A1>A2$), provides for a slightly larger perimeter, thereby allowing for more tubular film to be stored in the cassette for the same given minimum diameter $A2$.

[31] In the submissions of May 20, 2015, the Applicant pointed out that the passage in claim 1, noted above at para [28], describing the geometric shape of the film cassette, includes the limitation that there are two of the first (maximum) diameters and two of the second (minimum) diameters.

[32] In our view, the skilled person would consider a requirement that there be two maximum diameters and two minimum diameters to be inconsistent with certain embodiments disclosed in the application since it would exclude a rectangular outline (shown in Figure 6A of the application), as well as an oval outline (shown in Figure 6B of the application). Both rectangles and ovals only have one minimum diameter. Likewise, if there is an upper limit of two maximum and two minimum diameters, the hexagonal outline of Figure 6C of the application would be excluded as it has three maximum diameters and three minimum diameters. If the Applicant's interpretation of May 20, 2015

- [33] were to be adopted, the outline of the central opening defined in claim 1 would only include square or square-like (squiracle) shapes.
- [34] We raised this inconsistency of the Applicant's interpretation with the disclosed embodiments at the hearing and the Applicant responded by submitting that claim 1 should be construed to mean "at least two" maximum diameters and at least two minimum diameters. We disagree with the Applicant on this point for two reasons.
- [35] Firstly, the discussion at page 8 of the description describes several shapes as equally suitable, including the oval shape of Figure 6B of the application, which itself would not satisfy the "at least two" maximum and "at least two" minimum diameter requirement set forth by the Applicant. There is no support in the description for the Applicant's "at least two" criterion. As such, in our view, upon reviewing the description, the skilled person would have no reason to interpret the claims as requiring "at least two" maximum and "at least two" minimum diameters.
- [36] Secondly, as pointed out by the Examiner at the hearing, "at least two" would encompass shapes having many maximum and many minimum diameters. As the numbers of maximum and minimum diameters become sufficiently large, shapes comprising many sides approach or essentially become circles. Since a circle is the conventional shape that the Applicant intended to improve upon (application at page 9, lines 12-23), the Applicant cannot have meant to encompass an anticipated invention within the scope of the claims. Further, even if the claim were interpreted to have the "at least two" requirement, there is nothing in the record to support the view that the skilled person would understand there to be any upper limit.
- [37] In light of the above, in our view, the skilled person would understand claim 1 to be limited to exactly two maximum and exactly two minimum diameters.
- [38] In our letter of April 15, 2015 we also set out our understanding of the meaning the skilled person would attribute to the "clearance in a bottom of the annular body and open

to the central opening”, set out in claim 13, which the Applicant did not dispute. Reference may be made to our letter at page 3 for our understanding of this phrase.

The problem to be solved and the solution provided by the invention

[39] As with the panel’s characterization of the skilled person and the relevant common general knowledge, the Applicant did not dispute the panel’s assessment of the problem to be solved and the solution provided by the application. We set these out below.

[40] The problem to be solved is one of:

coming up with a film cassette structure which increases the amount of tubular film carried within the cassette while avoiding drastically increasing the cassette dimensions.

[41] The panel views the solution provided by the application to be:

the provision of a film-supporting device for use with a waste disposal unit incorporating a combination of specific structural features in order to maximize the amount of tubular film carried by the film-supporting device. The solution also provides for variations on these structural features.

The essential elements of the claims

[42] The panel’s identification of the essential elements of claim 1, as set out in our letter dated April 15, 2015, was also not disputed by the Applicant.

[43] The essential elements of claim 1 are as follows:

- a) An annular body removably insertable in a waste-disposal unit and having at least an annular wall;
- b) With an inward radial surface defining a central opening of the annular body;
- c) An outline of the central opening in a transverse plane of the device having variable diametrical dimensions with a first diameter being of greater dimension than a second diameter, the outline having in the

- transverse plane of the device two of the first diameter of generally equal dimension and two of the second diameter of generally equal dimension, with the first diameter being the maximum diameter of the outline in the transverse plane, and with the second diameter being the minimum diameter of the outline in the transverse plane;
- d) wherein the annular body is adapted to allow the tubular film to be dispensed outwardly from the annular wall.

[44] With respect to the dependent claims 2-11 and 13, we identified the additional features of these claims as essential in that they further define the structural features of the film supporting device, which relate to the solution identified above. This view was not disputed by the Applicant.

[45] With respect to claim 12, the Applicant did not dispute our view that the additional features of this dependent claim relate to the configuration of the tubular film referred to in claim 1, which is itself considered to be non-essential. Therefore, the additional features of this claim would be non-essential as well.

Do claims 1-4 and 12 on file lack novelty?

[46] In our letter of April 15, 2015, the panel set out a preliminary view that claims 1-4 and 12 were anticipated by prior art document D2. Although we had also cited D3, we have conceded in light of our construction of claim 1 that D3 does not anticipate the claims. However, D3 is still relevant later for the purpose of obviousness. Both are identified below:

D2:	US20080272140A1	Mowers et al.	Published: Nov. 6, 2008
D3:	CA2366384A1	Maufette et al.	Published: Jun. 30, 2003

Disclosure

[47] The table below provides a comparison between the essential features of claims 1-4 and 12 as identified in our April 15, 2015 letter, and those of the prior art document D2. For

completeness we have included the additional features of claim 12, despite our view that the person skilled in the art would consider them to be non-essential.

Claim 1	D2- Mowers et al.
a) An annular body removably insertable in a waste-disposal unit and having at least an annular wall	Cassette 20
b) With an inward radial surface defining a central opening of the annular body	Tube central portion 24 and opening 38
c) An outline of the central opening in a transverse plane of the device having variable diametrical dimensions with a first diameter being of greater dimension than a second diameter, the outline having in the transverse plane of the device two of the first diameter of generally equal dimension and two of the second diameter of generally equal dimension, with the first diameter being the maximum diameter of the outline in the transverse plane, and with the second diameter being the minimum diameter of the outline in the transverse plane;	Paragraph [0027] – squares, rectangles, ovals or combinations thereof described as suitable shapes
d) Wherein the annular body is adapted to allow the tubular film to be dispensed outwardly from the annular wall (from construction analysis)	See gap 40 shown in Figures 1 and 2 through which the tubular film would be fed outwardly from the tube central portion 24
Claim 2	
Radial wall projecting outwardly from inner annular wall	Cassette bottom 30
Claim 3	
Outer annular wall projecting upwardly from radial wall of claim 2	Outer wall 28
Claim 4	
Outer annular wall geometrically similar to central opening	As shown in Figs. 1-13 and given the disclosure at paragraph [0027] with respect to different shapes, the outer and inner wall would be taken to be the same
Claim 12	

Tubular film is in an accumulated condition about the annular wall – non-essential	See discussion in paragraph [0027] regarding interior area 32
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[48] In their oral and written submissions the Applicant disputed that D2 disclosed an outline of the central opening being of a shape falling within the language of claim 1 (Applicant’s submissions dated May 20, 2015 at page 3). The Applicant contends that D2 only discloses circular central openings, despite that at paragraph [0027] of D2, excerpted below, a square shape is explicitly disclosed as an alternate shape for the cassette 20. In the Applicant’s view the central opening of the cassette of D2 and its external outline would not necessarily be the same when a shape other than the circular one is used since “the identified passage of D2 does not direct the skilled person to provide a square-shaped opening 38 for the selected square-shaped cassette.” At the hearing, the Applicant similarly contended that there is no clear direct teaching in D2 that the interior outline of the film cassette would be the same as the external outline.

[49] The relevant passage from D2 paragraph [0027] in relation to the alternative cassette shapes is as follows:

While the cassette 20 has been shown in the illustrated embodiment as being cylindrical, the present invention is not limited in this regard as other shapes such as squares, rectangles, ovals, and the like, or combinations of these shapes, can be substituted without departing from the broader aspects of the present invention.

[50] In our view, the skilled person would understand this passage to refer to the cassette 20 as a whole unit, including the exterior and interior and to disclose each shape as a viable alternative to the circular shape described and illustrated in D2.

[51] In our view, the skilled person would understand the passage “other shapes such as squares, rectangles, ovals and the like” to mean that the external and internal outlines of these cassettes are the same shape (e.g., “squares” would indicate a square external outline and a square internal outline). In contrast, in our view, the skilled person would understand the passage “or combinations of these shapes” to mean that the external and

internal outlines of these cassettes can be of different shapes (e.g., a cassette could have a square external outline and a circular internal outline).

[52] In light of the above, it is our view that a cassette where the external and internal outlines are the same shape is disclosed by D2.

[53] The Applicant also contends that D2 is silent with respect to the increase in tubular film amount which may be carried by the cassette. On this point, we note that no such feature is present in claim 1 on file. Claim 1 is directed to the structural features of the film-supporting device including the particular shape of the central opening, which is disclosed in D2. A skilled person would understand from D2 that a film cassette could be square shaped, which is encompassed by claim 1 of the present application. If there is an increase in tubular film amount carried by the cassette it would have to result from the claimed shape, which is encompassed by the D2 disclosure.

[54] In light of the above, the panel concludes that the combination of essential features of claims 1-4 and 12 was disclosed by prior art document D2.

Enablement

[55] Given the structural nature of the claimed invention and in light of the accompanying drawings and description in D2, we consider the skilled person to have been taught to make a film cassette having the essential features of claims 1-4 and 12 without undue burden. We note that at page 3 of their submission dated May 20, 2015, the Applicant did contend (based on their view that the D2 reference disclosed only a circular central opening despite the disclosure of other shapes) that the skilled person would need to adapt the opening 38 of D2 to be square-shaped, if one used a square-shaped cassette. However, we see no difficulty for the skilled person in adapting the cassette to reflect a different shape. Just as in the Applicant's present application, in D2 several shapes are described and the skilled person would readily produce a structure to reflect them based on commonly understood manufacturing techniques.

[56] In light of the above the panel concludes that claims 1-4 and 12 lack novelty in view of prior art document D2 and are therefore non-compliant with paragraph 28.2(1)(b) of the *Patent Act*.

Would claims 1-13 on file have been obvious?

(1)(a) Identify the notional "person skilled in the art"

(1)(b) Identify the relevant common general knowledge of that person

[57] As noted earlier, the identification of the skilled person and the relevant common general knowledge were not disputed by the applicant and are set out at paragraphs [25] and [26].

(2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it

[58] As stated in our letter of April 15, 2015, considering the problem to be solved, the solution to the problem and our view of the essential elements of the claims, we see no reason why in this case the inventive concept is something more or less than the essential elements of the claims. The Applicant did not take issue with this view.

(3) Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed

[59] In the response dated May 20, 2015, in respect of the *Sanofi* assessment, the Applicant disputed the panel's views as to the differences at step (3) of *Sanofi* only in respect of the recited shape of the central opening of the annular body (Applicant's submissions of May 20, 2015 at page 2). Although we have concluded above under anticipation that the shape of the central opening of the cassette as defined by claim 1 is disclosed by D2, we will, for the sake of completeness, also consider, at step (4) below, the points made by the

Applicant as to why the shape defined by claim 1 would not have been obvious. The Applicant did not dispute the views of the panel with respect to the differences in relation to other claimed features.

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

[60] In its letter of May 20, 2015, the Applicant contended that ingenuity was required in choosing to use a square-shaped opening based on the disclosure of prior art document D2. The Applicant contended that in order to arrive at a square-shaped film cassette based on D2, the skilled person must perform “mental gymnastics” comprising:

- 1) Pick a square cassette from a one-off reference in paragraph [0027] of the disclosure, and disregard the entire remainder of the disclosure of D2 which teaches that a circular cassette should be used;
- 2) Adapt the opening 38 of the selected square cassette to be square-shaped as well, despite there being no teaching to do so, and despite D2 showing and describing only circular openings; and
- 3) Perform steps 1 and 2 despite no motivation to do so, i.e., no indication in D2 that doing so would increase the amount of tubular film for the same minimum diameter and allow tools to be inserted while minimizing the size of the cassette.

[61] In relation to point 1), we do not agree with the applicant that the reference at paragraph [0027] to a square cassette in the D2 document should be disregarded thereafter. The “DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT” starts at paragraph [0027] and at the end of this first paragraph it is stated that the teachings that follow in paragraphs [0028] to [0035] equally apply to other shapes including a square, etc. In our view, the skilled person would understand from this statement that D2 teaches that a variety of shapes are equally viable, the disclosure not being limited to the circular embodiment particularly described.

[62] With respect to point 2), we do not see any requirement for inventive ingenuity in adapting the opening 38 of D2 to be a square or other shape. As we have already noted

under anticipation, it is our view that the skilled person would understand that when D2 discloses a square as an alternative shape for the film cassette, both the exterior and interior outlines of the annular body are square, just as both the exterior and interior outlines for the circular cassette are circular.

[63] With respect to point 3), as noted above at step (2) of the *Sanofi* assessment, the inventive concept of claim 1 comprises the structural features of the cassette. The resulting advantages are not part of claim 1 or any of the dependent claims. Looking to prior art document D2, no inventive ingenuity is required to choose to use a square outline, since it is explicitly disclosed as an alternative. In using the mentioned square outline, it would necessarily follow that the capacity for tubular film would increase in proportion to the increase in perimeter (as compared to a circular shape with same internal diameter). Further, the disclosure of a square outline in D2 inherently provides for the presence of a maximum diameter (such that the $A1 > A2$ criterion of the application is met), which can allow for the insertion of larger tools along the maximum diameter dimension (tools that are wider than the sides of the square outline). Therefore any advantage to allow tools to be inserted while minimizing the size of the cassette derives directly from the square outline disclosed by D2.

[64] In respect of point 3), Document D3 is also relevant; it discloses another film cassette, similar to that of D2 and in its preferred embodiment uses an oval outline for the film cassette, though “other shapes of cassette are foreseen, such as circular, which could be used to collect disposed baby nappies” (page 5, lines 7-8 of D3). D3 also recognized the advantage of using a shape having one diameter greater than the other (such that $A1 > A2$), namely the advantage that a larger scoop may be accommodated along the maximum diameter (page 5, lines 5-7 of D3).

[65] At the hearing, the Applicant discussed other advantages of the claimed cassette/film supporting device, for example, as compared with a conventional circular cassette with the same minimum diameter $A2$, the claimed device would not take up significantly more space when packed beside another. While we agree that this would be the case given the

same minimum diametrical dimension, again this is the inherent result of using a square or squircle outline.

[66] During prosecution before the Patent Branch, another point was made by the Applicant in relation to the shape disclosed by D2, to which we responded in our letter of April 15, 2015:

the Applicant has argued that the D2 document is limited to a “tubular central portion 24” (i.e. circular or oval). However, in our view the skilled person would not take the word “tubular” to only refer to embodiments where the cross-section of a tube is circular or oval. Although these are possible cross-sections of a tube, a tube with a square cross-section would also be considered to be tubular. This interpretation is consistent with the variations in shape disclosed at para. [0027] of D2.

[67] Our views on the above point were not challenged in the Applicant’s subsequent written or oral submissions.

Commercial success

[68] In the written submissions of September 3, 2015 the Applicant contended that the commercial sales (5,936,684 cassettes were sold between November 1, 2011 and May 31, 2015) of the squircle embodiment of the claimed cassette/film-supporting device are indicative of the “uniqueness of the claimed invention, and of the unexpected advantages provided by the recited shape of its central opening.”

[69] In this case, the panel concludes that there was no evidence before us to support the contention that commercial success was the result of inventive ingenuity.

[70] As we noted earlier, we do not agree that the advantages that flow from the use of a square or squircle shaped outline are unexpected. Further, sales figures on their own did not demonstrate to the panel that the commercial success was due to the inventive ingenuity of the claimed features and not due to other factors such as marketing skills.

[71] Having considered the record before us, including the Applicant's submissions relating to commercial success, it is our view that no inventive ingenuity would have been required for the skilled person to arrive at a film supporting device such as that of claim 1 in light of prior art documents D2 and D3.

The dependent claims

[72] In our letter of April 15, 2015 at pages 10-12, we set out our views as to why the subject matter of the dependent claims 7, 8, 10, 11 and 13, which contained differences over the state of the art, would have been obvious to the skilled person and invited submissions from the Applicant on these points. The Applicant did not take issue with our views other than in the context of claim 1, which we have dealt with above. Therefore, for the reasons set out in our letter, we conclude that no inventive ingenuity would have been required to arrive at the film supporting device of the dependent claims.

Proposed claim 9

[73] Proposed new dependent claim 9 was the only claim proposed by the Applicant in response to the Final Action, it being directed to the additional feature of the cover wall of the film-supporting device having a plurality of through holes spaced apart along a circumference of the cover wall.

[74] In our letter of April 15, 2015, we invited submissions in response to our preliminary view that proposed claim 9 would have been obvious. However, no submissions were received in relation to this proposed claim. We conclude that since the additional features of claim 9 are non-essential, as set out in our letter at page 12, the subject matter of proposed claim 9 would have been obvious as well.

[75] Having considered D2 and D3, the common general knowledge of the skilled person and the Applicant's submissions, we conclude that claims 1-13 on file and proposed claim 9 would have been obvious and are therefore non-compliant with s. 28.3 of the *Patent Act*.

RECOMMENDATION OF THE BOARD

[76] The panel recommends that the application be refused because:

- Claims 1-4 and 12 on file lack novelty and are therefore non-compliant with paragraph 28.2(1)(b) of the *Patent Act*; and
- Claims 1-13 on file would have been obvious and are therefore non-compliant with section 28.3 of the *Patent Act*.

[77] Further, proposed new claim 9 also suffers from the obviousness defect and is therefore not considered “necessary” under subsection 30(6.3) of the *Patent Rules*.

Stephen MacNeil
Member

Paul Sabharwal
Member

Andrew Strong
Member

DECISION

[78] I concur with the conclusions and recommendation of the Patent Appeal Board that the application be refused because:

- Claims 1-4 and 12 on file lack novelty and are therefore non-compliant with paragraph 28.2(1)(b) of the *Patent Act*; and
- Claims 1-13 on file would have been obvious and are therefore non-compliant with section 28.3 of the *Patent Act*.

[79] Proposed new claim 9 does not overcome these defects and is therefore not considered “necessary” under subsection 30(6.3) of the *Patent Rules*.

[80] Therefore, in accordance with section 40 of the *Patent Act*, I refuse to grant a patent on this application. Under section 41 of the *Patent Act*, the Applicant has six months within which to appeal my decision to the Federal Court of Canada.

Johanne Bélisle

Commissioner of Patents

Dated at Gatineau, Quebec,

this 31st day of March, 2016