

Commissioner's Decision # 1391
Décision de la Commissaire # 1391

TOPICS: F00, O00, A11, B00, B22
SUJETS: F00, O00, A11, B00, B22

Application No. : 2,645,815
Demande N° : 2,645,815

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,645,815, having been rejected under subsection 30(3) of the *Patent Rules*, has subsequently been reviewed in accordance with paragraph 30(6)(c) of the *Patent Rules* by the Patent Appeal Board and by the Commissioner of Patents. The recommendation of the Board and the decision of the Commissioner follow:

Applicant

Ms. Olga Johnson
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INTRODUCTION

- [1] This recommendation concerns a review of patent application no. 2,645,815, filed on December 22, 2008, entitled “Portable Adjustable Durable Suspended Soccer Goal Target”. The inventor and applicant is Ms. Olga Johnson.
- [2] The present application relates to a soccer training target adapted to be positioned in a soccer goal. The target consists of a rectangular frame with an opening and adjustable fastening straps that allow the frame to be suspended from the cross bar of the soccer goal to offer a smaller area through which a ball may be directed.
- [3] For the reasons that follow, we recommend that the application be refused.

PROSECUTION HISTORY

- [4] On July 25, 2013 the Examiner wrote a Final Action pursuant to subsection 30(4) of the *Patent Rules*. The Final Action stated that the application was defective on the following grounds:
- claims 1, 2, 4, 5, 7 and 8 fail to comply with paragraph 28.2(1)(b) of the *Patent Act* for comprising subject matter that was anticipated;
 - all of the claims on file (claims 1-8) fail to comply with section 28.3 of the *Patent Act* for comprising subject matter that was obvious;
 - claim 3 and the description fail to comply with section 38.2 of the *Patent Act* for including matter that is not reasonably to be inferred from the specification and drawings as originally filed;
 - claims 1-5 and 7-8 fail to comply with subsection 27(4) of the *Patent Act* for being indefinite;
 - claims 3 and 8 fail to comply with section 84 of the Patent Rules for lacking

support in the description; and

- various informalities (page numbering, line spacing, lack of title).

- [5] In an October 29, 2013 response to the Final Action, the Applicant amended the abstract, description, claims 1-8, and drawings. The Applicant also presented arguments regarding the novelty, non-obviousness and new matter defects noted in the Final Action.
- [6] As the Examiner considered the application not to comply with *Patent Act*, pursuant to subsection 30(6) of the *Patent Rules* the application was forwarded to the Patent Appeal Board [“the Board”] for review on December 4, 2013, along with a Summary of Reasons explaining why the application did not comply with the *Patent Act*. The Summary of Reasons maintained the grounds set out in the Final Action, except for those pertaining to informalities.
- [7] In a letter from the Board dated January 10, 2014, the Applicant was forwarded a copy of the Summary of Reasons and was provided an opportunity for a hearing. In a response dated April 14, 2014, the Applicant requested a hearing.
- [8] After a preliminary review, this panel sent a letter dated February 12, 2015 to the Applicant, making preliminary observations on claim construction and the defects relating to paragraph 28.2(1)(b) and section 28.3 of the *Patent Act* and providing the Applicant an opportunity to make submissions regarding the observations.
- [9] The Applicant did not provide written submissions concerning the preliminary observations, but provided oral arguments to the panel during a teleconference held on June 30, 2015.

ISSUES

[10] The issues requiring determination in this review are as follows:

- Are the claims anticipated?
- Are the claims obvious?
- Does claim 3 (and the description) improperly include new matter?
- Are claims 1-5 and 7-8 indefinite?

[11] Regarding the issue of lack of support identified in the final action with respect to claims 3 and 8, we approach this as a question as to whether there is a lack of structural features in the claims. Accordingly, this issue will be included in the consideration of claims indefiniteness.

LEGAL PRINCIPLES

Purposive construction

[12] In accordance with *Free World Trust*, 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), 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 disclosed in the application. Essential elements can then be identified as those elements of the claims that are required to achieve the disclosed solution.

Novelty

[13] Section 28.2 of the *Patent Act* sets out the information that may be considered in determining whether the subject matter of a claim is novel. Paragraph 28.2(1)(b) states:

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.

[14] In *Apotex Inc v Sanofi-Synthelabo Canada Inc*, 2008 SCC 61, [2008] 3 SCR 265 [*Sanofi*], the Supreme Court concluded that the issue of novelty requires that the Court have regard to two questions:

1. Was the subject matter of the invention disclosed to the public by a single disclosure?
2. If there has been such a clear disclosure, is the working of the invention enabled by that disclosure?

Obviousness

[15] The *Patent Act* requires that the subject matter of a claim not be obvious. Section 28.3 of the Act provides as follows:

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.

[16] In *Apotex Inc v Sanofi-Synthelabo Canada Inc*, 2008 SCC 61 at para. 67 [*Sanofi*], the Supreme Court of Canada stated that it is useful in an obviousness inquiry to follow the following four-step approach:

- (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?

New matter

[17] Subsection 38.2(2) of the *Patent Act* sets forth the conditions under which amendments may be made to the specification of a patent application:

Restriction on amendments to specifications

38.2 (2) The specification may not be amended to describe matter not

reasonably to be inferred from the specification or drawings as originally filed, except in so far as it is admitted in the specification that the matter is prior art with respect to the application.

[18] The question as to whether matter added to the specification by amendment complies with section 38.2 of the *Patent Act* is considered from the point of view of the person skilled in the art at the time the application was filed.

[19] The assessment as to the presence of new matter therefore requires a comparison of the pending specification with the originally filed specification and drawings, and a determination as to whether the subject-matter of the amendments is that which would have been reasonably inferred from the original specification or drawings by the person skilled in the art at the time of filing.

Claims indefiniteness

[20] Subsection 27(4) of the *Patent Act* states:

The specification must end with a claim or claims defining distinctly and in explicit terms the subject-matter of the invention for which an exclusive privilege or property is claimed.

[21] In *Minerals Separation North American Corp v Noranda Mines Ltd*, [1947] Ex CR 306, 12 CPR 99 at 146, [“*Minerals Separation*”], the Court emphasized the obligation an applicant has to make clear in his claims the ambit of the monopoly sought and the requirement for terms used in the claims to be clear and precise:

By his claims the inventor puts fences around the fields of his monopoly and warns the public against trespassing on his property. His fences must be clearly placed in order to give the necessary warning and he must not fence in any property that is not his own. The terms of a claim must be free from avoidable ambiguity or obscurity and must not be flexible; they must be clear and precise

so that the public will be able to know not only where it must not trespass but also where it may safely go.

ANALYSIS

Purposive construction

The person skilled in the art and the common general knowledge of this person

[22] This panel's letter dated February 12, 2015 provided a preliminary view of the characterization of the skilled person and the common general knowledge:

The person skilled in the art is a designer of sports training aids. The skilled person would have knowledge of sports training aids generally, and of targets for practicing accuracy in particular, including knowledge of common manufacturing methods and materials.

[23] The Applicant did not disagree with this characterization, and we use it in our review.

Problem and solution

[24] This panel's letter provided a preliminary view of the problems with prior art devices and the solution proposed by the application:

The description of the present application, in particular the "Background of the Invention", states that "[t]he invention of the adjustable suspended soccer goalmouth target was to fulfill the need for a state of the art training device that would increase the ability of a striker to score more goals, and develop the goalie's ability to read where in the goalmouth the ball would be sent by the opponent's striker." The solution proposed by the description is an adjustable

suspended soccer goalmouth target that addresses the above need and has the following advantages:

- adjustability (both vertically and horizontally) within the plane of the goal line of a goal);
- durability;
- portability;
- ease of set-up, disassembly and storage; and
- simulating the objective of the game (to direct a ball into the goal) by requiring a player to direct the ball through the target.

[25] The Applicant did not disagree with this characterization, and we use it in our review.

The essential elements of the claims

[26] The panel letter set out a preliminary determination of the essential elements of claims 1-8. At the hearing, the Applicant did not take issue with this determination, which is summarized below.

[27] The skilled person would understand the essential elements of the claims, considered as a whole, to be:

- a. a goalmouth target for use within a goal comprising pieces of material assembled into a frame;
- b. two adjustable straps attached to one of the sides of the frame for suspending the frame at various heights from the crossbar of the goal between the crossbar and the ground, and at various positions between the two posts;
- c. the frame provides an opening of a sufficient size to allow a soccer ball to pass through it;

- d. the straps are loosely attached to the frame;
- e. the frame is many times smaller than the actual goal; and
- f. the frame is made of plastic.

[28] A breakdown of the essential elements by claim is provided below:

Claim	Essential elements
1	a, b
2	a, b, c
3	a, b, c, d
4	a, b, c
5	a, b, c, e
6	a, b, c, e, f
7	a, b
8	a, b, c, e

Novelty

[29] In the Final Action and Summary of Reasons, the following references were cited by the Examiner as forming part of the state of the art:

Patent Documents

D1: ES 2 128 981 A1	published May 16, 1999	Cicuendez
D2: GB 2 431 361 A	published April 25, 2007	O'Neill
D5: US 6,402,641 B1	issued June 11, 2002	Lee

[30] The prior art references were published before the filing date of the present application, which is December 22, 2008, and therefore are citable as prior art.

[31] The novelty issue can be dealt with quickly. Neither D1 nor D2 disclose, in relation to element b, adjustable straps attached to one of the sides of the frame for suspending the frame at various heights from the crossbar of the goal. As this is an essential element of all of the claims on file, the claims are not anticipated by either D1 or D2.

[32] As for D5, this reference does not disclose, in relation to element a, pieces of material assembled into a frame. As this is an essential element of all of the claims on file, the claims are not anticipated by D5.

[33] In summary, the claims are not anticipated by any of the cited references, D1, D2 or D5.

Obviousness

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

[34] The person skilled in the art was identified at para. [22].

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

[35] The relevant common general knowledge of the skilled person was identified at para. [22].

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

[36] In this case, we see no reason why the inventive concept of each claim should be anything other than the essential elements of the claim, as set out in paras. [27] and [28].

(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

[37] The panel’s letter set out a preliminary determination of the differences between each cited reference and the essential elements of claims 1-8. At the hearing, the Applicant did not take issue with this determination, which is summarized as follows.

[38] As stated in the novelty analysis, D2 does not disclose, in relation to element b (which is an essential element of all of the claims), adjustable straps attached to one of the sides of the frame for suspending the frame at various heights from the crossbar of the goal. Further, D2 does not disclose that the frame can be suspended from various positions along the length of the crossbar. These are the differences between D2 and the inventive concept of the claims.

[39] Similar to D2, D1 does not disclose, in relation to element b, adjustable straps attached to one of the sides of the frame for suspending the frame at various heights from the crossbar of the goal, nor does it disclose that the frame can be suspended from various positions along the length of the crossbar. Further, D1 does not disclose, in relation to element d (an essential element of claim 3), that the straps are loosely attached to the frame. Still further, D1 does not disclose, in relation to element f (an essential element of claim 6), that the frame is made of plastic. These are the differences between D1 and the inventive concept of the claims.

[40] The difference between D5 and the inventive concept of the claims is that D5 does not disclose a goal comprising pieces of material assembled into a frame, but rather it discloses a solid target. The solid target of D5 does not provide an opening of a sufficient size to allow a soccer ball to pass through it.

[41] Although, as noted in the novelty analysis, no single prior art reference discloses the subject matter of the claims of the present application, the elements comprising the claimed combination were known in the state of the art on the filing date, from the combination of D2 and D5, and the combination of D1 and D5, respectively.

[42] Accordingly, the difference between the state of the art and the inventive concept of the claims is that the state of the art does not teach a combination of features comprising the inventive concept of each of claims 1-8.

(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?

[43] The skilled person, presented with D2 or D1 and desirous of obtaining a soccer training device for increasing the ability of a striker to score more goals and developing a goalie's ability to read where in the goalmouth the ball would be sent by the opponent's striker, would have discovered D5 in a reasonable and diligent search of the prior art, since D5, like D2 and D1, relates to training aids for use in soccer goals. D5 discloses a training device in which the (solid) target can be suspended at various heights from the crossbar of the goal between the crossbar and the ground, and at various positions between the two posts.

[44] The skilled person would understand that combining this feature of D5 with the combination disclosed in either D2 or D1 would allow the target to be located at any location within the soccer goal, thereby providing the desired solution of training both strikers and goalies. While D1, unlike D2, does not teach—in relation to element d—that the straps are loosely attached to the frame (an essential element of claim 3) and—in relation to element f—that the frame is made of plastic (an essential element of claim 6), D5 discloses these differences, as well as the other essential elements of claims 1-8 with

the exception that the target of D5 is solid, and does not—in relation to element a—comprise pieces of material assembled into a frame.

- [45] The Applicant emphasized this point at the hearing, noting that the target in D5 is a solid target, not a frame that provides an opening of a sufficient size to allow a soccer ball to pass through it. However, the skilled person would appreciate that the variable-height feature of D5 is not limited to solid target design and it would not require inventive ingenuity to adapt the target of D5 with a frame as disclosed in D1 and D2 through which a ball can be directed.
- [46] The Applicant also argued at the hearing that the claimed invention was safer than earlier devices, noting in particular that the elastic cords disclosed in D5 could potentially come loose and strike someone. However, the skilled person would understand that while D5 does disclose elastic cords extending from the target to each goal post in order to stabilize the target, such cords were not essential to the invention. The skilled person would recognize that this non-essential feature could be dispensed with when design factors such as ease of set-up, disassembly, storage and safety outweighed any desire to provide additional stability to the target.
- [47] The Applicant further argued at the hearing that the claimed invention facilitated an easier set-up than the devices cited as prior art. However, the set-up of the D1 and D2 devices also facilitate a quick assembly and disassembly by the user, and the device of D5 would likewise not involve any particular difficulties for the user in assembly and disassembly, particularly when the elastic cords are dispensed with for the reasons set out above.
- [48] Finally, the Applicant argued at the hearing that there is ingenuity in the claimed device due to its simplicity, and that something cannot be considered obvious merely because of its simplicity. While we agree that something cannot be considered obvious merely

because of its simplicity, in this case we find that the skilled person would consider the claimed invention to be obvious in view of the cited prior art, for the reasons provided above.

[49] Accordingly, claims 1-8 would have been obvious to the person skilled in the art on the claim date having regard to the combination of D2 and D5, or D1 and D5, and thus do not comply with section 28.3 of the *Patent Act*.

New matter

[50] The Final Action and Summary of Reasons state that claim 3 and the description include the following subject matter that cannot be reasonably inferred from the originally-filed specification and drawings:

- the straps are loosely attached to the frame;
- the straps can be used on any side of the frame; and
- the straps are seven feet long.

[51] Regarding the first feature—that the straps be loosely attached to the frame—the original specification merely states “Attached to the rectangular device are permanent Velcro straps that is used to adjust the different heights, lengths, and positions.” There is no suggestion in the original specification and drawings that the straps are loosely attached to the frame. The inclusion of this feature in the application constitutes new matter that contravenes section 38.2 of the *Patent Act*.

[52] While in order to provide a more complete obviousness analysis we proceeded on the

assumption that the inclusion of this feature in claim 3 was permissible, we concluded that this claim would have nevertheless been obvious.

[53] Concerning the second feature—that the straps can be used on any side of the frame—the original specification states only that permanent Velcro straps are attached to the rectangular device. Since the original drawings illustrate only an embodiment in which the straps are attached to one of the long sides of the rectangle, it cannot be reasonably inferred from the original specification that the straps can be used on any side of the frame. The inclusion of this feature in the application constitutes new matter that contravenes section 38.2 of the *Patent Act*.

[54] As for the third feature—that the straps are seven feet long—in view of the fact the skilled person knows that a standard soccer goal is eight feet high, this feature can be reasonably inferred from the original specification. The skilled person would appreciate that the length of seven feet would allow the target to be located at ground level while allowing the other end of the strap to wrap around the cross bar and attach to itself using Velcro fasteners. Since this feature can be reasonably inferred from the originally-filed specification and drawings, the inclusion of this feature in the application complies with section 38.2 of the *Patent Act*.

Claims indefiniteness

[55] The Final Action states that claims 1-5 and 7-8 are indefinite for various reasons. In the response to the Final Action and at the hearing the Applicant provided no arguments on this issue. Having reviewed the claims, we agree that they are not clear and precise for the reasons provided in the Final Action. Accordingly, claims 1-5 and 7-8 are indefinite and do not comply with subsection 27(4) of the *Patent Act*.

CONCLUSIONS

[56] We have found that: the claims on file (claims 1-8) are obvious and do not comply with section 28.3 of the *Patent Act*; claim 3 and the description include subject matter that does not comply with section 38.2 of the *Patent Act*; and claims 1-5 and 7-8 are indefinite and do not comply with subsection 27(4) of the *Patent Act*.

RECOMMENDATION OF THE PANEL

[57] In view of the above, we recommend that the application be refused.

Paul Fitzner
Member

Andrew Strong
Member

Paul Sabharwal
Member

DECISION OF THE COMMISSIONER

[58] I concur with the Patent Appeal Board's findings and its recommendation that the application be refused because the claims on file (claims 1-8) are obvious and do not comply with section 28.3 of the *Patent Act*, claim 3 and the description include subject matter that does not comply with section 38.2 of the *Patent Act*, and claims 1-5 and 7-8 are indefinite and do not comply with subsection 27(4) of the *Patent Act*.

[59] Accordingly, 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