Commissioner’s Decision #1475

Décision du commissaire #1475

TOPICS: A20 Double-Patenting

SUJETS: A20 Double brevet

Application No: 2,510,594

Demande no: 2 510 594

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,510,594, 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 to refuse the application.

Agent for the Applicant

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## INTRODUCTION

[1] This recommendation concerns the review of rejected Canadian patent application number 2,510,594 ("the instant application"), which is entitled "ADJUSTABLE STATIONARY EXERCISE BICYCLE" and is owned by MAD DOGG ATHLETICS, INC. ("the Applicant"). A review of the rejected application has been conducted by the Patent Appeal Board ("the Board") pursuant to paragraph 30(6)(*c*) of the *Patent Rules*. As explained in more detail below, our recommendation is that the Commissioner of Patents refuse the application.

## BACKGROUND

### The Application

[2] On July 22, 2005, the subject-matter of the instant application was divided from its parent application, no. 2,467,051, for which a patent was granted on January 17, 2006 ("the '051 Patent"). As a divisional application, the instant application carries, as its actual filing date, the same filing date as its parent, November 4, 2002.

[3] The instant application relates to a brake adjustment mechanism for a stationary exercise bike and a bike incorporating the same. According to the application, prior exercise bikes were primarily designed for adults, with few being designed for use by both adults and children. The prior bikes lacked the ability to have the exercise wheel coast with the pedals remaining stationary even with the wheel rotating. Further, according to the application, it is desirable in the case of use by children to have an emergency brake system or total brake release system in place.

[4] Claim 1 on file allows for both gradual adjustment of the friction applied to the wheel through rotation of a force transmitting member, as well as both the sudden application of emergency braking force and sudden release of friction through independent axial movement of the force transmitting member. Figures 1A and 5 of the instant application,

shown below, illustrate the general configuration of the stationary exercise bike and the mechanism that provides for the claimed functionality, respectively.

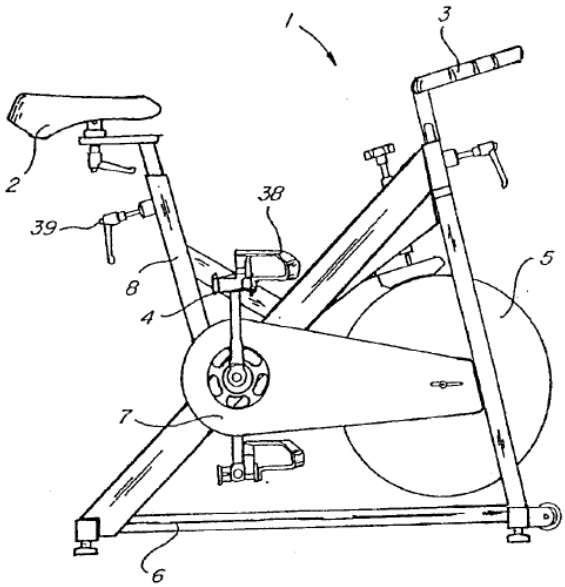


Fig. IA

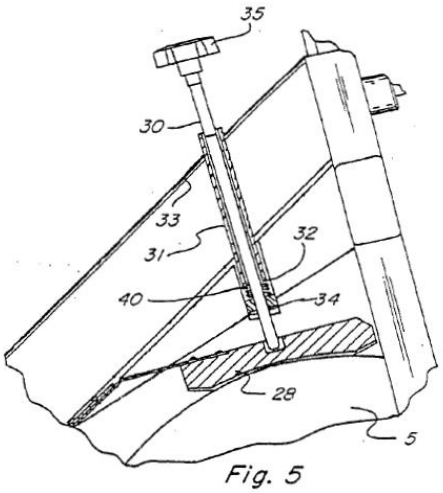


Fig. 5

**Prosecution History**

[5] On October 14, 2014, a Final Action (FA) was written pursuant to subsection 30(4) of the *Patent Rules*. The FA stated that the instant application is defective on the ground that the claims on file at the time of the FA ("claims on file") are not patentably distinct from those of the '051 Patent and are therefore defective due to obviousness double-patenting.

[6] In an April 14, 2016 response to the FA (RFA), the Applicant proposed an amendment to claim 1 on file to include a further limitation in an effort to overcome the obviousness double-patenting defect. The Applicant argued in favour of the proposed amendment but did not submit arguments supporting the claims on file.

[7] As the Examiner considered the application not to comply with the *Patent Act* and *Patent Rules*, pursuant to paragraph 30(6)(*c*) of the *Patent Rules*, the application was forwarded to the Board for review on December 14, 2016 along with an explanation outlined in a

Summary of Reasons (SOR). The SOR set out the position that the application was still defective on the grounds set out in the FA.

[8] In a letter dated December 23, 2016, the Board forwarded to the Applicant a copy of the SOR and offered the Applicant an opportunity to make further submissions and/or attend an oral hearing.

[9] The present panel (the Panel) was formed to review the instant application under paragraph 30(6)(*c*) of the *Patent Rules*.

[10] In a preliminary review letter (PR letter) dated August 16, 2018, the Panel set out its preliminary analysis of the double-patenting issue with respect to the claims on file and the proposed claims.

[11] In a response to the PR letter dated November 13, 2018 (RPR), the Applicant proposed a further amendment to claim 1 on file to add a limitation in addition to that proposed in the RFA. The Applicant also proposed the deletion of dependent claim 9 and provided arguments in favor of the patentability of the claims on file as well as the proposed claims. This latest set of proposed claims will be those assessed later in this recommendation subsequent to our assessment of the claims on file.

[12] An oral hearing via teleconference was held on November 19, 2018.

**ISSUES**

[13] The only issue to be addressed by the present review is whether the claims on file are defective due to obviousness double-patenting in light of the ‘051 Patent.

[14] If the claims on file are considered to be defective, we may turn to the proposed claims and consider whether they constitute amendments necessary for compliance with the *Patent Act* and *Patent Rules*.

## LEGAL PRINCIPLES AND OFFICE PRACTICE

### Claim Construction

[15] In accordance with *Free World Trust v Électro Santé Inc*, 2000 SCC 66, 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 – "*Whirlpool*"). In accordance with the *Manual of Patent Office Practice*, §13.05 (revised 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 put forth in the application. Essential elements can then be identified as those required to achieve the disclosed solution as claimed.

### Double-Patenting

[16] There are no express provisions in the *Patent Act* dealing with double-patenting. However, the Supreme Court of Canada has indicated that the statutory basis for double-patenting is subsection 36(1) of the Act which indicates, in the singular, that "a patent shall be granted for one invention only" (*Whirlpool*, *supra*, at para 63). The courts have also considered double-patenting to be a proper basis for the Commissioner of Patents to refuse an application: *Bayer Schering Pharma Aktiengesellschaft v Canada* (Attorney General), 2010 FCA 275; aff'g 2009 FC 1249.

[17] In *Whirlpool*, the Supreme Court noted that there are two branches to the test for double-patenting. The first is "same-invention" double-patenting, which occurs when the claims of a first and second patent, both of which are owned by the same party, are "identical" or "conterminous" to one another. The second branch is known as "obviousness double-patenting." This is a "more flexible and less literal test" than same-invention double-patenting, which prohibits the issuance of the second patent unless its claims are

"patentably distinct" and exhibit "novelty or ingenuity" over those of the first patent (*Whirlpool*, paras 66-67).

[18] Obviousness double-patenting is assessed from the perspective of the person of skill in the art, taking into account that person's common general knowledge. The analysis compares the claims in the subject application to the claims of the issued patent: *Mylan Pharmaceuticals ULC v Eli Lilly Canada Inc*, 2016 FCA 119 at paras 28-29.

## ANALYSIS

### Claim Construction

*The person skilled in the art*

[19] In the PR letter, the person skilled in the art was characterized as "one skilled in the art of exercise/spin bicycle brake system design", as it was in the FA.

[20] The above characterization was not disputed by the Applicant in the RFA, RPR or at the hearing. We apply it in our analysis below.

*The relevant common general knowledge*

[21] In the PR letter, the relevant CGK was set out as including knowledge of:

- the use of standard bicycle with platform or framework so that the bicycle does not move, as a stationary bicycle;
- the knowledge that some devices have eliminated the back wheel with just a seat and handlebars to simulate a regular bicycle with pedals driving a front wheel; and
- the lack of stationary bicycles adapted for use by children.

*Meaning of terms and essential elements*

[22] With respect to the meaning of terms in the claims and essential/non-essential elements, as stated in the PR letter:

> In the present case, there is no indication on the record of any debate as to the meaning of any terms in the claims, nor does the Panel see any issues in that regard. There is also no analysis as to which claimed features are essential and which are not, if any.
>
> Considering all of the features of the claims on file, we are of the preliminary opinion that they are defective due to obviousness double-patenting in light of the parent '051 Patent. We have therefore not undertaken a construction of the claims, as the outcome is not affected by the omission of any non-essential elements.

[23] We adopt the same approach in this recommendation.

**Double-Patenting**

*Independent claim 1*

[24] In the PR letter, we set out a comparison of the features of claim 1 of the instant application with those of claim 1 of the '051 Patent in Table 1, reproduced below:

**Table 1**

| **Claim 1 of instant application** | **Claim 1 of '051 Patent** | **Comparison** |
|---|---|---|
| A brake adjustment mechanism for varying rotational resistance applied to a wheel, the brake adjustment mechanism comprising: | An adjustable exercise bicycle, comprising: | The brake adjustment mechanism of the instant application is a portion of the adjustable exercise bicycle of the '051 Patent, as shown below. |
| a force transmitting member for applying rotational resistance to a wheel, the force transmitting member being rotatable in one direction and in a direction opposite thereto about an axis of rotation | a threaded tightening shaft located within the longitudinal bore of said adjusting cylinder, having a top end, threaded lower portion, and a lower end, said lower end being in contact with said friction piece | The threaded tightening shaft of the '051 Patent is equivalent to the force transmitting member of the instant application, being rotatable in the tightening nut and applying resistance to the wheel through the friction piece. |

| **Claim 1 of instant application** | **Claim 1 of '051 Patent** | **Comparison** |
|---|---|---|
| a biasing mechanism coupled to the force transmitting member and configured to | a tensioning and quick brake and disengagement means comprising….a tensioning spring, located around the lower portion of said shaft, under said flange and above said tightening nut…wherein said cylinder, shaft, nut and spring cooperate to adjust the tension on said friction piece | Through the tensioning spring, cylinder, shaft and nut of the '051 Patent, a biasing force is applied to the threaded tightening shaft (i.e., force transmitting member) as illustrated in Figure 5 of the '051 Patent showing the arrangement of these elements. |
| (1)<br>apply a biasing force to the force transmitting member along the axis of rotation and, together with the wheel, thereby establish a biased position of the force transmitting member | See above | See above. With the tensioning spring between the flange and tightening nut, the threaded tightening shaft of the '051 Patent would be biased [*towards*] the wheel. |
| (2)<br>progressively vary a magnitude of the applied biasing force in accordance with an angle and direction of rotation of the force transmitting member about the axis of rotation and thereby vary a magnitude of the applied rotational resistance in accordance with the angle and direction of rotation of the force transmitting member | …a threaded tightening shaft located within the longitudinal bore of said adjusting cylinder, having a top end, threaded lower portion, and a lower end, said lower end being in contact with said friction piece; the tightening nut slidably located in the lower portion of said adjusting cylinder, threadedly attached to the lower portion of said tightening shaft; and<br>a tensioning spring, located around the lower portion of said shaft, under said flange and above said tightening nut | Through rotation of the threaded tightening shaft of the '051 Patent in one direction, the tensioning spring is compressed by the tightening nut moving up along the tightening shaft, thereby varying the magnitude of a biasing force as in the instant application. At the same time the rotational resistance applied to the wheel would be increased. Rotation of the threaded tightening shaft in the opposite direction would have the reverse result. |
| (3) permit axial movement of the force transmitting member along the axis of rotation independently of the rotation of the force transmitting member and thereby allow the applied rotational resistance to be directly varied in accordance with a magnitude of displacement of the force transmitting member from the biased position independently of the angle of rotation of the force transmitting member | …wherein said cylinder, shaft, nut and spring cooperate to adjust the tension on said friction piece and wherein the top end of said threaded shaft may be pushed or pulled, respectively, to quickly brake said wheel or quickly disengage said friction piece from said wheel | While the threaded tightening shaft of the '051 Patent may be rotated to vary the friction applied to the wheel through the friction piece, the arrangement also provides for independent push/pull movement along the axis of rotation of the threaded tightening shaft through the shaft, nut, spring and friction adjusting cylinder arrangement. |

[25] We note that, as clarified during the hearing and agreed to by the Applicant at that time, in the comparison section corresponding to point (1) in Table 1 from the PR letter set out above, the comparison should have stated that "the threaded tightening shaft of the '051 Patent would be biased [*towards*] the wheel."

[26] In the PR letter, after setting out Table 1 we stated:

> In light of the above comparison, it is our preliminary view that there is nothing in claim 1 on file that would result in it being considered patentably distinct from claim 1 of the '051 Patent. In our view, claim 1 of the instant application is broader in scope than claim 1 of the '051 Patent and represents the functional characteristics of the combination of elements of the "tensioning and quick brake and disengagement means" set out in claim 1 of the '051 Patent. In our view, the functional characteristics of such means would have been obvious to the person skilled in the art, given the configuration set out in claim 1 of the '051 Patent. Further, in our view there is nothing unobvious in the broader claim to the "tensioning and quick brake and disengagement means" sub-combination of claim 1 of the '051 Patent, as now set out in claim 1 on file. Although claimed as part of an exercise bike in the patent, "the invention"(the brake adjustment mechanism intended to permit coasting, rapid disengagement or emergency braking) is still the same, even if claimed in the patent in narrow structural terms rather than in the broad functional language of the application.

[27] The only argument submitted in relation to the patentability of the claims on file in the RPR or at the hearing was that claim 1 of the instant application is broader in scope than claim 1 of the '051 Patent, in that claim 1 of the instant application broadly relates to a brake adjustment mechanism for varying rotation resistance applied to a wheel and claim 1 of the '051 Patent more narrowly relates to an adjustable exercise bike.

[28] In our view, the above difference identified by the Applicant is essentially the same as the one addressed in the PR letter with respect to the specific "tensioning and quick brake disengagement means" of the '051 Patent and the brake adjustment mechanism of claim 1 on file. Both differences relate to the broadened scope of the claims in the instant application. The broader functionally claimed brake adjustment mechanism applied to a <u>wheel</u> in the instant application would have been obvious to the person skilled in the art in light of the more specific tensioning and quick brake disengagement means applied to an

adjustable exercise bicycle working wheel of the ‘051 Patent. In our view, the broader functional characteristics of the tensioning and quick brake disengagement means of the ‘051 Patent (embodied in claim 1 of the instant application) would have been self-evident to the person skilled in the art. Further, we see noting unobvious in a claim to the brake adjustment mechanism sub-combination, as in claim 1 on file, in light of the exercise bike comprising a specific version of such a mechanism, as in claim 1 of the ‘051 Patent.

[29] Therefore, the skilled person would regard claim 1 on file as not being patentably distinct from claim 1 of the ‘051 Patent.

*Dependent Claims 2-11*

[30] In the PR letter, we stated with respect to dependent claims 2-11 that:

> In our preliminary view, the additional details set forth in dependent claims 2-11 on file do not represent features that would cause the dependent claims to be considered patentably distinct from claim 1 of the ‘051 Patent. While the dependent claims do set out more detailed components that perform the functions set out in claim 1 on file, they are still considered not patentably distinct from the components set out in claim 1 of the ‘051 Patent.

[31] The Applicant made no submission with respect to the above in the RPR or at the hearing. In our view, the skilled person would therefore not regard dependent claims 2-11 as patentably distinct from claim 1 of the ‘051 Patent.

**Proposed Claims**

[32] In the RPR, the Applicant proposed limiting the axial movement of the force transmitting member of claim 1 on file to “toward the wheel” as opposed to the “axial movement” language of claim 1 on file that more broadly encompasses alternative movements of the member both towards and away from the wheel. This was in addition to the limitation proposed in the RFA, which was addressed by the Panel in the PR letter:

> In the R-FA, the Applicant proposed amending claim 1 on file to add the feature "wherein said axial movement of said force transmitting member is independent of its rotation."
>
> In our preliminary view, the addition of this feature would not change our view as to the patentability of claims 1-11 on file. In our view, this characteristic is already present in claim 1 on file which states:
>
> > a biasing mechanism coupled to the force transmitting member and configured to …(3) permit axial movement of the force transmitting member along the axis of rotation independently of the rotation of the force transmitting member [emphasis added].

[33] The Applicant made no further submission in the RPR on the patentability of claim 1 on file when it included the limitation discussed above.

[34] With respect to the limitation of movement of the force transmitting member as "toward the wheel", the Applicant contends in the RPR that this limitation is supported by the description at page 7, lines 1-10 and that since the movement of the force transmitting member away from the wheel is disclosed therein as an alternative movement, movement toward the wheel is an essential element in one embodiment of the invention and therefore the scope of proposed claim 1 is different from that of claim 1 of the '051 Patent.

[35] The relevant portion of the description reads as follows:

> When it is necessary to stop the movement of the wheel (5) immediately, the handle (35) of the mechanism is simply pushed down. This pushes the friction piece (28) tightly against the wheel (5) and stops rotation of the wheel. It has been found that this type of emergency quick stop mechanism is necessary for applications involving children. Adult riders and children are sometimes careless or inattentive to the motion of the exercise bicycle and a quick stop emergency mechanism such as the one described is deemed highly advisable. Alternatively, if the friction adjusting shaft handle (35) is raised, compressing the shaft spring (32), the wheel may then be disengaged from the friction piece and spin freely. Moving the handle (35) upwards disengages the friction piece (28) from the moving wheel (5) and enables a person, particularly a child or adolescent, to easily and safely alight from the exercise bicycle. [emphasis added by Applicant]

[36] In our view, when considered in context, the supposed "alternative" movement used by the Applicant to justify the essential nature of the added limitation is not directed to an

*alternative embodiment* of the invention, but instead is merely directed to a further function of an already disclosed embodiment. The passage from page 7 of the description refers to the spring biasing mechanism of Figure 5 of the instant application, the spring biasing mechanism providing for movement both towards the wheel and away from it in order to provide a braking force or, alternatively, to allow the wheel to spin freely. In our view, the passage beginning with "[a]lternatively" simply describes the additional functionality of the mechanism, namely, providing for release of the friction piece from the wheel. Therefore, the passage does not support the essentiality of a specific direction of movement of the force transmitting member, as in proposed claim 1.

[37] Despite the above, even if the scope of proposed claim 1 were different from claim 1 of the '051 Patent, the proposed claim must be "patentably distinct" in order to avoid a finding of obviousness double-patenting. In our view, limiting the direction of movement of the force transmitting member to one direction would not amount to a patentable distinction. The proposed claim would simply be omitting a feature of the brake adjustment mechanism of claim 1 on file with the corresponding evident omission of the functionality associated with it. "[I]t is not an invention to omit one or more of the parts of an existing thing, unless that omission causes a new mode of operation of the parts retained" (*Allen v Reid* (1888), 14 QLR 126 (Sup Ct)). In the present case, there is no new mode of operation, only the expected mode of operation that remains upon removal of the other movement functionality. Further, there is nothing in the claim or the specification to indicate any implementation issues associated with such a limitation and that would indicate some inventive ingenuity.

[38] With respect to the proposed dependent claims, the only proposed amendment was to delete claim 9. The Applicant's submission in the RPR and at the hearing with respect to the patentability of the dependent claims was limited to their patentability in light of proposed independent claim 1. In light of our conclusion above with respect to proposed independent claim 1, in our view, proposed dependent claims 2-8 and 10-11 are also not patentably distinct from claim 1 of the '051 Patent for the reasons provided in the PR letter and reproduced at paragraph [30] above.

## CONCLUSIONS

[39] We have determined that claims 1-11 on file are not patentably distinct from claim 1 of the ‘051 Patent and are therefore defective due to obviousness double-patenting. We have also determined that the proposed claims do not overcome the obviousness double-patenting defect and therefore the introduction of these claims does not constitute a specific amendment that is “necessary” pursuant to subsection 30(6.3) of the *Patent Rules*.

## RECOMMENDATION OF THE BOARD

[40] In view of the above, the Panel recommends that the application be refused on the ground that claims 1-11 are not patentably distinct from claim 1 of the ‘051 Patent and are therefore defective due to obviousness double-patenting.

[41] Further, the proposed claim set does not overcome the obviousness double-patenting defect and therefore the Panel declines to recommend the introduction of these claims since they do not constitute a specific amendment that is “necessary” pursuant to subsection 30(6.3) of the *Patent Rules*.

| | | |
|---|---|---|
| Stephen MacNeil | Paul Fitzner | Ed MacLaurin |
| Member | Member | Member |

**DECISION**

[42] I concur with the conclusions and recommendation of the Board that the application be refused on the ground that claims 1-11 are not patentably distinct from claim 1 of the ‘051 Patent and are therefore defective due to obviousness double-patenting.

[43] 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 21st day of January , 2019.