

Commissioner's Decision No. 1497
Décision du commissaire n° 1497

TOPIC: O-00 Obviousness

SUJET: O-00 Évidence

Application No. 2760341
Demande n° 2760341

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2760341, 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*. The recommendation of the Patent Appeal Board and the decision of the Commissioner are to refuse the application.

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INTRODUCTION

- [1] This recommendation concerns the review of rejected patent application number 2760341, which is entitled “Touch screen protector” and owned by Aevoe Corp. The outstanding defect indicated by the Final Action (FA) is that the claims are obvious, contrary to section 28.3 of the *Patent Act*. The Patent Appeal Board (the Board) has reviewed the rejected application pursuant to paragraph 30(6)(c) of the *Patent Rules*. As explained below, our recommendation is to refuse the application.

BACKGROUND

The application

- [2] Canadian patent application 2760341 was filed on November 22, 2011 and has been open to public inspection since February 9, 2012.
- [3] The invention relates to a touch screen protector that is easily attached to and removed from a hand held electronic device.

Prosecution history

- [4] On July 15, 2016, an FA was issued pursuant to subsection 30(4) of the *Patent Rules*. The FA indicated that the application was defective on the ground that the claims (i.e. claims 1 to 37) are directed to obvious subject matter and contravene section 28.3 of the *Patent Act*.
- [5] In a January 13, 2017 response to the FA (RFA), the Applicant submitted arguments for allowance, but the Examiner was not persuaded to withdraw the rejection. Therefore, pursuant to subsection 30(6) of the *Patent Rules*, the application was forwarded to the Board for review on behalf of the Commissioner of Patents. On April 26, 2017, the Board forwarded a copy of the Examiner’s Summary of Reasons with a letter acknowledging the rejection to the Applicant.
- [6] A Panel was formed to review the rejected application and make a recommendation to the Commissioner as to its disposition. Following our preliminary review, we sent a letter on May 2, 2019 (the PR letter) presenting our analysis and rationale as to why, based on the record before us, the subject matter of the claims contravenes section 28.3 of the *Patent Act*.
- [7] A June 11, 2019 email indicated that there were no instructions from the Applicant and that no response to the PR letter was expected.

- [8] Nothing has changed in the written record since the preliminary review, so we have maintained its rationale and conclusions.

ISSUE

- [9] This review addresses the issue of whether the claims define subject matter that would have been obvious, contravening section 28.3 of the *Patent Act*.

LEGAL PRINCIPLES AND PATENT OFFICE PRACTICE

Obviousness

- [10] Section 28.3 of the *Patent Act* requires claimed subject matter to not be obvious:

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.

- [11] In *Apotex v Sanofi-Synthelabo Canada*, 2008 SCC 61 at paragraph 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?

ANALYSIS

Obviousness

[12] The PR letter cited the following references:

- D1: Jake Gaecke, “Appletell reviews the iVisor AG for iPad” (Gadgetell, September 15, 2010), archived online:
Appletell reviews the iVisor AG for iPad
<<https://web.archive.org/web/20101119053318/http://www.appletell.com/apple/comment/appletell-reviews-ivisor-ag-for-ipad/>>.
- D2: WO 97/08260 March 6, 1997 Kellen
- D3: EP 2031030 March 4, 2009 Murota et al.
- D4: US 7070837 July 4, 2006 Ross

[13] D1 provides a review of the Moshi iVisor AG, a touch screen protector for the Apple iPad. D1 briefly describes the screen protector and how it works, from the point of view of the consumer. Each of D2 (e.g. abstract; pages 1, 3 and 6), D3 (e.g. abstract; paragraphs 1 and 10) and D4 (e.g. abstract; columns 1 to 4 and 6; figures 2 to 3) describes transparent films for covering the screens of electronic devices.

Identify the notional person skilled in the art and the relevant common general knowledge

[14] In the PR letter, we identified the notional skilled person as a team comprising a chemical engineer, chemist and materials engineer with relevant education and experience in designing and manufacturing screen protectors for hand held electronic devices.

[15] We then identified the following as common general knowledge (CGK):

- using plastics, materials and chemical compositions to design transparent films that can be used as screen protectors for hand held electronic devices;
- imparting adhesiveness and an anti-static effect to such transparent films;
- commonly known and commercially available micro-particles associated with reducing static effects in the field of screen protection;
- using micro-particles on a display screen to reduce glare;
- the inconvenience of interference patterns, or Newton rings, to the users of touch screens with non-adhesive protective films and the consequent desirability of eliminating or minimizing them;
- the potential harm to electronic components from electrostatic discharge; and

- various commercially available adhesives that are removable, re-applicable and washable.

[16] Support for inclusion of this knowledge within the CGK is found in statements in the present application and the cited documents acknowledging what was commercially available or known at the time. Those statements are in the present application (page 1, line 10 to page 2, line 9, page 5, line 29 to page 6, line 4, page 6, lines 20 to 21 and page 7, lines 19 to 24), D2 (page 1, line 9 to page 2, line 14 and page 2, line 23 to page 3, line 10), D3 (paragraphs 2 to 9) and D4 (column 1, lines 16 to 52).

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

[17] Independent claims 1, 17 and 36 define touch screen protectors and independent claim 33 defines a method of protecting a touch screen by attaching a touch screen protector. Claim 1 is provided as a reference:

1. A touch screen protector for a hand held electronic device having a front face that includes a touch screen portion and an outer perimeter comprising:
 - a film having front and back sides, an outer perimeter that corresponds to that of the device, and a transparent window that corresponds in size to the touch screen portion; and
 - a spacer provided along the outer perimeter of the film surrounding the transparent window, having a thickness sufficient to space the film near but not in contact with the touch screen portion, and an exposed adhesive for removably mounting the protector upon the outer perimeter of the front face to form space between the transparent window of the film, the spacer and the touch screen portion of the device;
 - wherein the window can be pressed against the touch screen portion for operation of the electronic device while preventing direct contact of a user's fingers with the touch screen portion;
 - and wherein micro-particles are present on the back side of the film at a density which is sufficiently high to provide an anti-static effect without adversely affecting quality of images viewed through the window, and which prevents visible interference patterns during use, and effects the protector to bounce back or pull away from the touch screen portion once it is no longer pressed against the touch screen portion.

- [18] As the PR letter stated, we consider independent claims 1, 17 and 36 to share the same inventive concept:

a touch screen protector for a hand held electronic device having a touch screen, the protector comprising a film with an outer perimeter and a transparent window, and a spacer, wherein:

the spacer is provided along the outer perimeter of the film, having a thickness sufficient to space the film near the touch screen and an exposed adhesive for removably mounting the protector upon the outer perimeter of the touch screen;

the window can be pressed against the touch screen portion for operation of the electronic device while preventing direct contact of a user's fingers with the touch screen portion; and

micro-particles are present on the back side of the film at a density which is sufficiently high to provide an anti-static effect without adversely affecting the quality of images viewed through the window, which prevents visible interference patterns during use, and which does not interfere with the protector bouncing back or pulling away from the touch screen once it is no longer pressed against the touch screen.

- [19] The exact wording in these independent claims is that the micro-particles are present on the back side of the film at a density that "effects the protector to bounce back or pull away". The description (page 6, lines 11 to 13) states: "As a result of the anti-static effects of the micro-particles, the screen protector will quickly bounce back or pull away from the touch screen portion when it is no longer pressed against it." According to the description (page 5, lines 14 to 23 and page 6, lines 10 to 25), the placement and structure of the screen protector is such that the film including the layer of micro-particles on its back side does not physically contact the touch screen unless it is pressed against the screen. Therefore, this functioning would be interpreted as the micro-particles of the film preventing or avoiding the production of static electricity between the screen protector and the touch screen, which would interfere with the screen protector resuming its original position.

- [20] The inventive concept for independent method claim 33 is similar to the one above but does not specify that the exposed adhesive is provided on a spacer that positions the film above the touch screen. The claim nonetheless specifies that there is adhesive on the perimeter of the film, and a space between the transparent window of the film and the touch screen.

- [21] Claim 35 depends on claim 33 and specifies that the exposed adhesive is provided on a spacer. Thus, we see dependent claim 35 as sharing essentially the same inventive concept as independent claims 1, 17 and 36.
- [22] The remainder of the dependent claims specify further details relating to the material and thickness of the film and spacer (claims 3, 4, 15, 16, 18, 31 and 32), to the adhesive and its application (claims 2, 6 to 11, 21 to 27, 34 and 37), to the mounting of the protector and the types of devices it protects (claims 12, 13, 28 and 29), and to the effects imparted to the protector by the micro-particles (claims 5, 14, 19, 20 and 30). In particular, claim 19 specifies that the micro-particles are used on the back side of the film to prevent interference patterns when the transparent window is pressed against the touch screen.

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

- [23] We consider D1 to be the most relevant cited reference. As explained in the PR letter, the difference between the disclosure of D1 and the inventive concepts for the independent claims 1, 17, 33 and 36, and dependent claim 35, is the lack of any reference to micro-particles in D1.
- [24] Since the additional details in the inventive concepts for claims 4, 6, 12 to 14, 16, 18, 21, 28 to 30, 32, 34 and 37 are also disclosed by D1, our view is that there are no further differences between D1 and these inventive concepts.
- [25] On the other hand, the additional details in the inventive concepts for claims 2, 3, 5, 7 to 11, 15, 19, 20, 22 to 27 and 31 are not disclosed by D1, and we consider these details to represent further differences over D1.

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

- [26] In the RFA, the Applicant had contended that the cited references do not render obvious the use of micro-particles to effect the protector to bounce back or pull away from the touch screen when it is no longer pressed against the touch screen. The Applicant submitted that D2 discloses the adhesion of the micro-particles to the display, thus making it impossible for the protective film to bounce or pull away from the display.

- [27] As we explained in the PR letter, D2 (abstract; pages 1, 3 and 6) discloses an adhesive protective transparent film. Micro-particles with anti-static properties are applied to the surface of the film facing the screen (or other element being protected) to prevent electrostatic damage to the screen caused by triboelectric charging when the protective film is peeled from the screen (see e.g. page 9, lines 13 to 21 and page 20). Given that the micro-particles avoid or prevent the production of static electricity between the film and the screen, they also remove this source of interference with the ability of the film to bounce or pull away from the screen. Furthermore, the micro-particles can also provide a range of desired levels of adhesiveness. That is to say, D2 (page 9, lines 4 to 12 and page 20) not only discloses the use of tacky micro-particles, but also non-tacky micro-particles and blends thereof to achieve the desired level of adhesiveness for the intended application.
- [28] With the protector of D1, the desire to avoid harmful effects caused by triboelectric charging each time the protector is pressed against the touch screen and released would motivate the skilled person to apply the teachings of D2 and add a layer of anti-static micro-particles to the back side of the film. The skilled person would understand that adhesion of the film to the touch screen is undesirable in view of the intended application and accordingly select the micro-particles providing the appropriate lack of tackiness.
- [29] As observed in the PR letter, D4 is another document that would have led the skilled person to add micro-particles to the back side of the film. D4 (column 1, line 27 to column 4, line 65 and column 6, lines 5 to 67; figures 2 to 3) discloses a touch screen protector that, like the invention, does not rely on an adhesive to stick the film of the protector to the touch screen itself. Instead, there is a coating or dispersion of micro-particles on the surface of the film facing the touch screen that minimizes contact with the touch screen and leaves an air space between the film and the screen. The micro-particles eliminate or minimize interference patterns, or Newton rings, (by causing this space to be left) and are of such concentration and size that the film remains transparent: users must be able to view and use the touch screen while the protector is in place.
- [30] With the protector of D1, the conventional desire to eliminate or minimize Newton rings would motivate the skilled person to apply the teachings of D4 and add a layer of micro-particles to the back side of the film to minimize the contact between the protector and the screen, such as when the protector is pressed. Given their function of leaving an air space between the touch screen and the protector,

the micro-particles would not interfere with the protector pulling back when it is no longer pressed against the screen. Since it is CGK that electronic devices can be harmed by electrostatic discharge, and that types of micro-particles impart an anti-static effect, the skilled person would select micro-particles accordingly.

- [31] Given the above reasons, our view is that adding micro-particles to the back side of the film of D1 would have been obvious to the skilled person in view of either D2 or D4. Accordingly, the difference between D1 and the inventive concepts for independent claims 1, 17, 33 and 36, and for dependent claim 35, would have constituted an obvious step.
- [32] Since the additional details of the inventive concepts for dependent claims 4, 6, 12 to 14, 16, 18, 21, 28 to 30, 32, 34 and 37 are disclosed by D1, there are no further differences between D1 and these claims. Therefore, the difference between D1 and the inventive concepts for these claims would have constituted an obvious step in the same way as had the difference between D1 and the above independent claims.
- [33] Although the inventive concepts for claims 2, 3, 5, 7 to 11, 15, 20, 22 to 27 and 31 include further features not disclosed by D1, there is no indication in the specification or on record of any unexpected result from these features, or of any difficulties in implementing them. The PR letter expressed our view that these features represent design options available to the skilled person from within their CGK, and the Applicant did not dispute that view. Therefore, the differences between D1 and the inventive concepts for these claims would have constituted obvious steps.
- [34] Our view regarding claim 19 is, as explained above, that adding micro-particles to the back side of the film of D1 to prevent interference patterns would have been obvious to the skilled person in view of D4. Accordingly, the difference between D1 and the inventive concept for claim 19 would also have constituted an obvious step.

Conclusion on obviousness

- [35] We consider that the subject matter of claims 1 to 18 and 21 to 37 on file would have been obvious to the skilled person in view of D1 and either D2 or D4, and the CGK. Claims 19 to 20 would have been obvious in view of D1 and D4, and the CGK. Consequently, the claims on file do not comply with section 28.3 of the *Patent Act*.

RECOMMENDATION OF THE BOARD

- [36] In view of the above, the Panel recommends that the application be refused on the basis that claims 1 to 37 define subject matter that would have been obvious as of the claim date and thus do not comply with section 28.3 of the *Patent Act*.

Leigh Matheson
Member

Minghui Shi
Member

Cara Weir
Member

DECISION OF THE COMMISSIONER

- [37] I concur with the findings of the Board and its recommendation to refuse the application. The claims on file do not comply with section 28.3 of the *Patent Act*.
- [38] Accordingly, I refuse to grant a patent for this application. Under section 41 of the *Patent Act*, the Applicant has six months to appeal my decision to the Federal Court of Canada.

Johanne Bélisle
Commissioner of Patents
Dated at Gatineau, Quebec,
this 12th day of October, 2019