

Citation: The Proctor & Gamble Company (Re), 2022 CACP 23
Commissioner's Decision # 1630
Décision du Commissaire n° 1630
Date: 2022-11-23

TOPIC: O00 Obviousness

SUJET: O00 Évidence

Application No. 2,953,250
Demande n° 2,953,250

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,953,250, having been rejected under subsection 86(3) of the *Patent Rules* (SOR/2019-251) ("*Patent Rules*") has consequently been reviewed in accordance with paragraph 86(7)(c) of the *Patent Rules*. The recommendation of the Patent Appeal Board and the decision of the Commissioner are to withdraw the rejection and allow the application.

Agent for the Applicant:

TORYS LLP
79 WELLINGTON ST. WEST
30TH FLOOR
BOX 270, TD SOUTH TOWER
TORONTO Ontario M5K 1N2

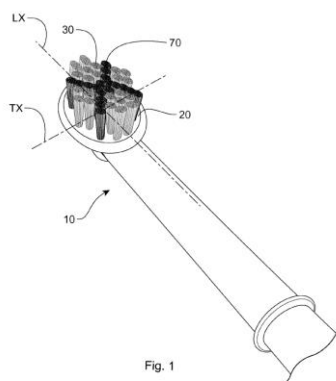
INTRODUCTION

- [1] This recommendation concerns the review of rejected Canadian patent application number 2,953,250 (“the instant application”), which is entitled “ORAL-CARE IMPLEMENT HAVING COLOR-COMMUNICATIVE ELEMENT” and is owned by THE PROCTOR & GAMBLE COMPANY (“the Applicant”). A review of the rejected application has been conducted by the Patent Appeal Board (“the Board”) pursuant to paragraph 86(7)(c) of the *Patent Rules*. As explained in more detail below, the Board’s recommendation is that the Commissioner of Patents withdraw the rejection and that the application be allowed.

BACKGROUND

The Application

- [2] The instant application was filed under the provisions of the *Patent Cooperation Treaty* and has an effective filing date in Canada of July 14, 2015. It was laid open to public inspection on January 21, 2016.
- [3] The instant application relates to an oral-care implement, such as a toothbrush, wherein the bristles of the implement have varying functional characteristics such as structure, composition or shape. The working surface of the implement has more than one color such that the difference in color between bristles produces a scaled-up image that graphically replicates the functional characteristic. For example, if the individual bristles have an X-shaped configuration, the colors would produce the image of an X-shape on the working surface. Such an example is illustrated in Figure 1 of the instant application, reproduced below.



Prosecution History

- [4] On April 20, 2021, a Final Action (“FA”) was written pursuant to subsection 86(5) of the *Patent Rules*. The FA stated that the instant application is defective on the ground that all of the claims 1-14 on file at the time of the FA (“claims on file”) would have been obvious to a person skilled in the art and are therefore non-compliant with section 28.3 of the *Patent Act*.
- [5] In an August 16, 2021 response to the FA (“R-FA”), the Applicant submitted a proposed claim set 1-32 (“proposed claims”) and submitted arguments in favor of patentability for both the claims on file and the proposed claims.
- [6] As the Examiner considered the application did not to comply with the *Patent Act*, pursuant to subsection 86(7) of the *Patent Rules*, the application was forwarded to the Board for review on November 4, 2021 along with an explanation outlined in a Summary of Reasons (“SOR”). The SOR indicated that the claims on file remained defective for obviousness as set out in the FA. With respect to the proposed claims, the SOR indicated that the proposed claims would not overcome the obviousness defect.
- [7] In a letter dated November 8, 2021, the Board forwarded to the Applicant a copy of the SOR and requested that the Applicant confirm their continued interest in having the application reviewed.
- [8] In a response dated January 31, 2022, the Applicant indicated their desire for the Board to proceed with a review of the application.
- [9] The undersigned panel (“the Panel”) of the Board was assigned to review the instant application and to make a recommendation to the Commissioner of Patents as to its disposition.
- [10] The Panel has reviewed the instant application and provide our analysis below.

ISSUE

- [11] The issue to be addressed by the present review is whether the claims on file would have been obvious to the person skilled in the art.

- [12] In the present review, given our recommendation in respect of the claims on file, it is not necessary to review the proposed claims to determine if they are considered a necessary amendment under subsection 86(11) of the *Patent Rules*.

LEGAL PRINCIPLES AND OFFICE PRACTICE

Purposive Construction

- [13] In accordance with *Free World Trust v Électro Santé Inc*, 2000 SCC 66 and *Whirlpool Corp v Camco Inc*, 2000 SCC 67, purposive construction is performed from the point of view of the person skilled in the art in light of the relevant common general knowledge (“CGK”), considering the whole of the disclosure including the specification and drawings. In addition to interpreting the meaning of the terms of a claim, purposive construction distinguishes the essential elements of the claim from the non-essential elements. Whether or not an element is essential depends on the intent expressed in or inferred from the claim, and on whether it would have been obvious to the skilled person that a variant has a material effect upon the way the invention works.
- [14] All elements set out in a claim are presumed essential unless it is established otherwise or such presumption is contrary to the claim language.

Obviousness

- [15] 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 before the one-year period immediately preceding the filing date or, if the claim date is before that period, before the claim 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 [*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

Purposive Construction

The person skilled in the art

[17] In the FA at page 2, the person skilled in the art was characterized as:

a team consisting of oral care implement specialists/engineers, manufacturing specialists/engineers, and marketing and sales specialists.

[18] In the R-FA at page 3, the Applicant stated that they do not concede or otherwise agree with any of the analysis in the FA, including the identification of the person skilled in the art. However, the Applicant did not propose their own characterization.

[19] In our view, the characterization of the person skilled in the art is appropriate given the subject-matter of the application and claims. We proceed on this basis below.

The relevant common general knowledge

[20] In the FA at page 3, the relevant CGK was identified as comprising:

- Knowledge of oral care implements such as toothbrushes (i.e. both manual and electrical);

- Knowledge of the different bristle/filament configurations and their functional characteristics (e.g. bristle protrusions or depressions, layered filament composition, color-changing bristle, etc.);
- Knowledge of producing images using bristles of different colors; and
- Knowledge of visual marketing/advertisement tactics.

[21] As was the case for the person skilled in the art, the Applicant did not concede or agree with the relevant CGK set out in the FA, but did not offer any of their own points.

[22] While most of the points of CGK set out in the FA find a basis in the instant application itself as part of the BACKGROUND OF THE INVENTION section, we can find no basis in the background discussion or prior art documents cited in the specification for the point of common general knowledge related to producing images using bristles of different colors. From our review of the FA, this point does not appear to be applied at *Sanofi* step 4 and no basis for it was identified in the FA. In our view, given the lack of an apparent basis for this point and the Applicant's non-concession to its validity, we do not take such a point to have been part of the relevant CGK.

The claims on file

[23] The instant application contains 14 claims with one independent claim 1, reproduced below:

1. An oral-care implement comprising:
 - a mounting surface having a longitudinal axis and a transverse axis perpendicular to the longitudinal axis;
 - a plurality of filaments outwardly extending from the mounting surface in at least one direction not parallel to either one of the longitudinal and transverse axes, each filament having a free end terminating with a filament tip, a plurality of the filament tips forming an overall working surface;
 - wherein at least some of the filaments possess at least one functional characteristic selected from the group consisting of filament's structure, composition, cross-sectional shape, tip geometry, and any combination thereof;
 - wherein the overall working surface comprises at least a first color and a second color different from the first color;
 - wherein the at least first and second colors form, in combination, at least one scaled-up image disposed on the overall working surface and graphically replicating

the at least one functional characteristic, thereby visually communicating to a consumer that the oral-care implement includes filaments having said at least one functional characteristic,

wherein the at least one functional characteristic comprises a filament's tip surface including at least one island comprising a depression, and the at least one scaled-up image disposed on the overall working surface comprises at least one area having the first color.

[24] We note that there have been no issues raised during the prosecution of the instant application in regard to the meaning or scope of any of the terms used in the claims on file. We proceed below on the basis that the meaning and scope of the claims would have been clear to the skilled person.

The essential elements

[25] The FA did not identify the essential elements of the claims on file.

[26] Given that the person skilled in the art would understand that there is no use of language in any of the claims indicating that the elements in each claim are optional, alternatives or a preferred embodiment, in our view, all the elements of the claims on file are considered to be essential and are taken into account in our analysis below.

Obviousness

[27] Below we assess obviousness using the *Sanofi* four-step approach, which was also used in the FA at pages 2-4.

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

[28] The person skilled in the art has been identified above under Purposive Construction. We apply the same characterization here.

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

[29] The relevant CGK has also been identified under Purposive Construction and we apply the same CGK here.

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

[30] In this assessment, we take into account all the essential elements of the claims on file. In our view, the combination of essential elements of each claim represent their inventive concepts as well.

(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

[31] In the FA at page 3, the state of the art was taken to be represented by the following prior art document:

D3: US5770307

Rackley et al.

Published: June 23, 1998

[32] The FA at page 3 alleged, in relation to claim 1 on file, that D3 disclosed an oral care implement with the following features:

mounting surface having a longitudinal axis and a transverse axis perpendicular to the longitudinal axis (implicit features of a toothbrush);

a plurality of filaments outwardly extending from the mounting surface in at least one direction not parallel to either one of the longitudinal and transverse axes, each filament having a free end terminating with a filament tip, a plurality of the filament tips forming an overall working surface (fig. 6);

wherein at least some of the filaments possess at least one functional characteristic selected from the group consisting of filament's structure, composition, cross-sectional shape, tip geometry, and any combination thereof (figs. 1 and 6);

wherein the at least one functional characteristic comprises a filament's tip surface including at least one island comprising a depression (figs. 1 and 6).

[33] Prior art document D3 discloses a coextruded monofilament having a core material made of a first resin and a sheath material made of a second resin, with a pocket or depression formed in the filament end. Although the document mentions at several points, for example at col. 1, lines 9-10, that the monofilaments may be used as bristles for toothbrushes, no basic structure of such a toothbrush is disclosed. It appears that the FA relied on the relevant common general knowledge of the person skilled in the art for the disclosure of the basic structure of a toothbrush. Figures 1 and 6 of D3 do not show any structure of the toothbrush onto which the monofilaments are mounted.

[34] In light of the above, it is our view that other than the filaments having a functional characteristic such as their shape (circular in D3) and a depression in the end,

none of the other elements of claim 1 on file are disclosed by D3.

- [35] However, it is also our view that the other features alleged to have been disclosed by D3 were part of the relevant CGK, given that they would have been commonly known features of toothbrushes at the relevant date, including variation in bristle shape, composition and color. This may be taken into account at step 4 below.

(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?

- [36] In the FA at pages 3-4, it is alleged that the following prior art document, in combination with the relevant CGK and document D3, disclose sufficient information to render the subject-matter of the claims on file obvious:

D2: WO01/64072 Mijatovic Published: September 7, 2001

- [37] D2 is a document of Swiss origin that was published in French. The FA alleged that D2 discloses toothbrushes where a colored image or identification mark is created by arranging colored bristles in a predefined pattern, referring to Figures 2A-5.

- [38] The FA provided a Google translation of the second paragraph of page 1 of the description of the D2 document:

This technique of producing colored bristle brushes makes it possible to permanently affix an image or brand identification to the brush. The benefit of this opportunity is to produce brushes that are more targeted to their clientele, for example by putting pictures such as comic characters on children's toothbrushes. In the same way, the companies of shoes or clothes will be able to identify their brushes on the face including the hairs, and the companies of all kinds will be able to make produce brushes which will communicate to their users, for an advertising purpose, a message or the logo of the company.

- [39] The R-FA at page 4 referenced this translation and did not object to its accuracy. We take it to be accurate for the purpose of our review.

- [40] In our view, D2 does disclose a process for forming an image on the working surface of brushes, including toothbrushes. The image is produced by the use of differing colors of bristles. The images are intended to convey an advertising

message or company logo.

- [41] In the FA at page 4, it is contended that based on the disclosure of D2 and the CGK that the oral care industry generally advertises the benefits of their products in various ways, it would have been obvious for a person skilled in the art to incorporate the advertisement technique taught by D2 into the toothbrush of D3 in order to advertise the benefits of the D3 bristles.
- [42] As mentioned earlier, though we do not view D3 as disclosing the basic structure of a toothbrush, this was in our view part of the relevant CGK and therefore this structure would not itself lend inventive ingenuity to the claims.
- [43] However, as the Applicant points out at page 5 of the R-FA, we see nothing in D2 that suggests any link between the image formed on the working surface of a toothbrush (or other type of brush) and any functional characteristic of the bristles. Figures 2A-5 of D2 illustrate various types of images that may be produced including business names, words, types of flags and images such as a smile. One example, Figure 2A, forms the word “Backscratch” on the working surface of what appears to be a backscratcher. However, in such a case, the image would describe the overall function of the brush rather than any functional characteristics of the bristles.
- [44] We agree with the Applicant that D2 does not disclose, teach or suggest the communication of a functional characteristic of the brush bristles by means of a scaled-up image of the functional characteristic (such as bristle shape) on the brush working surface, as is specified in claim 1 on file.
- [45] While D2 suggests the creation of any image that is desired on the brush working surface, the images described do not in any way relate to the functional characteristics of the bristles themselves. D2 is not concerned at all with the specific properties of the bristles, illustrating them only as commonly known circular bristles and not discussing any other properties.
- [46] Further, we see nothing in D3, D2 or the relevant CGK, alone or in combination, that would have led the person skilled in the art to the subject-matter of claim 1 on file. D3 is concerned with a specific bristle type, while D2 is concerned with reproducing a logo or message on the brush working surface, irrespective of the

type of bristle. The relevant CGK does include knowledge of different bristle/filament configurations and their functional characteristics but there is no evident reason why the person skilled in the art would have been led to use the image forming method of D2 to form a scaled-up image representing those functional characteristics, including the specific one of D3. There is no hint or suggestion of such a step. As the Applicant states at page 3 of the R-FA, the use of “hindsight” is not permitted in evaluating the obviousness of a claim.

- [47] In the SOR at page 2 it is stated that the motivation to combine the prior art documents need not come from the documents themselves. While this is true, if the motivation does not come from the prior art, then it would need to come from the relevant CGK of the person skilled in the art. In the present case, the relevant CGK provides general information regarding varying bristle configurations and functional characteristics, as well as knowledge of basic marketing and advertising tactics. There is no link between the two such that a person skilled in the art might be led to represent the bristle configuration or function as an image on the brush working surface.
- [48] In our view, having regard to D2, D3 and the relevant CGK, the person skilled in the art would not have come directly and without difficulty to the subject-matter of claim 1 on file (the classic test for obviousness from *Beloit Canada Ltée/Ltd v Valmet Oy*, 8 CPR (3d) 289 at page 294, recently cited with approval in *Janssen Inc v Sandoz Canada Inc*, 2022 FC 715 at paragraph 95).
- [49] Given that it is our view that claim 1 on file would not have been obvious to the person skilled in the art, the same would have been true of dependent claims 2-14, which depend directly or indirectly on claim 1.

Proposed Claims

- [50] The Applicant submitted a set of proposed claims with the R-FA. However, given that we do not agree with the basis for the rejection of the application and have not identified any further defects, there is no reason to review the proposed claims.

CONCLUSION

- [51] We have determined that the claims on file would not have been obvious and are

therefore compliant with section 28.3 of the *Patent Act*.

RECOMMENDATION OF THE BOARD

[52] In light of the above, we are of the view that the rejection is not justified on the basis of the defect indicated in the Final Action notice and have reasonable grounds to believe that the instant application complies with the *Patent Act* and the *Patent Rules*. We recommend that the Applicant be notified in accordance with subsection 86(10) of the *Patent Rules* that the rejection of the instant application is withdrawn and that the instant application has been found allowable.

Stephen MacNeil
Member

Helena Forbes
Member

Liang Ji
Member

DECISION OF THE ASSISTANT COMMISSIONER

[53] I concur with the conclusion and recommendation of the Board. In accordance with subsection 86(10) of the *Patent Rules*, I hereby notify the Applicant that the rejection of the instant application is withdrawn, the instant application has been found allowable and I will direct my officials to issue a Notice of Allowance in due course.

Virginie Ethier
Assistant Commissioner of Patents

Dated at Gatineau, Quebec

this 23rd day of November, 2022