COMMISSIONER'S DECISION

Division (Rule 60) - Printing and applying pressure-sensitive labels

Linking claims were found to contravene Rule 60. There was no claim broader in scope than any other claim.

Final Action: Affirmed

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This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated March 15, 1978, on application 281303 (Class 101-29). The application was filed on June 24, 1977, in the name of Paul H. Hamisch, Jr. with the title "Apparatus For Printing And Applying Pressure Sensitive Labels." The Patent Appeal Board conducted a Hearing on September 20, 1978, at which Mr. E.B. O'Connor represented the applicant.

This application is directed to apparatus for printing and applying to articles pressure sensitive labels, which are carried on a web of supporting material.

In the Final Action the examiner required the applicant "to restrict his claims to those defining one invention only," under the provisions of Section 38 of the Patent Act. The examiner then analysed the claims to demonstrate the lack of unity of invention.

In the first response to the Final Action the applicant cancelled claims 10 to 17 and stated that the amendment should overcome the objection in the Final Action. On June 28, 1978 the applicant filed a second response and argued for the allowance of the claims on file notwithstanding that they "may not be [in] strict compliance with Rule 60...." He argued, inter alia, that a strict requirement of Rule 60 "places an onerous burden on an applicant both financial and otherwise...."

At the Hearing Mr. O'Connor argued that the application should be allowed in its present form notwithstanding "that Rule 60 is not complied with in the strict sense dictated by an application of the infringement test."

He went on to say that "it is not in fact the consistent practice of your Office to apply Rule 60 rigidly in all instances and that indeed Examiners are permitted to exercise a certain amount of discretion in their application of Rule 60." He also maintains that "it is not in the public interest to apply Rule 60 rigidly in all instances...." Finally he claims that "it is inappropriate in a Final Action or indeed in any action requiring division, not to group each and every claim so as to indicate clearly to the applicant and their agent just what the Examiner and therefore the office is prepared to allow in the existing application and what will have to be divided out."

The issue which the Board must decide is whether this particular application complies with Section 38 of the Patent Act and Rule 60 of the Patent Regulations. We do not believe it could be proper for us to reach conclusions based on alleged inconsistencies in prior practise as they relate to other applications, upon "public interest," whatever that may imply, or to make observations which could reflect upon applications not before us. If the applicant wishes general policy guidelines he should look to Chapter 10 of the Manual of Patent Office Practice. We ourselves have a specific case before us and must limit our attention to it.

In reviewing the amended claims we find they are not in compliance with Rule 60, because there is no claim broader in scope than any other claim. Since the applicant admits "that Rule 60 is not complied with in the strict sense" we consider that no detailed discussion on this issue is necessary. It is our view then that the amended claims submitted after the Final Action do not fully overcome the objections raised in the Final Action, i.e. there is no claim broader in scope than all other claims.

We recommend that the decision in the Final Action, requiring the restriction of the claims to one invention, should be affirmed.

J. F. Hughes
Assistant Chairman
Patent Appeal Board, Canada

I have reviewed the prosecution of this application and considered the recommendations of the Patent Appeal Board. I concur with the recommendations of the Board. Accordingly, I refuse to grant a patent on the claims as presently filed in this application. The applicant has six months within which to limit the claims to define one invention only or to appeal my decision under the provisions of Section 44 of the Patent Act.

J.A. Brown
Acting Commissioner of Patents

Dated at Hull, Quebec
this 28th. day of November, 1978

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