

BETWEEN:

ROHM & HAAS COMPANY APPELLANT;

AND

THE COMMISSIONER OF PATENTS . . RESPONDENT.

1956
 Jan. 10, 11, 12
 1959
 Feb. 11

*Patent—Appeal from Commissioner of Patents’ refusal to grant patent—
 Process Patent—Claims too broadly expressed—The Patent Act, 1935
 S. of C. 1935, c. 32, s. 35(2) as amended.*

In a divisional application for a patent for invention entitled “Fungicidal Compositions” the Commissioner rejected claims 1 to 6 and claims 10 to 13, but allowed claims 7 to 9 inclusive. Claim 1, which is typical of claims 1 to 6, reads:

“A fungicidal composition having as an active ingredient a salt of an alkylene bisdithiocarbamic acid.”

Claim 10, which is typical of claims 10 to 13, reads: “A method of controlling the fungus growth on living plants which comprises applying to the plant a fungicidal composition having as an active ingredient a salt of ethylene bisdithiocarbamic acid.”

On appeal from the Commissioner’s decision

Held: That in order to comply with the provisions of s. 35(2) of *The Patent Act, c. 32, 1935, Statutes of Canada*, it is necessary to define all the ingredients of the composition in which an exclusive property is claimed. Claims 1 to 6 were properly rejected on the ground that they did not state definitely and in explicit terms the things or combinations which the applicant regards as new. The claims as drawn are so broad that they may cover compositions which the applicant “does not know and has not dreamed of” and they therefore fail to comply with the provisions of s. 35(2). *B.V.D. Co. Ltd. v. Canadian Celanese Ltd.*, [1937] S.C.R. 221, followed. *Continental Soya Co. Ltd. v. J. R. Short Milling Co.*, [1942] S.C.R. 187, distinguished.

2. That claims 10 to 13 cannot be allowed. They are process claims and as admittedly there is nothing new in the process itself, it cannot be patented. *Refrigerating Equipment Ltd. v. Waltham System Inc.*, [1930] Ex. C.R. 154, applied.
3. When the Commissioner requires that the claims in an application be divided, such requirement does not necessarily mean that all the claims so divided are considered to be valid.

APPEAL from the refusal of the Commissioner of Patents to grant a patent in respect of certain claims for an alleged invention entitled “Fungicidal Compositions.”

The appeal was heard before the Honourable Mr. Justice Cameron at Ottawa.

David Watson for appellant.

K. E. Eaton for respondent.

1959
 ROHM &
 HAAS
 COMPANY
 v.
 COMMISSIONER OF
 PATENTS

CAMERON J. now (February 11, 1959) delivered the following judgment.

This is an appeal from the refusal of the Commissioner of Patents to grant a patent in respect of claims 1 to 6 inclusive, and 10 to 13 inclusive, in the Application of William F. Hester, assignor of Rohm & Haas Company, the appellant, for Letters Patent for an alleged invention entitled "Fungicidal Compositions".

I should state here that while the decision of the Commissioner is dated August 24, 1954—and was therefore made after the coming into effect of *The Patent Act*, R.S.C. 1952, c. 203—it was agreed upon the hearing of the appeal that all references to *The Patent Act* would be understood to mean *The Patent Act* 1935, being c. 32 of the Statutes of Canada 1935, as amended. For the sake of convenience I shall adopt the same procedure in this opinion unless otherwise stated.

The application, Serial No. 558,568, was filed on May 3, 1947. By an amended petition filed on May 28, 1947, the petitioner requested that the application be treated as entitled to priority, having regard to U.S. application, Serial No. 407,674, filed August 20, 1941, it being stated that the claims in the application related to all of the claims in that U.S. application, which later application matured into Patent No. 2,317,765 on April 27, 1943 (Exhibit 1). On June 13, 1947, a request was made that "this application should be accorded all the benefits of s. 28A of *The Patent Act*." On September 19, 1947, the Commissioner advised that "the Convention date asked, August 20, 1941, United States, has been made of record in the case".

On October 2, 1950, the applicant substituted nineteen claims in place of its original five claims. On July 21, 1952, the applicant was advised that claim 7—a method claim—was rejected, and that

Only one process and the direct product thereof may be claimed in one patent application. Thus, claims 8 to 19 inclusive, may not be presented in the same case with the remaining claims herein—(see s. 37 of *The Patent Act*).

In response to that notice that division was required, the applicant retained claims 1 to 6 in the original application and on October 22, 1952, filed a divisional application for twelve claims representing the same subject matter as in

the former claims 8 to 19 inclusive. On that divisional application, Letters Patent No. 496,683 (Exhibit 3) were issued to the appellant on October 6, 1953, the expiry date being August 20, 1963. The first ten claims therein are for new chemical compounds stated to be effective in fungicidal compositions, and claims 11 to 12 are respectively method claims for preparing polyvalent and divalent metal salts of an alkylene bisdithiocarbamic acid.

1959
ROHM &
HAAS
COMPANY
v.
COMMISSIONER OF
PATENTS
Cameron J.

The original application was then continued. Following certain correspondence, the attorney for the applicant on July 16, 1953, substituted a new set of thirteen claims, and as the appeal relates to this set of claims, it will be convenient to set them out in full. They are as follows:

The embodiments of the invention in which an exclusive property or privilege is claimed are defined as follows:

1. A fungicidal composition having as an active ingredient a salt of an alkylene bisdithiocarbamic acid.
2. A fungicidal composition having as an active ingredient a salt of ethylene bisdithiocarbamic acid.
3. A fungicidal composition having as an active ingredient the disodium salt of ethylene bisdithiocarbamic acid.
4. A fungicidal composition having as an active ingredient the cupric salt of ethylene bisdithiocarbamic acid.
5. A fungicidal composition having as an active ingredient the ferric salt of ethylene bisdithiocarbamic acid.
6. A fungicidal composition having as an active ingredient the zinc salt of ethylene bisdithiocarbamic acid.
7. A fungicidal composition comprising a water-insoluble salt of ethylene bisdithiocarbamic acid suspended in water.
8. A fungicidal composition comprising a salt of ethylene bisdithiocarbamic acid and a solid inert carrier such as clay.
9. A fungicidal composition comprising a salt of ethylene bisdithiocarbamic acid dissolved in water.
10. A method of controlling fungus growth on living plants which comprises applying to the plant a fungicidal composition having as an active ingredient a salt of ethylene bisdithiocarbamic acid.
11. A method of controlling fungus growth on living plants which comprises applying to the plant a fungicidal composition having as an active ingredient a divalent metal salt of ethylene bisdithiocarbamic acid.
12. A method of controlling fungus growth on living plants which comprises applying to the plant a fungicidal composition having as an active ingredient the sodium salt of ethylene bisdithiocarbamic acid.
13. A method of controlling fungus growth on living plants which comprises applying to the plant a fungicidal composition having as an active ingredient the zinc salt of ethylene bisdithiocarbamic acid.

1959

ROHM &
HAAS
COMPANY
v.
COMMISSIONER OF
PATENTS

Cameron J.

It may be noted here that claims 1 to 6 thereof are identical with the previous claims 1 to 6. In place of the former claim 7 which had been rejected, the applicant substituted new method claims 10 to 13 inclusive.

On October 1, 1953, the applicant was advised that claims 1 to 6 inclusive and claims 10 to 13 inclusive were finally rejected. No objection was taken to claims 7, 8 and 9, in which the claims are for fungicidal compositions comprising a salt of ethylene bisdithiocarbamic acid, either suspended in water, dissolved in water, or with a solid inert carrier such as clay. These claims specify the matter with which the salt is associated to make up the "fungicidal composition".

Before turning to the legal problems involved, it will be convenient to set out certain additional agreed facts. The appellant is a corporation of Delaware, U.S.A., which has been engaged for many years in the manufacture and sale of various chemical products. The invention of the application in suit was made by one of its chemists, Dr. William F. Hester, now deceased. The sodium, copper, zinc, ferrous, ferric and cadmium salts of ethylene bisdithiocarbamic acid were first made by Hester in 1935 and in January 1941 he proposed that they be used as fungicides. Field testing of these salts was carried out in 1941 and their effectiveness as fungicides was shown.

The first application for patent was filed in the United States on August 20, 1941, and issued to Patent 2,317,765 on April 27, 1943 (Exhibit 1). The five claims therein are for fungicidal compositions and are identical to claims 1 to 5 inclusive of the present application. That U.S. patent was re-issued as Re. 23,742 on November 24, 1953 (Exhibit 2). The re-issue included the original five claims and in addition eight claims for "the process of controlling fungus growth on living plants which comprises applying to the plant a fungicidal composition having as an active ingredient" a salt of an alkylene or ethylene bisdithiocarbamic acid, or the bivalent salts of the latter or the sodium, cupric, ferric, zinc or cadmium salts of the latter. Claims 7, 8, 9 and 10 of the re-issue correspond precisely

with claims 10 to 13 inclusive of the present application, except that in the former the word "process" is used instead of "method".

Prior to 1940, the commercially important agricultural fungicides were inorganic copper compounds and powdered sulphur which had but limited effectiveness and were injurious to many plants. Organic fungicides were being investigated by many people but without significant success. The suppliant markets three of the products referred to in the claims of this application under the trade names of Nabam, Zineb and Maneb which are respectively disodium, zinc, and manganese salts of ethylene bisdithiocarbamic acid, Zineb and Maneb being also covered by Canadian Patent No. 496,683. These three products have achieved considerable commercial success.

It is agreed that for the purpose of this appeal there was no proposal by others to use any of the compounds referred to in the claims of this application as fungicides or for analogous purposes prior to the filing in 1941 of the application for U.S. Patent No. 2,317,765. It is also agreed that the polyvalent metal salts of ethylene bisdithiocarbamic acid were not known to others or described in the literature prior to the filing of that U.S. application.

I shall first consider the appeal regarding claims 1 to 6. In his decision, the Commissioner stated:

I have reviewed the prosecution of this application and I concur with the decision of the Examiner rejecting claims 1 to 6 and claims 10 to 13. Claims 1 to 6, notwithstanding any assertion to the contrary, overlap with the claims of Canadian Patent No. 496,683 (application Serial No. 637,902) and the overlapping is not of the type called genus and species as would be acceptable.

I refer to the first paragraph on page 2 of the Examiner's report of October 1, 1953 and in the case where the composition is made up entirely of the active ingredient, claims 1 to 6 are no different from those of the divisional application which has now become a patent; in the case where something else goes into the composition to make a mixture there is no basis for allowing such claims under Section 36. (Note—formerly section 35 of the Patent Act 1935) They obviously do not state distinctly the things or combinations which the applicant regards as new. In fact these claims are much broader than the disclosures and may cover compositions which the applicant does not know and has never dreamed of. No inventor can be given protection for things he has not invented or does not know about.

1959

ROHM &
HAAS
COMPANYv.
COMMISSIONER OF
PATENTS

Cameron J.

1959

ROHM &
HAAS
COMPANY
v.
COMMISSIONER OF
PATENTS

Cameron J.

One of the grounds of appeal is stated as follows:

(2) The Commissioner erred in finding that claims 1 to 6 do not state distinctly the things or combinations which the applicant regards as new, are broader than the disclosure, and give protection extending beyond the invention. These claims specifically define the inventive step of providing a fungicidal composition having a specified substance as its active ingredient.

The Commissioner relied on the provisions of s. 35(2) of the Act, which is as follows:

35.(2) The specification shall end with a claim or claims stating distinctly and in explicit terms the things or combinations which the applicant regards as new and in which he claims an exclusive property or privilege.

The Commissioner's objection on this point relates to all of the first six claims, of which claim 1 may be taken as typical.

1. A fungicidal composition having as an active ingredient a salt of an alkylene bisdithiocarbamic acid.

On this point, the contention of the Commissioner—and this was one of the grounds on which he rejected claims 1 to 6—is that the claim relates to a composition the ingredients of which, other than the one specified active ingredient, are not named. He submits, therefore, that the appellant has not complied with the requirements of s. 35(2).

Now there can be no doubt that the fungicidal composition referred to in claim 1 (and also in claims 2 to 6) is not made up solely of the named salt. The use of the phrase "having as an active ingredient" clearly implies that in addition to the salt named as an active ingredient there are one or more other ingredients.

During the prosecution of this application, the attorney for the applicant in a letter to the Commissioner dated November 27, 1953, said:

It is submitted that in Claims 1 to 6 it is clear that applicant is using the term "composition" to include only admixtures of the active ingredient with one or more further ingredients. When claims such as Claim 1 are regarded as a whole, it will be appreciated that the salt in question could not be referred to as an "ingredient" if it represented the whole composition. The use of the word "ingredient" qualifies "composition" and makes it clear that other substances are present in the mixture. The other substances are not specifically defined in the claims, but as the inventive step is the inclusion of a salt of alkylene bisdithiocarbamic acid as an active ingredient in the composition, the present claims distinctly and explicitly define what applicant regards as new, as required by *The Patent Act*.

Then at the hearing of this appeal, counsel for the appellant stated:

Therefore it is important to obtain a range of claims and these claims for the fungicidal composition cover fungicidal compositions other than those consisting solely of the chemical compound represented by the salt as the only ingredient.

And later he said:

In the present case, the applicant's essentially active ingredient has been very carefully and concisely defined and the possibility has been left open in the remainder of the claim for including not a limited added ingredient such as water or some specific carrier, but a number of different ingredients, but . . . that is not the type of indefiniteness which is objectionable because it does not relate to the essential feature of the applicant's invention.

And again he said, "The other ingredients which may be included in that fungicidal composition are indicated in the disclosure but are not specifically defined in the claims."

In the specification it is stated:

The salt, whether soluble or insoluble, may be suspended or dissolved in an aqueous spray, or may be mixed with or coated on a carrier, such as clay, magnesium carbonate, or similar inert material, and applied from a dust or from an aqueous spray. The salt may be used as the sole fungicidal material or it may be used in conjunction with other fungicidal agents. Also, the salt of a bisdithiocarbamic acid may be used in conjunction with an insecticidal agent or insecticidal agents.

It seems to me, therefore, that the fungicidal composition claimed in claim 1 is not made up of the named salt and a carrier such as water or an inert material such as clay. Compositions of that type are found in claims 7, 8 and 9, all of which have been allowed. It seems equally clear that what is claimed in claim 1 is a fungicidal composition comprising in part the named salt and also one or more other ingredients (not intended as carriers), none of which is specified in the claim. If these unnamed other ingredients are not carriers, it would seem (if the disclosure can be relied on to support the claim) that there must be some other fungicidal agent or agents or some insecticidal agent or agents, or perhaps both. If that be so, then the claim is broad enough to include *any* fungicidal composition in which the named salt is an active ingredient but in which fungicidal composition there are one or more active

1959
 ROHM &
 HAAS
 COMPANY
 v.
 COMMISSIONER OF
 PATENTS
 Cameron J.

ingredients of a fungicidal or insecticidal nature, or of both. The inventive step, it is said, is the inclusion of the named salt as an active ingredient in any such fungicidal composition.

Now it seems to me that the property or privilege claimed in claim 1 is quite unambiguous. It is for *any* fungicidal composition in which the named salt is *an* active ingredient but in which there are also one or more unspecified ingredients, the nature and function of which are not stated. That, in my view, is the natural and ordinary meaning of the words used. In these circumstances, therefore, it would not be legitimate to refer to the other parts of the specification to explain what I think are the plain words of the claim itself.

In *Electric and Musical Industries v. Lissen, Ltd.*¹, Lord Russell said:

The Court of Appeal have stated that in their opinion no special rules are applicable to the construction of a specification, that it must be read as a whole and in the light of surrounding circumstances; that it may be gathered from the specification that particular words bear an unusual meaning; and that, if possible, a specification should be construed so as not to lead to a foolish result or one which the patentee could not have contemplated. They further have pointed out that the claims have a particular function to discharge. With every word of this I agree; but I desire to add something further in regard to the claim in a specification.

The function of the claims is to define clearly and with precision the monopoly claimed, so that others may know the exact boundaries of the area within which they will be trespassers. Their primary object is to limit and not to extend the monopoly. What is not claimed is disclaimed. The claims must undoubtedly be read as part of the entire document, and not as a separate document; but the forbidden field must be found in the language of the claims and not elsewhere. It is not permissible, in my opinion, by reference to some language used in the earlier part of the specification, to change a claim which by its own language is a claim for one subject-matter into a claim for another and a different subject-matter, which is what you do when you alter the boundaries of the forbidden territory. A patentee who describes an invention in the body of a specification obtains no monopoly unless it is claimed in the claims. As Lord Cairns said, there is no such thing as infringement of the equity of a patent (*Dudgeon v. Thompson*, 3 A.C. 34). . . .

And at p. 41 he said:

I would point out that there is no question here of words in Claim 1 bearing any special or unusual meaning by reason either of a dictionary found elsewhere in the specification or of technical knowledge possessed by persons skilled in the art. The *prima facie* meaning of words used in

a claim may not be their true meaning when read in the light of such a dictionary or of such technical knowledge, and in those circumstances a claim, when so construed, may bear a meaning different from that which it would have borne had no such assisting light been available. That is construing a document in accordance with the recognized canons of construction. But I know of no canon or principle which will justify one in departing from the unambiguous and grammatical meaning of a claim and narrowing or extending its scope by reading into it words which are not in it; or will justify one in using stray phrases in the body of a specification for the purpose of narrowing or widening the boundaries of the monopoly fixed by the plain words of a claim.

A claim is a portion of the specification which fulfils a separate and distinct function. It, and it alone, defines the monopoly; and the patentee is under a statutory obligation to state in the claims clearly and distinctly what is the invention which he desires to protect. As Lord Chelmsford said in this House many years ago: "The office of a claim is to define and limit with precision what it is which is claimed to have been invented and therefore patented" (*Harrison v. Anderston Foundry Co.*, 1 A.C. 574). If the patentee has done this in a claim the language of which is plain and unambiguous, it is not open to your Lordships to restrict or expand or qualify its scope by reference to the body of the specification. Lord Loreburn emphasized this when he said: "The idea of allowing a patentee to use perfectly general language in the claim and subsequently to restrict or expand or qualify what is therein expressed by borrowing this or that gloss from other parts of the specification is wholly inadmissible" (*Ingersoll Sergeant Drill Co. v. Consolidated Pneumatic Tool Co.*, 25 R.P.C. 61, at p. 83). Sir Mark Romer expressed the same view in the following felicitous language: "One may and one ought to refer to the body of the specification for the purpose of ascertaining the meaning of words and phrases used in the claims, or for the purpose of resolving difficulties of construction occasioned by the claims when read by themselves. But where the construction of a claim when read by itself is plain, it is not, in my opinion, legitimate to diminish the ambit of the monopoly claimed merely because in the body of the specification the patentee has described his invention in more restricted terms than in the claim itself" (*British Hartford-Fairmont Syndicate, Ltd. v. Jackson Bros. (Knottingley), Ltd.*, 49 R.P.C. 495, at p. 556).

In my view, claim 1 does not comply with the requirements of s. 35(2) in that it does not state distinctly or in explicit terms the thing which the applicant regards as new—namely, the fungicidal composition; it fails to define and limit with precision that which is claimed to be the invention. In a composition which undoubtedly comprises more than one substance, only one ingredient is named. The reader is left in doubt as to how many other ingredients there may be and must speculate as to what they actually are. The claim as drawn is so broad that it includes any

1959
 ROHM &
 HAAS
 COMPANY
 v.
 COMMISSIONER OF
 PATENTS
 Cameron J.

1959

ROHM &
HAAS
COMPANY
v.
COMMISSIONER OF
PATENTS

—
Cameron J.
—

fungicidal composition in which the specific salt is included and in which there are other ingredients of a useful nature which neither the applicant nor any one else has knowledge of.

In order to comply with the requirements of s. 35(2), I think it is necessary to define all the ingredients of the composition in which an exclusive property or privilege is claimed. Counsel for the appellant relies on the decision of McLean P. in this Court in *J. R. Short Milling Co. (Canada) Ltd. v. George Weston Bread and Cake, Ltd., et al.*¹, and on the decision of the Supreme Court of Canada in the same case, reported as *Continental Soya Co. Ltd v. J. R. Short Milling Co.*² He submits that in that case, in which the validity of the plaintiff's patents was upheld, one of the claims was for a process of making bread comprising incorporating with unbleached or lightly bleached flour to further bleach it "and with other ingredients to form a dough batch"—a certain carotin-decolourizing agent. He points out that while the words "with other ingredients to form a dough batch" were not further defined, the patent was upheld. I think it may be assumed, however, that to anyone conversant with such matters, the other ingredients necessary to form a dough batch would be clearly understood. In any event, a careful reading of the judgments in the case indicates that no question was raised at any time as to whether that claim lacked the distinctiveness and clarity required by s. 35(2) or its predecessor, and that matter was not mentioned in any way or adjudicated upon. On that point, therefore, the case is of no assistance to the appellant.

Counsel for the Commissioner referred to a number of cases on this point but I think it necessary to refer to only one—*B.V.D. Co. Ltd. v. Canadian Celanese*³—a decision of the Supreme Court of Canada. In part, the headnote reads as follows:

Throughout the specification of the Dreyfus patent, there is a continuous reference to the use of the thermoplastic derivative of cellulose in the form of yarns, filaments or fibres and it is plainly the very essence of the disclosure in the specification; but the inventor did not state in his Claims the essential characteristic of his actual invention.

¹[1941] Ex. C.R. 69.

²[1942] S.C.R. 187.

³[1937] S.C.R. 221.

The Court is invited to read through the specification and import into the wide and general language of the claims that which is said to be the real inventive step disclosed. The claims are unequivocal and complete upon their face; it is not necessary to resort to the context and as a matter of construction the claims do not import the context. In no proper sense can it be said that though the essential feature of the invention is not mentioned in the claims the process defined in the claims necessarily possesses that essential feature. The Court cannot limit the claims by simply saying that the inventor must have meant that which he has described. The claims in fact go far beyond the invention and upon that ground the patent is invalid. *The Patent Act* specifically requires that the specification shall end with a claim or claims stating distinctly the things or combinations which the applicant regards as new and in which he claims an exclusive property and privilege. *The Patent Act, 1923* (13-14 Geo. V, c. 23, s. 14, ss. 1); *The Patent Act, 1935* (25-26 Geo. V, c. 32, s. 35, ss. 2).

1959
 ROHM &
 HAAS
 COMPANY
 v.
 COMMISSIONER OF
 PATENTS
 —
 Cameron J.
 —

The judgment of the Court was delivered by Davis J. and in part he said at p. 237:

In the Canadian patent involved in this appeal before us the inventor did not state in his claims the essential characteristic of his actual invention though it does appear in the claims in his British and United States patents. No explanation is offered. We are invited to read through the lengthy specification and import into the wide and general language of the claims that which is said to be the real inventive step disclosed. But the claims are unequivocal and complete upon their face. It is not necessary to resort to the context and as a matter of construction the claims do not import the context. In no proper sense can it be said that though the essential feature of the invention is not mentioned in the claims the process defined in the claims necessarily possesses that essential feature. The Court cannot limit the claims by simply saying that the inventor must have meant that which he has described. The claims in fact go far beyond the invention. Upon that ground the patent is invalid.

I am entirely in agreement with the finding of the Commissioner that claims 1 to 6 should be rejected on the ground that they do not state definitely and in explicit terms the things or combinations which the applicant regards as new, that they are so broad that they may cover compositions which the applicant "does not know and has not dreamed of", and that consequently they fail to comply with the provisions of s. 35(2) of the Act. The appeal as to these claims fails on these grounds and it is unnecessary to discuss at length the other objections raised by counsel for the Commissioner.

I am of the opinion, however, that when a claim to a compound has been allowed, a claim to a fungicidal composition merely having that compound "as an active ingredient" is not patentable. The mere use in claims 4,

1959
 ROHM &
 HAAS
 COMPANY
 v.
 COMMISSIONER OF
 PATENTS
 Cameron J.

5 and 6 of words which are broad enough to permit the inclusion of some unspecified ingredient or ingredients in addition to the compounds claimed and allowed in claims 8, 9 and 5 of the issued patent does not seem to justify a finding that such claims in the application and in the issued patent define different inventions. The utility of the compounds as fungicides is fully set forth in the specification of the patent which has been allowed; to name the compound as a fungicidal composition is merely to recite one of its inherent qualities.

It is of considerable interest to note that claims similar to claims 1 to 6 were disallowed in two cases by the United States Court of Customs and Patent Appeals. In *re Jones*¹, claims 1 to 3 were for new products and claims 4 to 9 were "product-use" claims in which the specified active ingredients were the same products as in claims 1 to 3. Claim 5 thereof may be taken as a sample.

It reads:

An insecticidal and fungicidal composition having as an active ingredient thereof 1-naphthyl methyl thiocyanate.

The Court reversed the Board of Appeals and allowed the product claims 1 to 3, but affirmed the Board's decision disallowing claims 4 to 9. The reasons are succinctly stated as follows:

With respect to claims 4 to 9 inclusive we are in agreement with the Tribunals of the Patent Office in holding that they are "product-use" claims, and would only cause multiplicity where the product per se is held to be new and patentable. It is trite to state that a patentee, is entitled to every use of which his invention is susceptible, and claims 4 to 9 are merely for such use.

In the same Court, a similar decision was arrived at in the case of *In re Jones*². In disallowing the "product-use" claim, the Court followed *In re Thuan*³ in deciding that the addition of a statement of use to a claim to a compound does not produce a substantially different claim. In part the Court said at p. 152:

Counsel for appellant seek to distinguish this case from *In re Thuan*, supra, on the ground that claims 6, 7, 9, 10, and 11 are not drawn to the compounds of claims 1, 2, 4, and 5, per se, but to growth regulating compositions or insecticidal and fungicidal compositions having those compounds as active ingredients. However, claims 6, 7, 9, 10, and 11 do not state that the growth regulating or insecticidal and fungicidal compo-

¹ [1945] 65 USPQ 480.

² [1947] 74 USPQ 149.

³ 57 USPQ 324.

tions include anything in addition to the compounds called for in claims 1, 2, 4, and 5. The mere use in claims 6, 7, 9, 10, and 11 of language which is broad enough to permit the inclusion of some unspecified ingredient or ingredients in addition to the compounds of claims 1, 2, 4, and 5, does not justify a holding that the claims of the two groups define different inventions.

[4] The issue presented as to claims 6, 7, 9, 10, and 11 is substantially identical with that *In re Jones*, 32 C.C.P.A. (Patents) 1020, 149 F. 2d 501, 65 USPQ 480. In that case we held that when a claim to a compound had been allowed, a claim to an insecticidal and fungicidal composition having that compound as an active ingredient was not patentable.

I should refer, however, to one other matter mentioned by counsel for the appellant. He submits that the applicant could not be prejudiced by the fact that the Commissioner under s. 37 required that the applicant should divide his claims. He says that in doing so, the Commissioner must have recognized that the original application as filed did contain more than one valid claim, for inventions. I cannot agree with that submission. It seems to me that at the time division was required, the Commissioner made no decision as to the validity of any of the claims advanced, nor was he required to do so. He was merely stating that from the material filed it appeared that more than one invention was claimed. The validity of all the claims as so divided was a matter for later determination.

There remains the question as to the rejection of claims 10 to 13 inclusive. The Commissioner's main reasons for rejecting these claims apply equally to all five claims of which claim 10 is a sample.

Claim 10. A method of controlling fungus growth on living plants which comprises applying to the plant a fungicidal composition having as an active ingredient a salt of ethylene bisdithiocarbamic acid.

The Commissioner's reasons for rejecting these claims was stated as follows:

The question of claims 10 to 13 is an obvious one. It is sufficient to invoke the provisions of Rule 53.

The United States actions or laws have no bearing on the Canadian practice. I shall point out here that notwithstanding the rulings of the United States courts sustaining this type of claim, it still left the situation so unsettled that legislation had to be introduced in *The Patent Act* in an effort to settle the question. No such legislation is in force or contemplated in Canada.

1959
 ROHM &
 HAAS
 COMPANY
 v.
 COMMISSIONER OF
 PATENTS
 Cameron J.

1959
 ROHM &
 HAAS
 COMPANY
 v.
 COMMISSIONER OF
 PATENTS
 Cameron J.

The claims do not disclose anything new over the composition of matter claims. No new method is involved in applying the composition. These claims are not necessary for the full protection of the applicant and they come under the provisions of Rule 53.

Rule 53 is as follows:

No more claims will be allowed than are necessary adequately to protect the invention disclosed; if two or more claims differ so slightly that the several claims could not be allowed in separate patents the applicant may be required to elect which of such claims he desires to have allowed and to cancel the others.

The Notice of Appeal in relation to these claims is as follows:

3. The Commissioner erred in rejecting Claims 10 to 13 inclusive on the basis of Rule 53, as

- (a) the protection given by Claims 10 to 13 is not coextensive with that given by others of the claims, and Claims 10 to 13 are required for adequate protection;
- (b) Rule 53 applies only to the claims of a single application;
- (c) Rule 53 can only justify a requirement for election and not a rejection.

4. The Commissioner erred in sustaining the Examiner's rejection of Claims 10 to 13 inclusive as not describing a patentable process.

It is to be noted at once that in these claims the fungicidal composition to be applied is lacking in definiteness and clarity to the same extent as I have found in regard to claims 1 to 6, in that only one of the ingredients is specifically named and that the manner of "applying" the fungicidal composition to the plant is not defined.

Claims 10 (as well as claims 11 to 13) is a process claim. Clause 3(d) of the agreed Statement of Facts defines fungicide as "a substance which is applied to crops and other living plants to preserve the plants from deterioration due to fungus diseases such as mildew, potato blight and tomato blight". By clause 3(d), it is agreed that the manipulative steps of a method of controlling fungus growth on living plants by applying to the plants a fungicidal composition were well known prior to 1935. It is also common ground that the salts specified in claims 10 to 13 were new compositions at the date of the original application. The main question, therefore, is whether under the provisions of the Act, the well known method or process

of applying a fungicidal composition to living plants is patentable as a method or process when the fungicidal composition has as *an* active ingredient composition which was new at the date of the original application.

Invention is defined in *The Patent Act* as follows:

2.(d) "Invention" means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter;

Briefly, the contention made on behalf of the appellant is that the process for which protection is claimed is not limited to the manipulative steps of the process (which are admittedly old), but is rather the entire process which includes both the manipulative steps of "applying" the fungicide, and the use of the specified ingredients in the fungicidal composition. That, it is said, constitutes the invention. It is common ground that Hester, the assignor of the appellant, was the first to apply the specified salts to living plants as a fungicide.

Earlier, I have set out the course followed in securing the patents in the United States and have pointed out that claims 6 to 13 of the re-issue were process claims almost identical in form to the present claims 10 to 13, except that "process" is used instead of "method" and there are some differences in the specified salts. The parties are in agreement that there is no essential difference between the words "method" and "process".

Counsel for the appellant referred me to two decisions of the U.S. Patent Office Board of Appeals. In *Ex parte Kittleson*¹, a decision dated September 28, 1950, the Court allowed an appeal from a decision of the Examiner rejecting the following claim:

9. The method of combatting fungi, bacteria and insects, which comprises treating material liable to attack by said fungi, bacteria and insects, with a composition containing a N-trichloromethylthio-imide of a dicarboxylic acid as an active ingredient.

It was held:

(4) In the instant case, claim 9 contains a feature of patentable novelty, i.e., treating the recited material with a new material not analogous to that of Gertler, thereby securing an unobvious result. Even though this claim to a method recites only the single step—"treating"—nevertheless the step is performed by using a compound that is not

1959
 ROHM &
 HAAS
 COMPANY
 v.
 COMMISSIONER OF
 PATENTS

—
 Cameron J.
 —

1959
 ROHM &
 HAAS
 COMPANY
 v.
 COMMISSIONER OF
 PATENTS
 Cameron J.

analogous to the compound of Gertler due to the unpredictability of the results. The presence in the case of the allowed claims to a different invention can have no adverse effect on claim 9. (The reference to "a different invention" is to the compounds themselves.)

In *Ex parte Wagner*,¹ dated October 6, 1950, the Court allowed an appeal from a decision of the Examiner who had rejected claims 14 to 17 to well drilling process claims employing drilling mud claims which had been allowed. It was held:

In application wherein claims to well drilling mud have been allowed, Board allows claims to well drilling process employing such mud; presence or absence of composition claims should have no effect on patentability of process claims; manipulative processes may be patentable although they are otherwise old except for employment of different material; many processes, which are old in procedural sense, become new when new result is accomplished by use of different agent; in considering patentability of such processes, real criterion is not whether steps are shown in prior art but whether use of material in process is suggested by prior art; it is not proper to disregard specific nature of material employed in process which is responsible for unobvious result and determine patentability of process solely on novelty of physical manipulative steps; if result of process is unobvious and particular use of material is not suggested by prior art, process claims should be allowed, even if material is old for nonanalogous use.

Counsel for the appellant submitted that the principles stated in these two cases are equally applicable under our Patent Act. It seems to me, however, that they cannot be reconciled with the two cases which I have referred to earlier, namely, *In re Jones*², and *In re Jones*³, both of which are decisions of the Court of Customs and Patent Appeals. As I read those cases, the findings were that when a claim to a compound has been allowed—and even allowed in the same application—a further claim to an insecticidal or fungicidal composition having that compound as an active ingredient was not patentable. If that be so, then it would seem to be the case that the fungicidal composition was not new in an inventive sense and could not be patented. From these considerations, it would seem to follow that a claim for a well-known method of applying the fungicidal composition and which fungicidal composition was not itself patentable inasmuch as the specified ingredient therein was patented, would be disallowed.

¹88 USPQ 217.

²[1945] 65 USPQ 480.

³[1947] 74 USPQ 149.

Neither the manipulative steps of the method nor the fungicidal composition could be considered as novel in an inventive sense.

1959
 ROHM &
 HAAS
 COMPANY
 v.
 COMMISSIONER OF
 PATENTS
 Cameron J.

By reason of the provisions of the new *United States Patent Act* of January 1, 1953, it would seem that the problem there has been put at rest. The relevant provisions are as follows:

100. When used in this title unless the context otherwise indicates—

(b) The term “process” means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

101. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title. (R. S. 4886; 35 U.S.C., 1946 ed., 31.)

Under these provisions it would appear that a patent for a claim such as claim 10 now before me might be granted as being a new use of a known process or new use of a composition of matter or material.

On the other hand, the decision in the English courts would seem to indicate that a claim similar to claim 10 could not be the subject of a patent. There, invention is defined in s. 101 of *The Patent Act* 1949, as follows:

“invention” means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies and any new method or process of testing applicable to the improvement or control of manufacture, and includes an alleged invention.

Under that Act an invention, to be patentable, must be either “a manner of new manufacture” or a new method or process of testing applicable to the improvement or control of manufacture (*Terrell and Shelley on Patents*, 9th Ed., p. 12).

In *G. E. C.’s Application*¹, which was for a method of extinguishing incendiary bombs, Morton J. said at p. 4:

In my view a method or process is a manner of manufacture if it (a) results in the production of some vendible product or (b) improves or restores to its former condition a vendible product or (c) has the effect of preserving from deterioration some vendible product to which it is applied. In saying this I am not attempting to cover every case which may arise by a hard and fast rule.

¹60 R.P.C. 1.

1959
 ROHM &
 HAAS
 COMPANY
 v.
 COMMIS-
 SIONER OF
 PATENTS
 Cameron J.

These so-called rules in the *G. E. C.* case were considered by the Patents Appeal Tribunal *in the Matter of an Application for a Patent by Alexander Lenard*¹. That case in many respects is similar to the present one. The application was in respect to "improved methods for meeting or offsetting the advance of disease in clove trees", and was based on the alleged discovery by the applicant that the disease known as Dieback and Sudden Death was due to a fungus as opposed to a virus. The improved method was described in the provisional specification as follows: "It is held that pruning would cause death of clove trees but my findings are that it heals and that mortality caused by disease can be reduced by carrying out drastic tree surgery and long pruning, provided the raw surfaces are protected with good sterilizing dressing to prevent the entry of fungi".

The Examiner considered that the application appeared to be concerned with a method of agriculture or horticulture which is not regarded as a manner of manufacture. On appeal, Lloyd-Jacob J. said in part at p. 191-2:

For my own part, I think that it is clear that when Morton, J., in the *R. H. F.* case was approving Mr. Oates' decision he was approving it upon the basis that in considering the word "vendible" or "vendibility" the exclusion from it of, for example, fruit was a proper exclusion, and I regard that decision as indicating that there must be that limitation applied to the word "vendible" when the so-called rules in the *G. E. C.* case are being applied. It is true that in that particular instance the limitation was only in respect of the application of the first rule, namely, the rule which says that a manner of manufacture must result in the production of some vendible product; but, seeing that it was in fact a limitation of the "vendibility", in my judgment it must necessarily apply, not only to the first, but to the second and third rules alike, and therefore the *G.E.C.* rules must be applied against the background of the limitation upon the scope of "vendible product", not only in respect of the exclusion of fruit and the like, but also in the light of the subsequent considerations expressed by the present Master of the Rolls in other cases. Attention must be directed to the industrial or commercial or trading character of the process alleged to be patentable. If in a field of activity which can fairly be said to have a manufacturing characteristic the alleged invention finds its place, this difficulty will not normally present itself. There may, no doubt, be borderline cases, but, in my judgment, once the end product of an alleged invention is defined it becomes possible to consider whether in the preparation or formulation of that end product a manner of manufacture has been utilised.

Mr. Gratwick has urged that in this case the end product is the clove tree as improved, that is to say, as pruned and sprayed and thereby rendered resistant to or unaffected by further outbreaks of disease, but I cannot hold this to have proceeded from a manner of manufacture.

It appears to be plain that a great advance may have been made in the culture of clove trees—an advance which may well result, not only in great prosperity in the territory in which clove trees are cultivated, but also to all those persons in trade and commerce who are concerned with the distribution of cloves. It may be unfortunate that someone who by the application of his ingenuity and ability has conferred this benefit upon the world is unable to get the form of protection for his discovery which is afforded to persons following other lines of development; but I sit here to apply the Statute and, so long as the law remains as it is at present, I can find no way of persuading myself that a method of agricultural or horticultural treatment such as the present can fairly be said to come within the present *Patents Act*.

Accordingly, I must dismiss this appeal.

Reference may also be made to the case of an application by *N. V. Philips' Gloeilampenfabrieken*¹—a decision of Lloyd-Jacob J. sitting as the Patent Appeal Tribunal. The application was for “improvements in and relating to methods of producing a new form of *Poinsettia*.” It was rejected by the Examiner and his decision was affirmed by the Tribunal. The judgment in part is as follows:

It is true, as Mr. Graham has explained, that under modern conditions the circumstances surrounding the development of agricultural and horticultural products approach the conditions obtaining in productive industries. The use of equipment and appliances and premises, the nature of the labour, skilled and unskilled, which is required find parallels in the production of articles in respect of which patent protection is conferred. That cannot be a useful, and certainly not an accurate, criterion when the question whether or not a manner of manufacture is disclosed in the specification under examination. The “manner of manufacture” has to be disclosed as an essential ingredient of the invention itself, and cannot satisfactorily be found in the means by which the invention is exploited.

From these two decisions, it would appear likely that a claim similar to claim 10 could not be the subject of a patent under *The Patents Act* 1949, since the method or process relates to the control of fungus growth on living plants which are not considered to be “a manner of manufacture”.

The English and United States decisions have been considered at some length out of deference to the arguments submitted to me by counsel. It seems to me that in the United States it was necessary to amend the statute, as was done in *The Patent Act* which came into effect on

1959
 ROHM &
 HAAS
 COMPANY
 v.
 COMMISSIONER OF
 PATENTS
 —
 Cameron J.
 —

1959
 ROHM &
 HAAS
 COMPANY
 v.
 COMMISS-
 SIONER OF
 PATENTS
 ———
 Cameron J.
 ———

January 1, 1953, in order to permit the grant of a valid patent for such claims as claims 10 to 13 in the instant case. There is no similar provision in our Act.

After full consideration of the matter, I have reached the conclusion that claims 10 to 13 cannot be allowed. They are process claims and admittedly there is nothing new in the process itself. I am in agreement with the view of this matter taken by the late President of this Court in *Refrigerating Equipment Ltd. v. Waltham System Inc.*¹ The facts of that case need not be detailed. The learned President's opinion on this point is stated at p. 166:

Conceding for the moment that the patent in question describes a true method or process patent as distinguished from an apparatus or manufacture, yet before the applicant became entitled to a patent, it would be necessary that the method be new. If the method described is not new it cannot be patented as a process. Where the method is old, and the instrumentalities new, the latter may be patented as a machine, or manufacture, if to do so required invention.

In my opinion, also, there is no necessity under our Act for granting a patent for claims such as claims 10 to 13. A patentee is entitled to every use of which his invention is susceptible. To the extent that the assignor of the applicant has invented the compounds for which patents have been issued, the applicant has full protection for such patents.

For these reasons, the appeal from the Commissioner will be dismissed, but without costs.

Judgment accordingly.