

BETWEEN:

WINTHROP CHEMICAL COMPANY }
 INCORPORATED } APPELLANT;

1937
 1937
 Feb. 15.
 April 24.

AND

THE COMMISSIONER OF PATENTS...RESPONDENT.

Patent—Appeal from Commissioner of Patents—Patent Act 25-26 Geo. V, c. 32, s. 40—Product claims—Specification.

Appellant applied for a patent for medical or therapeutic substances prepared by chemical processes described in the specification. The Commissioner of Patents rejected the claims made by the applicant on the ground that it is necessary that the process be disclosed clearly and completely in the claims and that the product claims be restricted to the product when prepared or produced by such process.

Held: That there cannot be a reference in a claim to the specification in the case of inventions relating to substances prepared or produced by chemical processes and intended for food or medicine.

2. That under s. 40, ss. 4 of the *Patent Act*, 25-26 Geo. V, c. 32, an appeal to the Exchequer Court of Canada may be taken from the decision of the Commissioner of Patents even though there had been no refusal on his part to grant a patent.

APPEAL from the decision of the Commissioner of Patents rejecting certain claims in an application for a patent.

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

C. Robinson for the appellant.

W. L. Scott, K.C. for the respondent.

The facts are stated in the reasons for judgment.

ANGERS J., now (April 24, 1937) delivered the following judgment:

This is an appeal from the decision of the Commissioner of Patents rejecting all the claims of an application by Max Bockmühl and Walter Krohs, of Germany, dated January 22, 1934, for a patent for alleged new and useful improvements in "pyrazolones containing wholly or partially hydrogenated cyclic hydrocarbon radicals."

In opening the case counsel for the appellant moved verbally to substitute the name Winthrop Chemical Company, Incorporated, for that of I.G. Farbenindustrie A.G. as appellant, Winthrop Chemical Company, Incorporated, being the assignee of the alleged invention and the appli-

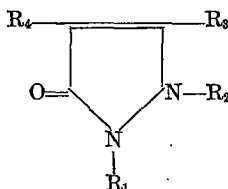
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cation in connection therewith. Counsel for the Commissioner of Patents declared that he was satisfied that the change should be made and the motion was accordingly granted.

The application is for medicinal or therapeutic substances prepared by chemical processes described in the specification. It is not necessary for the purpose of the present appeal to discuss what the products and what the processes are.

The application contains seven claims; it will suffice to cite the first one; this claim was originally worded as follows:

1) The compounds of the following general formula:



where R_1 stands for phenyl or a wholly or partially hydrogenated cyclic hydrocarbon radical, R_2 for alkyl or a wholly or partially hydrogenated cyclic hydrocarbon radical, R_3 for alkyl, and R_4 for hydrogen, alkyl or

the group $-N$ wherein X_1 and X_2 stand for hydrogen, alkyl, aralkyl, or a wholly or partially hydrogenated cyclic hydrocarbon radical,

at least one wholly or partially hydrogenated cyclic hydrocarbon radical being present in the molecule, said compounds being colourless substances of a feebly alkaline reaction.

On March 6, 1935, the Acting Commissioner wrote to the applicants, through their attorneys in Ottawa, quoting a communication from the examiner of the department in charge of the application, reading thus:

Attention is directed to Section 17 of the Patent Act, relating to food and medicine. Under this section no product can be claimed unless it is accompanied by and restricted to patentable process claims.

On March 6, 1936, the applicants wrote to the Commissioner as follows:

In response to the official action of March 6, 1935, please cancel the claims on file and substitute the new claims presented herewith in triplicate.

Remarks: In accordance with section 40 of the Act, the claims have been restricted to the process of manufacture and, in view of the amendment, further action on the merits of the application is respectfully requested.

The claims were amended by adding after the word "formula" in the first line thereof the words "when

produced by the processes of manufacture particularly described or by their obvious chemical equivalents."

On March 23, 1936, the applicants wrote to the Commissioner supplementing their letter of the 6th of March with regard to the amended claims; the letter of March 23 reads in part thus:

With reference to the amended claims submitted on March 6th last, the examiner will have noticed that separate process claims have not been presented as suggested by him since it is submitted that these are not required by section 40.

If the case were not one which fell within the section, there would be no question that the product might be claimed as such without limitation to any particular process of manufacture, since the product would properly be said to be "the invention." In our submission section 40 makes no change in this respect. Its only effect is to restrict the scope of the monopoly in the case of products to which it applies by disentitling the patentee from asserting that his rights have been infringed except when the alleged infringer has used the processes which the patentee has devised. The "invention" is still the product; the process is only a means to an end. Therefore, when the section says that a substance may not be claimed except when prepared by the methods of manufacture "particularly described and claimed," it does not mean that these methods must be set out in independent process claims as independent inventions but simply that the processes must be described in the specification and that the claims must in terms be limited to the product when made by such processes.

On May 7, 1936, the Commissioner replied to the applicants' letter of the 23rd of March quoting a communication from the examiner in charge of the application; it seems to me expedient to cite the essential statement of this communication:

The Office cannot concur with the attorneys' interpretation of section 40 of the Act. To do so, requires that the last lines of sec. 40 (1) are read "except when prepared * * * * * by the methods * * * * * particularly described or claimed * * * * * equivalent." If the Act were so worded it would clearly indicate that the inclusion of process claims was optional. However the Act is not so worded nor can this interpretation be read into the section. The words "particularly described and claimed" leave the Office no alternative and it must therefore insist that some process claims are made part of the application so that the section may be satisfied.

In a letter to the Commissioner dated June 12, 1936, the applicants reiterated the opinion that the amended claims complied with the requirements of section 40 of the Patent Act; the letter contains *inter alia* the following statements:

The argument made in the applicants' letter of March 23, 1936, is believed to accord perfectly with the terms of section 40. In the applicants' submission the phrase "particularly described and claimed" means "particularly described in the specification and specified in the claims."

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The phrase "particularly described or claimed" would have defeated the purpose of the provision since it is quite clear that the claims must be restricted to the product when produced by the process invented. The section's purpose is fully effected by giving the phrase as it stands the common sense meaning suggested.

On July 2, 1936, the Commissioner replied in part as follows:

The position of the Office has been made clear in the Examiner's report of May 7, 1936, and it is not deemed necessary to restate it again.

The phrase "particularly described and claimed" is perfectly clear and it is absolutely necessary that the process be disclosed clearly and completely in the claims and that the product claims be restricted to the product when prepared or produced by such process. If the applicants have discovered several processes to make the product they have made as many inventions which call for as many patent applications to protect them.

The claims are now finally rejected under the above rule.

The notice of appeal sets out the following reasons, to wit:

That the processes of manufacture of the product described in the application are not required by section 40 of *The Patent Act, 1935*, to be set out in independent process claims but merely to be described in the specification; that the product claims are not required by the said section to refer back to such process claims but merely to be limited in terms to the product when made by the processes described; and that accordingly the claims of the said application, being so limited, comply with the said section.

Subsection (1) of section 17 of the Patent Act, R.S.C., 1927, chap. 150, in force when the appeal was lodged, applies to the question at issue; it reads as follows:

In the case of inventions relating to substances prepared or produced by chemical processes and intended for food or medicine, the specification shall not include claims for the substance itself, except when prepared or produced by the special methods or processes of manufacture described and claimed or by their obvious chemical equivalents.

The Patent Act, chapter 150 of the Revised Statutes of Canada, 1927, was repealed and replaced by the Patent Act, 1935, 25-26 Geo. V, chap. 32, which came into force by proclamation on August 1, 1935. Section 17 of the old Act became section 40 of the new Act. Subsection (1) of section 40 is worded as follows:

In the case of inventions relating to substances prepared or produced by chemical processes and intended for food or medicine, the specification shall not include claims for the substance itself, except when prepared or produced by the methods or processes of manufacture particularly described and claimed or by their obvious chemical equivalents.

As one may note the adjective "special" which immediately preceded the word "methods" in subsection (1) of section 17 was deleted from subsection (1) of section 40, but the adverb "particularly" which did not appear in

subsection (1) of section 17 was added before the word "described" in subsection (1) of section 40. I do not think that the change has any materiality in the present case.

It was submitted on behalf of the Commissioner that the appeal had been improperly brought, because there had been no refusal on the part of the latter to grant a patent; this submission is based on section 21 of the old Patent Act or section 43 of the Patent Act, 1935, which is in substance similar. The appeal however, in my opinion, lies under subsection (4) of section 17 of the old Act or subsection (4) of section 40 of the new Act, which are literally the same, both being in the following terms:

Any decision of the Commissioner under this section shall be subject to appeal to the Exchequer Court.

This clause is very broad and I have no doubt that an appeal lies from the Commissioner's decision in a matter of the nature of the one before me. The question remaining for determination is whether the appeal in the present instance is well founded or not.

Section 17 of the old Patent Act, as well as section 40 of the Patent Act, 1935, provides that, when an invention relates to a substance prepared or produced by chemical processes and intended for food or medicine, the specification cannot include claims for the substance itself, except when the substance is prepared or produced by the methods or processes described and claimed or by their obvious chemical equivalents. It was argued on behalf of the appellant that the inclusion in each of the claims, as amended, of the words "when produced by the processes of manufacture particularly described or by their obvious chemical equivalents" complies adequately with the requirements of subsection (1) of section 17 (or 40). In other words, it was contended that, if the method or process were described in the specification, it was not necessary that the method or process should be made the subject of a distinct claim. I must say that I do not feel disposed to agree with this view.

It was urged that, if the Commissioner's contention that subsection (1) of section 17—or of section 40 of the new Act—requires an applicant for a patent for an invention relating to a substance prepared or produced by chemical processes and intended for food or medicine to have in his

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application independent claims to the processes to which the product claims should refer is right, it means that the applicant would be put in the position of claiming something which he might not have considered to be his invention. I do not believe that this proposition is founded because in the case of inventions referring to substances prepared or produced by chemical processes and intended for food or medicine the inventor cannot obtain a patent for the substance alone but he must get a patent for the substance prepared or produced by a method or process of his own. So that, in making a claim for the method or process of manufacture by which he has prepared or produced the substance described, he is claiming the very thing which he has invented and for which he is entitled to obtain a patent; if he has no claim to the method or process of manufacture, he is not entitled to a patent, the substance itself alone not being patentable.

It was also urged that if the Commissioner's interpretation of subsection (1) of section 17 were adopted, an applicant might be compelled to take out a number of patents, to wit one for each of the processes described. If the applicant has invented various processes and if he wishes to protect them all, he may have to apply for several patents. This may occasion a certain hardship, but it is no answer to the exigencies of subsection (1). Perhaps I may note incidentally that, in this regard, rule 34 of the Patent Act rules and regulations, approved by an Order in Council passed on September 26, 1935, may possibly be of some assistance to the applicant; rule 34 was formerly, in a somewhat different and narrower form, rule 29 of the rules and regulations approved by an Order in Council bearing date the 16th of September, 1933.

Subsection (1) of either section 17 of the old Act or of section 40 of the new Act is, in my judgment, clear and precise; the difference in their text is, in the present instance, unimportant and immaterial. The use of the conjunction "and" between the verbs "described" and "claimed" indicates unequivocally, to my mind, that the methods or processes have to be both described and claimed in the application. The Act does not permit a reference in a claim to the specification. The only reference in claims which the statute allows are those men-

tioned in subsection (3) of section 35, which reads as follows:

A dependent claim may refer to one preceding claim only. The latter may itself be a dependent claim.

The legislature having deemed it necessary to enact that a dependent claim may refer to a preceding claim, I think that it must be inferred that the legislature did not intend to allow a reference to the specification; otherwise it would have stipulated it.

Section 17 was first introduced in the Patent Act in 1923: 13-14 Geo. V, chap. 23. Subsection (1) of section 17 then contained a proviso which later became subsection (2) of section 17. This proviso has no relevance to the matter in controversy.

Subsection (1) of section 17, with its proviso, is in almost identical terms as subsection (1) of section 38A of the Patents and Designs Act, 1919 (Imp.), 9 & 10 Geo. V, ch. 80, from which it was derived. Subsection (1) of section 38A, leaving out the proviso which, as previously stated, is irrelevant, reads thus:

In the case of inventions relating to substances prepared or produced by chemical processes or intended for food or medicine, the specification shall not include claims for the substance itself, except when prepared or produced by the special methods or processes of manufacture described and claimed or by their obvious chemical equivalents: * * *

The only substantial difference between the British section and the Canadian one is the substitution in the latter of the word "and" after the words "chemical processes" for the word "or." The change, needless to say, greatly reduces the scope of the operation of the provision; it does not, however, affect the present appeal.

I may note briefly that subsection (1) of section 38A of the English Act was amended in 1932 (Patents and Designs Act, 1932, 22 & 23 Geo. V, chap. 32, s. 8) by striking out the word "special," by inserting the word "particularly" after the words "manufacture" and by substituting the word "ascertained" for the word "claimed." The proviso was omitted and the clause which followed the words "provided that" was made a separate subsection; another proviso was added to subsection (1), which has no bearing on the question at issue.

With the amendment made in 1932 to section 38A the English Act is, on the point with which we are concerned, essentially different from the Canadian Act. Since the

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amendment in question there is, in my opinion, no requirement in section 38A to claim with regard to the methods or processes of manufacture. In 1935 when our Patent Act was revised, the Canadian Parliament had before it the Act passed in England in 1932 and it did not deem fit to adopt the amendment therein enacted. Prior to the amendment of 1932 to subsection (1) of section 38A of the English Act the said subsection was substantially similar to subsection (1) of section 17 of the Canadian Patent Act. In view of this similarity the decisions rendered in England are useful; reference may be had with benefit to the following: *In the matter of an application for a Patent by the S. Co.* (1); *In the matter of M's application for a Patent* (2); *In the matter of an application for a Patent by R. R.* (3); *Sharp & Dohme Inc. v. Boots Pure Drug Company Ltd.* (4).

It was submitted on behalf of appellant that the insertion of the phrase "when produced by the processes of manufacture particularly described or by their obvious chemical equivalents" filled the requirements of subsection (1) of section 17; I am unable to share this view. As I have previously stated, the statute does not permit a reference in a claim to the specification. Moreover paragraph (c) of subsection (1) of section 14 of the old Act (R.S.C., 1927, chap. 150) as well as subsection (2) of section 35 of the new Act enact 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 or privilege. The claims in the appellant's application do not comply with these requirements.

In this connection reference may be had to the case of *Ingersoll Sergeant Drill Company v. Consolidated Pneumatic Tool Company Ltd.* (5); see also Terrell on Patents, 8th ed., p. 134.

For the above reasons I am of opinion that the appeal fails. The appeal is accordingly dismissed, with costs against appellant.

Judgment accordingly.

- (1) (1921) 33 R.P.C., 399 at 402
 (2) (1922) 39 R.P.C. 261.
 (3) (1925) 42 R.P.C. 303.

- (4) (1928) 45 R.P.C. 153 at 174
 and 182.
 (5) (1908) 25 R.P.C. 61 at 82.