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BETWEEN :

A. C. COSSOR LIMITED..... APPELLANT;

AND

THE COMMISSIONER OF PATENTS RESPONDENT.

*Patent Act—Patent Rules—Reference in one claim to a preceding claim  
 in the same specification.*

*Held:* That the inclusion by reference in one claim, of one or more preceding claims, in the specification accompanying an application for Letters Patent for an invention, is permissible under the Patent Act.

APPEAL by A. C. Cossor Limited from the refusal of the Commissioner of Patents to accept certain claims in the specification accompanying an application for Letters Patent for an invention relating to television systems.

The appeal was heard before the Honourable Mr. Justice Maclean, President of the Court, at Ottawa.

*O. M. Biggar, K.C.*, for the appellant.

*E. G. Gowling* for the respondent.

The facts and questions of law raised are stated in the reasons for judgment.

THE PRESIDENT, now (September 13, 1934) delivered the following judgment:

This is an appeal from the final rejection, by the Commissioner of Patents, of claims 8, 9, 11, 12, 13, and 15 to 20 inclusive, in the specification of one Bedford, accompanying an application for Letters Patent for an alleged invention relating to Television Systems; Bedford is the

assignor of A. C. Cossor Ltd., the appellant herein. The reason for rejecting such claims was that they did not meet the Patent Office requirement that a dependent claim refer only to one preceding claim by number, and which preceding claim must be complete in itself. The objection to these claims may be illustrated by saying that claim 8 refers to claim 7 which in turn refers to claim 1, the latter being a complete claim in itself. Apparently the Patent Office practice, which is not a statutory rule, requires that if the applicant, in a dependent claim, desires therein to refer to, or to incorporate, say two preceding claims, he must repeat the precise language of the next preceding claim and not refer to it by number, but he may refer to the first of such two preceding claims by its number, providing it is complete in itself. For example, in this particular case the contention is that claim 7 should have been incorporated textually into claim 8 because it was not complete in itself, but claim 1, which was complete in itself, might be referred to by number.

The sole question involved in the appeal is whether the rejection of the claims in question, upon the ground mentioned, was authorized by the Patent Act, or the Patent Rules. No question arises here as to whether the claims might be rejected on other grounds, such as redundancy, insufficiency, ambiguity, want of subject matter, and objections of that character. The specification filed here, I might say, is in precisely the same form as that filed by the same patentee in the British Patent Office, and which latter specification was there allowed; apparently the practice in the British Patent Office is to permit, by numeral reference, the incorporation in one claim of alleged subject matter described and claimed in one or more preceding claims.

The provision of the Patent Act referable to the content of the claims of a specification is sec. 14 (c) which states: "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." There is no specific Patent Rule bearing directly upon the subject matter of this controversy.

It was urged on behalf of the appellant that the rejected claims were in complete compliance with the Patent Act. The claims here number twenty-six, and it was urged by

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Mr. Biggar that the claims in question describe and claim as inventions, particular subordinate features or elements combined with the main invention, or, subordinate integers, and that it does not contravene the provisions of the Patent Act or any Patent Rules to incorporate in one claim one or more preceding claims by reference, as in this specification.

I do not think there was any authority for rejecting the claims in question upon the grounds taken by the Patent Office; I think these claims fully complied with the requirements of the statute. These claims were rejected not because they were improper or invalid on legal grounds, but because that in respect of form only, as explained, they were contrary to a practice prevailing in the Patent Office. I do not think the statute empowers the Patent Commissioner, or his Examiners, to reject a claim or claims upon the grounds stated. The practice of the Patent Office would seem to encourage prolixity in stating claims, which should always be discouraged; whereas the inclusion by reference in one claim, of one or more preceding claims, would, or should, tend toward brevity and clarity in stating the things or combinations in which an applicant claims an exclusive property or privilege; the latter practice would appear reasonable and logical, and if it have disadvantages they presently do not occur to me and there is no authority against such a practice; at any rate, if an applicant for a patent chose to state his claims in this manner, and to take the risk of so doing, I think he should be permitted to do so. It is my opinion therefore that the grounds stated for the rejection of the claims in question were not proper or valid grounds, and in my opinion the claims in question should be allowed. I am not deciding that these claims are valid, or that they may not be refused upon other grounds, for with that I am not presently concerned. The appeal is allowed.

*Judgment accordingly.*