

1952

BETWEEN:

Mar. 6

HOFFMAN-LA ROCHE LIMITED APPELLANT;

1953

AND

Dec. 31

THE COMMISSIONER OF PATENTS RESPONDENT.

Patents—Process for manufacture of aldehyde—The Patent Act, 1935, S. of C. 1935, c. 32, s. 2(d), 12(2), 26(1), 35(2), 40—The Patent Rules, 1948, R. 53—When product old process dependent product claim invalid for lack of novelty—Process dependent product claim unnecessary.

In an application for a patent for a process for the manufacture of an aldehyde the applicant made claims for the product when prepared according to his process. The Commissioner rejected the product claims and an appeal was taken from this decision.

Held: That where a product is old a process dependent claim for it cannot make it new and is invalid as a product claim for lack of novelty.

2. That since a process patent protects not only the process, but the thing produced by the process, a claim for the product when prepared according to the patentable process is not necessary.

APPEAL from the decision of Commissioner of Patents.

The appeal was heard before the President of the Court at Ottawa.

A. A. MacNaughton, Q.C. and *G. F. Henderson, Q.C.* for appellant.

W. P. J. O'Meara, Q.C. for respondent.

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

THE PRESIDENT now (December 31, 1953) delivered the following judgment:

This is an appeal from the decision of the Commissioner of Patents, dated September 12, 1951, rejecting certain claims in an application for a Canadian patent entitled "Process for the manufacture of an aldehyde" made by Herbert Lindlar and filed on October 1, 1951, in the Canadian Patent Office under Serial Number 565,296, of which the appellant is the assignee.

In the specification the applicant described his invention of a process for the manufacture of an aldehyde and end it with 18 claims, of which claims 1 to 13 are for a process as specified in them and claims 14 to 18 for a product when prepared according to the process of the specified claims. The process claims were not questioned by the Commissioner but he rejected all the product claims and it is from this decision that this appeal is taken.

It will be sufficient to consider only claim 14 which reads as follows:

14. Products when prepared according to the process of claims 1, 2 or 3.

This claim is typical of all the product claims and what is said of it is applicable to the other product claims. It is an example of what are called process dependent product claims and the issue in the appeal is whether such claims are allowable in an application for a Canadian patent for an invention.

The issue is one of difficulty and importance and there is a dearth of judicial authority on it.

The case for the appellant was put on several grounds. It was admitted that aldehyde, which is a chemical substance used in the production of Vitamin A, was an old product and was not claimed *per se*. Any person was free to produce it by a new process or an old one or to deal with it in any way so long as it was not prepared according to the applicant's process. But his process was new and it was

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submitted that when aldehyde was prepared according to it there was sufficient novelty in it when so prepared on which to found a process dependent claim for it. It was argued that in making such a claim the applicant was not claiming more than he had invented or fencing off property that did not belong to him. He had a monopoly in respect of his process and all that he was doing by his product claim was to claim the result of his process. By law he had a monopoly in respect of aldehyde when prepared according to his process: *Vide Von Heyden v. Neustadt* (1) and *Saccharin Corporation, Ltd. v. Anglo-Continental Chemical Works, Ltd. et al* (2). Thus by his process dependent product claim he was not seeking any protection for his invention beyond that to which he was entitled. His claim was only commensurate with his invention and his contribution to the art and the public was not deprived of anything it had before. Finally on this argument, it was submitted that process dependent product claims were recognized as valid by this Court and by the Supreme Court of Canada in *J. R. Short Milling Co. (Canada) Ltd. v. Geo. Weston Bread & Cakes Ltd. et al* (3) and should be allowed in the present case.

The next submission was that process dependent product claims are allowable under The Patent Act, 1935, Statutes of Canada, 1935, chapter 32, as a matter of implication from the specific provisions of section 40. This section, which was considered in *Winthrop Chemical Company Inc. v. Commissioner of Patents (No. 2)* (4), prohibits a claim for a substance *per se* in cases where it is prepared or produced by a chemical process and is intended for food or medicine. It allows a claim for such a substance only when it is prepared or produced by a method or process of manufacture particularly described in the claim and there is a claim for such method or process. That is to say, there must be a patentable process before there can be a claim for the substance and the claim for the substance must be limited to the substance as prepared or produced by the process. Thus section 40 recognizes process dependent product claims in

(1) (1881) L.J. 50 Eq. 126.

(2) (1900) 17 R.P.C. 307.

(3) [1941] Ex. C.R. 69;

[1942] S.C.R. 187.

(4) [1947] Ex. C.R. 36; [1948] S.C.R. 46.

the cases to which it applies. From this premise it was argued that since such claims are recognized in cases under section 40 where there is a statutory bar to a claim for the product *per se* it should also be recognized in other cases where the bar to a claim for the product is a priority bar, namely, that the product is old. It was pointed out that the Patent Office allowed process dependent product claims in cases under section 40 and urged that there was no reason why a similar practice should not be followed in other cases. Coupled with this submission was the argument that although an invention resides in a process a process dependent product claim is a proper way of claiming the invention of the process.

The third main submission was that process dependent product claims are allowed in England: *Vide* 24 Hals (Second Edition) at page 551:

An invention may . . . be claimed under different aspects, e.g., there may be a claim for a process . . . and for the product, even though not new in itself, manufactured by such process.

and also the statement in Patents for Invention by T. A. Blanco White, at page 59. There, after referring, *inter alia*, to *Von Heyden v. Neustadt (supra)* in which it was held that the importation into and sale in England of a patented article that had been made abroad by a patented process was an infringement of the English patent and to *Saccharin Corporation, Ltd. v. Anglo-Continental Chemical Works, Ltd. et al* (1) where it was held, *inter alia*, that the importation of saccharin in which the product of a patented process was used was an infringement of the patent for the process, the author made the following statement:

it would seem logically to follow that the product of a patented process must be treated precisely as if there were a separate claim for the product "when made by the process claimed in any preceding claim". It is, of course, very common to insert such a claim, or a series of claims to the same effect.

Counsel also referred to three English patents containing process dependent product claims similar to claim 14 and contended that since such claims are allowed in England under an Act not as liberal as the Canadian Act they should be allowed in Canada.

(1) (1900) 17 R.P.C. 307.

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Finally, counsel urged that since the applicant had a monopoly in respect of aldehyde when prepared according to his process it was in the public interest that he should be allowed to make a process dependent claim for it so that the public might be apprised of his rights and duly warned that any unauthorized dealing with it when prepared according to his process was an infringement of his invention.

While the argument in support of the appeal was impressive I have come to the conclusion for several reasons that effect should not be given to it.

It is essential to the validity of a claim that the thing claimed should have novelty. This is lacking in claim 14. Aldehyde is admittedly an old product and the submission that when it is prepared according to the appellant's process there is sufficient novelty on which to found a claim for it when so prepared cannot be accepted. The weight of judicial authority in Canada and the United States is against it. In *Hosiers Limited v. Penmans Limited* (1) Maclean J. made the following statement:

If a product is known to the trade, its production by a new process or new instruments cannot make it new. A manufacture is not new and patentable until the creative act in which it originated, is distinct from that required to invent the process or apparatus by which it is made.

This is the only Canadian judicial statement directly on the question that has been brought to my attention. But there is ample support for it in United States decisions: *vide Collar Company v. Van Dusen* (2); *Cochrane v. Badische Anilin & Soda Fabrik* (3); *Societe Fabriques de Produits Chimiques de Thann et De Mulhouse v. George Bueders & Co.* (4); and *ex parte Fesenmeier* (5) where Kinman, First Assistant Commissioner, said:

Where the product is old, it is not patentable because a new process of producing it has been discovered, nor does a claim for the product become patentable merely by including the steps of the new process. If such a claim is sustained by the court, it is construed as a claim for a novel process, and should, therefore, be drawn in the form of a process claim.

In my opinion, this statement is applicable to the present case.

(1) [1925] Ex. C.R. 93 at 104.
 (2) (1874) 90 U.S. (23 Wall).
 530 at 563.

(3) (1883) 111 U.S. 293 at 311.
 (4) (1904) 135 Fed. Rep. 102.
 (5) (1922) C.D. 18 at 20.

Consequently, I find that claim 14 lacks novelty. That being so, it is not a claim for an invention within the meaning of section 2(d) of The Patent Act, 1935, which defines an invention as follows:

2. In this Act, and in any rule, regulation or order made under it, unless the context otherwise requires,

(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;

And it follows automatically that it cannot comply with the requirement of section 26(1) of the Act in that aldehyde was known and used before the so-called invention. And it would be impossible for the applicant to meet the requirements of section 35(2) of the Act and state what he regards as new in his product claim.

Nor can I agree with the argument that the decision in the *J. R. Short Milling Company* case (*supra*) sanctioned process dependent product claims generally. It is true that the claim for the product in that case was held to be valid because the product was limited to a dry process instead of a wet one and in that sense was a process dependent product claim. But the product was a new manufacture so that the decision has really no bearing on the question now under consideration. Certainly, there is no warrant for saying that it recognizes process product claims where the product is old. I am, therefore, of the opinion that where a product is old a process dependent claim for it, such as claim 14, cannot make it new and is invalid as a product claim for lack of novelty. There was novelty only in the applicant's process but none in the product even when prepared according to his process.

There is, I think, a brief answer to counsel's submission based on the recognition of process dependent product claims in cases to which section 40 of the Act applies. This is the necessary consequence of the prohibition of claims for products *per se* contained in it. But this prohibition is confined to a limited class of products, namely, substances prepared or produced by chemical processes and intended for food or medicine. In the case of other substances there is

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no such prohibition. There can be a claim for them wit'
 out being limited to the processes by which they are pre-
 pared or produced. This is now settled: *vide Continental*
Soya Co. Ltd. v. J. R. Short Milling Co. (Canada) Ltd.
 (1). Just as the prohibition of claims for products *per se* is
 limited to the class of substances specified in the section so
 also is the recognition of process dependent product claims
 restricted to the same class of substances. Under the cir-
 cumstances, I am unable to find any logical reason for
 thinking that this limited recognition should become general
 and there is nothing in the Act to indicate or suggest that
 any such extension of it was intended.

There is a further reason for not allowing claims like
 claim 14. While it is framed as a product claim, albeit a
 process dependent one, the only justification for finding it
 valid would be to consider it as another way of claiming the
 applicant's process. That is really what it is. The only
 novelty in his invention is in his process. There is none in
 the aldehyde produced by it. But if a process dependent
 product claim is regarded as merely another way of claiming
 the process by which the product is produced, as I think
 must be the case where the product is old, then there is no
 need for the product claim, for it is well established that
 the law gives the owner of the patented process all the pro-
 tection for his process that is necessary. I have already
 touched on this subject. The most concise statement of the
 extent of the protection that I have been able to find is in
 Fisher and Smart on Patents, at page 184:

A process patent protects not only the process, but the thing produced
 by the process, and an action will therefore lie against any person pur-
 chasing and using or selling articles made in derogation of the patent,
 no matter whether they are made in Canada or elsewhere.

And the authors cite several decisions in support of this
 statement, including the *Von Heyden* case (*supra*) and the
Saccharin Corporation case (*supra*) to which I have already
 referred. That being so, a dependent product claim is not
 necessary to protect the applicant's invention for he is
 entitled to the same protection for his process without a
 process dependent product claim as he would get with one.
 He is entitled only to protection for his process for that is

(1) [1942] S.C.R. 187 at 189.

all that he has invented. Consequently, the applicant falls within the ambit of Rule 53 of The Patent Rules, 1948, which provides:

53. 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.

In my opinion, the Commissioner might well have justified his decision under the first part of this Rule, which by virtue of section 12(2) of The Patent Act, 1935, has the same force and effect as if it had been enacted in the Act. I should add that I was advised by counsel for the respondent that he had not been able to find any similar rule in England. That being so, I need not deal with the submission that since process dependent product claims are allowed in England they should be allowed in Canada beyond saying that even if Rule 53 were not in effect I can see no reason, in the absence of express or implied statutory direction to do so, for allowing process dependent product claims such as claim 14.

For the reasons given I have reached the conclusion that it is only the applicant's process that should be covered by a patent and that the Commissioner was right in rejecting his product claims. The appeal will, therefore, be dismissed, but without costs.

Judgment accordingly.

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