

THE CORPORATION OF THE  
**CITY OF WHITE ROCK**  
CORPORATE REPORT



**DATE:** May 30, 2022  
**TO:** Mayor and Council  
**FROM:** Jim Gordon, P.Eng., Director of Engineering & Municipal Operations  
**SUBJECT:** White Rock Water Treatment Plant – Patent Applications

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**RECOMMENDATION**

THAT Council receive the report dated May 30, 2022, from the Director of Engineering & Municipal Operations, titled “White Rock Water Treatment Plant – Patent Applications” for consideration and direct that the Patent applications submitted on behalf of the City of White Rock at both the US and Canadian Patent Offices be discontinued.

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**EXECUTIVE SUMMARY**

On January 13, 2020, Council approved the request to proceed with the submission of a Patent for the Water Treatment Plant (WTP) approach and design. Patent submissions were subsequently made through Patent lawyers Oyen Wiggs (OW) to both the Canadian and US Patent and Trademark offices. Appendix B is a document from the US Patent and Trademark Office rejecting the Patent Application.

This report discusses the rejection notice, costs spent to date and recommends against further expenditures.

**PREVIOUS COUNCIL DIRECTION**

| <b>Motion # &amp; Meeting Date</b> | <b>Motion Details</b>  |
|------------------------------------|--|
| 2020-07<br>January 13, 2020        | THAT Council approves the request to proceed with the submission of a Patent for the Water Treatment Plant.<br><p style="text-align:right"><u>Motion CARRIED</u></p> |

**INTRODUCTION/BACKGROUND**

Pursuant to Council direction, staff submitted Patent Applications through OW to both the Canadian and US Patent and Trademark Offices for the water treatment processes at the City WTP. The Canadian application is filed, but a request for examination of the application was held pending the results of the US Application.

The January 13, 2020 Council report requesting approval to proceed with Patent submission is attached as Appendix A.

Attached as Appendix B is the rejection notice from the US Patent and Trademark Office. OW advises that the examiner considers that some of the application claims lack novelty and the remainder lack inventiveness as they were previously described in a 2017 Res'Eau-Waternet publication. This publication is attached as Appendix C.

### **DISCUSSION**

Staff requested that OW study the rejection and comment on the likelihood of a successful appeal. OW advises that it is difficult to show patentability over the Res'Eau-Waternet publication because the publication discloses so much of what is claimed in the patent application. An argument could potentially be made related to the low ozone concentration being unobvious to a skilled person. OW believes this argument would have a low probability of success unless supported by a declaration from an expert. Given that it is reasonable to test the efficacy of the ozone dosing by starting with a low dose, and the cost savings of a lower dosage, it is not likely that a skilled person would overlook lower dosages.

Although an examination has not been requested from the Canadian Patent Office, it appears from the US report that the Application lacks the requirements for a Patent. OW advises that it is common to test a patent application against the US patent requirements before moving forward with examination of the Canadian application.

It is recommended that the City not make any further expenditures on this Patent Application and that staff advise OW that their services are no longer required.

### **FINANCIAL IMPLICATIONS**

The City has spent approximately \$30K to date on the Patent application process. There will be further costs of approximately \$5K related to legal work done studying the rejection and considering legal arguments for an appeal.

### **LEGAL IMPLICATIONS**

No legal implications, however, a final legal bill for services rendered by OW will be received and if there is direction to continue with an appeal, additional legal expenses will be incurred.

### **OPTIONS / RISKS / ALTERNATIVES**

The following option for Council's consideration is that the City contests the Patent rejection by the US Patent Office through its solicitors, which will incur ongoing legal costs.

## **CONCLUSION**

The application submitted on behalf of the City for a patent related to the approach and design of the WTP has been rejected by the US Patent Office. It appears there is a low probability of a successful appeal. It is recommended that the Patent applications at both the US and Canadian Patent Offices be discontinued.

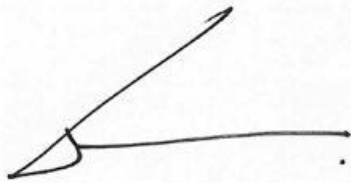
Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jim Gordon', written over a light grey rectangular background.

Jim Gordon, P.Eng.,  
Director, Engineering & Municipal Operations

## **Comments from the Chief Administrative Officer**

I concur with the recommendation of this corporate report.

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Guillermo Ferrero  
Chief Administrative Officer

- Appendix A: Corporate Report dated January 13, 2020, titled “Patent Submission for the White Rock Water Treatment Plant”
- Appendix B: Rejection notice from the US Patent and Trademark Office dated December 20, 2021
- Appendix C: 2017 Res’Eau-WaterNet publication “A Community Circle Approach to Evaluating Water Treatment Solution for the City of White Rock”