

DECISION OF THE COMMISSIONER

IN THE MATTER OF a request for a review by the Commissioner of Patents of the Examiner's Final Action under Section 46 of the Patent Rules (Prior to the Amendment by Order-in-Council P.C. 1970 - 728 effective June 1, 1970).

AND

IN THE MATTER OF a patent application serial number 030,373 filed September 19, 1968 for an invention entitled:

SPORT SHOE

Patent Agent for Applicant:

Messrs. Marks & Clerk  
Ottawa, Ontario.

This decision deals with a request for a review by the Commissioner of Patents of the Examiner's Final Action rejecting application 030,373. The request was made in accordance with Section 46 of the Patent Rules (prior to amendment by Order-In-Council P.C. 1970-728).

The Patent Appeal Board conducted a Hearing on December 3, 1970. Mr. George Seaby of Marks & Clerk represented the Applicant.

Subsequent to the Hearing the Patent Appeal Board made a study of the prosecution of the application and the following observations are noted:

- (a) The examiner rejected the application for the first time in the Final Action report. In previous reports only the claims were rejected.
- (b) The United States patents cited in the Final Action were not previously cited by the Canadian Patent Office.
- (c) The amendment which was accepted and entered as a result of the Final Action was not officially considered by the examiner in that no report was made to the applicant on the merits of the amendment, and which action the application was entitled to receive under the old Final Rejection procedure which applied to this application.

The agent did not object to these points at the Hearing, however in all fairness to the applicant, I find they should not be overlooked.

In the circumstance, therefore, I recommend that the application should be returned to the examiner for a second action under Section 46 of the Patent Rules.

R.E. Thomas,  
Chairman,  
Patent Appeal Board.

I concur with the findings of the Patent Appeal Board and I am therefore returning the application to the examiner for resumption of prosecution.

Decision accordingly,

A.M. Laidlaw,  
Commissioner of Patents.

Dated at Ottawa,  
Ontario, this 15th  
day of December, 1970.