



REGISTERED

Your file - Votre référence

Section 63(2)  
4 months

Our file - Notre référence

November 15, 1979

Mr. D.S. Johnson  
133 Richmond St. W.  
Toronto, Ontario  
M5H 2L3

Application No: 231873  
Date Filed: July 21, 1975  
Title: Apparatus & Methods for Weighing Railroad Cars  
Coupled Together And In Motion

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Dear Sir,

This will acknowledge receipt of your letter of October 22, 1979, and the certified copy of U.S. Application 493218 showing that the Applicant is entitled to a convention priority.

I have considered the arguments submitted on behalf of the Applicant, but for the reasons explained below, am not persuaded by them. Consequently I now reject this application under Section 63(2) of the Patent Act unless the Applicant commences an action to set aside prior Canadian patent 954148, Sept. 3, 1974, insofar as it covers the invention in question, within four months of the date of this letter, and diligently prosecutes said action subsequently. In the alternative the Applicant may delete claims 40 and 41 within the same time frame. Canadian Patent 954148 was filed on July 20, 1972, which it may be noted predates Applicant's Canadian filing date by three years plus one day and predates his convention priority date by more than two years. It was allowed by the Examiner on May 14, 1974, before the Applicant's convention priority, and more than a year before his Canadian filing date.

The Applicant does not contest and there is no doubt that claims 40 and 41 of this application cover the same invention as is claimed in Canadian patent 954148. This was acknowledged in Applicant's letter of June 9, 1978, at the bottom of page 4.

It is also quite clear that when Canadian Patent 954148 issued on Sept. 3, 1974, the present application was not pending in Canada, since it was not filed with this Office until July 21, 1975, some ten months after the Canadian patent issued. I am consequently satisfied that a patent for the invention had already been issued under the Canadian

Commissioner  
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Patent Act, and that this application should be rejected under Section 63(2).

The Applicant contends, however, that he is entitled to the grant of what would be a second Canadian patent for the same invention by reason of a judicial precedent, and what happened in the matter of In Re Fry (1939) as reported in the Canadian Patent Reporter, Vol. 1, Sec. II at 135, and by virtue of the fact that his corresponding convention application was filed in the United States on July 31, 1974, just one month before Canadian Patent 954148 issued. He argues that under Section 29 he is entitled to have his Canadian Application 231875 considered as if it were filed in Canada on July 31, 1974; that consequently Canadian Patent 954148 should be deemed to have been copending with his application, and that it is no obstacle to the allowance of his application since Section 61(2) was held in re Fry not to extend to applications which were copending.

It should be noted, however, that the facts in this case do not correspond to those that existed in the Fry matter. In Fry, both applications were actually copending before the Canadian Office at one and the same time, and there was an error in the Patent Office in not establishing a conflict under Section 44. Neither of these situations are present in this case.

Furthermore the correctness of the Fry decision is moot. The defendant in that action was unrepresented, and the arguments why the Fry application should not be allowed were not made. In a much more recent decision, Radio Corp. of America v Philco Corp. 1966 CPR Vol. 64 1 at 14 & 15, the President of the Exchequer Court cast considerable doubt upon Fry, saying:

...In my view, the subsection [63-2] should be read as applying to any application for an invention for which a patent has already issued at the time the Commissioner is having to decide whether the application should "be rejected." Certainly it seems that public interest would be served if the Commissioner were required to apply the rule in s. 63(2) whenever he recognizes that there is an existing patent for the invention claimed so as to avoid the co-existence of two patents for the same invention whenever possible....

and

...Section 63(2) deals with quite a different problem [than Sec.43], that of avoiding, where possible, the co-existence of two patents under the Patent Act for the same invention. That subsection prohibits the issue of a patent for an invention for

which a patent has already issued under the Canadian Act until the prior patent has been successfully attacked in the Courts. This rule obviously applies to some of the cases to which s. 43 applies and it is expressed to apply notwithstanding that section. There is no reason why the rule in s. 63(2) should be restricted to an application made after the patent was issued and the subsection does not contain such a limitation expressly. The fact that s. 43 contains such a limitation expressly and that s. 63(2) does not confirms me in my view that it is not to be implied in s. 63(2).

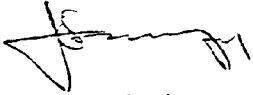
It should further be noted that under Section 29(1) the Applicant is not entitled to the benefits of that Section unless the priority country affords the same rights to citizens of Canada. In the present case the priority filing was in the United States of America. In the same circumstances under American law, the application would be refused unless he could show that he made the invention before July 20, 1972, and even in that eventuality he would then be put into interference with the patent to determine who actually was the prior inventor. This is the same as what is now being required under Section 63(2) in Canada, i.e. the Applicant is being required to prove that he is the prior inventor. Since in Canada that determination cannot be made within the Patent Office, as conflict cannot be set up between an issued patent and an application, that determination is made by the court.

Article 4 B of the London Accord of the International Convention, to which Canada subscribes assures that the applicant's Canadian application will not be invalidated by acts accomplished in the interval between his American and Canadian filing, and does this by affording him the opportunity by virtue of Section 63(1) c of setting aside the Canadian patent. This is a right he would not otherwise have possessed.

Applicant has himself quoted a paragraph from the decision in R.C.A. v Philco, but I fail to see the relevancy. In the present case the Office has recognized that the applications would conflict if copending, so the factual situation is not comparable. No conflict was missed by the Office since applicant's application was not on file. The last sentence of the quotation is that Section 63 permits the one patent to attack the other's patent. That does not, however, preclude an applicant also utilizing Section 63 to set aside an issued patent. Indeed Section 63(1)(c) says that the applicant can resort to Section 63 to upset the earlier patent if he wishes to obtain a patent himself.

I am consequently satisfied that a second patent should not be permitted for the same invention before the first is set aside.

Yours truly,

A handwritten signature in dark ink, appearing to read 'J.H.A. Gariepy', with a stylized flourish at the end.

J.H.A. Gariepy  
Commissioner of Patents