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Commissaire
des brevets
Ottawa — Hull
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It is also quite clear that when Canadian Patent 1,040,043 issued on Oct. 10, 1978, the parent application was not pending in Canada, since it was not filed with this Office until Mar. 13, 1979, some five months after the Canadian patent issued. I am consequently satisfied that a patent for the invention had already been issued under the Canadian 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 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 Mar. 24, 1978, some six months before Canadian Patent 1,040,043 issued. He argues that under Section 29 he is entitled to have his Canadian Divisional Application 366,748 considered as if it were filed in Canada on Mar. 24, 1978, and that consequently it and Canadian Patent 1,040,043 should be deemed to have been copending. He argues further that Canadian patent 1,040,043, is not a bar to the grant of a patent because of the in re Fry decision, and the applicability of Section 29(1).

I note 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 45 (then 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 the earliest date of record of patent 1,040,043, i.e. Feb. 19, 1976, and even in that eventuality he would then be put into interference with the patent to determine who actually was the prior inventor.

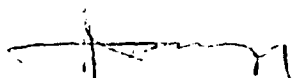
In Canada that determination cannot be made within the Patent Office, as conflict cannot be set up between an issued patent and an application. That determination must be made by the court, under the provisions of Section 63. Section 63(1)(c) says that the Applicant can resort to Section 63 to upset the earlier patent if he wishes to obtain a patent himself. Applicant is therefore required, under Section 63(2) to set aside the prior patent by means of a court action.

In the present case the Office has recognized that the applications would conflict if copending. No conflict was missed by the Office since applicant's application was not actually copending before it at the same time as that application which issued as patent 1,040,043.

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

Applicant's attention is drawn to the Commissioner's Decision which was published in the Patent Office Record on Dec. 16, 1980, where essentially the same situation was encountered.

Yours truly,



J.H.A. Gariépy
Commissioner of Patents