COMMISSIONER'S DECISION

SECTION 28(1)(a) TELEVISION RECEIVERS

The application filed on July 5, 1953 contains claims 8 to 16 nearly identical to claims in Canadian Patent 577,734 which was filed on September 3, 1954 and expired in 1976. There is no provision in the Patent Act to refuse the application where two applications are pending where one issues to patent and expires while the other is still pending.
Final Action Reversed.

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This decision deals with Applicant's request for review by the Commissioner of Patents of the Final Action on application Serial Number 650290 (Class 350-67) assigned to Radio Corporation Of America. The application, which was filed on July 3, 1953 by the inventors Dalton Harold Pritchard and Alfred Christian Schroeder, is entitled SYNCHRONOUS DETECTORS FOR TELEVISION RECEIVERS. The Examiner issued a Final Action refusing to allow the application.

This application relates to improvements in synchronous detectors employed in color television receivers. In the course of a long and complicated prosecution the applicant introduced the subject matter of present claims 8 to 16 into the application on October 17, 1961. The examiner in charge of the application in May, 1964 rejected these claims in view of Canadian Patent 577,734, granted on June 16, 1959 to Farr. The application contains claims 8 to 16 which are identical or nearly identical to claims in the patent. At that time, Applicant pointed out that the Farr patent had been copending before the Patent Office with this application and indicated these claims must be allowed on the basis of in re Fry 1 C.P.R. 135. The examiner made no further comment on the in re Fry situation, and the prosecution of the application was continued through protracted conflict proceedings which were resolved in 1982. The Farr patent expired in 1976. The examiner now in charge of the application has again rejected claims 8 to 16 of this application in view of the Farr patent. He takes the position that the decision in re Fry is no longer pertinent because the Farr patent has expired. In his view therefore, the subject matter of Applicant's claims 8 to 16 has been in the public domain since 1976, and cannot now be patented.

In response to the examiner's Final Action the Applicant presents reasons for allowance of his claims as follows (in part):

> ...
> The Farr patent issued on an application which was filed September 3, 1954, claiming a United States priority date of September 4, 1953. The present application was filed on July 3, 1953, and is entitled to a United States priority date of July 25, 1952. Farr's filing date and his priority date are both later than the filing date of this application in the Canadian Patent Office. There is no basis upon which the Farr patent can be a reference against the present application.
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> ...
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> The examiner based his final rejection of claims 8 to 16 on the stated ground that, the Farr patent having expired on June 16, 1976, the subject matter of the rejected claims is now in the public domain. He stated "This rejection is based on the well known principle of patent law that when an invention once becomes part of the public domain then the public cannot be deprived of its right to use what it already possesses, for there is, and can be, no consideration to support such a monopoly". No authority is given for the proposition. No authority exists for it.
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> The law relating to the granting of patents is the Patent Act.[1] It sets out very clearly in what circumstances and to whom the Commissioner is to grant a patent (Sections 28 and 29). The Commissioner may refuse to grant a patent only upon being "satisfied that the applicant is not by law entitled to be granted a patent"[2] (Section 42).
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> In order properly to refuse a patent, the Commissioner must come to his conclusion on the basis of some provision of the Patent Act not having been complied with in respect to the application which is before him.
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> The rejection by the examiner has no basis at all in the Patent Act. There is no law to support it. It thus cannot form the basis for a conclusion by the Commissioner that the applicant "is not by law entitled to a patent" in respect to claims 8-16 of the present application.
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> ...
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> [1] Commissioner of Patents v. Farbwerke Hoechst Aktiengesellschaft Vormals Meister Lucius & Bruning, (1964) S.C.R. 49, per Judzon J. at page 57 -- "An inventor gets his patent according to the terms of the Patent Act, no more and no less."
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> [2] Monsanto Co. v. Commissioner of Patents, (1979) 42 C.P.R. (2d) 161, at page 178 where, after setting out the text of Section 42, Pigeon J. said "I have emphasized by law to stress that this is not a matter of discretion: the Commissioner is to justify any refusal".
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> ...

The issue before the Board is whether or not claims 8 to 16 may be rejected on the ground that the subject matter therein has become part of the public domain.

When the Farr patent was first cited, in May 1964, Applicant's response was satisfactory. We have no reason to doubt that if the application had been otherwise allowable at that time, it eventually would have issued, taking into consideration the comments by the Applicant concerning in re Fry. We must now determine if the practical effect of the Fry decision lapses with the expiry of the cited patent and if the Farr patent, although not a proper citation in 1964, has now become a proper citation and provides a good reason to refuse to grant a patent containing claims 8 to 16.

In addition to the two court cases mentioned by the applicant we would also like to refer to the case of Vanity Fair Silk Mills v. Commissioner of Patents (1939 S.C.R. 245) where it was said:

> No doubt the Commissioner of Patents ought not to refuse an application for a patent unless it is clearly without substantial foundation.

It is therefore clear to the Board that, however reluctant the Commissioner of Patents may be to grant a second patent for a second term of 17 years for an invention that has been previously patented, he must do so unless he can find, within the terms of the Patent Act, reasons that satisfy him that the applicant is not entitled to the grant.

In seeking guidance from the Patent Act, the Board reviewed Sections 28, 43 and 63 in particular, because these are the sections which must be satisfied with respect to novelty, entitlement to a grant, and previous grants for the same invention.

In Section 28 there are various provisions outlined in subsections (1), (2) and (3), which an Applicant must satisfy. In our view, subsections (2) and (3) are not pertinent to the review of this application. Subsection (1) sets out provisions concerning availability of the invention which exists prior to filing an application. It also refers to the date the application

was filed, and does not refer to a later time, for example, during its pendency. We find nothing in Section 28 that may be used as a ground for refusal of Applicant's claims 8 to 16 in view of the Farr patent which issued after the filing date of this application.

Section 43 relates to the situation where a patent exists "before the filing of an application." This is not the situation here, therefore Section 43 does not apply.

In Section 63(1), sub-paragraphs (a), (b) and (c) refer also to conditions which exist before the filing of an application. In particular, sub-paragraph (b) refers to a person who filed an application before the issue of a patent, and it also provides the means for that person to bring an action before the Federal Court to determine which of two patentees claiming the same invention is the prior inventor.

Section 63(2) provides the Commissioner with the authority to refuse to grant a second patent when a patent has already issued in Canada for the same invention. The in re Fry case, decided by the Exchequer Court, now the Federal Court, reviewed the term "already issued".

In that case, two applications were co-pending, and one issued to patent. The Commissioner refused the other application in view of that patent, citing Section 61(2). The Court found that the provisions of that Section applied where an application for a patent was actually filed after a patent had issued for the same invention. By its ruling, the Court brought to that section an interpretation to the wording "already issued", which is still included in Section 63(2), briefly stated, that an application should be refused where the Canadian patent issued prior to the filing of the application.

In the case of RCA v Philco, 29 Fox Pat. C., 97, Jackett, J. made certain observations about the in re Fry decision, to the effect that he thought that the reference in Section 63(2) to a patent already issued, related to the time when the Commissioner was considering the provisions of that section. The Supreme Court in reviewing that case was silent with respect to those observations. We are unable therefore to attach any significance to the remarks by Jackett, J. in RCA v Philco, and we are bound to follow the interpretation given in re Fry which is directly related to the conditions found in Section 63(2).

In a recent Federal Court case, Farbwerke Hoechst v Halocarbon, dated July 25, 1983, Collier J. remarked that "...the plaintiff's patent has now expired, so that issue becomes academic." That remark however was made with respect to the determination of injunctive relief in that case. While that patent has expired and is in the public domain, we must recognize that the remarks were directed to a particular issue which in our view is not related to the provisions of Section 63(2).

In summary, the review of the prosecution emphasizes that the provisions of the Patent Act are directed to a first to invent system. When there are two co-pending applications disclosing or claiming the same subject matter, and the later filed application issues to patent, as is the situation before us, we are satisfied that the Act provides no direction to the Commissioner to refuse the other application. Even though the Farr patent has expired and has become part of the public domain, we are satisfied that Applicant, by law, may not be denied the right to a grant of a patent containing claims 8 to 16, particularly considering the provisions of Section 28(1)(a) of the Act.

We recommend that the rejection of claims 8 to 16 be withdrawn and the application be returned to the examiner for normal prosecution.

M.G. Brown
Acting Chairman
Patent Appeal Board

S.D. Kot
Member

I concur with the findings and the recommendation of the Patent Appeal Board. Accordingly, I withdraw the rejection of claims 8 to 16, and I remand the application to the Examiner for prosecution consistent with the recommendation.

J.H.A. Gariépy
Commissioner of Patents

Dated at Hull, Quebec

this 27th. day of January, 1984

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