

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application 524,633, having been deemed abandoned under Subsection 30(1) of the Patent Act, the Applicant has asked that the matter be reviewed by the Commissioner of Patents. The status of the application has consequently been reviewed by the Patent Appeal Board and the Commissioner of Patents. The findings of the Board and the ruling of the Commissioner are as follows:

Agent for the Applicant

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This decision deals with the Applicant's request for review by the Commissioner of Patents of the status of application serial number 524,633 (Class 167-227) filed on December 5, 1986 and assigned to Ciba-Geigy AG which was deemed abandoned for failure of the Applicant to restore the application within the time limit set by Subsection 73(2) of the Patent Act. The application is entitled RESINATE SUSTAINED RELEASE DEXTROMETHORPHAN COMPOSITION and the inventors are Franz X. Fischer and Satish C. Khanna.

The examiner in charge of the application allowed the application on April 25, 1990 and a notice of allowance was mailed on June 19, 1990. The Applicant failed to pay the final fee by the due date of December 19, 1990 with the result that the application became forfeited pursuant to Subsection 73(1) of the Act. The Applicant did not restore the application within the time limit of June 19, 1991 set by Subsection 73(2) of the Act and on March 2, 1992 the Office sent a letter to the Applicant stating that the application was deemed to be abandoned as of December 19, 1990. On March 31, 1992 subsequent to receiving the notice of abandonment the Applicant wrote requesting that the application be reinstated and providing an affidavit of Patrick K. Sloan, the Office Manager of Applicant's agent explaining that the failure to both pay the final fee and to restore the application within the respective time limits was due to a misinterpretation of the Applicant's instructions.

On April 24, 1992 a supplementary letter was submitted by the Applicant enclosing both a final fee and a restoration fee in the amount of \$1,100.00 and on June 15, 1992 the Applicant submitted a memorandum of fact and law setting forth its position in the matter. At the Applicant's request a hearing was held on May 26, 1993 at which the Applicant was represented by Mr. J. Bochnovic and Mr. D. Hill and the members of the Board were F.H. Adams, Chairman, M. Howarth, member and M. Wilson, member. The hearing was held concurrently with a hearing on a similar case in which the applicant was represented by Mr. D. Watson of Gowling, Strathy & Henderson.

This decision deals with Patent Office procedure concerning forfeiture rather than the subject matter of the application. Under the provisions of Subsection 73(1) of the Act an applicant has six months from the date of the notice of allowance in which to pay the final fee. If the applicant fails to pay the final fee within the time limit the application becomes forfeited and the applicant then has a further six months under the provisions of Subsection 73(2) to restore the application by the payment of a restoration fee along with the original final fee. When an applicant fails to restore an application within the time limit it has been the practice of the Office to deem the application to be abandoned and to give the applicant 12 months from the date on which the application became forfeited to reinstate the

application under the provisions of Section 30 of the Act, i.e. the applicant is given a further six months from the time limit for restoration in which to revive the application. The question before the Board is whether or not to change the date of the application's deemed abandonment as established by the longstanding Office policy.

In this instance the application was forfeited and not restored and it was not until the Applicant became aware that the application was deemed abandoned that action was taken to revive the application. Thus on December 19, 1990 the application became forfeited and under present policy the Applicant had until December 19, 1991 in which to reinstate. However since the Applicant did not become aware that the application was deemed to be abandoned until early March, 1992, too late to reinstate according to the time limit set out in Subsection 30(2) of the Act the Applicant has submitted that the date of deemed abandonment be changed to June 19, 1991 so that the final date for reinstatement would be June 19, 1992.

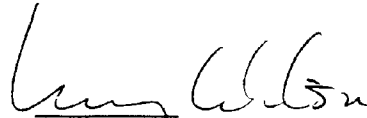
The Board has carefully considered the Applicant's written and oral arguments and has concluded that the date of deemed abandonment should not be changed. The Board therefore recommends that Applicant's request that the date of the application's deemed abandonment be changed from December 19, 1990 to June 19, 1991 be refused.



F.H. Adams  
Chairman  
Patent Appeal Board



M. Howarth  
Member  
Patent Appeal Board



M. Wilson  
Member  
Patent Appeal Board

I concur with the recommendation of the Patent Appeal Board and refuse to grant the Applicant's request that the date of the application's deemed abandonment be changed from December 19, 1990 to June 19, 1991.



M. Leesti  
Commissioner of Patents

Dated at Hull, Quebec  
this 15<sup>th</sup> day of July, 1993