

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 592,357, having been rejected under Subsection 47(2) of the Patent Rules, the Applicant asked that the Final Action of the Examiner be reviewed. The rejection has consequently been considered by the Patent Appeal Board and by the Commissioner of Patents. The findings of the Board and the ruling of the Commissioner are as follows:

Agent for Applicant

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This decision deals with the Applicant's request that the Commissioner of Patents review the Examiner's Final Action on patent application number 592,357 (Class 182-9) which was filed on February 28, 1989 by Applicant/Inventor Ernst F. Hark for an invention entitled "Improved Method for Water Filtration". The Examiner in charge issued the Final Action on November 27, 1992 refusing the application under Subsection 27(2) of the Patent Act. The Applicant submitted a written response on May 26, 1993 and requested a review by the Commissioner of Patents.

The application relates to a process and apparatus for treating water from a municipal water supply. This involves various steps including prefiltration, activated carbon filtration, secondary guard filtration as well as a double reverse osmosis step. The Applicant's objective is to produce ultra-pure water with a purity in the 16 megohm-cm' and greater range.

The Applicant had also filed a patent application directed towards the identical subject matter in the United States on December 21, 1987, which application issued as U.S. Patent 4,808,287 on February 28, 1989. Since the date of February 28, 1989 is the same date as the Canadian filing date, the Examiner rejected the application under Subsection 27(2) of the Patent Act which reads as follows:

Any inventor or legal representative of an inventor who applies in Canada for a patent for an invention for which application for patent has been made in any other country by that inventor or his legal representative before the filing of the application in Canada is not entitled to obtain a patent for that invention unless this application in Canada is filed, either

- (a) before issue of any patent to that inventor or his legal representative for the same invention in any other country, or
- (b) if a patent has issued in any other country, within twelve months after the filing of the first application by that inventor or his legal representative for a patent for that invention in any other country.

It is the Examiner's position that the application was not filed in Canada before the issue of the U.S. Patent referred to above i.e. Subsection 27(2)(a) of the Patent Act is a bar to obtaining a patent in Canada. In taking this position the Examiner is following the policy laid down by the Patent Office in the Manual of Patent Office Practice.

The Board notes that the Patent Office has on several occasions sought to resolve the question associated with filing a Canadian application on the same day as the date of issue of a foreign patent. In a decision of the Commissioner of Patents dated May 28, 1957 it was decided not to object to the grant of a patent on an application on the grounds that the application had been filed in Canada on the same day as the issue date of a corresponding

foreign patent. This decision did not give reasons but did reverse previous Commissioner's decisions rendered on June 24, 1954 and June 14, 1956. As a result, this has been the practice of the Patent Office until a change was made to the Manual of Patent Office Practice in July 1989. The practice was changed in view of another Commissioner's Decision rendered in 1989 relating to a divisional application that had been filed on the day of issue of a Canadian patent on the parent application.

The Board however believes that a decision relating to the grant of patents on divisional applications is not necessarily persuasive in the present case which relates to the date of issue of a patent in a foreign country since the facts and legal principles as they pertain to the country of issue have to be considered.

Accordingly the question before the Board is whether a Canadian application filed on a specific date can be considered to have been filed before the issue of its corresponding United States patent which bears the same date, i.e. whether or not the present application filed on Feb. 28, 1989 can be said to have been filed before the issue of the corresponding United States patent which bears an issue date of Feb. 28, 1989.

The Board has examined the statutory provisions in the United States covering the issue of a patent, in particular 35 U.S.C. 154, which refers to the contents and term of a patent but does not provide guidance as to the date of issue. The Patent Rules do make a reference to a date in § 1.315 entitled "Delivery of patent" as follows:

The patent will be delivered or mailed on the day of its date to the attorney or agent ...

This does not however clarify the issue to be decided.

The Board notes that a text book, written in the last century, Robinson, The Law of Patents (Boston : Little, Brown and Company 1890) calculated the term of an U.S. patent not affected by that of a prior foreign patent, in paragraph § 625 in Volume II of Book III, at page 263 :

In calculating the term of a patent whose duration is not affected by that of a foreign patent, the day of its date is excluded, and it will expire on the last hour of the same day and month, seventeen years after its issue.

The Applicant has referred the Board to a decision of the United States Circuit Court Of Appeals, Seventh Circuit, Standard Oil Co. v. Commissioner of Internal Revenue (1942), 129 F.(2d) 363.

This is a tax case involving a computation of the depreciation allowance for a patent. The U.S. patent in question issued on January 7, 1913 while the relevant federal tax act came into force on March 1, 1913 (all calculations appear on page 373 of the judgment). The court accepted that the patent had seven days, as opposed to six days, to run in 1930. Further the court found that from, and including March 1, 1913, the patent had 16 years and 313 days to run. The Applicant argues that this judgment stands for the proposition that a U.S. patent issues at the end of the day on which it is dated.

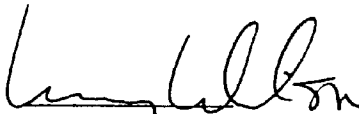
In support of this position the Applicant has also referred to Chapter 201.11 of the Manual of Patent Examining Procedure issued by the United States Patent and Trademark Office which defines copendency as follows:

If the first application issues as a patent, it is sufficient for the second application to be copending with it if the second application is filed on the same date....

In view of the above, the Board accepts that a U.S. patent that bears the issue date of February 28, 1989 (a Tuesday) issued at the end of that day, i.e. at midnight between the Tuesday and the Wednesday. Accordingly Applicant's Canadian application filed on February 28, 1989 was filed before the issuance of Applicant's corresponding U.S. patent so that Subsection 27(2)(a) of the Act is therefore not a statutory bar. The Board therefore recommends that the rejection of the application be reversed.

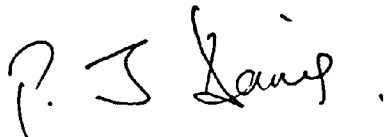


Michael Howarth  
Member  
Patent Appeal Board



Murray Wilson  
Member  
Patent Appeal Board

I concur with the findings and the recommendation of the Board and accordingly withdraw the rejection of this application.



Peter J. Davies  
Acting Commissioner of Patents

Dated at Hull, Quebec  
this 16<sup>th</sup> day of August 1995