

COMMISSIONER'S DECISION SUMMARY

C.D. 1205 ....Application No. 2,022,718 (F01, F10, F20)

Application rejected in view of prior public use

The examiner rejected the application on the grounds that the invention had been made available to the public before the application was filed citing an affidavit provided by a third party. The Board ruled that the affidavit did not provide sufficient information for a conclusion that there was public disclosure of the invention by a person who did not obtain the information directly or indirectly from the inventor himself.

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,022,718, 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:

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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 2,022,718 (Int. Class A01D-67/00) which was filed on August 3, 1990 by Applicants/Inventors Larry Downey and Patrick Downey for an invention entitled "TOOL-SUPPORTING ATTACHMENT FOR A VEHICLE". The Examiner in charge issued the Final Action on March 5, 1993 refusing the application under Subsection 27(1)(c) of the Patent Act on the grounds that the invention was available to the public before the application was filed. The Applicant submitted a written response on June 15, 1993 and requested a review by the Commissioner of Patents.

The application relates to a tool-supporting attachment to be mounted on a tractor for use in suspending motorized tools which must be carried on long distances, in particular an attachment for suspending hedge clippers for use in the pruning of Christmas trees whilst the trees are growing in a plantation. This attachment comprised levelling means to permit the upper frame of the attachment to always be in a substantially horizontal position with respect to the ground on which the vehicle is moved such that the tools are always kept at a constant height above the ground.

In his Final Action the Examiner relied on an affidavit provided by Richard J. Downey, the uncle of Larry Downey and the brother of Patrick Downey, in a protest filed on January 6, 1992. In making the rejection the Examiner stated that:

The above reference establishes that the subject of the instant application was made available to the public prior to the filing date of the instant application August 3, 1990.

Accordingly this application stands rejected.

Section 27(1)(c) is the section of the Patent Act under consideration here. This section establishes that an applicant is not entitled to a patent when the invention was, before the date of filing of an application, disclosed by a person in such a manner that it became available to the public in Canada or elsewhere.

It is held that the affidavit establishes that the invention of the instant application was made available to the public before the filing date of the instant application. It is to be noted that item 6) of the affidavit notes that there was no involvement of the named inventors Larry Downey and Patrick Downey in the design and construction of the tool.

In its reply to the Final Rejection dated June 15, 1993 the Applicant has objected to the Examiner's reliance on an affidavit from a third party on the grounds that such an affidavit is not a

citable document. It is reasoned by the Applicant that since the Patent Act does not provide any right for an applicant to cross-examine an affiant on his affidavit acceptance of an affidavit as a valid reference would be in opposition to the principle of fairness. It is further suggested that it is sufficient for an applicant to merely contest the veracity of an affidavit in order to overcome it.

It is also suggested that the relevant subsection of the Patent Act to be applied is Subsection 27(1)(d) rather than Subsection 27(1)(c) on which the Examiner relies. Subsections 27(1)(c) and (d) are as follows:

27.(1) Subject to this section, any inventor or legal representative of an inventor of an invention may, on presentation to the Commissioner of a petition setting out the facts (in this Act termed the filing of the application) and on compliance with all other requirements of this Act, obtain a patent granting to the applicant an exclusive property in the invention unless:.....

....(c) the invention was, before the date of filing of the application or before the priority date of the application, if any, disclosed by a person other than a person referred to in paragraph (d) in such a manner that it became available to the public in Canada or elsewhere; or

(d) the invention was, more than one year before the date of filing of the application, disclosed by the applicant or by a person who obtained knowledge of the invention, directly or indirectly, from the applicant, in such a manner that it became available to the public in Canada or elsewhere.

Applicant's contention that Subsection 27(1)(d) applies is based on his assertion that due to the family relationship between the affiant and the inventors and due to the fact that the parties lived within close proximity it is more than likely that Richard Downey learned of the invention from Messrs Larry and Patrick Downey themselves. Since Richard Downey states in his affidavit that he demonstrated the invention to members of the Quebec Christmas Tree Exporters Association between December 1989 and August 1990, i.e. less than one year before the filing date of the application, the provisions of Subsection 27(1)(d) would allow the inventors named in the application to obtain a patent for the disclosed invention.

The Board has considered the affidavit in the light of the Applicant's submission and is of the opinion that it does not provide sufficient information for the Board to conclude that there was public disclosure of the invention by a person who did not obtain the information directly or indirectly from the

inventor himself. The Board therefore recommends that the rejection of the application be withdrawn and the application be returned to the examiner for further prosecution on its merits.



Peter J. Davies  
Acting Chairman



Michael Howarth  
Member

I concur with the findings and the recommendation of the Board. I accordingly withdraw the rejection of this application and order that the application be returned to the examiner for further prosecution on its merits.



M. Leesti  
Commissioner of Patents

Dated at Hull, Quebec  
this 20th day of October 1995