
IN RE W. O. BEYER'S APPLICATION

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Jan. 13
Jan. 25

Patents—Practice—Filing of Petition for a patent does not in itself constitute a request for an extension under s. 28A of the Patent Act 1935—Appeal from Commissioner of Patents dismissed.

Held: That s. 28A of the Patent Act 1935 contemplates something of a definite nature which would draw to the attention of the Commissioner of Patents the fact that the provisions of that section were being invoked so that he could then consider whether the necessary requirements of subsections (b) and (c) of s. 28A had been complied with as a preliminary to granting extension to November 15, 1947; the mere filing of the petition for a patent does not constitute a request for extension.

APPEAL from the decision of the Commissioner of Patents.

The appeal was heard before the Honourable Mr. Justice Cameron at Ottawa.

Cuthbert Scott and *W. R. Meredith*, instructed by the attorneys for the applicant, for the appellant.

No one for the Commissioner of Patents.

(1) (1926) R.J.Q. 40 B.R. 509, à la page 514.

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The facts and questions of law raised are stated in the reasons for judgment.

CAMERON J. now (January 25, 1949) delivered the following judgment:

This is a motion by the above named applicant for Letters Patent, by way of an appeal from the rejection of the application by the Commissioner of Patents, dated December 2, 1948, on the ground that the Commissioner erred in finally rejecting said application under the provisions of sections 26(2) (a) and (b) of the Patent Act of 1935, and for an order declaring that the said applicant has complied with the provisions of section 28A of the Patent Act, and directing the Commissioner to grant an extension of time for the filing of the said application for patent in accordance with the provisions of section 28A.

The Commissioner, although notified of the Notice of Motion, did not appear on the hearing.

The facts are not in dispute. The application for patent was first applied for in the United States on December 8, 1938, and issued on October 21, 1941. The Canadian application was filed on July 18, 1947, and therefore could not be granted because of the provisions of section 26(2) (b) unless the applicant complied with the provisions of section 28A. That section, in part, is as follows:—

28A. (1) Subject as hereinafter provided, the Commissioner shall extend to the fifteenth day of November 1947, in favour of a patentee or applicant, such of the time limits fixed by this Act for the filing or prosecution of applications for patents, for appeals from the Commissioner or for the payment of fees, as expired after the second day of September, 1939: Provided

- (a) a request for such extension is made by or on behalf of such patentee not later than the fifteenth day of November 1947, or by or on behalf of such applicant for patent before the fifteenth day of May, 1948; and
- (b) such request specifies the date of the first application in any country for a patent for the same invention by such applicant or patentee or any one through whom he claims; and
- (c) such patentee or applicant is a Canadian citizen or a national of a country which gives substantially reciprocal privileges to Canadian citizens.

Section 28A was added to the Act by s. 7, c. 23, of the Statutes of Canada, 1947, and following that amendment the Commissioner of Patents under date June 30, 1947, issued a notice which appeared in The Canadian Patent

Office Record of July 1, 1947, regarding the procedure to be followed on applications for patents for inventions filed by United States nationals pursuant to the above section and which so far as new applications were concerned was as follows:—

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For New Applications.

- (a) A separate written request that the application be filed under the provisions of the section and specifying in the request the extensions desired.
- (b) A statement, preferably in the petition, giving the date on which and the country in which the first application was filed.

As I have pointed out the application here in question was filed subsequent to the publication of that notice.

I do not think that in this case it is necessary to consider whether the terms of that notice by the Commissioner have to be complied with in every detail. It is sufficient, I think, to consider the provisions of section 28A in reaching a conclusion on this motion.

For the appellant it is submitted that the petition for patent which was filed on July 18, 1947, is a sufficient compliance with the requirements of section 28A. It is submitted that paragraph 3 of the petition fulfils all the requirements of section 28A, that clause being as follows:—

3. Your petition requests that this application shall be treated as entitled to priority as follows, having regard to the following applications for patent heretofore made in other countries: United States, filed December 8, 1938—Serial No. 244,602 now patent No. 2,259,453, October 21, 1941.

It is submitted that while this may not be considered a direct request for extension under the provisions of section 28A, that such request may be inferred from the fact that particulars of the prior United States application and grant are supplied, and that inasmuch as the application for patent was out of time because of the provisions of section 26(2) (b) (in that it was not filed in Canada within twelve months after the filing of the application in the United States) that it must have been obvious to the Commissioner that the application was made under section 28A and that he should have treated it accordingly as a request for extension.

Following the filing of the application there was certain correspondence between the attorney for the applicant and the Commissioner's office. On September 8, 1947, the attorneys for the applicant were advised of the filing of

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the application for patent and there appears at the bottom of that letter the words, "Convention date—too late." Certain other matters in regard to the application were drawn to the attention of the applicant's attorneys which were corrected, and on June 23, 1948, notice was given that the application was refused in view of section 26(2) (a) and (b). It was not until June 29, 1948, that the attorneys for the applicant made any reference to the provisions of section 28A, at which time they submitted that the applicant had complied with the provisions of that section in that all the necessary information required by section 28A had been supplied and that it was obvious that a request that the application be treated as an application entitled to priority under section 27 was in effect a request for an extension of time for taking advantage of the Convention rights on the present application.

At that time—June 29, 1948—it was too late to make application for the extension for, at the latest, such application, under the provisions of section 28A(1) (a), must have been made by May 15, 1948.

After giving the matter careful consideration, I have reached the conclusion that the appeal must be dismissed. I am quite unable to find that there has been compliance with the provisions of section 28A(1) (a). I must find that no request for such extension was made by the applicant prior to May 15, 1948.

There was nothing in the petition or any of the correspondence prior to May 15, 1948, which in my opinion could be construed as a request for extension of the time. No specific request was made and there was nothing to draw to the attention of the Commissioner the fact that any extension of time was requested. I do not think it is possible to accede to the suggestion of counsel for the appellant that, as the application was undoubtedly barred by the provisions of section 26(2) (a) and (b) long before the application in Canada was made, the Commissioner should therefore have reached the conclusion, by inference, that the mere filing of the petition in itself constituted a request for extension. I think that section 28A contemplated something of a definite nature which would draw to the attention of the Commissioner the fact that the provisions of that section were being invoked so that he could then consider whether

the necessary requirements of subsections (b) and (c) had been complied with as a preliminary to granting extension to November 15, 1947. In enacting section 28A it was no doubt the intention of Parliament to give certain relief to the applicants for patents, etc., from the strict time limitations provided in the Act, and because of disturbances created in one way or another by the war; but such additional privileges were granted only upon the conditions laid down in the section itself, one of which was that a request for such extension should be made within the time limits therein mentioned. No such request having been made in this case I must confirm the finding of the Commissioner and the appeal from his finding will be dismissed, but under the circumstances without costs.

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Judgment accordingly.