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Nov. 15. THE PERMUTIT COMPANY.....PLAINTIFF;

VS.

G. L. BORROWMAN.....DEFENDANT.

Patents—Conflicting applications—Interference—Motion to amend claims in the application filed before Commissioner and now filed in court after notification of interference—Functus officio—Jurisdiction of the Court—Practice.

Both plaintiff and defendant applied for a patent and the Commissioner found that there was conflict between the two applications and gave notice of such finding to both parties. Thereupon plaintiff took action in this court to have it declared he was the first inventor of the patent in question. After the institution of the action, defendant presented further claims to the Commissioner to be added to his application which were refused owing to the action having been instituted. At trial defendant moved to add said further claims to his application as filed before the Commissioner and now filed in court. Subsequent to the

notice declaring conflict, correspondence was carried on between the defendant and the department from which, it is alleged, it might be implied that the department was still dealing with such application, and the defendant contended that this kept the matter open in the department and that it was not yet ripe to be brought before the court.

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Held, that all acts of the Commissioner of Patents or the department, subsequent to the notice given to the parties, declaring a conflict, were irregular, the Commissioner having then become *functus officio*. That the Court had no jurisdiction to pass upon any claims other than those which are referred by the department and which have already been passed upon by the Commissioner of Patents, and that the motion to amend should be dismissed.

2. That the court, in allowing defendant to make the proposed amendment at the trial, after he had had communication of plaintiff's application, would be giving him an unfair and oppressive advantage over the plaintiff. That such a judgment would be against the very spirit and letter of the Act which requires absolute secrecy until the full completion of the application.

MOTION of defendant to amend the claims in his application by adding further claims.

November 14th and 15th, 1923.

Motion now heard before the Honourable Mr. Justice Audette at the opening of the trial, at Ottawa.

W. N. Tilley, K.C., and *W. L. Scott, K.C.*, for defendant.
Russell S. Smart and *J. Lorne McDougall*, contra.

After hearing the argument on this motion the Court rendered judgment dismissing the said motion.

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

AUDETTE J. (this 15th day of November, 1923) delivered judgment.

Considering that in September, 1921, the Department notified both the plaintiff and the defendant that there was a conflict of applications and that the matter should be decided upon this conflict, as provided by section 20 of the Patent Act. *Attorney-General v. DeKeyser's Royal Hotel Ltd.* (1).

Considering that the proceedings herein were instituted in September, 1923, and that by the statement in defence filed the defendant acquiesced in the situation as framed at that time.

Considering that any correspondence which took place as between the Commissioner and the defendant after the

(1) [1920] 36 T.L.R. 600, at p. 609.

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matter had been referred to arbitration or to the court, under the Exchequer Court Act, was in itself an irregularity on behalf of the department; because after the Commissioner had advised the parties that there was a conflict and that that conflict should be settled under the provision of sec. 20 of the Act, the Commissioner was from that date *functus officio*, and that no letter or act by him or on his behalf, after September, 1921, should be considered upon the merit of the present case.

Considering moreover that the action of defendant in seeking to add additional claims to his application is against the very spirit and letter of the Act, in that when any application is made for a patent the matter remains absolutely secret, and that in this case one party is now afforded the opportunity of answering any of the conflict in the application by looking at his rival's application. In allowing the proposed amendment at this date I would be doing something against the very spirit of the Act which requires secrecy up to the full completion of the application, and would furthermore be giving an unfair and oppressive advantage to the defendant by allowing him to amend his application after having had communication of the plaintiff's application.

Therefore the motion is dismissed with costs.

Judgment accordingly.