

1946
Oct. 7
Nov. 29

BETWEEN :

ROGER GRUNWALD, APPELLANT;

AND

THE COMMISSIONER OF PATENTS, } RESPONDENT.

Patent—Filing date—The Patent Act, 1935, 25-26 Geo. V, c. 32, secs. 29 (1), 41 and 43—Patent Rules 5, 12 (a), 13 and 21—Incomplete application—Application substantially complete—Abandonment of application—Appeal from Commissioner of Patents allowed.

The Commissioner of Patents on June 17, 1937, received an application for letters patent forwarded by appellant's attorney, the applicant having been granted a French patent for the same invention on June 19, 1936. The power of attorney did not accompany the application. It was received by the Commissioner on September 21, 1937. The Commissioner gave the application the filing date of September 21, 1937 and allotted it a serial number. On October 5, 1937, the Commissioner requested that the oath required by s. 29 (1) of the Patent Act be filed. On October 8, 1937, the Commissioner was requested to give the application a filing date of June 17, 1937, and received at the same time an oath sworn by the applicant on July 30, 1937. The Commissioner refused to do so and demanded that another oath be filed. Much correspondence between the Commissioner and applicant's attorney followed and on May 4, 1939, the attorney forwarded a new oath having inserted a filing date of June 17, 1937. On July 17, 1939, the Commissioner finally rejected the application on the ground *inter alia* that it had been abandoned. On September 25, 1939, the applicant filed in this court a notice of appeal from this ruling of the Commissioner. By agreement between counsel the hearing of the appeal was allowed to stand until October 7, 1946.

Held: That the application received by the Commissioner of Patents on June 17, 1937, while incomplete, was substantially complete as to petition, specifications, drawings and fee, and should have been given a serial number and a filing date of June 17, 1937.

- 2 That the oath of the applicant sworn on July 30, 1937, was a proper oath.
- 3 That the Commissioner of Patents did not reject the application in the terms of s. 41 of The Patent Act until July 17, 1939, and the applicant having taken his appeal on September 25, 1939, could not be held to have abandoned his application.

APPEAL from a ruling of the Commissioner of Patents.

The appeal was heard before the Honourable Mr. Justice O'Connor, at Ottawa.

E. G. Gowling K.C. for the appellant.

Cuthbert Scott for the respondent.

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

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O'CONNOR J., now (November 29, 1946) delivered the following judgment:

The Appellant filed an application, entitled "Improvements in Safety Razors", in France on the 19th June, 1936, and the French Patent No. 807,417 was issued on the 19th October, 1936.

An application for Letters Patent of this invention was received by the Commissioner of Patents on the 17th June, 1937 and the application consisted of a petition, specifications, claims, drawings and fee. The application was made by an attorney for the Appellant, but the power of attorney did not accompany the application.

The power of attorney was received by the Commissioner on the 21st September, 1937 and the Commissioner then gave the application the filing date of 21st September, 1937, and allotted the application Serial No. 445,464. On the 5th October, 1937, the Commissioner requested that the oath required by section 29 (1) be filed.

On the 8th October, 1937, the attorney for the applicant wrote asking that the application be afforded a filing date of 17th June, 1937, in a letter in which he gave the filing date awarded by the Commissioner, 21st September, 1937, Serial No. 445,464; the name of the applicant, Roger Grunwald, and the subject matter of the invention, safety razors, and enclosed an oath in the following form:—

I, Roger Grunwald, a French Citizen, whose address is 23 Rue Des Mathurins—VIII^E, Paris, France, whose occupation is MAKE OATH AND SAY:—

1. That I am (the inventor of an invention entitled "Improvements in safety razors" for a patent for which an application was filed on my behalf) on the day of 1937.
2. That I verily believe that the said invention was not known or used by others before it was invented as aforesaid and has neither been in public use or on sale in Canada, nor described in any patent or in any publication printed in Canada or in any other country, more than two years before the filing of the said application.
3. That no application for a patent for the invention as defined in the claims specified in the request for priority in the said petition, has been made by me or any one claiming under me before the date of the earliest application specified in such request.

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4. That the several allegations contained in the said application are respectively true and correct.

SWORN before me at }
 Paris, this 30th }
 day of July, 1937. }

(Sgd.) ROGER GRUNWALD

Signature illegible
 Signature of person administering oath
 Consulate
 General's
 Stamp.

H. M. Vice-Consul

CONSULAR
 STAMPS.

(Official)
 (Character)

On the 1st December, 1937, the Commissioner in reply refused to change the filing date to 17th June, 1937.

On 3rd December the Commissioner wrote:—

I beg to inform you that the oath executed 30th July, 1937 is not acceptable under Rule 13. It should also identify the application by its execution or filing date. A new oath is required.

The attorney continued to write protesting the filing date, and requesting a change, and the Commissioner in his replies refused to change the filing date. This correspondence continued until 14th April, 1938, and was resumed again on 12th January, 1939, and continued until 4th May, 1939, when the attorney again asked that the filing date of 17th June, 1937, be accorded or that the application be finally rejected, and he enclosed a new oath in which paragraphs 2, 3 and 4 are the same as those in the oath quoted above but in which paragraph 1 read:—

1.—That I am the inventor of an invention entitled SAFETY RAZORS, for which an application for patent was received in the Patent Office on 17th June, 1937, and according a filing date of the 21st September 1937 and the Serial Number 445,464.

On 25th May, 1939, the Commissioner wrote stating that as the power of attorney was not filed until 21st September, 1937, it was not possible to give a filing date of the 17th June, 1937, and added that as the applicant had the opportunity to refer to the courts and did not avail himself of this privilege, he must, therefore, abide by the ruling.

On 17th July, 1939, the Commissioner finally rejected the application on the following grounds:—

(a) That it was filed after the issue of the French Patent No. 807,417 viz., 19th October, 1936, and more than one year after the filing of the application for the French Patent, 19th June, 1936, and

(b) that the case was abandoned under Rule 21 as a new oath was called for on the 3rd December, 1937 and was not received until 5th May, 1939.

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On the 25th September, 1939, a notice of motion by way of appeal was filed in this court from the decision of the Commissioner, dated 17th July, 1939, on the grounds:—

(a) That the applicant was entitled to a filing date of the 17th June, 1937.

(b) That the application was not abandoned in view of the fact that a proper oath dated 30th July, 1937 was filed on the 9th October, 1937 so that the letter of the Commissioner of the 3rd December, 1937 requiring a new oath was unauthorized.

By agreement between counsel for both parties the motion was allowed to stand until 7th October, 1946.

The first question that arises is whether the application as presented by the applicant and received by the Commissioner on the 17th June, 1937, was entitled to be given a serial number and filing date, and referred to the examiner for action pursuant to Rule 12 (a), or whether the Commissioner was correct in the construction he placed on this rule, that the application was not so entitled because the power of attorney was not included in the application.

If the Commissioner's construction of Rule 12 (a) is correct, then the applicant cannot obtain a Canadian patent because his application would have been filed after the issue of the French Patent and more than one year after the filing of the application for the French Patent, viz., 19th June, 1936.

Rule 12 (a) is as follows:—

12. (a) Applications transmitted to the office shall be regarded as incomplete unless they contain a petition, specifications in duplicate, triplicate copies of claims, drawings in duplicate and one set on Bristol board if such are required by the specification, power of attorney if given and appointment of representative if required, all accompanied by the prescribed filing fee. Such applications as are substantially complete as to petition, specification and drawings, and fee shall be given serial numbers and filing dates and referred to the examiner for action.

The Appellant contends that the application shall be regarded as incomplete unless the items specified in the first part are enclosed, but that if the application includes the petition, specifications, drawings and fee, then the application is to be regarded as substantially complete and shall be given a number and filing date and referred to the examiner for action.

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The Commissioner contends that all the documents mentioned in the first part of the Rule must be present and if they are present and if the petition, specifications and drawings and fee included in the application are substantially complete, then the application shall be given a number and filing date.

Rule 12 (a) in my opinion first describes a general class of applications to be regarded as incomplete but which are, nevertheless, applications and then out of this general class, it carves a particular class, i.e., those substantially complete. So that if an application is in the particular class of applications which can be regarded as substantially complete although in the general class of applications to be regarded as incomplete, it shall be given a serial number and a filing date and referred to the examiner for action.

Whether the application is or is not incomplete is not left to the discretion of the Commissioner. It is purely a question of fact. If the application does not contain the items specified in the first part of the rule it is regarded as incomplete. But while it is to be regarded as incomplete, if it includes the petition, specifications, drawings and fee it is nevertheless substantially complete and *shall* be given a number and filing date and referred to the examiner for action.

In my opinion the application which was received by the Commissioner on the 17th June, 1937, while incomplete, was nevertheless substantially complete as to petition, specifications, drawings and fee, and should therefore have been given a serial number and a filing date of the 17th June, 1937, and have been referred to the examiner for action.

Was the case abandoned under Rule 21 because the new oath called for on 3rd December, 1937, was not received until the 5th May, 1939, or was the oath dated 30th July, 1937, and filed on 9th October, 1937, a proper oath?

Rule 21 is as follows:

21. Any applicant for patent, or for the reissue of a patent, shall proceed with his application with due diligence. In the event of his failure to prepare and complete the application for examination within twelve months after the date of filing of his application or to prosecute the same within six months from a report of an examiner or other subsequent official action of which notice has been duly given to the applicant, such application shall be held to be abandoned, and any fees paid in connection therewith shall be forfeited.

Section 29 (1) of the Patent Act enacts that:—

The inventor shall, at or before the time of filing his application or within such reasonable extension of time as the Commissioner may allow, make oath . . . that he verily believes that he is the inventor of the invention for which the patent is asked, and that the several allegations in the application contained are respectively true and correct.

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Rule 13 is as follows:—

13. The oath of an inventor shall show that it has been sworn not earlier than thirty days before the date of the filing of the application for patent to which it relates.

And Rule 5 is as follows:—

5. Forms of proceedings will be found in the Appendix to these Rules. In proceedings for which no form is provided any form conformable to the letter and the spirit of the law will be accepted.

Paragraph 1 of Form 3, Oath of Inventor, is as follows:—

1. That I am (one of (a)) the inventor(s) of an invention entitled . . . for a patent for which an application was filed on my behalf (or on behalf of . . .) on the . . . day of . . . 19 . . .

The difficulty of filing the oath with the application arises from Form 3. Section 29 (1) provides that the oath is to be made (a) at or before the time of filing his application or (b) within such reasonable time as the Commissioner may allow. Form 3 requires the official filing date to be filled in and in paragraph 2 of Form 3 the inventor states that the invention has neither been in public use or on sale in Canada nor described in any patent or in any publication printed in Canada or in any other country, more than two years before the filing of the said application. So that the oath cannot be made at or before the time of filing the application if the filing date must be inserted. There is nothing in section 29 (1) that requires the date of filing of the application to be set out in the oath.

In the conflict between the section of the Act and the form, the section of the Act must prevail. The explanation of the difficulty would appear to be that at the time of the last revision of Rule 13, Form 3 was not revised. To avoid this difficulty I am informed by counsel that the practice is to change the form to read, “for which an application was signed by me on the . . . day of . . . 19 . . .”

The reason for filling in the filing date in the oath is for the purpose of identification.

The oath itself referred to an invention entitled “Improvements in Safety Razors” and the letter from the

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attorney enclosing the oath gave the name of the inventor, the filing date and serial number allotted by the Commissioner. The Commissioner identified the oath with the Plaintiff's application because he subsequently required a new oath on the grounds that the first oath did not comply with Rule 13, i.e., that it had been sworn earlier than thirty days before the 21st September, 1937.

The oath was not rejected on the ground that it did not identify the application.

If the Plaintiff had completed an oath by inserting the date which the Commissioner had fixed as the date of filing, 21st September, 1937, then a patent could not have been issued to him and his application must be rejected on the ground that it had been filed more than one year after the filing of the application for the French patent, namely 19th June, 1936. So that he was being asked to make oath on a basis that made it impossible for him to obtain a patent.

In view of the circumstances in this case, I am of the opinion that the oath dated the 30th July, 1937, was a proper oath.

When, after a lengthy correspondence the applicant knew that the Commissioner would not change the filing date nor accept the first oath, should he then have appealed to this court, and in failing to do so, did he abandon the application. The Commissioner stated in his letter of 25th May, 1939, that as the applicant had the opportunity to refer to the courts and not having availed himself of this privilege, he must abide by the ruling. Then on 17th July, 1939, the Commissioner finally rejected the case.

In my opinion the Commissioner did not reject the application in the terms of section 41 of the Patent Act, 1935, until the 17th July, 1939. The Act only provides for an appeal by an applicant from the final rejection of the application by the Commissioner. The applicant having taken his appeal on 25th September, 1939, has complied with section 43 of the Patent Act, 1935.

For the reasons which I have given, I hold that the applicant was entitled to the Canadian filing date, 17th June, 1937, and that the applicant did not abandon the application under the provisions of Rule 21.

Judgment accordingly.