

1939

Jan. 16.  
April 14.

BETWEEN:

SCARBOROUGH GUILD LIMITED... APPELLANT;

AND

THE COMMISSIONER OF PATENTS... RESPONDENT.

*Patent—Failure to file the statutory oath within time prescribed by the Patent Act—Application held to have been abandoned—Patent Act, 25-26 Geo. V, c. 32, s. 29 and s. 31—Appeal from Commissioner of Patents dismissed.*

Application for a Canadian patent was made on November 13, 1935, by one, Robson. The oath required by the Patent Act did not accompany the application. The applicant was notified by the Patent Office on November 20, 1935, that the oath must be filed within the time limit of three months from that date. The petition, specifications and drawings were filed within one year from the date of application. Nothing further was done until May, 1938, when application to amend the specification was made. Four days later the Patent Office advised that the application must be held to have been abandoned because the oath required to complete the application had not been filed within the time limit fixed, and also that the application had not been completed within one year from the date of it being filed.

*Held:* That the oath is part of the application for a patent, and must be filed within the time prescribed by s. 31 of the Patent Act.

2. That the Commissioner of Patents was right in holding that the application had been abandoned.

APPEAL from the ruling of the Commissioner of Patents holding that appellant's application for a patent had been abandoned.

The appeal was heard before the Honourable Mr. Justice Maclean, President of the Court, at Ottawa.

*G. E. Maybee* for appellant.

*H. A. Ayles, K.C.* for respondent.

The facts are stated in the reasons for judgment.

THE PRESIDENT, now (April 14, 1939) delivered the following judgment:

This is an appeal from the decision of the Commissioner of Patents who decided that the appellant's application for a patent of invention had been abandoned.

It appears from the Patent Office file that on November 13, 1935, one, Robson, of Toronto, Ont., personally filed an application for a patent for new and useful improvements in Machines for Weaving, but the statutory oath did not accompany his application. Robson, in response to his application, was advised, on November 20, 1935, by the Patent Office, that a limit of time of three months from that date was set within which it was required that the oath should be filed. On October 26, 1936, Robson named Mr. J. A. H. Dennison as his attorney to prosecute his application. Sometime later the appellant, Scarborough Guild Ltd., acquired the invention of Robson, precisely when is not clear, but that is not of any importance. The power of attorney to Mr. Dennison was subsequently revoked by Scarborough Guild Ltd. and on October 30, 1936, Messrs. Ridout & Maybee of Toronto were appointed its attorneys to prosecute the application. The petition, the specifications and drawings, were completed and filed within one year from the date of application, and there does not seem to be any dispute as to that.

From December, 1936, until May, 1938, there was complete silence so far as the record shows, but, on May 26, 1938, Messrs. Ridout and Maybee made an application to amend the specification. Four days afterward, May 30, 1938, they were advised by the Patent Office that it was found that the application for a patent must be held to have been abandoned because the oath required to complete the application had not been filed within the time fixed, three months from November 30, 1935, and further because that one year had elapsed from the date of appli-

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cation without the same having been completed, and that therefore on both grounds the application must be held to have been abandoned.

Messrs. Ridout & Maybee, then, in June, 1938, explained to the Patent Office that they were unaware that the oath had not been filed and that they had no notification that this requirement had not been complied with, they no doubt thinking that either Robson or his attorney had earlier supplied this requirement; and they requested reconsideration of the case and asked that the Commissioner extend the time for filing the oath. To this the Commissioner replied (1) that the oath to complete the application was not presented within one year from the date of filing, (2) that the applicant had been advised of the lack of the oath, (3) that no petition was presented to reinstate the application within twelve months after the date on which the application was deemed by the terms of the statute to have been abandoned, and (4) that he, the Commissioner, was without power to extend the time fixed by the statute. He held the patent to have become abandoned on November 13, 1936. Such are the facts of the case.

Sec. 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." As I have already pointed out the Commissioner on November 20, 1935, advised the applicant, Robson, that a limit of time of three months from that date was set within which it was required that the oath should be filed. No extension of that time was ever requested by Robson or his attorney, or by the appellant or its attorney. I might be pardoned if I said that I find it difficult to understand why the oath should not be required to accompany the application, and I do not think that any good reason can be advanced against such a requirement. Moreover, I have never been able to see that the oath is of any practical value in patent applications; and I find it difficult to conceive of any sound or practical reasons why it should be required at all. I understand that in

most countries the oath is not required. But the Act requires it and there it is. Mr. Maybee argued that the application, that is, the petition, the specification and drawings, were one thing, and that the oath was another thing, and that the application here was completed within twelve months from the date of application. That view is not, I think, tenable and the oath must, I think, be regarded as part of the application and the Patent Office might refuse, and perhaps do refuse, to consider or examine an application until the oath is filed. That, I think, would be justifiable practice inasmuch as the oath is required by the Act as part of the application.

The important section of the Patent Act in this controversy is section 31, and it reads as follows:

Each application for a patent shall be completed and prepared for examination within twelve months after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within six months after any action thereon of which notice shall have been given to the applicant, such application shall be deemed to have been abandoned, but it may be reinstated on petition presented to the Commissioner within twelve months after the date on which it was deemed to have been abandoned, and on payment of the prescribed fee, if the petitioner satisfies the Commissioner that the failure to prosecute the application within the time specified was not reasonably avoidable. An application so reinstated shall retain its original filing date.

As a matter of public policy it is essential, or at least it is desirable, that a time limit be set within which an application for a patent be completed, and s. 31 requires that it be completed within twelve months after the filing of the application. I think the true construction of s. 31 is that the oath, which is undoubtedly a part of the application, must be filed within that time. A completed application is one in which every document required by the Patent Act is filed, and this would include the oath. And the applicant has another twelve months within which he may petition for the reinstatement of the application, which the applicant here did not do. I think that is what was intended by the legislature—a very fair and practical provision—and, I think, that is what the statute says. That is my construction of the section in so far as we are here concerned with its provisions. While I have no doubt that Messrs. Ridout & Maybee assumed that the oath had been filed by the inventor, or his attorney, and my inclination would be to save their client's application, if possible, still the statute seems to offer an impenetrable

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barrier to any such inclination. The Patent Office cannot be expected to notify applicants of their failure to file the oath within the period fixed, or within the prescribed twelve months from the date of application, the Patent Office having to deal with thousands of applications annually. If the oath were required to accompany the application, as I think should be the case, there would be no difficulty as has arisen here.

My conclusion is therefore that the appeal must fail. I think the Commissioner was right in holding that the application had been abandoned. There will be no order as to costs.

*Appeal dismissed.*