

BETWEEN:

MONTECATINI SOCIETA GENER- ALE PER L'INDUSTRIA MIN- ERARIA ED AGRICOLA	}	APPELLANT;
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1938
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 Nov. 15.  
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 1939
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 Jan. 5.

AND

COMMISSIONER OF PATENTS .....RESPONDENT.

*Patent—Appeal from Commissioner of Patents—Article 4 of the Union Convention of Paris for the Protection of Industrial Property—Patent Act, 25-26 Geo. V, c. 32, s. 27 (1), s. 31—Filing date of patent—Filing of assignment of patent—Appeal allowed.*

Article 4 of the Union Convention of Paris for the Protection of Industrial Property, ratified by the Dominion of Canada, provides: "(a) Any person who has duly deposited an application for a patent . . . . in one of the contracting countries . . . . shall enjoy, for the purposes of deposit in the other countries . . . . a right of priority during the periods hereinafter stated. (b) Consequently, a subsequent

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deposit in any of the other countries of the Union before the expiration of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another deposit . . . . (c) The above-mentioned periods of priority shall be twelve months for Patents . . . . These periods start from the date of deposit of the first application in a country of the Union, the day of deposit is not included in the period."

The Patent Act, 25-26 Geo. V, c. 32, s. 27 (1) provides: "An application for a Patent for an invention filed in Canada by any person entitled to protection under the terms of any treaty or convention relating to patents to which Canada is a party who has . . . . previously regularly filed an application for a patent for the same invention in any other country which by treaty, convention or law affords similar privilege to citizens of Canada, shall have the same force and effect as the same application would have if filed in Canada on the date on which the application for patent for the same invention was first filed in such other country, provided the application in this country is filed within twelve months from the earliest date on which any such application was filed in such other country" . . . .

*Held:* That where an application for a patent was filed in Italy on December 31, 1936, and another application for a patent for the same invention was filed in Canada by the same applicant on December 29, 1937, the applicant for such patent is entitled to a filing date in Canada of December 29, 1937, and to the benefit of the filing date in Italy of December 31, 1936.

2. That the filing with the Commissioner of Patents of an assignment of a patent within the delay prescribed by s. 31 of the Patent Act for completion of an application for a patent, is sufficient and valid.

APPEAL from the decision of the Commissioner of Patents rejecting appellant's application for Letters Patent and refusing appellant's request for the benefit of a certain filing date.

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

*R. S. Smart, K.C.* and *G. H. Riches* for appellant.

*W. P. J. O'Meara, K.C.* for respondent.

The facts are stated in the reasons for judgment.

ANGERS, J., now (January 5, 1939) delivered the following judgment:

Appeal from the decision of the Commissioner of Patents dated February 28, 1938, rejecting the application of Montecatini Societa Generale per l'Industria Mineraria ed Agricola, of Milan, Italy, for letters patent for an invention concerning "a process for the simultaneous manufacture of calcium nitrate and carbon dioxide," and from the de-

cision of said Commissioner dated January 14, 1938, refusing appellant's request for the benefit of a date of filing based on appellant's application for the same invention filed in Italy on December 31, 1936, the said appeal dismissed by judgment of August 24, 1938, and coming up for re-hearing following an order of October 14, 1938, rescinding the judgment of the 24th of August, 1938, and adjudging that the appeal be re-argued.

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In an affidavit filed in support of the appellant's application for leave to re-open the appeal for argument, the affiant alleges (*inter alia*):

(2) That I am advised by the Commissioner of Patents, and do verily believe that since the coming into force of the Patent Act, 1935, Section 26 of that Act has been interpreted by him and by the persons practising before the Canadian Patent Office, as meaning that an applicant for patent may obtain a valid patent in Canada provided that his application is filed either before his first foreign patent issues, or alternatively, before one year from the date of the filing of his first foreign application has expired, with the consequence that a very large proportion, probably well over 50%, of the patents granted under the Patent Act, 1935, have been granted on applications which were filed in the Canadian Patent Office more than one year after the filing of the first foreign application, but prior to the issuance of the first foreign patent, or alternatively, which have been filed within the Convention year but after the first foreign patent has issued.

3. That the question determined by the judgment herein is accordingly one of very great public importance and I am informed, and do verily believe, that the point was not argued on the hearing of the appeal from the decision of the Commissioner, but believe that the only point which was argued was as to whether or not it was necessary that an assignment be filed before a filing date might be given by the Commissioner of Patents to an application for patent filed by an assignee of the inventor.

(4) That under the provisions of the International Convention for the Protection of Industrial Property, to which Canada is an adherent, and of section 27 of the Patent Act, 1935, an application for a Canadian patent which has previously regularly been filed in any other country of the Union has the same force and effect as the same application would have if filed in Canada on the date on which the application for patent for the same invention was first filed in such other country, provided that the application in Canada is filed within twelve months from the earliest date on which any such application was filed in such other country . . . .

The petition made in the name of and signed by Montecatini Societa Generale per l'Industria Mineraria ed Agricola, through its attorneys, contains, among others, the following statements:

(1) That Gerlando Marullo, of Milan, Italy, made the invention entitled "A Process for the Simultaneous Manufacture of Calcium

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Nitrate and Carbon Dioxide" which is described and defined in the attached specification.

(3) Your petitioner requests that this application be treated as entitled to priority as follows, having regard to the following applications for patent heretofore made in other countries:

ITALY, Serial No. 347,231, filed on Dec. 31st, 1936.

The petition makes no mention of the assignment by the patentee, Gerlando Marullo, of his right, title and interest in and to the said invention.

This petition was sent to the Commissioner of Patents in Ottawa by the applicant's solicitors in a letter dated December 28, 1937, reading in part as follows:

We are now enclosing herewith the necessary papers for filing an application for Canadian Letters Patent in the name of "Montecatini" Societa Generale per l'Industria Mineraria ed Agricola, as assignee of the inventor, Gerlando Marullo, for the invention "A Process for the Simultaneous Manufacture of Calcium Nitrate and Carbon Dioxide."

It will be noted that the applicant is claiming the priority date of the corresponding Italian application Serial No. 347,231, filed Dec. 31st, 1936. A certified copy of the supporting document will be filed in due course.

We would advise you that the application has been assigned to applicant company and we have been advised that the assignment has been mailed to us. In view of the fact that the convention date expires December 31st, we are filing the application immediately in order to obtain the Convention date. The assignment will be forwarded as soon as it is received.

Accompanying the application is the prescribed Government Filing Fee of FIFTEEN DOLLARS (\$15.00) . . . .

As may be noted, the letter states that the application has been assigned to the applicant company.

On December 30, 1937, the Commissioner of Patents sent to the applicant's solicitors the following telegram:

Cannot enter Marullo application until assignment received as your power from assignee.

On December 31, 1937, the applicant's solicitors wired to the Commissioner as follows:

Re your telegram re Gerlando Marullo application assignment received today executed December 16 establishing our power of attorney (Stop) Application entitled to receive filing date under rule 12 (Stop) Advise immediately by wire if given today's filing date (Stop) Assignment in mail to you.

On the same day the applicant's solicitors wrote to the Commissioner the following letter:

Further to our telegram of December 31st, copy of which is enclosed herewith, we are enclosing herewith assignment in duplicate together with the prescribed Government Fee for registering the same.

We are also enclosing herewith the Oath of Inventorship which has been duly executed by the inventor and we would ask you to file these documents with the application.

On January 3, 1938, the Commissioner wired to applicant's solicitors as follows:

Assignment Marullo application received today filing date January third.

In a letter dated January 11, 1938, the Commissioner confirmed his telegram.

On January 14, 1938, the Commissioner wrote to applicant's solicitors; his letter reads in part as follows:

I beg to advise that the application was entered and given a filing date and serial number on the 3rd instant. The request for the benefit of a date of filing in Italy on the 31st of December, 1936, may not be granted.

On February 21, 1938, the applicant's solicitors wrote to the Commissioner the following letter:

At a personal interview which we had with the Commissioner relative to the above entitled application, we again requested that this application be given a filing date as of the 30th day of December, 1937, the day upon which this application was received in the Patent Office. The request was again refused.

The Italian Patent referred to in the application and which corresponds to the invention described and claimed in the application was granted on April 2nd, 1937 as No. 347,231. As explained to the Commissioner we are desirous of taking an appeal to the Exchequer Court to have this question decided, we request an early action by the Examiner.

At the interview, we pointed out to the Commissioner that the oath required by the Act had not been filed and that we could not file it in proper form until this question has been determined. The Commissioner stated that the requested action could be given without the oath being filed.

On February 28, 1938, the Commissioner rendered the following decision:

This application, bearing a filing date of January 3, 1938, corresponds to an Italian application filed December 31, 1936, which matured into patent April 2, 1937. This is contrary to Section 26 (2) of the Act. The case is consequently rejected under the provisions of this section.

On March 11, 1938, the Commissioner wrote to applicant's solicitors in part as follows:

In reply to the question contained in the last paragraph of your letter you are advised that your letter of the 28th of December with the accompanying papers reached the Office on the 29th of December, 1937, and your further letter of the 31st of December with the required assignment on the 3rd of January, 1938.

A copy of the Italian letters patent for invention and a translation thereof were sent to the Commissioner and form part of the file of the Patent Office; they show that

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the application for the letters patent in Italy, made in the name of the present appellant, was filed on December 31, 1936, and that the letters patent were issued on April 2, 1937.

The decision of the Commissioner is based on subsection (2) of section 26 which, in my opinion, has no application to the present case; in view of the Union Convention for the Protection of Industrial Property hereinafter referred to, the question at issue is governed by subsection (1) of section 27.

At the re-hearing counsel for appellant relied on subsection (1) of section 27 of the Patent Act and on clauses (a), (b) and (c) and paragraph 4 of clause (d) of Article 4 of the Union Convention of Paris of the 20th of March, 1883, for the Protection of Industrial Property, revised at Brussels on December 14, 1900, at Washington on June 2, 1911, and at The Hague on November 6, 1925, the ratification whereof by Canada was deposited at The Hague on May 1, 1928.

Clauses (a), (b) and (c) of said Article 4 (English translation) read as follows:

(a) Any person who has duly deposited an application for a patent, or for the registration of a utility model, industrial design or model, or trade mark in one of the contracting countries, or his legal representative or assignee, shall enjoy, for the purposes of deposit in the other countries, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

(b) Consequently, a subsequent deposit in any of the other countries of the Union before the expiration of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another deposit, by publication or exploitation of the invention, by the putting on sale of copies of the design or model, or by use of the mark.

(c) The above-mentioned periods of priority shall be twelve months for patents and utility models, and six months for industrial designs and models and trade marks.

These periods start from the date of deposit of the first application in a country of the Union; the day of deposit is not included in the period.

If the last day of the period is a *dies non* in the country where protection is claimed, the period shall be extended until the first following working day.

The fourth paragraph of clause (d) of Article 4 has no materiality herein.

Subsection (1) of section 27 of the Patent Act reads thus:

27. (1) An application for a patent for an invention filed in Canada by any person entitled to protection under the terms of any treaty or

convention relating to patents to which Canada is a party who has, or whose agent or other legal representative has, previously regularly filed an application for a patent for the same invention in any other country which by treaty, convention or law affords similar privilege to citizens of Canada, shall have the same force and effect as the same application would have if filed in Canada on the date on which the application for patent for the same invention was first filed in such other country, provided the application in this country is filed within twelve months from the earliest date on which any such application was filed in such other country or from the thirteenth day of June, 1923.

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The period of priority in the present instance commenced on the 1st of January, 1937, the day of deposit of the application in Italy not being included in the period; it extended to December 31, 1937, inclusive.

Counsel for appellant urged that his client was entitled to a filing date as of the 29th of December, 1937, which is the date on which the application was received by the Commissioner, together with the filing fee of \$15, and that the deposit of the assignment with the application was not necessary.

According to subsection (1) of section 26 of the Patent Act the application for a patent must set forth the facts, which I assume to mean all the essential facts. The right, title and interest in and to the invention is, in my opinion, an essential fact; if the same is derived from an assignment, I think that the assignment must be alleged in the petition. There is no provision to that effect in the Patent Act; there is none either in the rules. Rule 5, however, states that forms of proceedings will be found in the appendix to the rules; it adds that in proceedings for which no form is provided any form conformable to the letter and the spirit of the law will be accepted.

There is in the appendix a form of petition for a patent for invention, namely, form I. It contains the following allegation:

(2) That the right to obtain a patent on such invention has been assigned or transmitted to Your Petitioner as appears from the document submitted herewith.

A marginal note says:

Omit this paragraph if the application is made by the inventor.

I may point out incidentally that, under section 12 of the Act, the Governor in Council on the recommendation of the Minister may make, amend or repeal such rules and

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regulations and prescribe such forms as may be deemed expedient:

(a) For carrying into effect the objects of this Act, or for ensuring the due administration thereof by the Commissioner and other officers and employees of the Patent Office; and

(b) . . . . .

(c) In particular with respect to the following matters:

(i) the form and contents of applications for patents.

The petition, as previously noted, makes no mention of the assignment; the letter accompanying it, however, signed by the attorneys who signed the petition on behalf of the applicant, states that the "application" has been assigned to the applicant and that the assignment has been mailed to them. Notwithstanding the fact that the petition is not entirely in compliance with form I of the Appendix to the Rules and lacks a declaration concerning the assignment, I feel inclined to overlook this omission in view of the statement relating to the assignment contained in the letter and of the fact that the Commissioner raised no objection against the form of the petition. Indeed the Commissioner, on receipt of the petition, wired the applicant's attorneys as follows: "Cannot enter Marullo application until assignment received as your power from assignee." Had the Commissioner objected to enter the application because it did not mention the assignment from Marullo to the applicant, the latter could have amended the petition and added thereto an allegation referring to the assignment. In view of these particular circumstances, I do not think that the omission aforesaid, likely due to the haste in which the petition was drawn, should deprive the applicant of its right to a patent, assuming of course that he has fulfilled the requirements of the law.

If the petition, as a general rule, must mention the assignment, I do not think that the assignment need be filed with the petition.

Rule 12 of the Rules, Regulations and Forms under the Patent Act approved by Order in Council of the 26th of September, 1935, stipulates that:

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.



No mention is made in this rule of the assignment.

Section 31 of the Act enacts that each application for a patent shall be completed and prepared for examination within twelve months after the filing of the application; it adds that 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. I believe that the filing of the assignment with the Commissioner within the delay prescribed in section 31 would be sufficient and valid.

The appellant's application was filed within the period prescribed by clause (c) of Article 4 of the Union Convention for the Protection of Industrial Property and subsection (1) of section 27 of the Patent Act, 1935, i.e., within twelve months from and exclusive of the 31st of December, 1936 (the date of deposit of the application in Italy), namely, on the 29th of December, 1937; the appellant's application is accordingly entitled to a filing date of the 29th of December, 1937; it is also entitled to the benefit of the filing date in Italy on the 31st of December, 1936.

The decisions of the Commissioner of Patents of the 14th of January and the 28th of February, 1938, are contrary to the terms of the Union Convention for the Protection of Industrial Property and subsection (1) of section 27 of the Patent Act and they are accordingly reversed and set aside.

There will be no order as to costs.

*Appeal allowed.*

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