

**Date: 20080527**

**Docket: A-558-07**

**Citation: 2008 FCA 148**

**Present: TRUDEL J.A.**

**BETWEEN:**

**DBC MARINE SAFETY SYSTEMS LTD.**

**Appellant**

**and**

**THE COMMISSIONER OF PATENTS  
and  
THE ATTORNEY GENERAL OF CANADA**

**Respondents**

Dealt with in writing without appearance of parties.

Order delivered at Ottawa, Ontario, on May 27, 2008.

**REASONS FOR ORDER BY: TRUDEL J.A.**

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**BETWEEN:**

**DBC MARINE SAFETY SYSTEMS LTD.**

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**Respondents**

**REASONS FOR ORDER**

**TRUDEL J.A.**

[1] The Intellectual Property Institute of Canada (IPIC) is seeking leave to intervene in this appeal of a decision of Mosley J. of the Federal Court (2007 FC 1142). The appellant, who has already requested that a date be set for the hearing, consents to the motion. The respondent requests that the motion for leave to intervene be dismissed.

[2] Mosley J. dismissed the appellant's application for judicial review of the decision of the Commissioner of Patents who issued a notice declaring a patent application ('846) abandoned for

failure to respond to an examiner's requisition by the prescribed deadline. This notice was sent out after the reinstatement period had expired.

[3] It appears that a patent examiner sent to the appellant's agent a letter containing two requisitions.

[4] The Applications Judge found that the appellant's agent had overlooked one of the requisitions and, while recognizing that the Patent Office erred in failing to follow its normal practice of providing a timely "courtesy" notice, he concluded that the application was abandoned by operation of the law, that the Commissioner had no discretion to that regard, and that the Court was unable to provide a remedy.

[5] In its Notice of Appeal, filed on December 5, 2007, the appellant raises three grounds of appeal, two of them requiring the interpretation of paragraph 73(1)(a) of the *Patent Act* and of Rule 29 of the *Patent Rules*. The last ground of appeal deals with the procedural fairness of the current Patent Office practice.

[6] The relevant provisions read:

*Patent Act*, R.S.C. 1985 c.P-4

73. (1) An application for a patent in Canada shall be deemed to be abandoned if the applicant does not:

73. (1) La demande de brevet est considérée comme abandonnée si le demandeur omet, selon le cas :

- |   |  |
|---|--|
| <p>(a) <u>reply in good faith to any requisition</u> made by an examiner in connection with an examination, within six months after the requisition is made or within any shorter period established by the Commissioner;</p> | <p>(a) <u>de répondre de bonne foi</u>, dans le cadre d'un examen, à toute demande de l'examineur, dans les six mois suivant cette demande ou dans le délai plus court déterminé par le commissaire;</p> |
| <p>(b) comply with a notice given pursuant to subsection 27(6);</p>   | <p>(b) de se conformer à l'avis mentionné au paragraphe 27(6);</p>   |
| <p>(c) pay the fees payable under section 27.1, within the time provided by the regulations;</p>  | <p>(c) de payer, dans le délai réglementaire, les taxes visées à l'article 27.1;</p>   |
| <p>(d) make a request for examination or pay the prescribed fee under subsection 35(1) within the time provided by the regulations;</p>   | <p>(d) de présenter la requête visée au paragraphe 35(1) ou de payer la taxe réglementaire dans le délai réglementaire;</p>  |
| <p>(e) comply with a notice given under subsection 35(2); or</p>  | <p>(e) de se conformer à l'avis mentionné au paragraphe 35(2);</p>   |
| <p>(f) pay the prescribed fees stated to be payable in a notice of allowance of patent within six months after the date of the notice.</p>  | <p>(f) de payer les taxes réglementaires mentionnées dans l'avis d'acceptation de la demande de brevet dans les six mois suivant celui-ci.</p>   |
| <p>(2) An application shall also be deemed to be abandoned in any other circumstances that are prescribed.</p>  | <p>(2) Elle est aussi considérée comme abandonnée dans les circonstances réglementaires.</p>   |
| <p>(3) An application deemed to be abandoned under this section shall be reinstated if the applicant:</p>   | <p>(3) Elle peut être rétablie si le demandeur:</p>  |
| <p>(a) makes a request for reinstatement to the Commissioner within the prescribed period;</p>  | <p>(a) présente au commissaire, dans le délai réglementaire, une requête à cet effet;</p>  |
| <p>(b) takes the action that should have been taken in order to avoid the abandonment; and</p>  | <p>(b) prend les mesures qui s'imposaient pour éviter l'abandon; et</p>  |
| <p>(c) pays the prescribed fee before the expiration of the prescribed period.</p>  | <p>(c) paie les taxes réglementaires avant l'expiration de la période réglementaire</p>  |
| <p>(4) An application that has been abandoned pursuant to paragraph (1)(f)</p>  | <p>(4) La demande abandonnée au titre de l'alinéa (1)f et rétablie par la suite est</p>  |

and reinstated is subject to amendment and further examination.

sujette à modification et à nouvel examen.

(5) An application that is reinstated retains its original filing date.

(5) La demande rétablie conserve sa date de dépôt.

[ Emphasis added]

[Je souligne]

*Patent Rules, S.O.R./96-423*

29. (1) Where an examiner examining an application in accordance with section 35 of the Act or the Act as it read immediately before October 1, 1989 has reasonable grounds to believe that an application for a patent describing the same invention has been filed, in or for any country, on behalf of the applicant or on behalf of any other person claiming under an inventor named in the application being examined, the examiner may requisition from the applicant any of the following information and a copy of any related document:

29. (1) Lorsque l'examineur chargé de l'examen d'une demande conformément à l'article 35 de la Loi ou de la Loi dans sa version antérieure au 1<sup>er</sup> octobre 1989 a des motifs raisonnables de croire qu'une demande de brevet visant la même invention a été déposée dans tout pays ou pour tout pays, au nom du demandeur ou d'une autre personne se réclamant d'un inventeur désigné dans la demande examinée, il peut exiger que le demandeur lui fournisse les renseignements suivants et des copies des documents connexes :

(a) an identification of any prior art cited in respect of the applications;

(a) toute antériorité citée à l'égard de ces demandes;

(b) the application numbers, filing dates and, if granted, the patent numbers;

(b) les numéros des demandes, les dates de dépôt et les numéros des brevets s'ils ont été octroyés;

(c) particulars of conflict, opposition, re-examination or similar proceedings; and

(c) les détails relatifs aux conflits, oppositions, réexamens ou procédures analogues;

(d) where a document is not in either English or French, a translation of the document, or a part of the document, into English or French.

(d) si le document n'est ni en français ni en anglais, une traduction en français ou en anglais de tout ou partie du document.

(2) Where an examiner examining an application in accordance with section 35 of the Act or the Act as it read immediately before October 1, 1989 has reasonable grounds to believe that an invention disclosed in the application was, before the filing date of the application, published or the subject of a patent, the examiner may requisition the applicant to identify the first publication

(2) Lorsque l'examineur chargé de l'examen d'une demande conformément à l'article 35 de la Loi ou de la Loi dans sa version antérieure au 1<sup>er</sup> octobre 1989 a des motifs raisonnables de croire qu'une invention mentionnée dans la demande faisait l'objet, avant la date du dépôt de la demande, d'une publication ou était brevetée, il peut exiger que le demandeur précise la première publication ou le brevet se rapportant à

of or patent for that invention.

(3) Subsections (1) and (2) do not apply to any information or document that is not available or known to the applicant, provided that the applicant states the reasons why the information or document is not available or known.

[Emphasis added]

cette invention.

(3) Les paragraphes (1) et (2) ne s'appliquent pas aux renseignements et documents qui ne sont pas à la disposition du demandeur ou qui ne sont pas connus de lui, dans la mesure où il donne les motifs pour lesquels ils ne le sont pas.

[Je souligne]

[7] In its notice of appeal, the appellant's first ground of appeal is that the Applications Judge erred in deciding that to reply "in good faith to one requisition in an office action containing two is not the equivalent of replying in good faith to both [requisitions]" (at paragraph 31 of the reasons for judgment). It is in that context that the appellant suggests that paragraph 73(1)(a) of the Act is to be interpreted in such a way that it refers not to the formal demands to perform a duty but to the document containing the demands (at paragraph 56 of the appellant's memorandum of fact and law).

[8] The second ground of appeal turns around Mosley J.'s conclusion that the Commissioner of Patents "has no inherent jurisdiction to relieve against inadvertent errors or omissions such as occurred in this instance" (at paragraph 28 of the reasons for judgment).

[9] Finally, the appellant raises a last ground of appeal pertaining to procedural fairness.

[10] On March 25, 2008 the appellant filed its memorandum of fact and law. In it, the appellant limits its arguments to the first two grounds of appeal.

[11] On April 23, 2008, the IPIC filed its motion for leave to intervene. It “proposes to address this Court from the broad prospective of the patent profession in Canada” (at paragraph 5 of the IPIC’s written representations on the motion). The IPIC is a professional association of patent agents, trade-mark agents, and lawyers practicing in all areas of intellectual property law. According to the IPIC, it has a membership of 1,700 individuals.

[12] To succeed, the IPIC must demonstrate how its participation in the proceedings will assist in the determination of a factual or legal issue related to the proceeding (*Canadian Union of Public Employees (Airline Division) v. Canadian Airlines International Ltd.*, [2000] F.C.J. No. 220 (F.C.A.) (QL) at paragraph 9, [*C.U.P.E.*]). In *C.U.P.E.*, at paragraph 8 of his reasons, Noël J.A. enumerated the factors to be considered on deciding whether a motion to intervene must be allowed:

- a. Is the proposed intervener directly affected by the outcome?
- b. Does there exist a justiciable issue and a veritable public interest?
- c. Is there an apparent lack of any other reasonable or efficient means to submit the question of the Court?
- d. Is the position of the proposed intervener adequately defended by one of the parties to the case?
- e. Are the interests of justice better served by the intervention of the proposed third party?
- f. Can the Court hear and decide the cause on its merits without the proposed intervener?

[13] The Court has the inherent authority to allow the intervention (*Canadian Pacific Railway Company v. Boutique Jacob inc.*, 2006 FCA 426 at paragraph 21). It is not necessary that all of the factors be met by a proposed intervener.

[14] However, the IPIC submits that it meets all of the criteria and it proposes to make three submissions said to be “different than those put forward by the parties”. They are:

1. The words “fails to reply to any requisition” found at paragraph 73(1)(a) are ambiguous and can lead to several interpretations meaning that the “applicant has not replied to even one requisition, or that the applicant has not replied to all requisition”.
2. Under paragraph 73(1)(a) of the Act, silence can be a “good faith” response to a requisition.
3. An applicant is entitled to legitimately expect a notice from the Patent Office in time to reinstate under subsection 73(3) of the Act when the Patent Office considers the application to be abandoned for lack of good faith response and thus not allowing for the issuance of the patent (at page 44 of the Motion Record).

[15] The respondent argues that the motion should be disallowed, adding that the interest of the IPIC is jurisprudential and indirect. There is no public interest.

[16] Considering the factors mentioned in *C.U.P.E., supra*, I fail to see how the IPIC's participation in the appeal will assist this Court to determine the relevant issues. The interpretation of the Act is well within the expertise of the Court.

[17] I agree with the respondent that the effect of the Court's decision will be simple and narrow: the '846 patent application filed by the appellant will either be reinstated, or it will not. This result cannot be said to directly affect the IPIC or its members. The IPIC has an interest in the objectives of the patent regime, and the attainment of some of these may be affected by the legislative interpretation applied in the present case. However, this does not amount to a "veritable public interest" as found in *Benoit v. Canada*, 2001 FCA 71.

[18] The present case provides reasonable and efficient means by which the question at issue may be submitted to the Court (*C.U.P.E., Ibid.*).

[19] The grounds of appeal, as stated by the appellant in its notice of appeal and as discussed in its memorandum of fact and law, certainly cover the two first submissions of the IPIC, that is the interpretation of paragraph 73(1)(a) of the Act.

[20] As for the third submission proposed by the IPIC, its interest is in the “adjudication of the applicable law and procedure that will affect pending and future applications for patent in Canada” (at paragraph 5 of its written representations, page 44 of the Motion Record).

[21] On this last point, I note that the appellant has already raised the importance of this appeal for the legal profession practicing in patent law. It writes, at paragraph 20 of its memorandum of fact and law:

20. ...Further, if the logic of the Application Judge is accepted, there is a very real risk that a very large number of patents allowed by the Commissioner to issue prior to 2004 may be subjected to litigation and risk being held invalid.

[22] Therefore, I conclude that the interest of justice would not be better served by the IPIC’s intervention. The Court can hear and decide the case on its merits without its intervention.

[23] For these reasons, the motion for leave to intervene should be dismissed with costs in favour of the respondents.

“Johanne Trudel”

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J.A.

**FEDERAL COURT OF APPEAL**

**NAMES OF COUNSEL AND SOLICITORS OF RECORD**

**DOCKET:** A-558-07

**STYLE OF CAUSE:** DBC Marine Safety Systems Ltd.  
v. The Commissioner of Patents and  
The Attorney General of Canada

**MOTION DEALT WITH IN WRITING WITHOUT APPEARANCE OF PARTIES**

**REASONS FOR ORDER BY:** TRUDEL J.A.

**DATED:** 20080527

**WRITTEN REPRESENTATIONS BY:**

Robert H.C. MacFarlane

FOR THE PROPOSED  
INTERVENER IPIC

John H. Sims, Q.C.

FOR THE RESPONDENT

**SOLICITORS OF RECORD:**

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FOR THE RESPONDENT