

Date: 20081209

Docket: A-280-08

Citation: 2008 FCA 391

**CORAM: LINDEN J.A.
SHARLOW J.A.
TRUDEL J.A.**

BETWEEN:

ANTIBALLISTIC SECURITY AND PROTECTION INC.

Appellant

and

THE COMMISSIONER OF PATENTS

Respondent

Heard at Vancouver, British Columbia, on December 8, 2008.

Judgment delivered at Vancouver, British Columbia, on December 9, 2008.

REASONS FOR JUDGMENT BY:

TRUDEL J.A.

CONCURRED IN BY:

**LINDEN J.A.
SHARLOW J.A.**

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REASONS FOR JUDGMENT

TRUDEL J.A.

[1] This is an appeal from a decision by Mr. Justice Blanchard (the Applications Judge), 2008 FC 587, who dismissed an application for judicial review of a decision rendered by the Commissioner of Patents.

[2] The Commissioner refused to accept the appellant's International Patent Application No. PCT/US2004/020989 for Canadian National Phase entry because the request was time-barred (see subsection 58(3) of the *Patent Rules*, SOR/96-423 (the Rules) and Regulation 90*bis*.3 of the Regulations under the *Patent Cooperation Treaty* (the PCT Regulations).

[3] The facts leading to the Commissioner's decision are as follows.

[4] The appellant filed three U.S. patent applications for three inventions with the filing dates of July 1, 2003 (first invention), April 2, 2004 (second invention), and May 5, 2004 (third invention).

[5] On July 1, 2004, pursuant to the *Patent Cooperation Treaty* (PCT), the appellant filed with the World Intellectual Property Organization Bureau (WIPO) an international patent application claiming priority to the three inventions assigned number PCT.US2004/020989. The appellant designated Canada as a country to which protection for the inventions would apply.

[6] On May 17, 2007, the appellant informed the WIPO that it wished to "disclaim" the priority claim to the first invention while retaining the priority claims to the second and third inventions (AB, Tab 4 at pp. 50-56). On May 23, 2007, WIPO declined to record the "withdrawal" of the priority claim to the first invention because the time had expired for a withdrawal under the PCT Regulations).

[7] On May 18, 2007, the appellant applied to the Canadian Intellectual Property Office (CIPO) claiming priority only to the second and third inventions (*ibid.* at pp. 37-47). The record also indicates that the appellant applied for, and in 2006 was granted, regional entry in Europe and national entry in Israel: AB, Tab 5A at pp. 63-96.

[8] On June 18, 2007, the Commissioner, as stated above, informed the appellant of the refusal to accept its application for national phase entry.

[9] In Canada, national phase entry is governed by sections 56-58 of the Rules. Applied to the appellant's circumstances, the Rules provide that the appellant had to file its application "not later than on the expiry of . . . the 42-month period after the priority date" (Rule 58).

[10] Pursuant to section 2(xi)(b) of the PTC, which is incorporated by reference into section 50 of the Rules, where the international application contains several priority claims, the priority date is deemed to be "the filing date of the earliest application whose priority is so claimed."

[11] The Commissioner and the Applications Judge applied this definition within the context of the international application. The Applications Judge wrote:

The relevant priority date to the Applicant's entry into the National Phase in Canada is July 1, 2003, the priority date for the First Invention claimed in the impugned International Patent Application. (reasons for Judgment at para. 23)

[12] The appellant argued that this interpretation is incorrect. The appellant's position before the Applications Judge, and in this appeal, is that the phrase "the filing date of the earliest application whose priority is so claimed" in section 2(xi)(b) of the PTC, as incorporated into section 50 of the Rules, should be interpreted to refer to the filing date of the earliest application whose priority is claimed in Canada.

[13] I am unable to accept the interpretation proposed by the appellant. I agree with the Applications Judge that the appellant, having chosen to file an international patent application for three related patents, must take the applicable time limitations as it finds them. The Rules do not contemplate the possibility that a person filing a three-invention application internationally may choose to proceed in Canada with only two of them, without complying with the time limits for the withdrawal of a claim under the PCT Regulations.

[14] The appellant had also relied on a common law right to disclaim “so long as there was no contradiction with anything in the [Patent] Act which may affect patent rights” (*ibid.*, at paragraph 21).

[15] The Applications Judge rejected the appellant’s arguments. First, the Applications Judge concluded “that there is no provision for a ‘disclaimer’ of a priority claim made in the international application in the PCT or in its Regulations” (*ibid.*, at para. 25). He was not persuaded that “because ‘disclaiming’ is not prohibited in the legislation, it should therefore be allowed” (*ibid.*, at para. 27).

[16] Ultimately, he found that “the legislation . . . provided for a comprehensive regulatory scheme for matters relating to the filing in Canada of international applications” (para. 29). In his view, the legislative scheme prevailed over the common law argument advanced by the appellant. I agree with the Applications judge on this point, substantially for the reasons he gave.

[17] In my view, the Applications Judge made no error in law in deciding as he did. I would dismiss this appeal.

[18] No award for costs should be granted as the respondent is not seeking costs.

"Johanne Trudel"

J.A.

"I concur
A.M. Linden J.A."

"I concur
K. Sharlow J.A."

FEDERAL COURT OF APPEAL

NAMES OF COUNSEL AND SOLICITORS OF RECORD

DOCKET: A-280-08

**APPEAL FROM A JUDGMENT OF THE FEDERAL COURT DATED MAY 8, 2008,
T-1329-07 (2008 FC 587)**

STYLE OF CAUSE: Antiballistic Security and
Protection Inc. v. The
Commissioner of Patents

PLACE OF HEARING: Vancouver, British Columbia

DATE OF HEARING: December 8, 2008

REASONS FOR JUDGMENT BY: TRUDEL J.A.

CONCURRED IN BY: LINDEN J.A.
SHARLOW J.A.

DATED: December 9, 2008

APPEARANCES:

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