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The Federal Court of Canada Upholds “Multiple Abandonments” for Failure to Respond to Each Requisition in an Office Action.

SUMMARY

The Federal Court of Canada (FCC) has recently upheld the policy instituted by the Canadian Intellectual Property Office (CIPO) in 2003 with respect to multiple abandonments. Specifically, to comply with the statutory requirement to “reply in good faith to any requisition”¹, CIPO requires the applicant to respond to every requisition contained within an office action.

THE ISSUES

Rule 29 of the Patent Rules² grants the examiner power to requisition from the applicant various information or documents related to the patent application. Section 73(1)(a) of the Patent Act deems an application abandoned if the applicant does not “reply in good faith to any requisition 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.” Under CIPO policy, to mitigate the risk of inadvertent abandonment, the Patent Office issues a notice of abandonment where an application is considered abandoned. However, CIPO maintains that the applicant is ultimately responsible to prevent its application from being inadvertently abandoned. That is, CIPO does not guarantee that, where applicable, a notice of abandonment will be issued to or received by the applicant.

Before 2003, where an office action contained more than one requisition, CIPO interpreted s.73(1)(a) to mean that to avoid abandonment, the applicant needed to make a good faith effort to respond to an office action as a whole, without specific regard to the number of requisitions within the office action. In 2003, CIPO altered its interpretation by requiring the applicant to respond to each requisition within an office to meet the statutory requirement to respond in good faith.

In the FCC decision *DBC Marine Safety Systems Ltd. v. The Commissioner of Patents and The Attorney General of Canada*³, the FCC addressed the validity of CIPO’s interpretation of s.73(1)(a) and fairness of CIPO’s disclaimer that absolves CIPO of any liability in the event it fails to issue the notice of abandonment. The facts of the case were that the examiner issued an office action that included two requisitions. The applicant’s patent agent responded to one requisition but inadvertently neglected to respond to the second requisition. Unfortunately, the Patent Office failed to issue a notice of abandonment to notify the applicant of the error. By the time the error was discovered, the statutory one-year reinstatement period had lapsed.

The applicant appealed to the Commissioner to reinstate the application. However, the Commissioner rejected the appeal explaining that he had no jurisdiction to interfere with direct operation of the statute. The applicant appealed to the FCC.

1. *Patent Act*, R.S.C. 1985, c. P-4, s. 73(1)(a).

2. , SOR/96-423.

3. 2007 FC 1142 <<http://decisions.fct-cf.gc.ca/en/2007/2007fc1142/2007fc1142.html>>.

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THE DECISION

The applicant submitted various arguments to the FCC to reinstate the application but the FCC found the arguments unconvincing. In particular, the FCC concluded that: (1) the Commissioner was correct in not interfering with the application's deemed abandonment since neither the Commissioner nor the court have the discretion to interfere with direct operation of the statute; (2) "Replying in good faith to one requisition in an office action containing two is not the equivalent of replying in good faith to both"⁴; (3) There is no discrepancy between the French and English versions of s. 73(1)(a). Reading the French version of the provision in its entirety, "The requirement of section 73(1)(a) is to respond to each requisition of the Commissioner; that is, each individual request for information"⁵; (4) The applicant, not the Commissioner, bears the ultimate responsibility to keep an application in good standing.

PRACTICAL IMPLICATIONS

The decision clarifies an important aspect of the patent application process. The applicant may not rely on the Commissioner to rectify inadvertent errors where the Commissioner has no jurisdiction to do so. To avoid abandonment of a patent application for failure to respond to an office action, the applicant must respond to every requisition made in the office action. Although not specifically addressed, the decision also appears to support the CIPO policy of requiring payment of multiple reinstatement fees to reinstate an application that has suffered "multiple abandonments".

Finally, the decision casts doubt on the validity of thousands of patents issued from applications that were abandoned between 1996 and 2003 (when CIPO instituted its policy) for failure to respond to office actions containing multiple requisitions and then reinstated each with only a single reinstatement fee.

If you wish to discuss these matters, please contact: Stephen Perry at 416.920.8170 x107 (perry@perry-currier.com) or Andrew Currier at 416.920.8170 x109 (currier@perry-currier.com).

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4. *DBC Marine Safety Systems Ltd. v. The Commissioner of Patents and The Attorney General of Canada*, 2007 FC 1142 <<http://decisions.fct-cf.gc.ca/en/2007/2007fc1142/2007fc1142.html>>, at para. 31.

5. *DBC Marine Safety Systems Ltd. v. The Commissioner of Patents and The Attorney General of Canada*, 2007 FC 1142 <<http://decisions.fct-cf.gc.ca/en/2007/2007fc1142/2007fc1142.html>>, at para. 36.