Ottawa
Aug. 24

BETWEEN:

TENNECO CHEMICALS INC. .....PLAINTIFF;

AND

HOOKER CHEMICAL CORPORATION ...DEFENDANT.

Patent—Patent Act, R.S.C. 1952, c. 203, s. 45(2)(5)(7)(8)(d)—Prior inventor—Question of law to be heard and determined before trial—Scope of subsection (7) of section 45.

The Commissioner of Patents disposed of the matter under subsection (7) of section 45 of the *Patent Act* insofar as claim C23 is concerned, by deciding that the claim was refused to both parties "because another party had invented species before the date at which the broad claim C23 was conceived by either of these parties".

On July 14, 1966, the Court made an order to determine before the trial the question whether this action is properly constituted in relation to claim C23.

The Commissioner had to decide under subsection (7) which of the applicants was the "prior inventor". It was essential to the determination of that question for him to make a finding as to what acts by each of the alleged inventors constituted the creation of the invention so that he could decide which of them did such acts first. If he had information which satisfied him that what was done by each of the applicants did not constitute the making of an invention, he was then bound to answer the question under subsection (7) by a determination that neither of them was the prior inventor.

Held, That the determination by the Commissioner regarding claim C23, was a determination under subsection (7) of section 45, even though it may have been incorrect, just as much as an incorrect determination that one of the applicants was the first inventor would have been.

2. That this action is properly constituted in relation to claim C23 insofar as the relief sought by paragraphs (*a*) and (*b*) of the Prayer for Relief are concerned.

G. A. Macklin and *K. H. E. Plumley* for plaintiff.

J. D. Kokonis and *R. H. Barrigar* for defendant.

N. D. Mullins for Commissioner of Patents.

Reasons delivered orally at conclusion of Argument on Question of Law set down to be heard and determined before trial.

JACKETT P.:—In these conflict proceedings, the Commissioner of patents disposed of the matter under subsec-

tion (7) of section 45 of the *Patent Act*[1] insofar as claim C23 is concerned, by deciding that the claim was "refused" to both parties "because another party has invented species before the date at which the broad claim C23 was conceived by either of these parties". The "inventors" referred to in the defendant's application were held to be the prior inventors of claim C24.

The plaintiff thereupon brought these proceedings under subsection (8) of section 45 and claimed *inter alia*, in respect of claim C23 the relief contemplated by paragraph (*d*) of subsection (8) of section 45, and, as well an order remitting the applications to the Commissioner of Patents for a determination of priority pursuant to subsection (2) of section 45 in relation to claim C23.

On July 14, 1966, I made an order setting down for hearing and determination before trial the question whether this action is properly constituted in relation to claim C23.

The arguments of counsel for the parties and of counsel for the Attorney General of Canada revolve around the requirements of subsection (7) of section 45, which reads in part as follows:

> (7) The Commissioner, after examining the facts stated in the affidavits, shall determine which of the applicants is the prior inventor to whom he will allow the claims in conflict and shall forward to each applicant a copy of his decision;
>
> . . .

The contention is that a decision by the Commissioner, in effect, that none of the applicants is the prior inventor to whom he will allow the claims in conflict (at least if it is based on evidence not found in the affidavits filed under subsection (5)) does not fall within subsection (7) and is therefore a nullity, that the statutory condition precedent for proceedings under subsection (8) in relation to claim C23 is therefore lacking, that the Commissioner has not therefore complied with the requirement of subsection (7) and that the matter should be remitted to him so that he may do his duty in relation thereto.

[1] R.S.C. 1952, c. 203.

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Whether or not this Court has jurisdiction to make such an order I need not decide having regard to my views about the scope of subsection (7) of section 45.

In my view, what the Commissioner had to decide under subsection (7) is which of the applicants was the "prior inventor" and it was essential to the determination of that question for him to make a finding as to what acts by each of the alleged inventors constituted the creation of the invention so that he could decide which of them did such acts first. If, by the time he came to make that decision, he had information—no matter where it came from—which satisfied him that what was done by each of the applicants did not constitute the making of an invention, it seems clear to me that he was bound to answer the question under subsection (7) by a determination that neither of them was the prior inventor. To require the Commissioner to decide that one of the applicants was the prior inventor when he is satisfied that neither of them was would be to require him to embark on a farce that I cannot conclude was intended by Parliament in the absence of specific language.

I am of the view that the determination by the Commissioner regarding claim C23 was a determination under subsection (7) of section 45, even though it may have been incorrect, just as much as an incorrect determination that one of the applicants was the first inventor would have been. The proceedings in this Court under subsection (8) are based on the assumption that a decision by the Commissioner under subsection (7) may have been wrong.

My decision is that this action is properly constituted in relation to claim C23 insofar as the relief sought by paragraphs (*a*) and (*b*) of the Prayer for Relief are concerned.