

[Abstract prepared by the PCT Legal Division (PCT-2010-0002)]

Case Name:

[First Green Park Pty. Ltd. v. Canada \(Attorney General\)](#)

Jurisdiction:

Canada
Federal Court of Appeal

Abstract:

The applicant failed to enter the national phase in Canada within the 30 month time limit. The time limit for national phase entry may be extended by 42 months upon request for reinstatement and payment of the prescribed fee. Reinstatement and payment must be made within the 12 month period following the expiry of the 30 month time limit. The applicant failed to make such a request within the prescribed time limit and requested that the Commissioner of Patents exercise discretion to extend the time period for requesting reinstatement. This request was refused by the Commissioner of Patents since there was no legal basis for a discretionary extension of the time limit. This decision was upheld by the Federal Court of Canada.

PCT Legal References:

- Article 8
- Article 48(2)(b)
- Rule 82*bis*.1

Source: http://decisions.fca-caf.gc.ca/en/2000/a-674-98_6316/a-674-98.html

Date: 20000322

Docket: A-674-98

CORAM: STRAYER J.A.

SEXTON J.A.

EVANS J.A.

BETWEEN:

FIRST GREEN PARK PTY. LTD.

Appellant

- and -

THE ATTORNEY GENERAL OF CANADA

Respondent

Heard at Toronto, Ontario on Wednesday, March 22, 2000

Judgment delivered at Toronto, Ontario on Wednesday, March 22, 2000

REASONS FOR JUDGMENT BY: STRAYER J.A.

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FIRST GREEN PARK PTY. LTD.

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REASONS FOR JUDGMENT

(Delivered from the Bench at Toronto, Ontario on

Wednesday, March 22, 2000)

STRAYER J.A.

_. This is an appeal from a decision of Muldoon J. of October 14, 1998. He concluded that the Commissioner of Patents had no discretion to extend the time for the appellant to apply for a reinstatement of an international patent application deemed to have been abandoned on February 9, 1993.

_. The matter arises under the *Patent Cooperation Treaty* ("the *Treaty*")¹ and the *Patent Cooperation Treaty Regulations* made by the Governor in Council to implement that *Treaty* in Canada ("the *Canadian Regulations*")². The details of the *Treaty* scheme have been well described in the Application Judge's reasons and in the reasons of Richard J. of March 5, 1997³ in a decision rendered at an earlier stage in this matter. Suffice it to say that the scheme permits an inventor to file an international patent application in one of the countries which are parties to the *Treaty* and to designate other member states where he may wish to seek patent protection. The priority date assigned is that applicable in the country of initial filing. In this case the application was filed in Australia, the priority date was August 9, 1990, and Canada was one of the countries designated. By virtue of the *Treaty* and the *Canadian Regulations* the

applicant in this case was entitled to seek registration in Canada within 30 months of the priority date, namely by February 9, 1993, but it failed to do so and the application was thus deemed abandoned as of that date. The *Canadian Regulations*, subsection 15(3), also allowed a further 12 months for the appellant to request a reinstatement of the application, but it did not do so within that period.

_. Its formal request for reinstatement was not submitted until October 12, 1994, some 18 months after the deemed abandonment. The Commissioner of Patents refused the request because it was submitted more than 12 months after abandonment.

_. The applicant sought judicial review of this refusal before Richard J. It appears, and counsel confirm, that the Commissioner's authority to grant such an extension beyond 12 months was not disputed before Richard J., and neither party at that time regarded subsection 15(3) as an impediment to an extension of time beyond that allowed in the *Regulations*. Richard J. assumed, as did the parties (consistently with a long-standing practice of the Commissioner in exercising such a discretion) that such authority existed, notwithstanding the *Canadian Regulations*, by virtue of sub-article 48(2) of the *Treaty* which provides as follows:

48. 2(a) Any Contracting State shall, as far as that State is concerned, excuse, for reasons admitted under its national law, any delay in meeting any time limit.

(b) Any Contracting State may, as far as that State is concerned, excuse, for reasons other than those referred to in subparagraph (a), any delay in meeting any time limit.

He held that the Commissioner had a discretion under paragraph 48(2)(b) to allow a reinstatement after the passage of 12 months, the normal rule for domestic patent applications, and that she had unduly fettered her discretion by refusing to consider a request submitted after that period had elapsed. He ordered a reconsideration.

_. The Commissioner accordingly reconsidered the request on its merits, but in the exercise of her discretion she again refused the extension of time. Judicial review of that decision was then sought before Muldoon J.

_. At that hearing the learned judge raised with the parties the effect of subsection 15(3) of the *Canadian Regulations* and how it relates to the application of paragraph 48(2)(b) of the *Treaty*. Subsection 15(3) provides as follows:

15. (3) The Commissioner may, at the request of the applicant, reinstate an international application that was deemed to be abandoned pursuant to subsection (2) if, *within twelve months* after the date on which it was so deemed, the applicant

(a) complies with the requirement of section 13 and, where applicable, section 14;

(b) pays the reinstatement fee set out in the schedule; and

(c) satisfies the Commissioner by affidavit that the failure to comply with the requirements of section 13 and, where applicable, section 14 was not reasonably avoidable.

(Emphasis added)

After considering oral and written submissions on the subject he held that paragraph 48(2)(b) did not of itself confer any authority on the Commissioner to extend time limits beyond those prescribed by subsection 15(3) of the *Canadian Regulations*. In other words, while in international law Canada, as the "Contracting State" referred to in the *Treaty*, might be at

liberty to extend time limits as contemplated by paragraph 48(2)(b) thereof, the relevant Canadian law-making authority for doing this would be the Governor in Council passing regulations under the *Patent Act*, such as subsection 15(3). The Governor in Council had thereby in fact limited the extension period to 12 months from the date of deemed abandonment, the same period as for national applications. He therefore held that the Commissioner had no discretion to entertain a request for reinstatement beyond the period of 12 months and her decision refusing to do so could not be assailed in law.

_. It should be noted that neither party raised an argument before Muldoon J. that the matter of the Commissioner's jurisdiction to exercise such a discretion was already *res judicata* on the basis that Richard J. had proceeded on the assumption that such power existed. Neither party now raises *res judicata* as an issue. In fact the issue of legislative limits on the authority of the Commissioner was never put before Richard J. for determination. It is therefore necessary for us to deal with it now, as Muldoon J. based his judgment on this ground.

_. We are of the view that the Commissioner had no authority to extend the period for reinstatement of an abandoned patent application beyond the 12 months prescribed by subsection 15(3) of the *Canadian Regulations*.

_. Counsel for the appellant argued that paragraph 48(2)(b) of the *Treaty* as quoted above provides the necessary authority of the Commissioner in this respect. He refers to another provision of the *Canadian Regulations*, section 6, which provides in part as follows:

6. The provisions of the Treaty and the Regulations under the Treaty shall apply in respect of
- (a) an international application that is filed with the receiving office in Canada;
- (b) an international application in which Canada is designated; and
- (c) an international application in which Canada is designated and elected.

He says that paragraph 6(c) which makes the *Treaty* apply in respect of an "international application in which Canada is designated and elected", such as the application in question here, makes paragraph 48(2)(b) applicable and it provides the necessary authority to the Commissioner to extend the time for reinstatement of an abandoned international application beyond the time (12 months) allowed for national applications. We are of the view that this argument is based on a misconception of what paragraph 48(2)(b) says. It is not a self-executing provision of international law which, if adopted as national law, has an automatic legal effect. Instead, it is an enabling provision which says in effect that if Canada extends the time further for reinstatement of international treaty applications, it will not be in violation of the *Treaty*. But it clearly contemplates that Canada, and by implication the relevant law making authority in Canada, will have to take some steps effective by Canadian law to extend the time or authorize someone to exercise a discretion to extend the time. We cannot read the *Canadian Regulations* as enacting such a change. The rather general language of section 6 providing that the *Treaty* "shall apply in respect of" such applications is incomplete as a grant of power to a domestic authority because the *Treaty* itself is only executory in this respect. Further, another provision of the same *Regulations*, subsection 15(3), specifically limits the time allowable to 12 months in respect of such applications. The general language of section 6 must be read consistently with the specific language of subsection 15(3).

_. As we are therefore of the view that the learned Applications Judge was correct in his finding that the Commissioner had no authority to grant an extension, it is unnecessary for us to consider whether the discretion (if it had existed) was properly exercised in this case.

_. The appeal will therefore be dismissed.

"B. L. Strayer"

J.A.

FEDERAL COURT OF CANADA

Names of Counsel and Solicitors of Record

DOCKET: A-674-98

STYLE OF CAUSE: FIRST GREEN PARK PTY. LTD.

THE ATTORNEY GENERAL OF CANADA

DATE OF HEARING: WEDNESDAY, MARCH 22, 2000

PLACE OF HEARING: TORONTO, ONTARIO

REASONS FOR JUDGMENT BY: STRAYER J.A.

Delivered at Toronto, Ontario on

Wednesday, March 22, 2000

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¹ Canada Treaty Series 1990, No. 22, p.1.

² SOR/89-453, made pursuant to paragraphs 12(1)(h) and (i) of the *Patent Act* R.S.C. 1985, c. P-4.

³ 72 C.P.R. (3d) 327.