Toronto 1965 Nov. 17 Nov. 17

BETWEEN:

MONTECATINI SOCIETE GENERALE PER L'INDUSTRIA MINERARIA E CHIMICA .....PLAINTIFF;

AND

CHARLES W. McGARY JR. .....DEFENDANT.

Patents—Conflict proceedings—Patent Act, R.S.C. 1952, c. 203, s. 45(7) and (8)—Appeal from decision of Commissioner of Patents—Two claims declared not patentable—Whether action by way of appeal lies—Pleadings—Application for particulars.

On a conflict proceeding with respect to three identical claims in the patent applications of plaintiff and defendant the Commissioner of Patents awarded one claim to defendant as prior inventor and refused the other claims to both parties as not being patentable. Plaintiff thereupon brought action in this court under s. 45(8) of the *Patent Act*, R.S.C. 1952, c. 203 for a determination that it was entitled to a patent for all three claims. The defence was a general denial of plaintiff's allegations. Plaintiff applied to the court for an order for further and better particulars of the defence.

Held: (1) Particulars were not required of defendant's denial of plaintiff's allegation that plaintiff's assignors were the prior inventors.

(2) The Commissioner's decision that certain claims were not patentable was not a decision under s. 45(7) determining which of the applicants was the prior inventor, and in the absence of a decision under s. 45(7) no action lay under s. 45(8). (In any event if an action did lie, in the circumstances this was not a proper case to order particulars).

Plaintiff, an Italian corporation, claimed to be sole owner by assignment from the inventors of an invention described in an application for a patent, three claims in which were made the subject of conflict proceedings with the defendant under s. 45 of the *Patent Act*, R.S.C. 1952, c. 203.

The Commissioner of Patents, by his decision dated April 30th, 1965, refused claim 1 to both parties, awarded claim 2 to defendant as prior inventor and refused claim 3 to both plaintiff and defendant as being dependent on claim 1 but declared he would allow it to defendant if it were made dependent on claim 2.

Plaintiff brought action in this court for a determination that it was entitled to the claims in conflict. Defendant by his defence put plaintiff to the proof of certain allegations in the statement of claim and generally denied certain other material allegations therein. Plaintiff applied for an order that defendant furnish full particulars of all facts in support of his general denial of plaintiff's allegations of fact and of those allegations of which he did not admit the truth.

APPLICATION.

R. B. Tuer for plaintiff.

W. M. Thom for defendant.

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MONTECATINI SOCIETE GENERALE PER L'INDUSTRIA MINERARIA E CHIMICA v. CHARLES W. McGARY JR.

JACKETT P.:—An application was made at Toronto on November 17 for an order directing the defendant to give particulars of his defence in this action arising under conflict proceedings under section 45 of the *Patent Act*. This is a note of the reasons why I refused the application.

In so far as Claim 2 is concerned, this is an action under section 45(8) by the plaintiff for an adjudication under section 45(8)(*d*) that the plaintiff and not the defendant is the prior inventor. I cannot see that any plea by the defendant is called for other than a denial of the plaintiff's allegation that its assignors were the prior inventors. No specific particulars were sought.

In so far as Claims 1 and 3 are concerned, I came to the conclusion that the Commissioner did not make any decision under section 45(7). Having apparently originally decided under subsection (4) that the subject matter of Claims 1 and 3 was patentable, after examining the facts stated in the affidavits, he decided that it was not patentable and he, therefore, made no decision under subsection (7) as to which of the applicants is the "prior inventor". There being no decision under subsection (7) with reference to Claims 1 and 3, subsection (8) does not authorize a conflict action in respect of those proceedings.

In any event, even if subsection (8) does authorize an action by the plaintiff for an adjudication that the subject matter of Claims 1 and 3 are patentable, I do not think that it is a proper case in which to order particulars. Normally, the recourse of an unsuccessful applicant for a patent, where refusal is on the ground that the subject matter is not patentable, is by way of appeal and it is for the appellant to plead the facts necessary to show that the subject matter is patentable. The Commissioner would be the only respondent in such proceedings. Here, if the proceedings are properly constituted in respect of Claims 1 and 3, the defendant has not counterclaimed for a declaration that Claims 1 and 3 are patentable by it. I see no reason why it should be required to take a more detailed position on the pleadings in respect of the plaintiff's claim that Claims 1 and 3 are patentable by it even if such particulars would be ordered as against the Commissioner if he were a party opposing this part of the plaintiff's action (a matter in respect of which I express no opinion).