

Federal Court



Cour fédérale

Date: 20210409

Docket: T-1560-20

Citation: 2021 FC 307

Ottawa, Ontario, April 9, 2021

PRESENT: The Honourable Mr. Justice Manson

BETWEEN:

CAE INC.

Applicant

and

COMMISSIONER OF PATENTS

Respondent

JUDGMENT AND REASONS

I. Background

[1] The Applicant, CAE Inc. (“CAE”) seeks to add Marc-André Proulx (“Mr. Proulx”) and Dac Toan Ho (“Mr. Ho”) as co-inventors to Canadian Patent No. 3,000,463 (the “463 Patent”), due to an inadvertent error or mistake pursuant to section 52 of the *Patent Act*, RSC, 1985, c P-4 [*Patent Act*].

[2] CAE is the sole owner of the 463 Patent.

[3] The 463 Patent issued on January 8, 2019 from Canadian Application No. 3,000,463 filed April 6, 2018 (the “Canadian Application”) and claiming priority from United States Application No. 15/942,404 filed March 30, 2018 (the “U.S. Application”).

[4] The U.S. Application lists four co-inventors: Jean-François Delisle, Anthoine Dufour, Marc-André Proulx and Dac Toan Ho.

[5] Through an error made by inadvertence or mistake, without any intent to mislead and not for the purpose of delay, Marc-André Proulx and Dac Toan Ho were incorrectly omitted as inventors to the Canadian Application.

[6] The Canadian Application subsequently issued as the 463 Patent, and the 463 Patent also incorrectly omits Marc-André Proulx and Dac Toan Ho, listing only two of the four inventors: Jean-François Delisle and Anthoine Dufour.

[7] Mr. Proulx and Mr. Ho are both inventors of the Invention, along with Jean-François Delisle and Anthoine Dufour.

[8] All four inventors, including Mr. Proulx and Mr. Ho, were correctly listed on the U.S. Application.

[9] The error in failing to name Mr. Proulx and Mr. Ho as co-inventors in the Canadian Application, and the resulting 463 Patent, came to CAE's attention after the 463 Patent issued, and following an internal audit by Canadian counsel for CAE.

[10] Mr. Proulx confirms that he is a co-inventor of the 463 Patent and consents to his addition as a named co-inventor in respect of the 463 Patent.

[11] Mr. Ho confirms that he is a co-inventor of the 463 Patent and consents to his addition as a named co-inventor in respect of the 463 Patent.

[12] Mr. Proulx and Mr. Ho also both acknowledge the role of each other in the Invention and consent to the addition of them both as co-inventors to the 463 Patent.

[13] Mr. Proulx and Mr. Ho both each confirm that their entire right, title and interest in and to the Invention were at all times owned by CAE.

[14] Any and all rights in and to the invention that is the subject of the 463 Patent are owned by CAE.

[15] The Respondent, the Commissioner of Patents, was served with the Application and takes no position and did not file material or participate in this Application.

II. Issue

[16] Should the Court order that the records of the Patent Office relating to the 463 Patent be amended to correct the names of the co-inventors by adding Mr. Proulx and Mr. Ho as co-inventors, pursuant to section 52 of the *Patent Act*.

III. Analysis

[17] Once a patent has issued, corrections to inventorship fall exclusively within the jurisdiction of the Federal Court.

[18] Section 52 of the *Patent Act* grants the Federal Court powers to vary or expunge any entry in the records of the Patent Office relating to the title of a patent, including errors related to inventorship.

52 The Federal Court has jurisdiction, on the application of the Commissioner or of any person interested, to order that any entry in the records of the Patent Office relating to the title to a patent be varied or expunged.

52 La Cour fédérale est compétente, sur la demande du commissaire ou de toute personne intéressée, pour ordonner que toute inscription dans les registres du Bureau des brevets concernant le titre à un brevet soit modifiée ou radiée.

[19] The Applicant is a “person interested” pursuant to section 52 of the *Patent Act*, since it is the sole owner of the 463 Patent.

[20] The *Patent Act* does not specify the test to be applied on applications pursuant to section 52 of the *Patent Act*. However, on application to add or remove an inventor, this Court

has considered subsection 31(4) of the *Patent Act*, which relates to the addition of applicants to a pending patent application.

31(4) Where an application is filed by one or more applicants and it subsequently appears that one or more further applicants should have been joined, the further applicant or applicants may be joined on satisfying the Commissioner that he or they should be so joined, and that the omission of the further applicant or applicants had been by inadvertence or mistake and was not for the purpose of delay.

31(4) Lorsque la demande est déposée par un ou plusieurs demandeurs et qu'il apparaît par la suite qu'un autre ou plusieurs autres demandeurs auraient dû se joindre à la demande, cet autre ou ces autres demandeurs peuvent se joindre à la demande, à la condition de démontrer au commissaire qu'ils doivent y être joints, et que leur omission s'est produite par inadvertance ou par erreur, et non pas dans le dessein de causer un délai.

[21] The 463 Patent discloses and claims the use of a simulation mapping system for determining a plurality of performance metric values.

[22] Mr. Proulx and Mr. Ho contributed to the Invention, and have provided sworn affidavits to this effect. The affidavit evidence from Mr. Proulx and Mr. Ho is sufficient, as there is no requirement to provide affidavit evidence from each inventor on an application to the Federal Court to correct inventorship of an issued patent under section 52.

[23] Moreover, Mr. Proulx and Mr. Ho are already listed as co-inventors to the U.S. Application from which the 463 Patent claims priority.

[24] Mr. Proulx and Mr. Ho consent to their addition as named co-inventors in respect of the 463 Patent.

[25] Mr. Proulx and Mr. Ho both contributed to the Invention, were named as inventors to the U.S. Application, and had assigned all their rights in and to the Invention to CAE.

[26] After the 463 Patent issued, it was during an internal audit that CAE noticed that Mr. Proulx and Mr. Ho were incorrectly omitted as co-inventors of the 463 Patent.

[27] This mistake arose due to Mr. Proulx and Mr. Ho being inadvertently omitted from the Canadian Application, which issued to the 463 Patent.

[28] I find that Mr. Proulx and Mr. Ho should be added as co-inventors to the 463 Patent.

JUDGMENT in T-1560-20

THIS COURT'S JUDGMENT is and it is ordered that:

1. The Commissioner of Patents vary the records of the Patent Office relating to Canadian Patent No. 3,000,463 issued January 8, 2019 to correct the names of the co-inventors by adding Marc-André Proulx and Dac Toan Ho as co-inventors.
2. The whole without costs.

"Michael D. Manson"

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-1560-20

STYLE OF CAUSE: CAE INC. v COMMISSIONER OF PATENTS

APPLICATION CONSIDERED IN WRITING pursuant to rule 369 of the *Federal Courts Rules* AT OTTAWA, ONTARIO

JUDGMENT AND REASONS: MANSON J.

DATED: APRIL 9, 2021

WRITTEN REPRESENTATIONS BY:

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FOR THE APPLICANT

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FOR THE APPLICANT