Federal Court Cour fédérale

Date: 20221024

Docket: T-1775-22

Citation: 2022 FC 1447

Ottawa, Ontario, October 24, 2022

PRESENT: The Honourable Mr. Justice Manson

BETWEEN:

GENENTECH, INC.

Applicant

and

COMMISSIONER OF PATENTS

Respondent

JUDGMENT AND REASONS

I. Introduction

[1] The Applicant, Genentech, Inc ["GNE"] seeks to add Jamie Harue Hirata [Dr. Hirata] as an inventor to Canadian Patent No. 2,979,671 [the "671 Patent"] under section 52 of the *Patent Act*, RSC 1985, c P-4 [the "*Act*"].

[2] The Respondent, Commissioner of Patents, takes no position on the matter.

II. Background

[3] The Applicant is the sole owner of the 671 Patent. There are currently four individuals listed as inventors on the 671 Patent.

[4] The 671 Patent was granted March 10, 2020 from Patent Cooperation Treaty Application No. PCT/US2015/051760 [the "PCT Application"], which entered the national phase in Canada on September 13, 2017. The PCT Application claims priority from United States Patent Application Nos. 62/054,257, 62/076,823 and 62/136,324 filed on September 23, 2014, November 7, 2014 and March 20, 2015 respectively [the "US Priority Applications"].

[5] The 671 Patent disclosure describes the patent as methods of treating B-cell proliferative disorders in particular Follicular Lymphoma and/or Diffuse Large B-Cell Lymphoma using immunoconjugates comprising anti-CD79B antibodies with additional therapeutic agents.

[6] Dr. Hirata is currently an employee of GNE and was also an employee during the relevant time. GNE failed list Dr. Hirata as an inventor of the 671 Patent in the initial application.

[7] As part of this application, GNE has submitted evidence Dr. Hirata should have been listed as an inventor of the 671 Patent, but she had not been included in the list of inventors by inadvertence or mistake. In GNE's view, Dr. Hirata made a significant contribution to the work leading to the invention that is the subject matter of the 671 Patent.

[8] The evidence GNE has submitted includes the affidavit of Dr. Hirata together with three exhibits [the "Hirata Affidavit"] and the affidavit of Gregory M Zinkl, GNE's Senior Patent Counsel together with six exhibits [the "Zinkl Affidavit"]. This evidence provides information about the 671 Patent and Dr. Hirata's contributions to the underlying invention.

[9] Dr. Hirata confirms that she is an inventor of the 671 Patent and consents to being added as a listed inventor to the 671 Patent. GNE and Dr. Hirata agree that she contributed to at least the following:

i. Example 2 in the disclosure of the 671 Patent describes the clinical protocol and safety and tolerability results for a study of polatuzumab vedotin in combination with an anti-CD20 antibody (rituximab or obinutuzumab) and an alkylating agent (bendamustine) in patients with relapsed or refractory follicular lymphoma or diffuse large B-cell lymphoma. Dr. Hirata was involved in designing and writing this protocol and selecting bendamustine-rituximab as the comparator arm for the study.

ii. Example 7 describes the clinical protocol for a study of polatuzumab vedotin in combination with obinutuzumab and a selective Bcl-2 inhibitor (venetoclax) in patients with relapsed or refractory follicular lymphoma or diffuse large B-cell lymphoma. Dr. Hirata was involved in designing and writing this protocol as the initial medical monitor of the study.

iii. Example 8 (see pages 94-97) describes the clinical protocol for a study of polatuzumab vedotin in combination with obinutuzumab and lenalidomide in patients with relapsed or refractory follicular lymphoma or diffuse large B-cell lymphoma. Dr. Hirata was involved in designing and writing this protocol as the initial medical monitor of the study.

[10] The addition of Dr. Hirata as an inventor will have no impact on the ownership of the 671 Patent. Dr. Hirata has assigned all rights in the invention to GNE.

III. Analysis

[11] Section 52 of the *Act* grants this Court the power to vary or expunge any entry in the records of the Patent Office relating to the title of a patent:

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.

[12] The word “title” has been interpreted broadly to include matters relating to the naming of inventors of a patent [*Micromass UK Ltd v Canada (Commissioner of Patents)*, 2006 FC 117 at paragraphs 12 to 13; *Qualcomm Inc v Canada (Commissioner of Patents)*, 2016 FC 1092 [*Qualcomm*] at paragraph 10].

[13] The *Act* does not state the test to apply when determining whether to vary patent titles under section 52. On applications to add an inventor, this Court has applied the principles from subsection 31(4) of the *Act,* which relate to the addition of applicants to a pending patent application [*Qualcomm* at paragraph 9 to 15; *Pharma Inc v Canada (Commissioner of Patents),* 2019 FC 208 at paragraph 5]. Under subsection 31(4) the Court must be satisfied that:

i. The person should be joined as a co-inventor; and

ii. That the omission of the further applicant or applicants had been by inadvertence or mistake and was not for the purpose of delay.

[14] This Court has the power to make orders under section 52 altering the named inventors without requiring affidavit evidence from each inventor [Qualcomm Inc v Canada (Commissioner of Patents), 2019 FC 499 at paragraphs 8 to 11; Inguran LLC dba Stgenetics v Canada (Commissioner of Patents), 2020 FC 338 at paragraphs 41 to 43].

[15] I am satisfied that Dr. Hirata should be added as inventor to the 671 Patent. The Hirata Affidavit and the Zinkl Affidavit provide sufficient evidence of her contribution to the invention. This contribution was significant, including playing an important role in Examples 2, 7 and 8 provided in the 671 Patent disclosure.

[16] Furthermore, I am satisfied that the omission of Dr. Hirata from the 671 Patent was due to mistake or inadvertence and not for the purpose of delay.

[17] GNE has met both requirements under subsection 31(4) of the Act. Accordingly, the 671 Patent is hereby varied under section 52 to add Dr. Hirata as an inventor.

IV. Conclusion

[18] The application is granted.

JUDGMENT in T-1775-22

THIS COURT'S JUDGMENT is that:

1. The application is allowed and Jamie Harue Hirata is hereby added as an inventor to Canadian Patent No. 2,979,671.

"Michael D. Manson"
Judge

FEDERAL COURT

SOLICITORS OF RECORD

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