

Federal Court



Cour fédérale

Date: 20241213

Docket: T-3027-24

Citation: 2024 FC 2027

Ottawa, Ontario, December 13, 2024

PRESENT: The Honourable Madam Justice Aylen

BETWEEN:

NOVARTIS AG

Applicant

and

THE COMMISSIONER OF PATENTS

Respondent

JUDGMENT AND REASONS

[1] This is an application brought pursuant to section 52 of the *Patent Act*, RSC 1985, c P-4 [Act]. The Applicant, Novartis AG [Novartis], seeks to add Hans-Christian Kliem [Dr. Kliem] and Clemens Kratochwil [Dr. Kratochwil] as co-inventors to the records of Canadian Patent No. 2,924,360 [360 Patent].

[2] The Respondent, the Commissioner of Patents, advised the Court by letter dated November 12, 2024, that they would not be filing material nor participating in this proceeding.

I. Background

[3] Patent Cooperation Treaty [PCT] Application No. PCT/EP2014/002808, entitled “LABELED INHIBITORS OF PROSTATE SPECIFIC MEMBRANE ANTIGEN (PSMA), THEIR USE AS IMAGING AGENTS AND PHARMACEUTICAL AGENTS FOR THE TREATMENT OF PROSTATE CANCER” was filed on October 17, 2014 [PCT Application] in the names of Deutsches Krebsforschungszentrum [DKFZ] and Ruprecht-Karls-Universität Heidelberg [Universität Heidelberg].

[4] The PCT Application claims priority to European Patent Application Nos. 13004991.9 and I4175612.2 filed by DKFZ and Universität Heidelberg on October 18, 2013, and July 2, 2014, respectively.

[5] On March 15, 2016, the PCT Application entered the national phase in Canada.

[6] On April 26, 2022, the 360 Patent was issued in the names of DKFZ and Universität Heidelberg, listing five co-inventors. Ownership of the 360 Patent was subsequently transferred and Novartis is currently the sole registered owner.

[7] Drs. Kliem and Kratochwil were not included in the list of named co-inventors in the PCT Application. Correspondingly, they were excluded from the current named co-inventors of the 360 Patent.

[8] Novartis submits that, in 2018, lawyers from the Marbury Law Group [Marbury] took over responsibility for prosecution of the national phase applications of the PCT Application, including the national phase application in Canada. As part of their work, Marbury conducted an investigation to confirm inventorship of the PCT Application. This investigation resulted in the discovery that both Drs. Kliem and Kratochwil should have been listed as co-inventors on the PCT Application, but had been omitted by mistake or inadvertence. As a result of their omission from the PCT Application, they were similarly not listed in the national phase application in Canada that led to the 360 Patent.

[9] Steps have since been taken to add Drs. Kliem and Kratochwil to patents that claim priority to the PCT Application in Canada, the United States of America, and Australia. In relation to Canada, on March 29, 2022, a request was filed with the Canadian Patent Office to correct inventorship of the 360 Patent prior to its issuance. However, the request was refused on the basis that it was received after the day on which the notice of allowance was sent.

II. Analysis

[10] The sole issue for determination on this application is whether each of Drs. Kliem and Kratochwil should be added as co-inventors to the records of the Canadian Patent Office relating to the 360 Patent.

[11] Section 52 of the *Act* grants this Court the power to vary an entry in the records of the Canadian Patent Office:

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 compétent, 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 power to vary title has been interpreted broadly to include matters such as inventorship, such that this Court is empowered to vary errors relating to the naming of inventors of an issued patent [see *Micromass UK Ltd v Canada (Commissioner of Patents)*, 2006 FC 117 at paras 12–13; *Qualcomm Incorporated v Canada (Commissioner of Patents)*, 2016 FC 1092 at para 10].

[13] In determining whether to grant the relief requested, the Court has applied the principles from subsection 31(4) of the *Act*, which governs the joining of applicants in pending patent applications. Namely, the Court must be satisfied that: (a) the proposed individual should be jointed as an inventor; and (b) the omission of the inventor was due to inadvertence or mistake and not for the purpose of delay [see *Alexion Pharmaceuticals, Inc v Canada (Attorney General)*, 2023 FC 115 at para 18; *Pharma Inc v Canada (Commissioner of Patents)*, 2019 FC 208 at para 5; *Segatoys Co, Ltd v Canada (Attorney General)*, 2013 FC 98 at paras 19–24].

[14] This Court has the power to make orders under section 52 altering the named inventors without requiring affidavit evidence from each inventor [see *Qualcomm Incorporated v Canada (Commissioner of Patents)*, 2016 FC 499 at paras 8–11; *Inguran LLC dba STgenetics v Canada (Commissioner of Patents)*, 2020 FC 338 at paras 41–43].

[15] In support of this application, Novartis has filed affidavits from each of Dr. Kliem and Dr. Kratochwil, who both individually confirm their inventorship and consent to being added as co-inventors of the 360 Patent. Novartis has also filed an affidavit from Michelle O'Brien [Ms. O'Brien], a US Patent Attorney and Partner at Marbury, who conducted the investigation into the inventorship of the PCT Application.

[16] I am satisfied that Drs. Kliem and Kratochwil should be joined as co-inventors, as Novartis has provided sufficient evidence showing their respective contributions to the 360 Patent. Dr. Kliem, who as an employee of DKFZ at the relevant time, made a significant contribution with respect to the linkers in the compounds that are described and set out in the claims of the 360 Patent. Dr. Kratochwil, who was an employee at Universität Heidelberg at the relevant time, made a significant contribution with respect to the selection of the radionucleotides described and set out in the claims of the 360 Patent.

[17] The addition of Drs. Kliem and Kratochwil as co-inventors will not affect the ownership of the 360 Patent. Dr. Kliem has confirmed that all of his rights in and to the subject matter of the 360 Patent were transferred to DKFZ, and Dr. Kratochwil has confirmed that all of his rights in and to the subject matter of the 360 Patent were transferred to Universität Heidelberg. The rights

of both DKFZ and Universität Heidelberg in and to the subject matter of the 360 Patent were transmitted to Novartis, who is now the registered owner of the 360 Patent.

[18] I am also satisfied, based on the evidence of Ms. O'Brien, that the omission of Drs. Kliem and Kratochwil as co-inventors on the PCT Application, and their subsequent exclusion from the 360 Patent derived therefrom, arose from inadvertence or mistake and was not done for the purpose of delay.

[19] As Novartis has satisfied both requirements to vary inventorship in relation to each of Drs. Kliem and Kratochwil, the application shall be granted and the 360 Patent shall be varied to add them both as co-inventors.

JUDGMENT in T-3027-24

THIS COURT'S JUDGMENT is that:

1. The application is allowed.
2. Hans-Christian Kliem and Clemens Kratochwil are hereby added as co-inventors to Canadian Patent No. 2,924,360.

“Mandy Aylen”

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-3027-24

STYLE OF CAUSE: NOVARTIS AG v THE COMMISSIONER OF
PATENTS

APPLICATION CONSIDERED IN WRITING AT OTTAWA, ONTARIO

JUDGMENT AND REASONS: AYLEN J.

DATED: DECEMBER 13, 2024

WRITTEN REPRESENTATIONS BY:

Erin Creber

FOR THE APPLICANT

SOLICITORS OF RECORD:

Gowling WLG (Canada) LLP
Barristers and Solicitors
Ottawa, Ontario

FOR THE APPLICANT