Federal Court  Cour fédérale

Date: 20100222

Docket: T-1645-09

Citation: 2010 FC 172

Ottawa, Ontario, February 22, 2010

PRESENT: The Honourable Mr. Justice O'Keefe

BETWEEN:

PLASTI-FAB LTD.

Applicant

and

THE ATTORNEY GENERAL OF CANADA

Respondent

REASONS FOR JUDGMENT AND JUDGMENT

O'KEEFE J.

[1] This is an application for an order pursuant to section 52 of the *Patent Act*, R.S.C. 1985, c. P-4 (the Act), to the Commissioner of Patents (the Commissioner) to add Gregory J. Doren as an inventor to two Canadian issued patents. The Commissioner is without jurisdiction to correct an issued patent by naming an additional inventor absent an order from this Court.

[2] The Attorney General of Canada is counsel for the Commissioner and is the only necessary respondent. The Commissioner has informed Plasti-Fab Ltd.(the applicant) and the Court that it is taking no position on this application.

Facts and Analysis

[3] The patents in question are Canadian Patent No. 2,298,435 (the ‘435 Patent) and Canadian Patent No. 2,402,580 (the ‘580 Patent) (collectively, the Canadian patents). Both patents generally relate to insulating concrete form systems. Both patents claim priority from U.S. Patent No. 5,896,714 (the ‘714 U.S. Patent). All three patents are currently owned by the applicant, Plasti-Fab Ltd. The ‘714 U.S. Patent has the same three inventors that are listed in the Canadian patents, Patrick M. Cymbala, Andrew W. Cymbala and Allan M. R. MacRae, but also lists one additional inventor, Gregory J. Doren.

[4] The evidence included by the applicant includes affidavits from Patrick M. Cymbala and Gregory J. Doren. These affidavits include the patents themselves as well as previous affidavits from these individuals which help to explain why Mr. Doren was not listed as an inventor for the Canadian patents.

[5] Mr. Cymbala, Mr. Doren and the other two inventors first submitted their patent application in the U.S. After getting the ‘714 U.S. Patent in 1999, they applied for a patent in Canada for the

same thing. As part of the Canadian application process, they both swore affidavits in 2000 in support of leaving Mr. Doren off the listed inventors.

[6] The applicant claims that the mistake that resulted in Mr. Doren being omitted as an inventor occurred during a dispute regarding Mr. MacRae's status which was subsequently resolved with Mr. MacRae being added as an inventor.

[7] The result, however, was that Mr. Doren was left off the list of inventors for both Canadian patents. Both affiants claim that they were not aware of the correct legal test for inventorship when they swore their 2000 affidavits. After receiving legal advice from their current counsel, Steven Tanner, on the correct test and reviewing their journal entries and memory of the discussion of concepts that became embodied in the '714 U.S. Patent, they now submit that Mr. Doren's contributions mean that he should be listed as an inventor.

[8] In any event, both affiants claim that the omission of Mr. Doren as an inventor was a mistake and not for the purpose of delay.

[9] The applicant is not aware of any pending litigation relating to either of the Canadian patents and is not aware of any party, other than the Commissioner, that is directly affected by the order sought or is required to be named under an Act of Parliament.

[10] The relevant provisions of the Act are as follows:

8. Clerical errors in any instrument of record in the Patent Office do not invalidate the instrument, but they may be corrected under the authority of the Commissioner.

. . .

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.

. . .

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.

8. Un document en dépôt au Bureau des brevets n'est pas invalide en raison d'erreurs d'écriture; elles peuvent être corrigées sous l'autorité du commissaire.

. . .

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.

. . .

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.

[11] Section 8 of the Act does not give the Commissioner authority to add an inventor to an existing patent (see *Micromass UK Ltd. v. Canada (Commissioner of Patents)*, 2006 FC 117, 46 C.P.R. (4th) 476, [2006] F.C.J. No. 148 (QL) at paragraph 10).

[12] Subsection 31(4) gives the Commissioner limited authorization and discretion to add an inventor, but only during the period in which the patent is pending.

[13] In *Micromass* above, Madam Justice Layden-Stevenson discussed this Court's power to direct that the records in the Patent Office be corrected after a patent issues to accomplish that which the Commissioner would have done prior to the issuance of the patent:

> 12 After the patent has issued, the Commissioner has no discretion, under section 8 of the Act or otherwise, to amend the inventorship of an issued patent. Such action falls exclusively within the jurisdiction of the Federal Court. Specifically, section 52 of the Act provides that 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 the patent be varied or expunged.
>
> 13 The word "title" in section 52 of the Act is broader than acquisition by assignment and covers matters relating to the root of title. The jurisdiction of the Court extends to correcting inadvertent errors relating to the naming of the inventors of an issued patent, including errors of a clerical nature relating to the transcribing of inventor names: *BF Goodrich v. Commissioner of Patents* (1960), 32 C.P.R. 122 (SEC.I) (Ex. Ct.).
>
> 14 An application under section 52 of the Act may be brought by an assignee of a patent, with notice to the Commissioner, by way of an originating process or by way of notice of motion during a pending infringement case relating to the patent in question. The assignee must notify any persons who are claiming an interest in the patent, and if there is a pending infringement case involving the patent at issue, any persons that may have a defence that could be

> affected by the order sought: *Clopay Corporation and Canadian General Tower Ltd. v. Metalix Ltd.* (1960), 34 C.P.R. 232 (Ex. Ct.) aff'd. (1961), 39 C.P.R. 23 (S.C.C.).
>
> 15 The powers conferred on the Court under section 52 are very broad. In *Clopay*, Cameron J. described section 54 (now section 52) of the Act in the following manner:
>
> > … I think, therefore, that s. 54 was enacted so as to enable the rectification by the Court of the records in the Patent Office relating to title in order that the party or parties actually entitled to the grant or to be registered as to the assignees of the patent, might have their rights properly recorded (p. 235)
>
> [...]
>
> I am of the opinion, however, that the provisions of s. 54 of our Patent Act are by themselves sufficiently broad to encompass a situation such as the one before me, in which the grantee of the patent was dissolved prior to the grant, and that there is power in the Court to direct that the records be corrected to accomplish that which the Commissioner would have done had the two assignments now recorded been registered prior to the grant (p. 236).

[14] Therefore this Court may, in place of the Commissioner, engage the test set out in subsection 31(4) to determine if an individual should be joined.

[15] The evidence discloses that Mr. Doren met with Mr. Cymbala prior to the filing of the priority application and discussed concepts that became incorporated into embodiments disclosed. Thus, it is uncontested that Mr. Doren provided the necessary inventive concepts to meet the test for inventorship at law established in *Apotex Inc. v. Wellcome Foundation Ltd.*, [2002] 4 S.C.R. 153, [2002] S.C.J. No. 78 (QL) at paragraphs 96, 97 and 99.

[16] I am also satisfied that the motivation behind the 2000 affidavits from Mr. Cymbala and Mr. Doren was not to cause any delay.

[17] As a result, I am satisfied, based on the evidence before me, that the applicant is entitled to the requested relief and will so order.

[18] There will be no order with respect to costs.

JUDGMENT

[19] **IT IS ORDERED that:**

1. Pursuant to section 52 of the *Patent Act*, the Commissioner of Patents vary all entries in the records of the Patent Office with respect to the inventorship of Canadian Patent No. 2,298,435 by adding Gregory J. Doren as an inventor.

2. Pursuant to section 52 of the *Patent Act*, the Commissioner of Patents vary all entries in the records of the Patent Office with respect to the inventorship of Canadian Patent No. 2,402,580 by adding Gregory J. Doren as an inventor.

3. There shall be no order with respect to costs.

"John A. O'Keefe"
Judge

FEDERAL COURT

SOLICITORS OF RECORD

DOCKET:	T-1645-09
STYLE OF CAUSE:	PLASTI-FAB LTD.
	- and -
	THE ATTORNEY GENERAL OF CANADA
PLACE OF HEARING:	Toronto, Ontario
DATE OF HEARING:	February 2, 2010
REASONS FOR JUDGMENT:	O'KEEFE J.
DATED:	February 22, 2010

APPEARANCES:

	FOR THE APPLICANT
Steven Tanner	
	FOR THE RESPONDENT
Jacqueline Dais-Visca	

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