

Federal Court



Cour fédérale

Date: 20160516

Docket: T-72-16

Citation: 2016 FC 499

Ottawa, Ontario, May 16, 2016

PRESENT: The Honourable Madam Justice Simpson

BETWEEN:

QUALCOMM INCORPORATED

Applicant

and

COMMISSIONER OF PATENTS

Respondent

JUDGMENT AND REASONS

[1] Qualcomm Incorporated [the Applicant] has applied for an order pursuant to section 52 of the *Patent Act*, RSC 1985, c. P-4 [the Act] varying the entries in the records of the Patent Office to delete Mr. Ravi Palanki [Mr. Palanki] as a co-inventor on Canadian Patent No. 3,860,309 [the “309” Patent] which was issued on June 23, 2015.

[2] The application is not opposed by the Respondent and Mr. Palanki has consented to the order sought on the basis that he is not a co-inventor of the invention described in the 309 Patent.

[3] The affidavits filed by Mr. Palanki (sworn on October 29, 2015) and by Mr. Anthony B. Morris, the Applicant's Patent Counsel, (sworn December 7, 2015) establish the following:

- a) The Applicant filed four United States provisional patent applications which correctly do not name Mr. Palanki as one of the co-inventors;
- b) The Applicant later filed United States Patent Application No. 12/269,676 claiming priority from the provisional applications. Mr. Palanki is correctly not listed as one of the co-inventors.
- c) However, through inadvertence or mistake, Mr. Palanki was incorrectly listed as a co-inventor [the Error] in the Patent Cooperation Treaty Application No. PCT/US2008/083658 [the PCT Application] filed on November 14, 2008 and published on May 22, 2009;
- d) The Applicant recognized the Error and attempted to have it corrected by submitting a request to the International Bureau of the World Intellectual Property Office [WIPO] dated May 13, 2010. On May 17, 2010, a Notification of the Recording of a Change was issued by the International Bureau of the WIPO [the Notification] indicating that Mr. Palanki should be deleted from the records of the PCT Application as a co-inventor. However, since it does not appear in the relevant file histories, the Notification apparently did not reach the Canadian Patent Office;
- e) Accordingly, when the 309 Patent was issued on June 23, 2015, it incorrectly listed Mr. Palanki as a co-inventor;
- f) Mr. Palanki has reviewed the 309 Patent and deposes that he is not an inventor of the invention described therein. Further, as mentioned above, he consents to the order sought.

I. THE ISSUE

[4] Should the Court order that the entries in the records in the Patent Office be varied to delete Ravi Palanki as a co-inventor?

II. THE LAW

[5] Section 52 of the *Act* gives the Court jurisdiction to order the removal of a co-inventor once a patent has issued but it is silent about the test to be used. However, recent decisions of this Court have suggested that, in deciding whether to remove a co-inventor, the Court should follow the test set out for the Commission of Patents in section 31(3) of the *Act* [the Section]. In this regard, see *Imperial Oil Resources Ltd. v Canada (Attorney General)*, 2015 FC 1218 and *Segatoys Co., Ltd. v Canada (Attorney General)*, 2013 FC 98.

[6] The Section was written to apply to the Commissioner of Patents' decision about whether to remove a co-inventor listed in a pending patent application. The Section reads as follows:

(3) Where an application is filed by joint applicants and it subsequently appears that one or more of them has had no part in the invention, the prosecution of the application may be carried on by the remaining applicant or applicants on satisfying the Commissioner by affidavit that the remaining applicant or applicants is or are the sole inventor or inventors.

(3) Lorsqu'une demande est déposée par des codemandeurs et qu'il apparaît par la suite que l'un ou plusieurs d'entre eux n'ont pas participé à l'invention, la poursuite de cette demande peut être conduite par le ou les demandeurs qui restent, à la condition de démontrer par affidavit au commissaire que le ou les derniers demandeurs sont les seuls inventeurs.

[My emphasis]

III. DISCUSSION

[7] I am satisfied that the first part of the test in the Section is relevant and has been met; Mr. Palanki clearly had no part in the invention described in the 309 Patent. However, the second part of the test described in the Section is not met because the affidavits described above do not clearly state that the remaining co-inventors listed in the 309 Patent are the sole inventors.

[8] In these circumstances, I must decide whether an affidavit is required.

[9] In my view, the affidavit mentioned in the Section is essentially a housekeeping requirement to promote the efficient processing of pending patent applications in the Patent Office. It makes sense that, if a patent applicant has made an error in a pending application, the Commissioner would want to ensure that the application was correct once it was amended. This was accomplished by requiring applicants to consider the inventor(s) and confirm in an affidavit that they were accurately listed.

[10] However, these considerations are not relevant when an issued patent is being considered by the Court under section 52 of the *Act*.

[11] Accordingly, the application will be granted notwithstanding the fact that the Applicant did not provide the affidavit mentioned in the Section stating that the remaining co-inventors listed in the 309 Patent are the sole inventors.

JUDGMENT

THIS COURT ADJUDGES that

1. The application is granted;
2. Pursuant to Section 52 of the *Patent Act*, the Commissioner of Patents shall vary all entries in the records of the Patent Office relating to Canadian Patent No. 2,860,309 issued June 23, 2015 to correct the names of the inventors by deleting Ravi Palanki as a co-inventor;
3. There is no Order as to costs.

"Sandra J. Simpson"

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-72-16

STYLE OF CAUSE: QUALCOMM INCORPORATED v COMMISSIONER
OF PATENTS

PLACE OF HEARING: OTTAWA, ONTARIO

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JUDGMENT AND REASONS: SIMPSON J.

DATED: MAY 13, 2016

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