Federal Court  Cour fédérale

Date: 20160222

Docket: T-1659-15

Citation: 2016 FC 229

Ottawa, Ontario, February 22, 2016

PRESENT: The Honourable Madam Justice McDonald

BETWEEN:

NOVARTIS AG

Applicant

and

THE ATTORNEY GENERAL OF CANADA

Respondent

JUDGMENT AND REASONS

[1] This is an Application by Novartis AG (Novartis) pursuant to sections 31(3) and 52 of the *Patent Act*, RSC 1985 c P-4 (*Patent Act*) to vary all entries in the records of the Patent Office with respect to the inventorship of Canadian Patent No. 2,782,650 (the '650 Patent).

[2] Novartis is the registered owner of the '650 Patent with respect to "arranging interaction and back pressure chambers for microfluidization" and is therefore an interested party for the purpose of section 52 of the *Patent Act*.

[3] The Application is supported by a Declaration of Barbara Santry, dated March 23, 2015, consenting to removing her name as an inventor from the registration of the '650 Patent. It is also supported by the Declaration of inventor Harald Rueckl, dated March 20, 2015, and the Declaration of inventor Hanno Scheffczik, dated March 24, 2015, both confirming that Barbara Santry did not contribute to the invention and that she was incorrectly named as an inventor.

[4] The Attorney General of Canada is not contesting this Application and has not filed an Affidavit or a Brief.

[5] The jurisdiction of the Federal Court on an application to amend the inventorship of an issued patent is reviewed in *Micromass UK Ltd v Canada (Commissioner of Patents)*, 2006 FC 117 as follows:

> [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.
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> [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).

[16] It is immaterial to the public whether there is one inventor or two joint inventors as this does not go to the term or to the substance of the invention nor even to entitlement *Apotex Inc. v. Wellcome Foundation Ltd.* (1998), 79 C.P.R. (3d) 193 (F.C.T.D.) appeal allowed in part, but not on this issue (2000), 10 C.P.R. (4th) 65 (F.C.A.) aff'd. (2002), 21 C.P.R. (4th) 499 (S.C.C.).

[6] The test to be meet on a section 31(3) application is outlined as follows:

31.(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	31.(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

the remaining applicant or applicants is or are the sole inventor or inventors.	affidavit au commissaire que le ou les derniers demandeurs sont les seuls inventeurs

[7] The Applicant relies upon the Declarations of three individuals. Barbara Santry is employed as a Site Head for Manufacturing Science and Technology at Novartis. She states that she was not an inventor of the invention contemplated in the '650 Patent and she consents to the removal of her name as an inventor. The other listed inventors, Harald Rueckl and Hanno Scheffczik, also confirm that Barbara Santry did not contribute to the invention and was incorrectly named as an inventor. According to the evidence filed with this Application, the related United States patent applications have already been varied to remove Barbara Santry as an inventor.

[8] Therefore the evidence is uncontradicted and the interested parties agree that the inclusion of that Barbara Santry as an inventor on this patent was an error. The Commissioner of Patents has not opposed the application and nothing suggests that third party rights will be affected.

[9] This evidence meets the requirements of subsection 31(3) of the *Patent Act*. Accordingly, the order sought by Novartis to amend the Patent Office's records by removing the name of Barbara Santry as an inventor of the '650 Patent should be granted.

JUDGMENT

THIS COURT'S JUDGMENT is that:

1. The Commissioner of Patents, pursuant to section 52 of the *Patent Act*, shall vary all entries in the records of the Patent Office with respect to the inventorship of Canadian Patent No. 2,782,650 by removing the name of Barbara Santry as an inventor.

"Ann Marie McDonald"
Judge

FEDERAL COURT

SOLICITORS OF RECORD

DOCKET:	T-1659-15
STYLE OF CAUSE:	NOVARTIS AG v THE ATTORNEY GENERAL OF CANADA
JUDGMENT AND REASONS:	MCDONALD J.
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SOLICITORS OF RECORD:

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