

Federal Court



Cour fédérale

Date: 20160928

Docket: T-1041-16

Citation: 2016 FC 1092

Ottawa, Ontario, September 28, 2016

PRESENT: The Honourable Mr. Justice Southcott

BETWEEN:

QUALCOMM INCORPORATED

Applicant

and

COMMISSIONER OF PATENTS

Respondent

JUDGMENT AND REASONS

I. Introduction

[1] This is an application by Qualcomm Incorporated [the Applicant] for an Order pursuant to s. 52 of the *Patent Act*, RSC 1985, c P-4 [the Act] that the records of the Patent Office relating to Canadian Patent No. 2,630,594 [the 594 Patent] be varied to correct the names of the inventors, by adding Bohuslav Rychlik as an inventor and deleting Uppinder Singh Babbar and

Rohit Kapoor as inventors. The Applicant also wishes to have the following documents recorded at the Patent Office against the 594 Patent [together the Replacement Documents]:

- A. A copy of the Assignment dated October 26, 2005 from Bohuslav Rychlik to QUALCOMM Incorporated; and
- B. A copy of the replacement sheets of the PCT Request form for PCT Application Number PCT/US2006/060849 with the Declarations of Entitlement filed on August 21, 2007.

[2] This application is not contested by the Respondent, the Commissioner of Patents.

II. Background

[3] The Applicant is the owner of the 594 Patent, which was issued on April 17, 2012 from PCT Application Number PCT/US2006/060849, filed November 13, 2006 [the PCT Application]. The PCT Application claims priority from United States Patent No. 11/271,545 filed November 10, 2005 [the United States Application] and entered the national phase in Canada on May 21, 2008.

[4] The Applicant submits that Bohuslav Rychlik is the sole inventor of the invention that is the subject of the United States Application, the PCT Application, and the 594 Patent. Mr. Rychlik was, and continues to be, an employee of the Applicant and has assigned to the Applicant the whole right, title and interest in and to the invention, including all foreign rights to the invention.

[5] The Applicant submits that Mr. Rychlik was correctly named as inventor in the United States Application, but, as a result of an administrative error, other employees of the Applicant, Uppinder Singh Babbar and Rohit Kapoor, were incorrectly named as inventors on the Request form for the PCT Application, including in the Declarations of Entitlement. The PCT Application was published on May 24, 2007, incorrectly naming Mr. Babbar and Mr. Kapoor as the inventors.

[6] On August 21, 2007, the Applicant filed replacement sheets for the Request form for the PCT Application, including the Declarations of Entitlement, to name Bohuslav Rychlik as the sole inventor. Following the receipt of subsequent correspondence from the Applicant, the Notification of the Recording of a Change in Inventorship for the PCT Application was issued from the International Bureau of the World Intellectual Property Organization on July 17, 2013, indicating that Mr. Babbar and Mr. Kapoor had been deleted from the records of the PCT Application and that Mr. Rychlik had been added as an inventor.

[7] However, the entrance of the PCT Application into the national phase in Canada was based upon the PCT Application as originally published on May 24, 2007. As a result, the documents filed for the Canadian national phase incorrectly named Mr. Babbar and Mr. Kapoor as inventors. The Applicant subsequently discovered that Mr. Babbar and Mr. Kapoor had been incorrectly named as inventors on the 594 Patent and brought this application to have the records of the Patent Office corrected.

III. Issue

[8] The sole issue in this application is whether the Court should grant the relief requested by the Applicant, by ordering that: (a) the records of the Patent Office relating to the 594 Patent be amended to correct the names of the inventors by adding Mr. Rychlik as an inventor and deleting Mr. Babbar and Mr. Kapoor as inventors; and (b) the Replacement Documents be recorded at the Patent Office against the 594 Patent.

IV. Analysis

[9] The provisions of the Act relevant to this application are the following:

Procedure when one joint applicant retires

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 the remaining applicant or applicants is or are the sole inventor or inventors.

Joining applicants

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

Procédure quand un codemandeur se retire

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 affidavit au commissaire que le ou les derniers demandeurs sont les seuls inventeurs.

Codemandeurs

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

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.

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.

Jurisdiction of Federal Court

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.

Jurisdiction de la Cour fédérale

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.

[10] The Applicant submits that, as the sole owner of the 594 Patent, it is clearly a “person interested” pursuant to section 52 and that the word “title” in section 52 has been interpreted broadly to include matters relating to the root of title such as inventorship (see *Segatoys Co., Ltd. v Canada (Attorney General)*, 2013 FC 98 [*Segatoys*], at para 13). I accept these propositions and that the Federal Court has jurisdiction to order the addition and/or removal of names of inventors as requested by the Applicant.

[11] Section 52 of the Act is silent on the test to be used. As Justice Simpson noted in *Qualcomm Incorporated v. Canada (Commissioner of Patents)*, 2016 FC 499 [*Qualcomm*] at para 5, 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. Similarly, section 31(4) of the Act sets out the test for adding inventors. (See *Imperial Oil Resources Ltd. v Canada (Attorney General)*, 2015 FC 1218; and *Segatoys*).

[12] The Applicant points out that Justice Simpson also held in *Qualcomm* that, although section 31(3) of the Act requires affidavit evidence that the remaining inventor or inventors are the sole inventor or inventors, this was not required when an issued patent was being considered by the Court under section 52 of the Act. Nevertheless, in the present case, Mr. Rychlik has sworn an affidavit confirming that he is the sole inventor of the invention that is the subject of the 594 Patent and that his whole right, title and interest in and to the invention has been assigned to the Applicant. Mr. Rychlik also states that he consents to being named as the sole inventor in respect of the 594 Patent.

[13] Each of Mr. Babbar and Mr. Kapoor has sworn an affidavit confirming that he is not an inventor of the invention that is the subject of the 594 Patent and that he consents to his removal as a named inventor.

[14] The Applicant has also filed an affidavit of Paul Holdaway, its Senior Patent Counsel, which swears that the incorrect naming of inventors was by inadvertence or mistake and was not for the purpose of delay. Mr. Holdaway's affidavit explains how the error occurred, as detailed above in the "Background" section of these Reasons, which evidence supports his assertion that the error resulted from inadvertence or mistake and was not for the purpose of delay.

[15] It is therefore my conclusion that the affidavits provided by the Applicant satisfy the relevant requirements of sections 31(3) and (4) of the Act. Accordingly, the records of the Patent Office relating to the 594 Patent should be amended as requested to add Bohuslav Rychlik as an inventor and delete Uppinder Singh Babbar and Rohit Kapoor as inventors.

[16] At the hearing of this application, I asked the Applicant for submissions on the jurisdiction and authority of the Court to order that the Replacement Documents be recorded at the Patent Office. The Applicant referred to the broad power conferred upon the Court by section 52 of the Act but has not identified any authorities interpreting this section as authorizing the Court to order the recording of documents. The Applicant also explained that its objectives in bringing this application can be achieved without the Court granting that particular relief and that it will have alternate means of filing the Replacement Documents.

[17] Section 52 of the Act provides the Court with jurisdiction "...to order that any entry in the records of the Patent Office relating to the tile to a patent be varied or expunged." In the absence of authority supporting the Applicant's position that the recording of a replacement document represents variation or expungement of a record of the Patent Office, and given that the Applicant can achieve its objectives without the Court ordering the recording of the Replacement Documents, I decline to order that relief.

[18] The Applicant sought no costs, and none are ordered.

JUDGMENT

THIS COURT'S JUDGMENT is that:

1. This 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. 2,630,594 issued April 17, 2012 to correct the names of the inventors by:
 - a. adding Bohuslav Rychlik as an inventor; and
 - b. deleting Uppinder Singh Babbar and Rohit Kapoor as inventors.
3. No costs are awarded on this application.

“Richard F. Southcott”

Judge

FEDERAL COURT

SOLICITORS OF RECORD

DOCKET: T-1041-16

STYLE OF CAUSE: QUALCOMM INCORPORATED v THE
COMMISSIONER OF PATENTS

PLACE OF HEARING: OTTAWA, ONTARIO

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JUDGMENT AND REASONS: SOUTHCOTT, J.

DATED: SEPTEMBER 28, 2016

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