

Federal Court



Cour fédérale

Date: 20170213

Docket: T-2188-15

Citation: 2017 FC 178

Calgary, Alberta, February 13, 2017

PRESENT: The Honourable Mr. Justice O'Reilly

BETWEEN:

BAYER CROPSCIENCE LP

Applicant

and

**THE ATTORNEY GENERAL OF CANADA
AND THE COMMISSIONER OF PATENTS**

Respondents

JUDGMENT AND REASONS

I. Overview

[1] Bayer Cropsience LP maintains that the Commissioner of Patents has incorrectly recorded the priority filing date for Bayer's Canadian Patent Application No 2,907,271 (the '271 Application). Bayer asks me to order the Commissioner to change the '271 Application's priority date from April 19, 2012 to April 3, 2012.

[2] I find that the Commissioner did not err in refusing Bayer's request to amend the priority date. Therefore, I must dismiss this application for judicial review.

[3] The sole issue is whether the Commissioner correctly applied the *Patent Act*, RSC 1985, c P-4 and the *Patent Rules*, SOR/96-423 when refusing Bayer's request.

II. Chronology of Events

[4] This application has a somewhat complicated history. The following events led to Bayer's application:

- On April 3, 2012, Bayer filed a patent application with the United States Patent and Trademark Office (USPTO). That filing concerned US Patent Application No 61/619,691, which I will refer to as the '691 US Priority Application.
- The USPTO refused to assign a filing date for the '691 US Priority Application because Bayer had failed to file accompanying drawings. Bayer filed the drawings on April 19, 2012.
- The USPTO assigned the '691 US Priority Application a filing date of April 19, 2012, which Bayer did not contest.
- The following year, on March 15, 2013, Bayer filed another patent application, this time with the World Intellectual Property Organization (WIPO), pursuant to the Patent Cooperation Treaty (PCT). This filing concerned Patent Application PCT/US2013/031888, which I will call the '888 PCT Application.

- The '888 PCT Application claimed priority from the '691 US Priority Application, which, as mentioned above, had a filing date of April 19, 2012. Bayer asked for a filing date of April 3, 2012 for the '888 PCT Application; however, after WIPO noticed a discrepancy with the '691 US Priority Application's filing date of April 19, 2012, Bayer requested that the '888 PCT Application be given the same filing date – April 19, 2012.
- On April 14, 2015, on Bayer's request, the USPTO amended the filing date for the '691 US Priority Application to April 3, 2012. The USPTO conceded that the original filing date should not have been delayed to April 19, 2002 because the requested drawings were not, in fact, required.
- In turn, Bayer asked the USPTO, which acted as the international receiving office for the '888 PCT Application on WIPO's behalf, to amend the filing date for that application as well. On July 27, 2015, Bayer's request was denied, so the filing date for the '888 PCT Application remained April 19, 2012. Bayer made a second request to amend the filing date, but it too was denied.
- On August 7, 2015, the '888 PCT Application entered the national phase in Canada as Canadian Patent Application No 2,907,271, which I will refer to as the Canadian '271 Application.
- Bayer requested that the Canadian '271 Application be given a filing date of April 3, 2012 on the basis that it was claiming priority from the '691 US Priority Application, which had an amended filing date of April 3, 2012. The Commissioner denied

Bayer's request on December 3, 2015, concluding that the correct date was April 19, 2012.

III. Was the Commissioner's Decision Incorrect?

[5] Bayer argues that the Commissioner erred in the following respects:

1. The Commissioner failed to correctly apply s 88 of the *Patent Rules*, which applies to the setting of priority dates.
2. The Commissioner failed to discharge her duty to ensure that the Patent Register does not contain errors.

[6] I disagree with Bayer's submissions on both points.

[7] First, the Commissioner correctly interpreted the *Patent Rules* in finding that Bayer's request to amend the priority date was out of time.

[8] Typically, the claim date for a Canadian patent application is the date on which the application was filed in Canada (*Patent Act*, s 28.1(1)). However, there is an exception where the Canadian application is filed within 12 months of a previously regularly filed application and the applicant requests that the prior date be considered the claim date (s 28.1(1)(b), (c)). The request for a priority date must include the filing date of the previous application, the country or office of filing, and the number of the prior application (s 28.4(2)). Further, the request must be made within 16 months of the filing of the prior application (s 88(1)(b) *Patent Rules*).

[9] In a case where, as here, an applicant has filed a PCT Patent Application, the applicant can claim a prior filing date based on the filing of a previous application. Accordingly, Bayer can claim priority based on the filing date of the '691 US Priority Application.

[10] The filing date of a PCT Patent Application is deemed to be the filing date for a Canadian Patent Application that is subsequently introduced in the national phase of the application. Therefore, the filing date for the Canadian '271 Application is March 15, 2013. Given that this date is less than 12 months after the priority date (whether it is April 3, 2012 or April 19, 2012), Bayer is entitled to use the claim date of the '671 Application. The question is: which of the two is the correct date?

[11] At the time of filing the '888 PCT Application, March 15, 2013, the filing date for the '691 US Priority Application was recorded as April 19, 2012. In the absence of a specific request for a different priority date, the Canadian '271 Application should be given a priority date of April 19, 2012.

[12] In its letter to the Commissioner dated August 7, 2015, Bayer made a specific request for the alternative filing date of April 3, 2012. The Commissioner replied that Bayer's request had to have been made within 16 months of the filing date of the '691 US Priority Application, namely before August 19, 2013 (the Commissioner's letter mistakenly states that the cut-off date was August 19, 2014, an obvious clerical error).

[13] Bayer argues that the Commissioner erred by not treating its request for an earlier priority date as having been made on March 15, 2013, when it filed the '888 PCT Application, not on August 17, 2015.

[14] I cannot agree. On March 15, 2013, Bayer indeed requested a priority date of April 3, 2012, but it had no basis for that request. Indeed, just two months later, Bayer conceded that the correct date was April 19, 2012. Therefore, even accepting that Bayer's request for an alternate priority date was made on March 15, 2013, there was no basis for it at that time. It was not until April 2015 that the filing date for the '691 US Priority Application was corrected to April 3, 2012. The filing date for the '888 PCT Application was never successfully amended.

[15] Further, the Commissioner correctly concluded that s 88(1)(b) of the *Patent Rules* requires that a request for a priority date be made within 16 months of the filing date of the application for which priority is sought. That provision states that an applicant can make a request by providing the required information (filing date, county of filing, and application number) within the 16-month period following the filing date of "that application", that is, the prior application to which priority is being claimed. Here, that means Bayer had to make its request by August 19, 2013. Clearly, its August 2015 request was out of time.

[16] On the second issue, the Commissioner's duty to correct the patent register, I can find no basis for Bayer's assertion. Bayer relies on *Procter & Gamble Co v Canada (Commissioner of Patents)*, 2006 FC 976 where Justice Robert Barnes stated that the Commissioner "by implication at least" has a responsibility to ensure "that the Patent Office records be maintained

accurately” (at para 25). Assuming that this implied duty exists, I would not characterize the patent records for Bayer’s application as being inaccurate. The patent register records will show that the filing date for the ‘691 US Priority Application was not amended until April 2015, that the filing date for the ‘888 PCT Application was never amended, and that Bayer did not request a different priority date for its ‘271 Canadian Application until August 2015, well after the 16-month deadline. Accordingly, I see no basis for concluding that the patent register requires correction or that Commissioner erred in refusing to amend it.

IV. Conclusion and Disposition

[17] The Commissioner of Patents correctly concluded that Bayer’s request for a priority date of April 3, 2012 was made too late. Further, she was under no duty to amend the patent register to reflect that date. I must, therefore, dismiss this application for judicial review, with costs.

JUDGMENT in T-2188-15

THIS COURT'S JUDGMENT is that the application for judicial review is dismissed,
with costs.

"James W. O'Reilly"

Judge

ANNEX

<i>Patent Act</i> , RSC 1985, c P-4	<i>Loi sur les brevets</i> , LRC (1985), ch P-4
Claim date	Date de la revendication
<p>28.1 (1) The date of a claim in an application for a patent in Canada (the “pending application”) is the filing date of the application, unless</p> <p>...</p> <p>(b) the filing date of the pending application is within twelve months after the filing date of the previously regularly filed application; and</p> <p>(c) the applicant has made a request for priority on the basis of the previously regularly filed application.</p>	<p>28.1 (1) La date de la revendication d’une demande de brevet est la date de dépôt de celle-ci, sauf si :</p> <p>[...]</p> <p>b) elle est déposée dans les douze mois de la date de dépôt de la demande déposée antérieurement;</p> <p>c) le demandeur a présenté, à l’égard de sa demande, une demande de priorité fondée sur la demande déposée antérieurement</p>
Requirements governing request	Conditions
<p>28.4 (2) The request for priority must be made in accordance with the regulations and the applicant must inform the Commissioner of the filing date, country or office of filing and number of each previously regularly filed application on which the request is based.</p>	<p>28.4 (2) Le demandeur la présente selon les modalités réglementaires; il doit aussi informer le commissaire du nom du pays ou du bureau où a été déposée toute demande de brevet sur laquelle la demande de priorité est fondée, ainsi que de la date de dépôt et du numéro de cette demande de brevet.</p>
Sales and expense information, etc., to be provided	Obligations des brevetés
<p>88 (1) A patentee of an invention pertaining to a medicine shall, as required by and in accordance with the regulations, or as the Board may, by order, require, provide the Board with such information and documents as the regulations or the order may</p>	<p>88 (1) Le breveté est tenu, conformément aux règlements ou aux ordonnances du Conseil, de fournir à celui-ci des renseignements et documents sur les points suivants :</p>

specify respecting

...

(b) the revenue of the patentee, and details of the source of the revenue, whether direct or indirect, from sales of medicine in Canada; and

Patent Rules, SOR/96-423

Priority Claims

88 (1) For the purposes of subsection 28.4(2) of the Act,

(a) a request for priority may be made in the petition or in a separate document

(b) where a request for priority is based on one previously regularly filed application, the request must be made, and the applicant must inform the Commissioner of the filing date, country of filing and application number of the previously regularly filed application, before the expiry of the sixteen-month period after the date of filing of that application; and

(c) where a request for priority is based on two or more previously regularly filed applications,

(i) the request must be made, and the applicant must inform the Commissioner of the filing date and country of filing of each previously regularly filed application on which the request for priority is based, before the expiry of the sixteen-month period after

[...]

b) les recettes directes ou indirectes qu'il a tirées de la vente au Canada du médicament, ainsi que la source de ces recettes;

Règles sur les brevets, DORS/96-423

Demandes de priorité

88 (1) Pour l'application du paragraphe 28.4(2) de la Loi :

a) la demande de priorité peut être incluse dans la pétition ou dans un document distinct;

b) lorsque la demande de priorité est fondée sur une seule demande de brevet antérieurement déposée de façon régulière, le demandeur la présente et communique au commissaire la date du dépôt, le nom du pays du dépôt et le numéro de la demande de brevet antérieurement déposée de façon régulière, dans les seize mois suivant la date du dépôt de cette demande de brevet;

c) lorsque la demande de priorité est fondée sur deux ou plusieurs demandes de brevet antérieurement déposées de façon régulière :

(i) le demandeur la présente et communique au commissaire la date du dépôt et le nom du pays du dépôt de chaque demande de brevet antérieurement déposée de façon régulière sur laquelle est fondée la demande de priorité, dans les seize mois suivant la date du dépôt de la première de

the earliest date of filing of those applications, and

(ii) the applicant must, for each previously regularly filed application on which the request for priority is based, inform the Commissioner of its application number before the expiry of the twelve-month period after its date of filing or before the expiry of the period referred to in subparagraph (i), whichever is later.

(2) Where a request for priority on the basis of a particular previously regularly filed application is withdrawn before the expiry of the sixteen-month period after the date of filing of that application, the times prescribed in subsection (1) shall be computed as if the request for priority had never been made based on that application.

(3) For the purposes of subsection (1), if the previously regularly filed application is for a patent granted by a national or an intergovernmental authority having the power to grant patents effective in more than one country, the applicant may provide the Commissioner with the name of the authority with which the application was filed instead of the country of filing.

(4) For the purposes of subsection (1), if the previously regularly filed application is an international application, the applicant may provide the Commissioner with the name of the

ces demandes,

(ii) le demandeur communique au commissaire le numéro de chaque demande de brevet antérieurement déposée de façon régulière sur laquelle est fondée la demande de priorité, dans le délai prévu au sous-alinéa (i) ou dans les douze mois suivant la date du dépôt de la demande de brevet antérieurement déposée de façon régulière, selon celui de ces délais qui expire après l'autre.

(2) Lorsqu'une demande de priorité fondée sur une demande de brevet déposée antérieurement de façon régulière est retirée avant la date d'expiration de la période de seize mois qui suit la date du dépôt de cette demande de brevet, les délais prévus au paragraphe (1) sont comptés comme si la demande de priorité n'avait jamais été fondée sur cette demande de brevet.

(3) Pour l'application du paragraphe (1), si la demande de brevet déposée antérieurement de façon régulière vise un brevet délivré par un organisme national ou intergouvernemental habilité à délivrer des brevets ayant effet dans plus d'un pays, le demandeur peut communiquer au commissaire le nom de l'organisme auprès duquel la demande a été déposée au lieu du nom du pays du dépôt.

(4) Pour l'application du paragraphe (1), si la demande de brevet déposée antérieurement de façon régulière est une demande internationale, le demandeur peut communiquer au commissaire le nom

receiving Office with which the application was filed instead of the country of filing.

(5) Subsection 26(1) does not apply in respect of the times specified in subsection (1).

de l'office récepteur où la demande a été déposée au lieu du nom du pays du dépôt.

(5) Le paragraphe 26(1) ne s'applique pas aux délais prévus au paragraphe (1).

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-2188-15

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