

Federal Court



Cour fédérale

Date: 20171205

Docket: T-1130-17

Citation: 2017 FC 1108

Ottawa, Ontario, December 5, 2017

PRESENT: The Honourable Mr. Justice Martineau

BETWEEN:

EVERLIGHT ELECTRONICS CO., LTD

Applicant

and

ATTORNEY GENERAL OF CANADA

Respondent

JUDGMENT AND REASONS

[1] The applicant, Everlight Electronics Co., Ltd [Everlight], is seeking to vary an entry in the records of the Patent Office. The application – which is uncontested – is allowed by the Court.

[2] Everlight is a global optoelectronics manufacturer constituted under the laws of Taiwan. On January 23, 2002, Gentex Corporation [Gentex], an American company in the automotive industry, filed an international patent application under the Patent Cooperation Treaty for

“radiation emitter devices and method of making the same.” The patent application made its national entry in Canada on June 5, 2003. The Canadian Patent Office issued Canadian letters of patent number CA 2,430,747 [Patent] on May 20, 2008. Following a worldwide transaction between Gentex and Everlight, ownership of several patents were transferred to the applicant. This involved, among other things, an assignment agreement: “Contract No. A03 16070001 Everlight Legal” [Assignment]. On October 13, 2016, the applicant’s patent agent inadvertently filed the complete Assignment to the Patent Office as evidence of the Patent’s transfer of ownership. Yet, Gentex and Everlight had always intended to only submit a more limited appendix (attached as Exhibit C of the affidavit of Hsien-Chia Lin) instead of the entire transaction, in order to protect their confidential information. Registration of the Assignment to the applicant was confirmed by the Patent Office on October 17, 2016. The applicant filed the present application after noticing this error.

[3] Section 52 of the *Patent Act*, RSC 1985, c P-4 [Act] confers a broad jurisdiction to the Federal Court “to order that any entry in the records of the Patent Office relating to the title to a patent be varied or expunged,” on the application of any person interested. This includes the patent’s owner and the assignee (see *Micromass UK Ltd v Canada (Commissioner of Patents)*, 2006 FC 117 at para 14 [*Micromass*] and *Novartis AG v Canada (Attorney General)*, 2016 FC 229 at para 2 [*Novartis*]). While section 52 of the Act is silent on the test to be used to decide whether or not to exercise jurisdiction (see *Qualcomm Incorporated v Canada (Commissioner of Patents)*, 2016 FC 1092 at para 11), the word “title” has been broadly interpreted by this Court to include various matters relating to the root of title (see *Micromass* at para 13).

[4] The Act and the *Patent Rules*, SOR/96-423, do not have requirements as to the assignments' content – other than evidence of the assignment of rights itself. In *Love v Claveau* (1989), [1990] 1 FC 64, 29 FTR 188 (FCTD), the Court held that its jurisdiction extended to the expungement of an assignment agreement that was improperly filed. In *Gray Manufacturing Company, Inc v Canada (Attorney General)*, 2016 FC 55, a patent was inadvertently filed under the wrong company name, and the Court used its power under section 52 of the Act to order the Commissioner of Patents to vary the entry. Factors considered were that the mistake was unintentional, made in good faith and without any attempt to mislead or cause delay. In *Micromass*, the Court mentioned that the change ordered would be immaterial to the public. In *Novartis*, the Court also considered the fact that third parties would not be affected.

[5] Based on the affidavit evidence and representations made by the applicant, I am satisfied that the Court should accept to vary the records concerning the Patent. Filing the Assignment was truly an honest mistake on the part of the patent agent. The proposed variation will cause no prejudice to third parties, as no outsider is claiming an interest in the Patent, there is no ongoing infringement case, and the rest of the Assignment is immaterial to the public. In the present case, the objective of protecting confidentiality can be met by varying the current records through redaction of confidential information in the Assignment. A copy of the Assignment to which said confidential information has been redacted is attached as Exhibit B of the affidavit of Hsien-Chia Lin (reproduced as Annex A of the present judgment).

JUDGMENT in T-1130-17

UPON AN UNCONTESTED application to vary an entry in the records of the Patent Office regarding patent CA 2,430,747 [Patent];

IT IS HEREBY ADJUDGED AND ORDERED THAT:

1. The application is allowed;
3. The assignment agreement “Contract No A03 16070001 Everlight Legal” [Assignment] is expunged from the records of the Patent Office regarding the Patent, and shall be replaced by the redacted assignment annexed to the present judgment (Annex A).
4. The Patent Office shall comply with the Court’s judgment and shall destroy any electronic copy of the Assignment from its records and return any physical copy of same to the applicant.
5. Without costs.

"Luc Martineau"

Judge

ANNEX A

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CONFIDENTIAL

Contract No.
A-3 1607001
Everlight Legal

ASSIGNMENT AGREEMENT

This ASSIGNMENT AGREEMENT is made and entered into as of July 25, 2016 ("Effective Date") between GENTEX CORPORATION, a Michigan corporation having a place of business at 600 N. Centennial Street, Zeeland, Michigan 49464 U.S.A. and its Affiliates ("Gentex") and EVERLIGHT ELECTRONICS CO., LTD, a Taiwanese Corporation having a place of business at No. 6-8, Zhonghua Rd. Shulin Dist. New Taipei City 23860, Taiwan ("Everlight"). Gentex and Everlight may be referred to herein collectively as the "Parties" or each individually as a "Party."

WHEREAS, Gentex owns all rights, title and interest in the Assigned Patents.

WHEREAS, Everlight desires to acquire and Gentex is willing to assign to Everlight all rights, title and interest in and to the Assigned Patents and any inventions claimed therein.



NOW, THEREFORE, in return for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the Parties agree as follows.

1 Definitions.

- 1.1. "Affiliate" means any company, subsidiary, parent, or other entity related to a Party, which is directly or indirectly: (i) Controlled by the Party or (ii) Controlling the Party, at any time during the term of this Agreement, but such company, subsidiary, parent, or other entity shall be deemed an Affiliate only for so long as such Control exists.
- 1.2. "Assigned Patents" means the patents listed in Appendix A attached to this Agreement.
- 1.3. "Assignment" means the assignment of the Assigned Patents as provided in Section 2.



[REDACTED]

[REDACTED]

1.6. "Tax" means any United States or any other jurisdiction where Gentex does business federal, provincial, state, local, foreign, or other income, gross receipts, license, payroll, employment, excise, severance, stamp, occupation, premium, windfall profits, customs, duties, capital stock, franchise, profits, withholding, social security (or similar), unemployment, disability, real property, personal property, sales, use, transfer, registration, value added, general service, alternative or add-on minimum, estimated, or other tax of any kind whatsoever, however denominated or computed, and including any interest, penalty, or addition thereto, whether disputed or not.

1.7. "Tax Return" means any return, declaration, report, claim for refund, or information return, or other document or statement relating to Taxes, including any form, schedule, or attachment thereto and any amendment or supplement thereof.

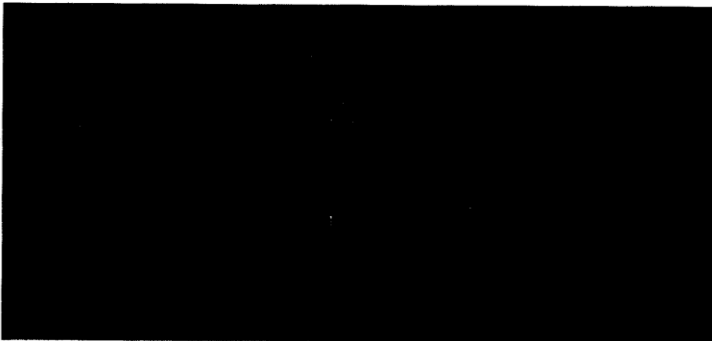
[REDACTED]

2 Assignment and License.

2.1. Subject to the payment provisions set forth in Item a of Section 3.1 and the other terms herein, Gentex hereby transfers, grants, conveys, assigns and relinquishes exclusively to Everlight all of Gentex's right, title and interest, including the right to past damages, in and to the Assigned Patents and the inventions claimed therein.

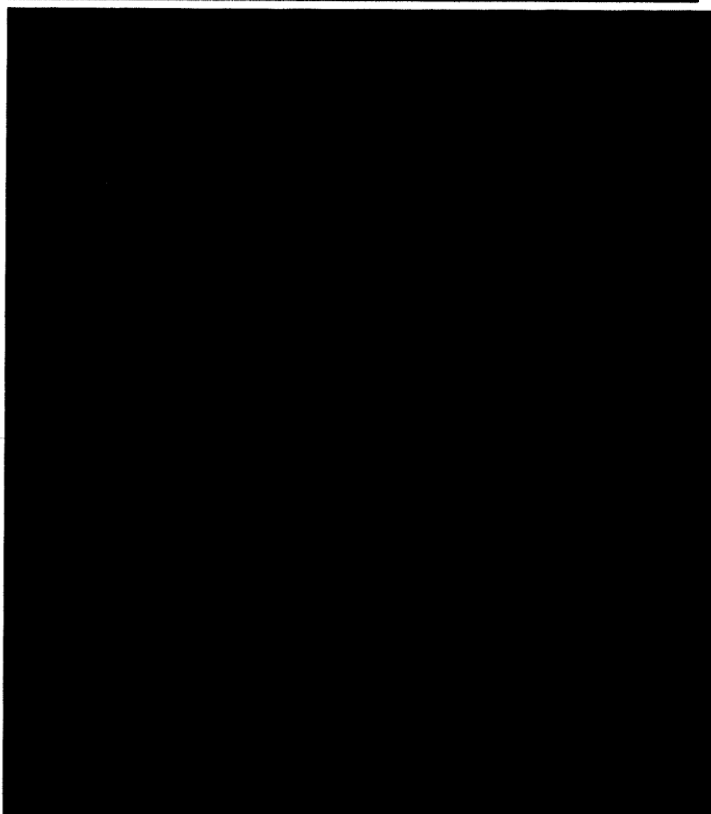
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- 2.2. The Assignment is subject to the terms herein, including a reserved nonexclusive license to Gentex to make, use, and import any product or component thereof covered by any of the Assigned Patents for use, sale, or offer for sale in a Gentex product, or practice any method covered by any of the Assigned Patents to make or use a Gentex product.
- 2.3. The assignment documents for the Assigned Patents to be executed by the Parties are included in Appendix B. If additional documents are needed for recording the assignment of the Assigned Patents, including, without limitation, a deed of assignment, and any written notice to an obligor of past damages, the Parties will cooperate for the preparing, signing, filing and sending of such additional documents.
- 2.4. Gentex hereby grants to Everlight a non-exclusive license, with the right to sublicense, the patents listed in Appendix C to the extent such patent is necessary for Everlight, or its sublicensee, to practice the claimed invention of the Assigned Patents.



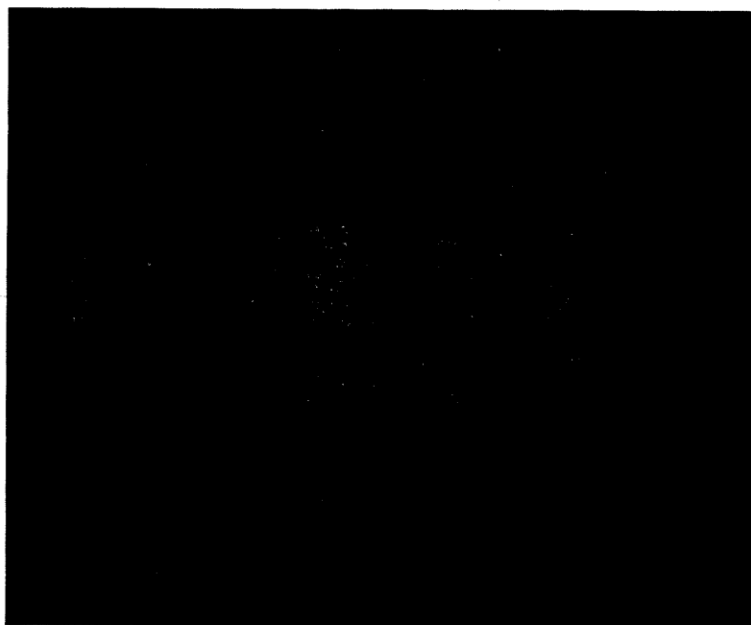
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4. Infringement Litigation

4.1. Infringement Litigation Decision. Subject to Sections 4.2 - 4.4 and 7.2(c), Everlight shall have the exclusive right to determine whether to bring any action for infringement of any of the Assigned Patents.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]



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[REDACTED]

[REDACTED]

e. Gentex has no ongoing litigation or imminent threat or expectation of litigation involving the Assigned Patents.

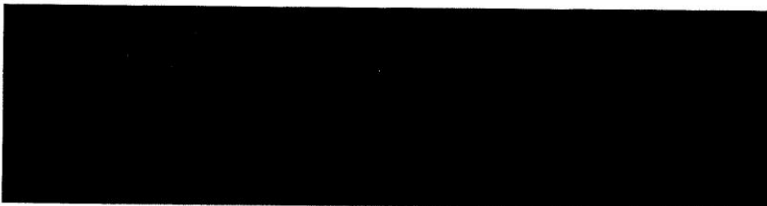
7.3. Nothing contained in this Agreement shall be construed as a warranty or representation that the manufacture, sale, lease, use, or other transfer or disposition of any product by either Party or any component thereof will be free from infringement of patents or other intellectual property or other rights third parties.

7.4. ALL INFORMATION AND MATERIALS PROVIDED TO EITHER PARTY ARE PROVIDED "AS IS" AND "WITH ALL FAULTS." EXCEPT AS EXPRESSLY PROVIDED HEREIN, THE PARTIES MAKE NO OTHER WARRANTIES EXPRESS OR IMPLIED, OF ANY KIND WITH RESPECT TO THE SUBJECT MATTER OF THIS AGREEMENT, INCLUDING ANY WARRANTIES OF MERCHANTABILITY, FITNESS FOR PURPOSE, NON-INFRINGEMENT, OR THOSE ARISING FROM CUSTOM OF TRADE OR COURSE OF DEALINGS. NOTHING IN THIS AGREEMENT SHALL BE DEEMED TO BE A REPRESENTATION OR WARRANTY BY EITHER PARTY TO THE OTHER PARTY OF THE ACCURACY, SAFETY, USEFULNESS, FREEDOM-TO-PRACTICE OR FREEDOM-TO-USE FOR ANY PURPOSE, ANY PROPERTY AND/OR TECHNICAL INFORMATION, TECHNIQUES, OR PRACTICES AT ANY TIME MADE AVAILABLE BY THAT PARTY WITH RESPECT TO THE SUBJECT MATTER OF THIS AGREEMENT.

[REDACTED]



5. Patent Maintenance. Everlight shall, at its own expense, keep each of the Assigned Patents in effect by paying all maintenance fees or annuities. This provision shall not impose an obligation of maintenance of the Assigned Patents on Everlight, and Everlight may, at its discretion, waive the Assigned Patents.

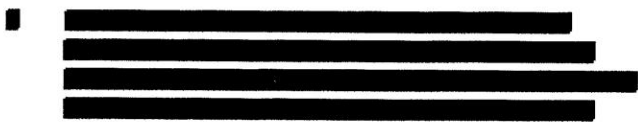


7. Representations and Warrants.

7.1. Each Party warrants to the other Party that it has the power and authority to enter into this Agreement and that its performance will not violate any duties it owes to any third parties.

7.2. Gentex warrants to Everlight that:

- a. Gentex is the legitimate owner of all and the entire rights in and title to the Assigned Patents and any corresponding foreign applications, second filings, divisions, continuations, continuation in part applications, renewals and extensions thereof and other terms and expressions which may be used from time to time in various countries for the same purposes as of the Effective Date; and
- b. The rights in the Assigned Patents have not been abandoned and all the maintenance fees for the Assigned Patents have been paid on time up to the Effective Date.



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12. Integration. Except for the Confidentiality and Non-Disclosure Agreement having an effective date of October 21, 2015 ("NDA"), this Agreement contains the entire and only understanding between the Parties with respect to the subject matter hereof and supersedes any prior or collateral agreements, negotiations and communications in connection with the subject matter covered herein, whether oral or written, and any warranty, representation, promise, or condition in connection therewith not incorporated herein shall not be binding upon either Party, and both Parties agree that this Agreement sets forth the entire agreement and understanding between the Parties as to the subject matter hereof and merges all prior discussions between them. Neither of the Parties shall be bound by any warranties, understandings, or representations other than as expressly provided herein. The terms of this Agreement are confidential information and subject to the terms of the NDA. The term of the NDA is hereby amended to be consistent with the term of this Agreement.

13. Severability. Both Parties agree that if any particular provision of this Agreement shall be judicially determined to be invalid, illegal or unenforceable in any respect for any reason, the remainder of this Agreement shall remain in full force and effect and the provision(s) in question shall be reformed so as to as nearly as possible achieve the purpose of the provision(s) in question.

14. Effect on Successor and Assigns. To the extent this Agreement is assignable, this Agreement shall bind and inure to the benefit of the Parties hereto, and their successors and assigns.

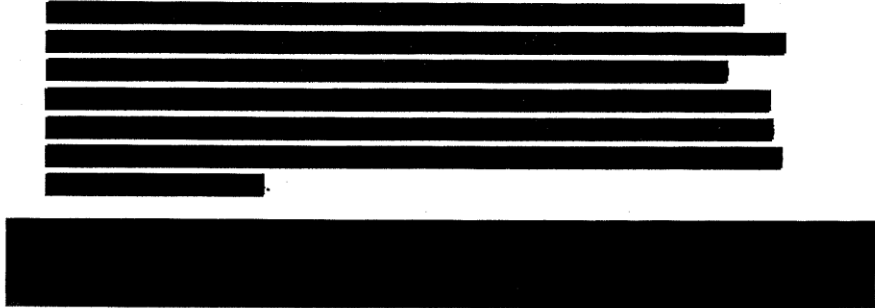
15. No Joint Venture. In all matters relating to this Agreement, the Parties are independent contractors. Neither Party will represent that it has any authority to assume or create any obligation, express or implied, on behalf of the other Party.

16. Condition of Binding Agreement; Amendments. This Agreement shall not be binding upon the Parties until it has been signed below by or on behalf of each Party. Both Parties agree that no oral modifications to this Agreement shall be legally binding on either Party. This Agreement may only be amended in writing, signed by the Parties. The waiver or failure of either Party to exercise in any respect any right provided for such Party herein shall not be deemed a waiver of any further right hereunder.

17. Force Majeure. Neither Party shall be liable for a default of any obligation under this Agreement, if such default results from a force majeure, which includes, without limitation,

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9. **Notice.** All notices and other communications hereunder shall be in writing and shall be deemed given (a) when received, if delivered personally, via overnight courier, or via facsimile, or (b) five (5) business days after mailing, if mailed by registered or certified mail, return receipt requested, to the Parties at the following address (or such addresses as they may hereafter specify by a notice complying herewith);

For Gentex:
Gentex Corporation
Attn: Legal Department
600 N. Centennial St.
Zeeland, MI 49464 USA
Tel: +1 (616) 772-1800
legal.notification@gentex.com

For Everlight:
Everlight Electronics Co., Ltd.
No. 6-8 Zhonghua Rd.
Shulin Dist.
New Taipei City 23860, Taiwan
Tel: +886(2)2685-6688
Attention: Senior Director, Henry Hsu
henryhsu@everlight.com

10. **Changes in Address.** Both Parties agree to notify the other Party in writing of any changes in address or attorney.

11. **Choice of Law.** Both Parties agree that any controversy or claim arising out of or relating to this Agreement, or the breach thereof, shall be interpreted, enforced, and governed by the laws of the State of California, without regard to its principles of the conflicts of laws. The Parties agree to the exclusive jurisdiction of the state or federal courts located in the Northern District of California, and waive any objection on the grounds of lack of personal jurisdiction or venue (forum non conveniens or otherwise) to the exercise of such jurisdiction over either of them by these courts. The Parties agree that the United Nations Convention on Contracts for the International Sale of Goods shall not apply to this Agreement.

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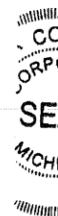
governmental acts or directives, strikes, acts of God, war, insurrection, riot or civil commotion, fires, flooding or water damage, explosions, embargoes, or delays in delivery, whether of the kind herein enumerated or otherwise, which are not within the reasonable control of the Party affected. The foregoing shall not be construed as a waiver of either Party's obligations under this Agreement, and as soon as such condition shall cease, the Party affected shall promptly fulfill its obligations.

18. **Interpretation.** Unless the context of this Agreement clearly requires otherwise, (i) references to the plural include the singular, and references to the singular include the plural, (ii) the words "include," "includes," and "including" do not limit the preceding terms or words and shall be interpreted as if followed by the words "without limitation," (iii) the terms "hereof," "herein," "hereunder," "hereto," and similar terms in this Agreement refer to this Agreement as a whole and not to any particular provision of this Agreement, (iv) the terms "day" and "days" mean and refer to calendar day(s), (v) the term "quarter" and "quarters" mean and refer to calendar quarter(s), and (vi) the term "year" and "years" mean and refer to calendar year(s). The headings and designated sections of this Agreement are inserted for convenience of reference only and are not intended to be a part of or to affect the meaning or interpretation of this Agreement. The Parties have participated jointly in the negotiation of this Agreement. In the event an ambiguity or question of intent or interpretation arises, the Agreement shall be construed as if drafted jointly by the Parties and no presumption or burden of proof shall arise favoring or disfavoring any Party by virtue of the authorship of any of the provisions of this Agreement.

19. **Waiver.** No relaxation, forbearance, delay or negligence by any Party in enforcing any of the terms and conditions of this Agreement, or the granting of time by any Party to another, shall operate as a waiver or prejudice, affect or restrict the rights, powers, or remedies of any Party hereto.

[REDACTED]

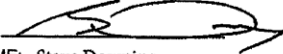
21. **Counterparts and Electronic Copies.** This Agreement may be executed on facsimile, email, or scanned copies in multiple counterparts, each of which shall be deemed an original and all of which together shall constitute one and the same Agreement.

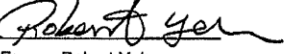


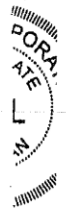
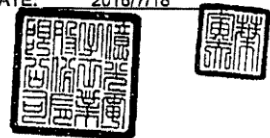
IN WITNESS WHEREOF, the Parties have executed this Agreement through their duly authorized representatives as of the Effective Date set forth above:

GENTEX CORPORATION

EVERLIGHT ELECTRONICS CO., LTD

BY: 
NAME: Steve Downing
TITLE: Senior Vice President
DATE: 2016/7/18

BY: 
NAME: Robert Yeh
TITLE: President
DATE: 2016/7/18



APPENDIX A

U.S. Patent No. 6,335,548 entitled "Semiconductor Radiation Emitter Package"

U.S. Patent No. 6,521,916 entitled "Radiation Emitter Device Having An Encapsulant With Different Zones Of Thermal Conductivity"

U.S. Patent No. 7,118,931 entitled "Radiation Emitter Device Having An Integral Micro-Groove Lens"

U.S. Patent No. 7,253,448 entitled "Semiconductor Radiation Emitter Package"

EP Patent No. 1169735 entitled "Semiconductor Radiation Emitter Package"

JP Patent 3850665 entitled "Semiconductor Radiation Emitter Package."

KR 768539 entitled "Semiconductor Radiation Emitter Package."

MX 243935 entitled "Semiconductor Radiation Emitter Package."

CA 2,430,747 entitled "Semiconductor Radiation Emitter Package."

APPENDIX B

PATENT ASSIGNMENT

This ASSIGNMENT from GENTEX CORPORATION, a Michigan corporation having a place of business at 600 N. Centennial Street, Zeeland, Michigan 49464 (the "Assignor"), to EVERLIGHT ELECTRONICS CO., LTD, a Taiwanese Corporation having a place of business at No. 6-8, Zhongua Rd. Shun Dist, New Taipei City 23860, Taiwan (the "Assignee") is entered into and effective as of the date written below.

WHEREAS, Assignor is the sole owner of the entire right, title and interest in and to the patents listed below: (the "ASSIGNED PATENTS")

- U.S. Patent No. 6,335,548 entitled "Semiconductor Radiation Emitter Package"
- U.S. Patent No. 6,521,916 entitled "Radiation Emitter Device Having An Encapsulant With Different Zones Of Thermal Conductivity"
- U.S. Patent No. 7,118,931 entitled "Radiation Emitter Device Having An Integral Micro-Groove Lens"
- U.S. Patent No. 7,253,448 entitled "Semiconductor Radiation Emitter Package"
- EP Patent No. 1169735 entitled "Semiconductor Radiation Emitter Package"
- JP Patent 3850665 entitled "Semiconductor Radiation Emitter Package."
- KR 768539 entitled "Semiconductor Radiation Emitter Package."
- MX 243935 entitled "Semiconductor Radiation Emitter Package."
- CA 2,430,747 entitled "Semiconductor Radiation Emitter Package."

WHEREAS, Assignee desires to acquire from Assignor, and Assignor desires to assign to Assignee, all of Assignor's right, title and interest in and to the ASSIGNED PATENTS, together with the right to recover for the past, present and future infringements and violations thereof;

NOW, THEREFORE, to all whom it may concern, be it known that for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, Assignor hereby sells, assigns, transfers and conveys to Assignee the entire rights, title and interest to Assignee, in and to the ASSIGNED PATENTS, including any reissues, all foreign issues, any divisions, any substitutions or extensions, all continuations or continuations-in-part, any certificates of reexamination already granted or which may be granted the same to be held and enjoyed by Assignee for its own use and enjoyment, and for the use and enjoyment of its successors, assigns

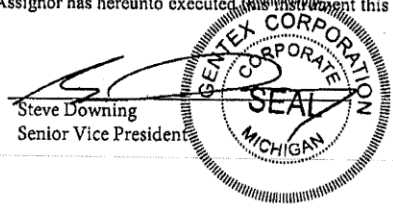
or other legal representatives, to the end of the term or terms for which the ASSIGNED PATENTS are or may be granted, reissued or extended; together, with all claims for damages by reason of past, present or future infringement of the ASSIGNED PATENTS, with the right to sue for, and collect the same for Assignor's own use and behalf, and on behalf of its successors, assigns or other legal representatives.

FURTHER, Assignor agrees that upon request and without further compensation, but at no expense to Assignor, it and its legal representatives and assigns shall do all lawful acts, including the execution of papers and the giving of testimony, that may be necessary or desirable for maintaining, reissuing or enforcing the ASSIGNED PATENTS. Assignor hereby authorizes and requests the Commissioner of Patents and Trademarks or an equivalent officer in any jurisdiction in which the ASSIGNED PATENTS may issue or have issued, any and all Letters Patent on said inventions to Assignee as assignee of the herein assigned.

Assignor represents and warrants that he has not granted and will not grant to others any rights inconsistent with the rights granted herein other than those rights described in the Patent Assignment Agreement dated July 25, 2016.

IN WITNESS WHEREOF, Assignor has hereunto executed this instrument this 25th day of July, 2016.

GENTEX CORPORATION:



STATE OF Michigan)
) ss.
COUNTY OF Ottawa)

On July 25, 2016, before me, Kristal L. DeZwaan, Notary Public in and for said State, personally appeared Steve Downing, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument and acknowledged to me that he/she executed the same in his/her authorized capacity, and that by his/her signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

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WITNESS my hand and official seal.

Signature Kresta L. Dezwaan



KRESTA L. DEZWAAN
Notary Public, State of Michigan
County of Kent
My Commission Expires Oct. 11, 2017
Acting in the County of Ottawa

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APPENDIX C

U.S. Patent	Description	Foreign Patent
5,803,579	Illuminator Assembly Incorporating Light Emitting Diodes	JP 3717943 CA 2,258,049 CA 2,497,515 MX 216207
6,132,072	LED Assembly	JP 3717943 CA 2,258,049 CA 2,497,515 MX 216207
6,523,976	LED Assembly	JP 3717943 CA 2,258,049 CA 2,497,515 MX 216207
6,550,949	Enhancing Rear Vision From A Vehicle	JP 3827952 CA 2,343,781 MX 257580
6,670,207	Radiation Emitter Device Having Micro-Groove Lens	
6,828,170	Method of Making A Semiconductor Radiation Emitter	
6,849,867	Method Of Making Radiation Emitter Devices	
7,524,097	Light Emitting Assembly	JP 3717943 CA 2,258,049 CA 2,497,515 MX 216207

NOTATION

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APPENDIX D

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APPENDIX E



NOTION



FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-1130-17

STYLE OF CAUSE: EVERLIGHT ELECTRONICS CO., LTD v THE
COMMISSIONER OF PATENTS (ATTORNEY
GENERAL OF CANADA)

PLACE OF HEARING: MONTRÉAL, QUEBEC

DATE OF HEARING: NOVEMBER 30, 2017

JUDGMENT AND REASONS: MARTINEAU J.

DATED: DECEMBER 5, 2017

APPEARANCES:

Me Camille Aubin

FOR THE APPLICANT

FOR THE RESPONDENT

SOLICITORS OF RECORD:

ROBIC, LLP
Montréal, Quebec

FOR THE APPLICANT

Attorney General of Canada

FOR THE RESPONDENT