

Federal Court



Cour fédérale

Date: 20190117

Docket: T-1778-18

Citation: 2019 FC 70

Ottawa, Ontario, January 17, 2019

PRESENT: Mr. Justice Grammond

BETWEEN:

GILEAD SCIENCES, INC.

Applicant

and

COMMISSIONER OF PATENTS

Respondent

JUDGMENT AND REASONS

[1] Gilead Sciences, Inc. [Gilead] owns certain patents. Jeff Zablocki and Elfatih Elzein are currently listed as the inventors of those patents. After an investigation, Gilead discovered that Robert Seemayer and Travis Lemons should also have been named as inventors. Gilead now applies for an order directing the Commissioner of Patents to vary the records concerning those patents, so that Messrs. Seemayer and Lemons can be added as inventors. I grant Gilead's application.

[2] An application of this kind is governed by section 52 of the *Patent Act*, RSC 1985, c P-4. Section 52 states that this Court has jurisdiction to order the variation of any entry in the records of the Patent Office. Section 52 does not set out the circumstances in which such an order may be made. This Court has said, however, that the criteria found in section 31(4), which governs the addition of applicants to a patent application, are relevant to an application under section 52 (*Micromass UK Ltd v Canada (Commissioner of Patents)*, 2006 FC 117; *Plasti-Fab Ltd v Canada (Attorney General)*, 2010 FC 172). Section 31(4) allows further applicants to be joined where “the omission of the further applicant or applicants had been by inadvertence or mistake and was not for the purpose of delay.”

[3] I am satisfied, on the basis of the application record, that Messrs. Seemayer’s and Lemons’s names have been omitted from the original application by inadvertence or mistake. Upon my request, counsel for Gilead confirmed that there is no pending litigation concerning the patents at issue. Gilead’s application is supported by affidavits of Messrs. Zablocki, Elzein, Seemayer and Lemons, who all consent to the proposed amendment. I also note that a similar application was made with respect to the corresponding American patents and was granted by the United States Patent and Trademark Office. There is no evidence of any improper purpose.

[4] For those reasons, Gilead’s application is granted.

JUDGMENT in T-1778-18

THIS COURT’S JUDGMENT is that:

1. The Commissioner of Patents shall, under section 52 of the Patent Act, vary all entries in the records of the Patent Office relating to:
 - (a) Canadian Patent No. 2,640,089 issued on July 23, 2013;
 - (b) Canadian Patent No. 2,685,589 issued on September 16, 2014; and
 - (c) Canadian Patent No. 2,787,759 issued on March 31, 2015,to correct the names of the inventors by adding Robert Seemayer and Travis Lemons as co-inventors.
2. No order as to costs.

“Sébastien Grammond”

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-1778-18

STYLE OF CAUSE: GILEAD SCIENCES, INC. v THE COMMISSIONER OF PATENTS

APPLICATION CONSIDERED IN WRITING AT OTTAWA, ONTARIO

JUDGMENT AND REASONS: GRAMMOND J.

DATED: JANUARY 17, 2019

WRITTEN REPRESENTATIONS BY:

Jeremy Want
Matthew Burt

FOR THE APPLICANT

SOLICITORS OF RECORD:

Smart & Biggar
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Ottawa, Ontario

FOR THE APPLICANT