

Federal Court



Cour fédérale

**Date: 20190219**

**Docket: T-2111-18**

**Citation: 2019 FC 208**

**Toronto, Ontario, February 19, 2019**

**PRESENT: The Honourable Mr. Justice Pentney**

**BETWEEN:**

**ASTELLAS PHARMA INC.**

**Applicant**

**and**

**COMMISSIONER OF PATENTS**

**Respondent**

**JUDGMENT AND REASONS**

[1] Astellas Pharma Inc. [Astellas] owns Canadian Patent No. 2,503,570 (“the 570- Patent”). Astellas is seeking an Order of this Court pursuant to s. 52 of the Patent Act, RSC 1985, c P-4, (“the Act”) to add Masayuki Shibasaki (“Dr. Shibasaki”) as a co-inventor to the 570 Patent. For the reasons set out below, I am granting this application.

[2] The 570 Patent was issued from an application filed on November 4, 2003 (PCT Application No. PCT/JP03/014065). It claims priority from a Japanese Patent Application filed November 7, 2002. Through an error, the Japanese Application listed Toshiyuki Takasu, Suichi

Sato, Masashi Ukai and Tatsuya Maruyama as co-inventors, but omitted to include Dr. Shibasaki as a co-inventor. This error was repeated in the PCT Application, which was then carried forward to the national phase entry form.

[3] The 570 Patent claims the use of a chemical compound for the treatment of overactive bladder. Dr. Shibasaki was an employee of a predecessor company (which merged with another to form Astellas in 2005). He proposed the idea of the use of the chemical compound for this application, but he was not part of the team that completed the invention that is the subject matter of the Japanese Application and the 570 Patent. Based on the affidavit evidence, it appears that this omission was simply an oversight. Dr. Shibasaki and Suichi Sato have both sworn affidavits explaining this background, and both indicate their consent to the addition of Dr. Shibasaki as a co-inventor. In response to questions from the Court, Astellas has filed documents indicating that the other co-inventors give their consent as well.

[4] Pursuant to s. 52 of the *Act*, this Court has jurisdiction to direct the Commissioner of Patents to correct the records regarding who is listed as an inventor or co-inventor; the Commissioner has no authority to do this without a Court Order: *Micromass UK Ltd v Canada (Commissioner of Patents)*, 2006 FC 117, at paras 12-13. Astellas is a “person interested” pursuant to s. 52, and as such has standing to bring this application. The Commissioner of Patents took no position on the merits of the application, and did not file any materials or participate in the matter, which was dealt with in writing pursuant to Rule 369 of the *Federal Courts Rules*, SOR/98-106.

[5] In prior cases involving the addition or deletion of an inventor’s (or co-inventor’s) name, the Court has considered the test set out in sub-sections 31(3) and (4) of the *Act*, which relate to

the addition or removal of applicants to a pending patent application: *Plasti-Fab v Canada* (Commissioner of Patents, 2010 FC 172, at para 14; *Qualcomm Inc v Canada* (Commissioner of Patents), 2016 FC 1092; *Gilead Sciences Inc. v Canada* (Commissioner of Patents), 2019 FC 70. The pertinent part for the purposes of this application requires that the Court be satisfied: (i) that the person should be joined as a co-inventor; and (ii) “that the omission of the further applicant or applicants had been by inadvertence or mistake and was not for the purpose of delay” (subsection 31(4)).

[6] I am satisfied, on the basis of the application record, that Dr. Shibasaki should be added as a co-inventor, because he made a substantial contribution to the inventive concept: *Apotex Inc. v Wellcome Foundation Ltd.*, 2002 SCC 77. I am also satisfied that his name was omitted from the original application by inadvertence or mistake, and was not for the purpose of delay. All of the co-inventors have given their consent to the addition of Dr. Shibasaki’s name as a co-inventor.

[7] Counsel have confirmed that they are not aware of any pending litigation relating to the 570 Patent. Counsel have also indicated that they are not aware of any other party, other than the Commissioner of Patents, that is directly affected by the order sought. Furthermore, Dr. Shibasaki’s name has already been added as a co-inventor in regard to the United States Corresponding Applications.

[8] For these reasons, Astellas’ application is granted. The Applicants did not seek their costs, and none are granted.

**JUDGMENT in T-2111-18**

**THIS COURT'S JUDGMENT is that:**

1. The Commissioner of Patents shall, pursuant to s. 52 of the *Patent Act*, vary the records in the Patent Office relating to Canadian Patent No. 2,503,570 issued April 19, 2011 to correct the names of the co-inventors by adding Masayuki Shibasaki as a co-inventor.
2. No order as to costs.

“William F. Pentney”

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Judge

**FEDERAL COURT**  
**SOLICITORS OF RECORD**

**DOCKET:** T-2111-18  
**STYLE OF CAUSE:** ASTELLAS PHARMA INC. v. COMMISSIONER OF PATENTS  
**JUDGMENT AND REASONS:** PENTNEY J.  
**DATED:** FEBRUARY 19, 2019

**SOLICITORS OF RECORD:**

Erin Creber  
Jay Zakaib  
Gowling WLG  
Barristers and Solicitors  
Ottawa, Ontario  
  
Attorney General of Canada

FOR THE APPLICANT

FOR THE RESPONDENT