

Federal Court



Cour fédérale

**Date: 20240828**

**Docket: T-1328-24**

**Citation: 2024 FC 1339**

**Ottawa, Ontario, August 28, 2024**

**PRESENT: The Honourable Madam Justice Furlanetto**

**BETWEEN:**

**EVERY DENNISON CORPORATION**

**Applicant**

**and**

**THE COMMISSIONER OF PATENTS**

**Respondent**

**JUDGMENT AND REASONS**

[1] By this application, the Applicant Avery Dennison Corporation [ADC] seeks to amend the records of the Patent Office to add Johannes Uijlenbroek [Uijlenbroek] as a named inventor of Canadian Patent No. 2,962,632 [632 Patent] and to change the ownership of the 632 Patent from ADC to Ferm RFID Solutions B.V. [Ferm]. The Applicant asserts that Uijlenbroek was omitted from the list of named inventors on the 632 Patent by inadvertence or mistake. It also refers to a decision of the Hague Court in the Netherlands relating to corresponding European Patent Applications [EP Applications] that requires the Applicant to correct the inventorship and

ownership of the EP Applications and its corresponding foreign filings, which it says includes the 632 Patent, in the manner requested on this motion.

[2] The Attorney General of Canada on behalf of the Respondent Commissioner of Patents takes no position on this application and has filed no submissions in response to the Applicant's request.

[3] For the reasons set out below, it is my view that the Applicant's request should be granted.

I. Analysis

[4] Pursuant to section 52 of the *Patent Act*, RSC, 1985, c P-4 [Act], the Court has jurisdiction to order that an entry in the records of the Patent Office relating to the title of a patent be varied at the request of a person interested in the patent. The word "title" in section 52 of the Act has been broadly interpreted by this Court to include errors relating to both the inventorship and ownership of a patent: *Gray Manufacturing Company Inc v Canada (Attorney General)*, 2016 FC 55 at para 9.

[5] With respect to a request to add an inventor to an issued patent, reference has been made to the provision of the Act relating to the addition of applicants to a pending patent application – namely, subsection 31(4) of the Act. Applied in this context, to add an inventor this would require that the Court be satisfied that: (i) the person should be joined as a co-inventor; and

(ii) the omission of the inventor was by inadvertence or mistake and was not for the purpose of delay: *Pharma Inc v Canada (Commissioner of Patents)*, 2019 FC 208 at para 5.

[6] In this case, the request for correction is made by ADC, the listed owner of the 632 Patent. As the sole owner of the 632 Patent, ADC is a person interested under section 52 of the Act: *Qualcomm Inc v Canada (Commissioner of Patents)*, 2016 FC 1092 at para 10.

[7] The 632 Patent issued from a national phase filing arising from a Patent Cooperation Treaty [PCT] application. The PCT application claimed priority from two United States [US] provisional patent applications 62/056,920 [920 Application] and 62/072,806 [US Priority Applications], which listed ADC as the owner and an employee of ADC, Pavel Janko [Janko], as the sole inventor.

[8] However, the evidence establishes that the 920 Application, which was the earlier of the two US provisional patent applications, was filed with haste and did not set out the full inventorship of the subject-matter of the application. This error perpetuated in the subsequent provisional patent application filing and the foreign patent application filings that claimed priority to the US Priority Applications.

[9] As set out in the evidence, in 2013, the European affiliate of ADC partnered with Ferm to develop and commercialize a tire tracking radio-frequency identification [RFID] label “that could be incorporated into car tires and withstand the harsh conditions of vulcanization applied to the tire”. The work in this area had begun in 2008 with Uijlenbroek, after Ferm was founded,

and continued after the partnership was formed. It was described in the evidence by Janko as a collaboration involving Uijlenbroek, Janko and another ADC employee, Denis Markov [Markov], in which Janko and Markov assisted Uijlenbroek with aspects of the invention and created and supplied materials required to commercialize the invention.

[10] ADC and Ferm could not come to an agreement as to the ownership of the patent rights arising from the collaboration on the RFID Tracking Label. When the PCT Application was filed, claiming priority to the US Priority Applications, it remained in the name of ADC and listed only Janko and Markov as inventors.

[11] When the application for the 632 Patent was filed in the national phase, it claimed priority to the US Priority Applications and consistent with those applications and the PCT Application, did not include Uijlenbroek as an inventor. At the same time, ADC similarly filed the EP Applications (EP3201841A1 and EP3637322A1), claiming priority to the US Priority Applications. The EP Applications also did not name Uijlenbroek as an inventor.

[12] The ownership and inventorship of the patent filings were ultimately raised before the Hague Court in the Netherlands. On April 24, 2024, the Hague Court released its decision, ordering ADC to register Uijlenbroek as an inventor of the EP Applications and its foreign related patents. The Hague Judgment also ordered ADC to transfer ownership of the EP Applications and its related patents to Ferm:

11.13 Orders ADC to transfer by deed to Ferm the EP 841 and EP 322 applications within four weeks of service of this judgment and to transfer to Ferm the patent applications and granted patent rights

related to EP 841 and EP 322 in the manner prescribed in the respective countries;

[..]

11.15 Orders ADC to cooperate within four weeks of service of this judgment, in registering with the patent granting authorities Uijlenbroek as the inventor of and Ferm as the rightful owner of applications EP 841 and EP 322 and the patent applications and granted patent rights related to those applications;

[13] In my view the evidence before me, which includes affidavits from Janko and Uijlenbroek, is sufficient to establish that Uijlenbroek made a significant contribution to the development of the invention underlying the 632 Patent and that in accordance with the Hague Judgment he should be named as an inventor on the patent. I am also satisfied from the evidence of Wendy Choi, Vice President & Associate General Counsel, IP, of ADC, that the omission of Uijlenbroek as a named inventor was by mistake such that the Court should exercise its discretion to order that the mistake be corrected.

[14] With respect to the issue of ownership, I am similarly satisfied from the Hague Judgment and the evidence filed, which indicates the consent of both ADC and Ferm to the relief requested, that the ownership of the 632 Patent should be with Ferm.

[15] While the Application Record does not include an affidavit from Markov, I note that Markov assigned all of his rights, title and interest to the 632 Patent and its underlying invention to ADC on November 13, 2015. As such, he no longer has any interest in the 632 Patent. Accordingly, I do not consider his evidence to be essential to this application and there is no evidence of any other party that is directly affected by this Judgment. Further, there is no

evidence of any ongoing litigation relating to the 632 Patent and the Applicant has confirmed that they are not aware of any such litigation.

[16] For all of these reasons, the application is granted.

**JUDGMENT IN T-1328-24**

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

1. The 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. 2,962,632, issued October 3, 2023, to:
  - (a) correct the names of the inventors, by adding Johannes Uijlenbroek as an inventor;
  - (b) correct the owner of Canadian Patent No. 2,962,632 from Avery Dennison Corporation to Ferm RFID Solutions B.V.
3. No costs are awarded.

"Angela Furlanetto"

---

Judge

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

**DOCKET:** T-1328-24

**STYLE OF CAUSE:** AVERY DENNISON CORPORATION v THE  
COMMISSIONER OF PATENTS

**MOTION IN WRITING CONSIDERED AT OTTAWA, ONTARIO PURSUANT TO  
RULE 369 OF THE *FEDERAL COURTS RULES***

**JUDGMENT AND REASONS:** FURLANETTO J.

**DATED:** AUGUST 28, 2024

**WRITTEN SUBMISSIONS BY:**

Christopher Van Barr  
Alex Gloor  
Richard Du

FOR THE APPLICANT

**SOLICITORS OF RECORD:**

Gowling WLG (Canada) LLP  
Barristers and Solicitors  
Ottawa, Ontario

FOR THE APPLICANT