

Federal Court



Cour fédérale

Date: 20140124

**Dockets: T-2231-12
T-2232-12
T-2233-12**

Citation: 2014 FC 80

Ottawa, Ontario, January 24, 2014

PRESENT: The Honourable Mr. Justice Beaudry

BETWEEN:

**THE REGENTS OF THE UNIVERSITY OF
CALIFORNIA**

Applicant

and

THE COMMISSIONER OF PATENTS

Respondent

REASONS FOR JUDGMENT AND JUDGMENT

[1] This is an application for judicial review pursuant to section 18.1 of the *Federal Courts Act*, RSC 1985, c F-7, of a decision by the Commissioner of Patents [the Commissioner] dated November 15, 2012 in the course of patent conflict proceedings under section 43 of the *Patent Act* RSC 1985, c P-4, as it read prior to October 1, 1989 [the *Act*].

[2] For the following reasons, the application for judicial review will be dismissed.

Background and Facts

[3] The Applicant filed three patent applications over 30 years which are each the subject of Court files T-2231-12, T-2232-12, and T-2233-12, respectively. Each of these patent applications is involved in the conflict proceeding along with 7 other patent applications.

[4] Under the pre-October 1989 system, when two or more patent applications dealt with very similar subject matter the Commissioner would initiate a conflict proceeding pursuant to section 43 of the *Act*.

[5] The conflict procedure is explained by Justice Hughes in *Mycogen Plant Science Inc v Bayer Bioscience NV*, 2010 FC 124 at para 9:

9 Essentially the conflict process began when the Patent Office examiners perceived that there were two or more applications pending before the Office that appeared to be directed to the same subject matter. Under the pre-October 1, 1989 system all patent applications were confidential and not available to the public. That remains the case with the applications at issue here. The Patent Office would select claims from the applications that appeared best to cover the subject matter common to all applications, or even draft such claims. These common claims would be presented to each of the applicants who could choose to remain in the conflict proceedings by including some or all of these claims in their application if they were not there already. The applicants were then invited to submit affidavits setting out facts that would establish the date of invention by their named inventors. Some would choose to rely only on the filing date of the application in Canada or a foreign country if the Canadian application claimed priority from such application. When all evidence was in, the Commissioner of Patents would review the evidence and make a determination as to which inventors had first made the invention as described in the subject matter of the conflict claims. Sometimes some inventors were first in respect of some of the claims and other inventors in respect of other claims. The claims would be awarded by the Commissioner to the application of the first inventor of each claim at issue and all the applications would proceed to final examination. However any party

to the conflict could, after receipt of the Commissioner's decision, if dissatisfied, commence an action in the Federal Court for a re-determination as to first to invent and consequent award of claims. This is not an appeal nor a judicial review but an action in which a fresh determination is made. In such an action redrafted claims (so-called substitute claims) could be proposed for resolution in the conflict. The Federal Court action would proceed as any other action and would be subject to appeal in the usual way.

[6] Conflict applications are not available to the public and details of the prosecution of each conflicting application are not discussed with, or divulged to other parties to the conflict.

[7] The steps of a conflict proceeding are set out in section 43 of the *Act*:

- s. 43(1): identification of a conflict between two or more pending applications, i.e. each of the applications contains one or more claims defining substantially the same invention, or one of the applications contains one or more claims defining the invention disclosed in one of the other applications;
- s. 43(2): notification of the conflict to the applicants together with a copy of the conflicting claims, and giving them an opportunity to add the conflicting claims or similar claims to their applications;
- s. 43(3): sending a preliminary notice of conflict to the applicants who have completed their applications according to subsection (2);
- s. 43(4): invitation to the applicants to avoid the conflict by amending or cancelling conflicting claim(s), or by submitting prior art to the Commissioner, whereupon the Commissioner will re-examine the applications and decide if the subject matter of the conflicting claims is patentable;

- s. 43(5): sending a formal declaration of conflict once the subject matter has been found to be patentable and applicants have elected to keep the conflicting claims in their applications. The applicants participating in the conflict are then required to submit an affidavit of the record of the invention, to establish the date upon which they invented the subject matter defined by the conflicting claim(s);
- ss. 43(6) and (7): examination of affidavits by the Commissioner and communication to the applicants of the Commissioner's decision regarding which applicant was the first to invent;
- s. 43(8): rejection or allowance of the claim(s) in conflict in accordance with the Commissioner's decision, unless one of the applicants commences proceedings in the Federal Court to determine the applicants' rights.

[8] The Commissioner, pursuant to sections 43(3) and 43(4) of the *Act*, notified the Applicant of the ongoing conflict claims and invited the Applicant to submit prior art which may cause the conflicting claims to be unpatentable in any of the applications in conflict. Sections 27(1) and 61(1) set out the requirements for patentability with respect to prior art.

[9] The Applicant responded with its submissions to the Commissioner. The submissions included prior art as well as a discussion of the patentability of certain conflict claims included in the conflict proceedings.

[10] The Applicant submitted that:

- i) prior art published more than two years before a patent application was filed should be cited against certain claims and applicants;
- ii) prior art published less than two years before a patent application was filed, but before the priority date of the patent applications, should also be cited against certain claims and applicants;
- iii) all categories of prior art should be assessed both with respect to novelty and obviousness of the subject matter of the conflict claims; and

[11] On November 15, 2012, the Commissioner sent the applicant a letter [the letter] in response to the Applicant's submissions. This letter is the subject of this judicial review.

[12] In the letter, the Patent Examiner, writing for the Commissioner, explained that the documents submitted by the Applicant pursuant to section 43(4) of the *Act* and subject to section 27(1)(b) of the *Act* (i.e. published more than two years prior to the filing dates of the applications in conflict) had been considered.

[13] The Examiner noted in the letter that documents subject to the provisions of section 27(1)(a) of the *Act* (i.e. published less than two years prior to the filing dates) have not yet been considered as this requires knowledge of the date of invention for the contested claims.

[14] The Examiner further explained that issues related to the sufficiency of disclosure can only be addressed after the submission of affidavits pursuant to section 43(5) of the *Act*;

[15] Finally, the Examiner informed the Applicant that he is given six months from the date of the letter to file in the Patent Office an affidavit of the record of the invention as required by section 43(5) of the *Act*.

[16] The judicial reviews in T-2231-12, T-2232-12 and T-2233-12 were filed on December 14, 2012. The files were consolidated on April 11, 2013 by order of Prothonotary Morneau with T-2231-12 serving as the primary Court file.

[17] On May 13, 2013, the Respondent filed a Motion to dismiss the application for judicial review pursuant to section 18.5 of the *Federal Courts Act*.

Relevant Legislation

[18] The relevant sections of the *Act* are reproduced as Annex A at the end of this judgment.

Standard of Review

[19] In *Dunsmuir v New Brunswick*, 2008 SCC 9 at para 54 the majority of the Supreme Court instructed that: "...Deference will usually result where a tribunal interpreting or applying its own statute or statutes closely connected to its function, with which it will have particular familiarity". This principle was reiterated in *Alberta (Information and Privacy Commissioner) v Alberta Teachers' Association*, 2011 SCC 61 at paras 30, 39 and applies to the decision in question. As the Commissioner is here applying his home statute, deference is warranted and the applicable standard of review is that of reasonableness.

[20] When assessing a decision on the standard of reasonableness, a reviewing Court will be concerned with “the existence of justification, transparency and intelligibility within the decision-making process” as well as “whether the decision falls within a range of possible, acceptable outcomes which are defensible in respect of the facts and law” (*Dunsmuir* at para 47). On the other hand, questions of procedural fairness are owed no deference and are reviewable on the standard of correctness (*Canada (Minister of Citizenship and Immigration) v Khosa*, 2009 SCC 12 at para 43; *Sketchley v Canada (Attorney General)*, 2005 FCA 404 at para 53).

Applicant’s Arguments

[21] The Applicant argues that the Commissioner incorrectly refused to fully assess and rule on the patentability of the subject matter of the conflict claims before requiring that the patent applicant submit evidence to demonstrate when he invented the subject matter. Specifically, the Commissioner failed to review the prior art published less than two years before the filing date, but before the priority date of the patent applications, as well as the Applicant’s submissions on the issue of disclosure.

[22] The Applicant disagrees with the Commissioner’s position in his November 15, 2012 letter that he is incapable of citing references published less than two years before the filing date but before the priority date of a patent application because he is unaware of the date of invention for a given conflict claim in a given patent application. The Applicant suggests that since the Commissioner is aware of the priority date for a given conflict claim in a given patent application, he can presume that the date of invention is at least as early as the priority date, until an applicant

asserts an earlier date of invention. The Commissioner is therefore capable of citing such “less than two year” references at this time.

[23] The Applicant suggests that section 41 of the *Act* can be applied to allow the applicant to “swear back” to establish a date of invention for the purposes of section 27(1)(a) (see para 105, Applicant’s Memorandum of Fact and Law).

[24] The Applicant further submits that the Commissioner erred when he ruled that disclosure issues would not be assessed at this time, but could be determined at a later stage in the conflict proceeding. While the Commissioner alleges that the remaining issues raised in the Applicant’s submissions can be reviewed at a later stage of the conflict, no such provision is found in the *Act*, the Manual of Patent Office Procedure, or the Handbook of Patent Examination. This results in the unfair situation where if an applicant loses the conflict to another applicant who is subsequently determined not to be entitled to a patent, for the reasons raised in the submissions, the deserving applicant will not have any opportunity to correct the error, other than asking the Federal Court to start the conflict proceeding all over again.

[25] The Commissioner’s refusal to complete a full patentability analysis as required by section 43(5) of the *Act* creates unnecessary procedural and substantive problems as the conflict proceeding will progress, thereby frustrating the Applicant’s desire to bring an end to what is already a 30-year patent application process. The Applicant argues that performing a more complete patentability analysis has the potential to greatly simplify and streamline the conflict proceedings and provides examples to that effect.

[26] The Applicant also alleges that the Commissioner's erroneous refusal to fully review the Applicant's submissions violates their rights of procedural fairness. Under the *Act* there is a duty of procedural fairness imposed on the Commissioner to decide if the subject matter of the conflict claims is patentable before requiring that the patent applicant submit evidence to show when he invented the subject matter. At the section 43(4) stage of a conflict proceeding the Commissioner is required to invite submissions on patentability, to evaluate those submissions, and to decide if the subject matter of the conflict claims is patentable. The section 43(5) stage will only begin once the Commissioner has completed his section 43(4) analysis and has decided that the subject matter is patentable (*Merck & Co v Apotex Inc*, 2010 FC 1265 at para 553). The Applicant asserts that this interpretation of requiring the patentability analysis to precede the question of first to invent is supported by the case law (*Tenneco Chemicals Inc v Hooker Chemical Corp*, [1967] 1 Ex CR 188 at para 6 [*Tenneco*]; *General Tire & Rubber Co v Dominion Rubber Co*, [1996] Ex CR 1164 at paras 45, 46 [*General Tire*]; *Dow Chemical Co v Richardson Co et al*, [1970] Ex CJ No 4 at para 10 [*Dow Chemical*]).

[27] The Applicant submits that had the Commissioner fully assessed and established the patentability of the subject matter of the conflict claims, the scope of the conflict proceeding would be reduced. This simplified conflict proceeding would clarify, inform, and facilitate the decision that the Applicant must make about whether to continue with the conflict proceeding and to what extent. This streamlined process has been lost.

[28] The Applicant further asserts that since the Commissioner has failed to rule on patentability, he will be forced to guess at what the Commissioner will ultimately determine to be patentable and will therefore lose the right to tailor evidence towards patentable subject matter and will lose its right to know the case it has to meet to comply with the subsection 43(5) request.

[29] The Commissioner's error in not undertaking a full patentability analysis creates an untenable situation that erodes the rights of the Applicant to an intelligible process and risks protracted litigation. By proceeding with inappropriate conflict claims in violation of his legal obligations under subsections 43(4) and (5), the Commissioner is effectively transferring this conflict to the Federal Court by way of the *de novo* determination provided for under subsection 43(8) of the *Act*. This will result in a loss of the Commissioner's particular experience and expertise in assessing the patentability of conflict claims, which is particularly relevant in the current context of complex biotechnological innovations.

[30] The Applicant requests that the Court quash the Commissioner's decision and order the Commissioner to review all of the submissions on patentability and decide whether the subject matter of the conflict claims is patentable before requesting that the patent Applicant submit affidavit evidence to demonstrate the date of invention.

Respondent's Arguments

[31] The Respondent underlines that the judicial review proceedings were commenced prematurely as the conflict proceedings process has not been completed and that the judicial review is therefore barred by virtue of section 18.5 of the *Federal Courts Act*, since the Applicant is entitled

to a *de novo* appeal under section 43(8) of the *Act* (*Turmel c Canada (Canadian Radio-Television and Telecommunications Commission)*, 2008 FCA 405 at para 12).

[32] The Applicant underscores that he would lose his rights if the Commissioner were to proceed with determination of first inventorship and he would be limited to the appeal available under section 43(8) of the *Act*. This is not accurate, since the Applicant may submit substituted claims in a *de novo* appeal (*Mycogen Plant Science Inc v Bayer Bioscience NV*, 2009 FC 1013 at para 9).

[33] The Respondent submits that the Applicant's argument that the conflict proceedings may potentially be simplified by a full patentability analysis is at best, opinionated and at worst, a mere conjecture, since the Applicant is only aware of its own submission in the conflict application. Therefore, the examples provided by the Applicant are pure speculations.

[34] Based on the Commissioner's patentability assessment in view of prior art submitted, several claims have been removed. Section 27(1)(a) of the *Act* however requires knowledge of the date of invention which in the case of conflict proceedings can only be ascertained after the stage of affidavit submissions under section 43(5) of the *Act*. Any further reduction of the number of claims in conflict can therefore only be made after the affidavits have been submitted. Contrary to the Applicant's submission, the Commissioner cannot "presume the date of invention"; the basis of conflict proceedings is to determine the inventorship of claims. In seeking this judicial review, the Applicant is attempting to short circuit the conflict proceeding by having the patentability assessment done in advance of the determination of date of invention.

Analysis

[35] The Commissioner's letter of November 15, 2012 included a sufficient analysis of the submissions made by the Applicant in its response. The Commissioner examined prior art published more than two years before the patent applications in accordance with section 27(1)(b) of the *Act* which resulted in a substantial reduction in the number of conflict claims on the basis of patentability. The Commissioner noted that the patentability analysis would necessarily be limited, since "[u]ntil first inventors and dates of invention can be established for all claims of the present conflict, prior disclosure or use may only be cited on the basis of documents applicable under Section 27(1)(b) of the *Patent Act* as it read immediately prior to October 1, 1989."

[36] The Commissioner's interpretation of section 27(1)(a) as requiring that a date of invention be established before this category of prior art can be considered is a reasonable one. The Court agrees with the Respondent that it would be unreasonable to require the Commissioner to "presume the date of invention". Identifying the date of invention is at the very core of conflict proceedings. As observed by Justice Snider in *Sanofi-Aventis Canada Inc v Apotex Inc*, 2009 FC 676 at paras 283, 286, in the context of a conflict proceeding, the Commissioner's "very job was to identify the date of invention..." and the "question of the invention date is not a minor detail".

[37] The cases cited by the Applicant, *Tenneco*, *General Tire* and *Dow Chemical*, support a finding that the Commissioner's decision was reasonable and that the procedure provided for under the *Act* was properly followed.

[38] The Commissioner does not yet have information by which he would be satisfied, based on “less than two year” citations, that any of the subject matter would be unpatentable, since the date of invention has not been assessed. By asking for affidavits attesting to the date of invention, the Commissioner wants to gather all of the information that he needs in order to complete the patentability analysis and therefore satisfy his obligations under sections 43(4) and 43(5) of the *Act*.

[39] The Court also agrees with the Respondent that the Applicant’s allegation that conducting the patentability analysis in the way suggested by the Applicant will result in simplification and expediency is not sufficiently grounded in the facts. Since the conflict proceedings and materials submitted in support of conflict claims are kept confidential, there is no way of predicting the Commissioner’s conclusions on patentability with any certainty.

[40] The Commissioner has not improperly taken away any of the Applicant’s rights in the conflict proceedings process. Both Chapter 18 of the Manual of Patent Office Practice, as it read in January 1990 and chapter 18 of the Handbook of Patent Examination, as it read in February 1993 provide that the rejection of a conflict claim on the basis of it not being patentable can be challenged. The Applicant has recourse to a *de novo* appeal before this Court, as provided for by section 43(8) of the *Act*. Furthermore, conflict proceedings do not dispose of the matter of patentability, but rather only address patentability within the context of determining the question of first to invent (*Branchflower v Akshun Manufacturing Co*, [1965] CCS No 1305).

[41] The Court is of the view that the Applicant has failed to demonstrate a breach of procedural fairness here. There is no evidence also that the Applicant has been treated differently than the other applicants in the conflicting proceedings.

[42] As the decision of the Commissioner was reasonable, this Court's intervention is not justified.

[43] It is not therefore necessary for the Court to address the Respondent's motion to strike the application, as the dismissal of the judicial review is sufficient to dispose of the present matter.

[44] The Court shall grant the Applicant's request for an extension for the filing of affidavit evidence pursuant to section 43(5) of the *Act* in order for the Applicant to have the benefit of the six-month deadline imposed by the Commissioner in his November 15, 2012 letter.

[45] The parties have indicated to the Court that they are not seeking costs.

JUDGMENT

THEREFORE, THIS COURT ORDERS that:

1. The application for judicial review be dismissed;
2. The Applicant shall have six months from the date of this judgment to file to the Commissioner, the affidavit evidence pursuant to section 43(5) of the *Act*;
3. No costs are awarded.

"Michel Beaudry"

Judge

ANNEX A

Patent Act RSC 1985, c P-4, as it read prior to October 1, 1989.

27. (1) Subject to this section, any inventor or legal representative of an inventor of an invention that was

- a) not known or used by any other person before he invented it,
- b) not described in any patent or in any publication printed in Canada or in any other country more than two years before presentation of the petition hereunder mentioned

....

may, on presentation to the Commissioner of a petition setting out the facts, in this Act termed the filing of the application, and on compliance with all other requirements of this Act, obtain a patent granting to him an exclusive property in the invention.

...

43. (1) Conflict between two or more pending applications exists

(a) when each of them contains one or more claims defining substantially the same invention, or

(b) when one or more claims of one application describe the invention disclosed in one of the other applications.

(2) When the Commissioner has before him two or more applications referred to in subsection (1), he shall

a) notify each of the applicants of the apparent conflict and transmit to each of them a copy of

27. (1) Sous réserve des autres dispositions du présent article, l'auteur de toute invention ou le représentant légal de l'auteur d'une invention peut, sur présentation au commissaire d'une pétition exposant les faits, appelée dans la présente loi le « dépôt de la demande », et en se conformant à toutes les autres prescriptions de la présente loi, obtenir un brevet qui lui accorde l'exclusivité propriété d'une invention qui n'était pas :

- a) connue ou utilisée par une autre personne avant que lui-même l'ait faite ;
- b) décrite dans un brevet ou dans une publication imprimée au Canada ou dans tout autre pays plus de deux ans avant la présentation de la pétition ci-après mentionnée ;

...

43. (1) Se produit un conflit entre deux ou plusieurs demandes pendantes dans les cas suivants :

a) chacune d'elles contient une ou plusieurs revendications qui définissent substantiellement la même invention ;

b) une ou plusieurs revendications d'une même demande décrivent l'invention divulguée dans l'autre ou les autres demandes.

(2) Lorsque le commissaire a devant lui deux ou plusieurs de ces demandes, il doit :

a) notifier à chacun des demandeurs le conflit apparent, et transmettre à chacun d'eux une

the conflicting claims, together with a copy of this section; and

b) give to each applicant the opportunity of inserting the same or similar claims in his application within a specified time.

(3) Where each of two or more of the completed applications referred to in subsection (1) contains one or more claims describing as new, and claims an exclusive property of privilege in, things or combinations so nearly identical that, in the opinion of the Commissioner, separate patents to different patentees should not be granted, the Commissioner shall forthwith notify each of the applicants to that effect.

(4) Each of the applicants referred to in subsection (3), within a time to be fixed by the Commissioner, shall either avoid the conflict by the amendment or cancellation of the conflicting claim or claims, or, if unable to make the claims owing to knowledge of prior art, may submit to the Commissioner such prior art alleged to anticipate the claims, and thereupon each application shall be re-examined with reference to the prior art, and the Commissioner shall decide if the subject-matter of such claims is patentable.

(5) Where the subject-matter of the claims described in subsection (3) is found to be patentable and the conflicting claims are retained in the applications, the Commissioner shall require each applicant to file in the Patent Office, in a sealed envelope duly endorsed, within a time specified by him, an affidavit of the record of the invention, which affidavit shall declare

(a) the date at which the idea of the invention described in the conflicting claims was conceived;

copie des revendications concurrentes, ainsi qu'une copie du présent article ;

b) procurer à chaque demandeur l'occasion d'insérer dans sa demande les mêmes revendications ou des revendications similaires, dans un délai spécifié.

(3) Si deux ou plusieurs de ces demandes complétées contiennent chacune une ou plusieurs revendications décrivant comme nouvelles des choses ou combinaisons de choses, et réclamant un droit de propriété ou privilège exclusif dans des choses ou combinaisons tellement identiques que, de l'avis du commissaire, des brevets distincts ne peuvent être accordés à des brevetés différents, le commissaire en notifie immédiatement chacun des demandeurs.

(4) Dans le délai fixé par le commissaire, chacun des demandeurs pare au conflit en modifiant ou radiant la ou les revendications concurrentes, ou, s'il est incapable de produire ces revendications parce qu'il connaît la découverte ou l'invention antérieure, il peut soumettre à l'appréciation du commissaire cette découverte ou invention antérieure qui, d'après l'allégation, devance les revendications. Chaque demande est dès lors examinée de nouveau par rapport à cette découverte ou invention antérieure, et le commissaire décide si l'objet de ces revendications est brevetable.

(5) Si l'objet des revendications visées au paragraphe (3) est reconnu brevetable et que les revendications concurrentes sont maintenues dans les demandes, le commissaire exige de chaque demandeur le dépôt, au Bureau des brevets, dans une enveloppe scellée portant une souscription régulière, dans un délai qu'il spécifie, d'un affidavit du relevé de l'invention. L'affidavit déclare :

a) la date à laquelle a été conçue l'idée de l'invention décrite dans les revendications concurrentes ;

(b) the date upon which the first drawing of the invention was made;

b) la date à laquelle a été fait le premier dessin de l'invention ;

(c) the date when and the mode in which the first written or oral disclosure of the invention was made; and

c) la date à laquelle a été faite la première divulgation écrite ou orale de l'invention et la manière dont elle a été faite ;

(d) the dates and nature of the successive steps subsequently taken by the inventor to develop and perfect the invention from time to time up to the date of the filing of the application for patent.

d) les dates et la nature des expériences successives que l'inventeur a pratiquées par la suite afin de développer et mettre graduellement au point cette invention jusqu'à la date du dépôt de la demande de brevet.

(6) No envelope containing any affidavit mentioned in subsection (5) shall be opened, nor shall the affidavit be permitted to be inspected, unless there continues to be a conflict between two or more applicants, in which event all the envelopes shall be opened at the same time by the Commissioner in the presence of the Assistant Commissioner or an examiner as witness thereto, and the date of the opening shall be endorsed upon the affidavits.

(6) Aucune enveloppe contenant l'affidavit mentionné au paragraphe (5) ne peut être ouverte, et il n'est pas permis d'examiner les affidavits, à moins que ne subsiste un conflit entre deux ou plusieurs demandeurs, auquel cas toutes les enveloppes sont ouvertes en même temps par le commissaire en présence du sous-commissaire ou d'un examinateur en qualité de témoin, et la date de l'ouverture des enveloppes est inscrite sur les affidavits.

(7) The Commissioner, after examining the facts stated in the affidavits, shall determine which of the applicants is the prior inventor to whom he will allow the claims in conflict and shall forward to each applicant a copy of his decision, together with a copy of each affidavit.

(7) Après l'examen des faits énoncés dans les affidavits, le commissaire décide lequel des demandeurs est le premier inventeur à qui il attribuera les revendications concurrentes, et il expédie à chaque demandeur une copie de sa décision. Copie de chaque affidavit est transmise aux divers demandeurs.

(8) The claims in conflict shall be rejected or allowed accordingly unless within a time to be fixed by the Commissioner and notified to the several applicants one of them commences proceedings in the Federal Court for the determination of their respective rights, in which event the Commissioner shall suspend further action on the applications in conflict until it has been determined in those proceedings that

(8) Les revendications concurrentes sont rejetées ou admises en conséquence, à moins que, dans un délai fixé par le commissaire et dont avis est donné aux divers demandeurs, l'un d'eux ne commence des procédures à la Cour fédérale en vue de déterminer leurs droits respectifs, auquel cas le commissaire suspend toute action ultérieure sur les demandes concurrentes, jusqu'à ce que, dans ces procédures, il ait été déterminé que, selon le cas :

(a) there is in fact no conflict between the claims in question;

a) de fait, il n'existe aucun conflit entre les revendications en question ;

(b) none of the applicants is entitled to the issue of a patent containing the claims in conflict as applied for by him;

(c) a patent or patents, including substitute claims approved by the Court, may issue to one or more of the applicants; or

(d) one of the applicants is entitled as against the others to the issue of a patent including the claims in conflict as applied for by him.

(9) The Commissioner shall, on the request of any of the parties to a proceeding under this section, transmit to the Federal Court the papers on file in the Patent Office relating to the applications in conflict.

...

61.(1) No patent or claim in a patent shall be declared invalid or void on the ground that, before the invention therein defined was made by the inventor by whom the patent was applied for, it had already been known or used by some other person, unless it is established that

(a) that other person had, before the date of the application for the patent, disclosed or used the invention in such manner that it had become available to the public;

(b) that other person had, before the issued of the patent, made an application for patent in Canada on which conflict proceedings should have been directed; or

(c) that other person had at any time made an application in Canada which, by virtue of section 28 had the same force and effect as if it had been filed in Canada before the issue of the patent and on which conflict proceedings should properly have been directed had it been so filed.

b) aucun des demandeurs n'a droit à la délivrance d'un brevet contenant les revendications concurrentes, selon la demande qu'il en a faite ;

c) il peut être délivré, à l'un ou à plusieurs des demandeurs, un ou des brevets contenant des revendications substituées, approuvées par le tribunal ;

d) l'un des demandeurs a droit à l'encontre des autres, à la délivrance d'un brevet comprenant les revendications concurrentes, selon la demande qu'il en a faite.

(9) À la demande de l'une des parties à une procédure prévue par le présent article, le commissaire transmet à la Cour fédérale les documents déposés au Bureau des brevets qui se rattachent aux demandes concurrentes.

...

61. (1) Aucun brevet ou aucune revendication dans un brevet ne peut être déclaré invalide ou nul pour la raison que l'invention qui y est décrite était déjà connue ou exploitée par une autre personne avant d'être faite par l'inventeur qui en a demandé le brevet, à moins qu'il ne soit établi que, selon le cas :

a) cette autre personne avait, avant la date de la demande du brevet, divulgué ou exploité l'invention de telle manière qu'elle était devenue accessible au public ;

b) cette autre personne avait, avant la délivrance du brevet, fait une demande pour obtenir au Canada un brevet qui aurait dû donner lieu à des procédures en cas de conflit ;

c) cette autre personne avait à quelque époque fait au Canada une demande ayant, en vertu de l'article 28, la même force et le même effet que si elle avait été enregistrée au Canada avant la délivrance du brevet et pour laquelle des procédures en cas de conflit auraient dû être régulièrement prises si elle avait été ainsi enregistrée.

FEDERAL COURT

SOLICITORS OF RECORD

DOCKETS: T-2231-12 T-2232-12 T-2233-12

STYLE OF CAUSE: THE REGENTS OF THE UNIVERSITY OF
CALIFORNIA v THE COMMISSIONER OF PATENTS

PLACE OF HEARING: MONTRÉAL, QUEBEC

DATE OF HEARING: JANUARY 15, 2014

**REASONS FOR JUDGMENT
AND JUDGMENT:** BEAUDRY J.

DATED: JANUARY 24, 2014

APPEARANCES:

Mr. Greg Moore FOR THE APPLICANT

M. Antoine Lippé FOR THE RESPONDENT

SOLICITORS OF RECORD:

Mr. Greg Moore FOR THE APPLICANT
Barrister and Solicitor
Montréal, Québec

M. Antoine Lippé FOR THE RESPONDENT
Barrister and Solicitor
Montréal, Québec