

Federal Court



Cour fédérale

**Date: 20140916**

**Docket: T-374-13**

**Citation: 2014 FC 887**

**Ottawa, Ontario, September 16, 2014**

**PRESENT: The Honourable Mr. Justice O'Keefe**

**Docket: T-374-13**

**BETWEEN:**

**DREXAN ENERGY SYSTEMS INC.**

**Applicant**

**And**

**THE COMMISSIONER OF PATENTS AND  
THERMON MANUFACTURING CO.**

**Respondents**

**REASONS FOR JUDGMENT AND JUDGMENT**

[1] Pursuant to section 52 of the *Patent Act*, RSC 1985, c P-4 [the Act], Drexan Energy Systems Inc. (the applicant or Drexan) applies to this Court for three things: a declaration that Steve Makar and Konrad Mech are co-inventors of the heating cable described in Canadian Patent No. 2,724,561; an order requiring the Commissioner of Patents to vary all entries in the records of the Patent Office to show that; and costs.

[2] The Commissioner of Patents takes no position, but Thermon Manufacturing Co. (the respondent or Thermon) opposes this application.

I. Background

[3] In cold environments, pipes used to transport substances can freeze unless they are equipped with heat tracing products. Steve Makar, Konrad Mech, Wells Whitney and Umesh Sopory perceived some deficiencies in the products that existed in 2006 and together decided to create a new type of heating cable without those defects. They eventually produced the invention in Canadian Patent No. 2,724,561, which the abstract describes as follows:

A heating cable includes a bus wire structure that includes a plurality of bus wires. An insulation layer is provided to insulate the plurality of bus wires. A plurality of node areas exposes portions of the bus wires from the insulation. A heating element is wrapped around the bus wire structure in a helical manner. The heating element includes an insulating core and one or more resistance wires wrapped around the core in a helical manner. The heating element is electrically coupled to the nodes of the bus wire structure at the plurality of node areas. The insulating core may be made of a folded-over tape made of a cloth material, such as glass cloth. Pluralities of redundant paths in between two nodes are provided to allow for current to flow in a zone if one of the redundant paths is broken.

[4] However, the relationship between the four men had broken down by 2010. Dr. Whitney and Mr. Sopory were the only listed inventors in the patent application, but Mr. Mech and Mr. Makar petitioned the Commissioner of Patents to be added as co-inventors in October 2011. They succeeded at first, but that decision was eventually reversed for undisclosed reasons and the patent was issued with only Dr. Whitney and Mr. Sopory listed as inventors.

[5] Dr. Whitney and Mr. Sopory assigned their proprietary rights in the patent to their corporation, WWUS, which eventually assigned them to Thermon. Mr. Makar and Mr. Mech assigned whatever rights they had in the patent to one of Thermon's competitors, Drexan.

## II. Issue

[6] The applicant does not challenge the validity of Canadian Patent No. 2,724,561, nor does it allege any infringement. Rather, there is only one main issue in this application:

Are Steve Makar and/or Konrad Mech co-inventors of the heating cable described in Canadian Patent No. 2,724,561?

## III. Applicant's Submissions

[7] The applicant argues that section 52 of the Act gives this Court authority to add or remove inventors from a patent, but acknowledges that it cannot succeed unless it proves that Mr. Makar and Mr. Mech are probably co-inventors.

[8] Generally, the applicant asks the Court to accept its witnesses' evidence and reject that of the respondent's witnesses. Particularly, it says that Dr. Whitney and Mr. Sopory were not credible and reluctant to make admissions even when faced with documentary evidence that contradicted their stories. With respect to the statements that no issue about inventorship had been raised until Dr. Whitney's and Mr. Sopory's rights in the patent were assigned to the respondent, the applicant says that is simply untrue and that Mr. Mech had raised them earlier. It

says that no adverse inference should be drawn from that since Dr. Whitney had been assigned to deal with the patenting issues and Mr. Makar and Mr. Mech had trusted him. Besides, up until that point, they had still been trying to arrange a going-forward relationship with Dr. Whitney and Mr. Sopory and the issue of inventorship would have been moot if they could have reached a deal.

[9] Beyond that, the applicant summarizes the law on inventorship and submits that anyone who contributes to the inventive concept is a co-inventor, even if others later help reduce it to the definite and practical shape required for patentability. It argues that this test is met when people discuss together concepts that become embodied in the invention and it does not matter how minor the contributions of any co-inventor might be.

[10] Here, the applicant says that Mr. Makar and Mr. Mech both made those necessary contributions. The process began in 2006. Mr. Makar was a passenger in a Subaru when he telephoned Dr. Whitney and sketched out his idea for a new heating cable (the Subaru conversation). It included features such as parallel construction, the use of a corrugated metal sheath and electrical path redundancy. By early 2007, many of the features had already been decided and were shown in a PowerPoint presentation to Fujikura Inc., a corporation the team had hoped to recruit for financing purposes.

[11] In July 2007, the four men met to discuss the product at Dr. Whitney's home in Glen Ellen, California (Glen Ellen meeting). The applicant argues that this was a collaborative brainstorming session in which Mr. Makar and Mr. Mech fully participated and even suggested

some of the concepts that ended up in the patent. Coming out of the meeting, the applicant says that the four men had decided on the following preferred design for the product:

- (a) a heating cable;
- (b) an insulated pair of bus wires, with notches in the insulation to expose the bus wires at spaced locations;
- (c) a heating element having two resistance wires counter-helically wound around a glass fiber insulating core;
- (d) the heating element wrapped around the insulated bus wires so that the heating element wraps over the notches which then act as electrical nodes for contact with the bus wires, with the counter-helical winding of the resistance wires providing electrical path redundancy between nodes;
- (e) the foregoing wrapped with mica tape or another insulating material; and
- (f) a corrugated metal sheath surrounding all of the foregoing.

[12] The applicant says this was a definite and practical shape for the invention and that the inventive concept can exist and be contributed to before a final decision on the specific constructional details is made. In its view, both Mr. Makar and Mr. Mech contributed to that inventive concept.

[13] Moreover, the applicant argues that it is significant that neither Dr. Whitney nor Mr. Sopory denied that many of the features found in claim 1 were proposed by Mr. Makar and Mr. Mech. Rather, they only take issue with the claim that it was “established” by that time, and Dr. Whitney simply says those features were known in the prior art. However, the applicant argues

that the invention does not yet need to be fixed for a person to contribute to its conception. Moreover, even if some features had been known in the prior art, the combination of them into a single heating cable is the invention in this case and the applicant says that anticipation or obviousness is not properly in issue before the Court since the validity of the patent is unchallenged.

[14] As for the work that Dr. Whitney and Mr. Sopory did after the meeting, the applicant says it was mostly limited to testing and verification. In any event, the applicant adds that they cannot lay sole claim to that since both Mr. Makar and Mr. Mech actively participated in such testing.

#### IV. Respondent's Submissions

[15] The respondent agrees that the applicant bears the burden of proof, but argues that the applicant has failed to discharge it. It emphasizes that Dr. Whitney and Mr. Sopory both have decades of experience in the design and manufacture of heat tracing cables, while Mr. Makar is a career salesman and Mr. Mech is a mechanical engineer who had never designed a heat tracing cable.

[16] Moreover, the respondent challenges Mr. Makar's and Mr. Mech's credibility throughout its submissions, saying that they were often contradictory, evasive and argumentative when being cross-examined. It also claims that the affidavits they filed with the Canadian Intellectual Property Office made different statements than the ones they wrote for this application and says this shows that they are exaggerating their involvement. As well, it pointed out some similarities

in wording between their two affidavits and argued that they had either collaborated or that the wording was selected by counsel. Either way, it says this raises serious doubts about whether the affidavits accurately record their unprompted recollection.

[17] The respondent says that Mr. Makar and Mr. Mech made no inventive contribution and challenged the applicant's version of each of the events. Although Dr. Whitney recalled the Subaru conversation, this was no eureka moment and they had many such conversations before, which Mr. Makar himself admitted on cross-examination. Though Mr. Makar may have suggested some features the cable would need to have, these were known features that any cable would need in order to compete in the market. The conversation did not extend to practical design aspects and Dr. Whitney denied Mr. Makar's statement that he had suggested the concept of electrical path redundancy at that time. These were all things which would have been known to any person skilled in the art.

[18] Similarly, the respondent says that nothing had been settled by the time they made their presentation to Fujikura and claims that Mr. Makar's testimony on this point was contradictory. As for the Glen Ellen meeting, the respondent says it was mainly about incorporation and marketing and the most that could be said was they had agreed on the desired attributes of the product, but never discussed its design. Dr. Whitney and Mr. Sopory also deny that Mr. Makar made any of the specific design suggestions he says that he made. Moreover, the respondent contends that the contemporaneous report on the meeting prepared and circulated by Dr. Whitney corroborates his and Mr. Sopory's evidence.

[19] The four men also met in San Francisco on February 28 and 29, 2008 (San Francisco meeting) to discuss patenting and the respondent says that a copy of the patent application was circulated and included a cover page identifying only Dr. Whitney and Mr. Sopory as inventors. In its view, the fact that Mr. Makar and Mr. Mech never objected shows that they did not consider themselves inventors at the time. Also, Mr. Mech did propose a variation at that meeting and a separate application to cover it was prepared. It named Mr. Mech as an inventor and he signed a declaration confirming his role. The respondent therefore argues that Mr. Mech must have been aware that he was not named as an inventor on the other patent applications since he did not have to do the same thing.

[20] Indeed, the respondent later says that Mr. Makar and Mr. Mech only began to consider themselves inventors after Drexan's competitor, Thermon, obtained the rights from Dr. Whitney and Mr. Sopory. The only time before then that Mr. Mech raised the issue of inventorship was with regard to the variant he had proposed and Dr. Whitney and Mr. Sopory ended up withdrawing the claim for that variant from the patents for which only they were named as inventors. As such, it argues that an adverse inference should be drawn.

[21] Beyond that, the respondent argues that the applicant misconstrues the law on inventorship. It emphasizes that a mere idea or suggestion is not invention and that it must be reduced to practice. Mr. Makar described the meeting as four people "bandying about ideas" at his cross-examination and the respondent says that type of input does not rise to that level. Moreover, the respondent distinguishes some of the cases cited by the applicant and says instead



that the inventive concept here is the combination, so there is no contribution to it by suggesting individual elements.

[22] The respondent also rejects the applicant's argument that everything Dr. Whitney and Mr. Sopory did after the Glen Ellen meeting was just testing and verification. It took months of trial and error to create a product with the desired features and there is no reasonable way to dismiss it as mere verification. As for the testing Mr. Makar and Mr. Mech allegedly did, neither said that in their affidavits. Indeed, the only mention of it was by Mr. Sopory, who said it was limited to powering samples up and down for potential customers or identifying testing requirements for regulatory certification. Neither type of testing contributed to the development of the cable.

#### V. Analysis and Decision

##### A. *Issue - Are Steve Makar and/or Konrad Mech co-inventors of the heating cable described in Canadian Patent No. 2,724,561?*

[23] I agree with the applicant that this Court has the authority under section 52 of the Act to order inventors added or removed from a patent (see *Comstock Canada v Electec Ltd (1991)*, 45 FTR 241 at paragraph 61, 38 CPR (3d) 29 (TD)). I also agree with both parties that to succeed, the applicant must prove that Mr. Makar and Mr. Mech are probably co-inventors (see *Weatherford Canada Ltd v Corlac Inc*, 2010 FC 602 at paragraph 238, 370 FTR 54 [*Weatherford (FC)*], aff'd 2011 FCA 228 at paragraph 99, 95 CPR (4th) 101 (but also var'd on other grounds [*Weatherford (FCA)*])).

[24] To do so, it needs to show that Mr. Makar or Mr. Mech are in some way responsible for the inventive concept (see *Apotex Inc v Wellcome Foundation Ltd*, 2002 SCC 77 at paragraph 96, [2002] 4 SCR 153 [*Wellcome*]). However, they do not need to be wholly responsible. As the Supreme Court said in *Wellcome* at paragraph 99, “an individual who contributes to the inventive concept may be a co-inventor without being the prime originator”. The applicant therefore argues that this test is satisfied so long as it shows that Mr. Makar and Mr. Mech met with Dr. Whitney and Mr. Sopory and “discussed concepts that became incorporated into embodiments disclosed.” (see *Plasti-Fab Ltd v Canada (Attorney General)*, 2010 FC 172 at paragraph 15, 364 FTR 217 [*Plasti-Fab*]).

[25] The respondent argues that *Plasti-Fab* is not on point since inventorship was undisputed in that case. To the extent that argument implies that the test for inventorship differs depending on whether the application is contested, I disagree. As the Federal Court of Appeal said in *Weatherford (FCA)* at paragraph 104, “an “agreement” between the parties does not resolve the issue of inventorship. An individual either contributes an inventive idea or does not.” Even in *Plasti-Fab* at paragraph 15, the test applied was that set out in *Wellcome*, though it may be easier to prove when the alleged co-inventors submit consistent evidence about their respective roles.

[26] Further, I agree with the applicant that even minor contributions to the inventive concept can be sufficient to make someone a co-inventor, so long as his or her ingenuity is applied to the original inventive concept and not just verification (see *Gerrard Wire Tying Machines Co v Cary Manufacturing Co*, 1926 CarswellNat 22 at paragraph 32, [1926] Ex CR 170, [1926] 3 DLR 374 [*Gerrard Wire*]; *Wellcome* at paragraph 99).

[27] However, I also agree with the respondent that the inventive concept at issue here is in the combination of particular elements, not in the elements themselves. As Mr. Justice Michael Phelan said in *Weatherford (FC)* at paragraph 240:

While the same analytical issue arises whether the invention is a combination patent or not, it is the combination itself which is the novelty not the elements of it. As held in *Lovell Manufacturing Co. v. Beatty Brothers Ltd.* (1962), 41 C.P.R. 18, even where certain elements have been contributed by persons other than the inventor named, this would not make them joint inventors of the combination.

[28] The Federal Court of Appeal affirmed this analysis when the case was appealed (see *Weatherford (FCA)* at paragraph 99).

[29] This means that the focus has to be on whether Mr. Makar's and Mr. Mech's contributions were directed not only to suggested features (see *Weatherford (FC)* at paragraph 260), but to how they could actually be combined. Put another way, if there are two competing products that have different advantages and disadvantages, it takes no ingenuity at all to suggest that it would be great if there could be a product that has the advantages of both without the disadvantages of either. If there is any inventive concept at all in combining those two products, it lies in discovering how to make a product that has the desired attributes of both and it is to that process that the inventive contribution must be made.

[30] Therefore, this case largely comes down to credibility. Mr. Makar and Mr. Mech both say that they made suggestions and that the design for the product was conceived jointly, including: counter-helical winding of resistance wires around an insulated core; the idea of using ties around the heating element; the use of a corrugated metallic sheath; a specific design

configuration similar to the ultimate product and more. Some of these are concrete claims detailed in the patent, which I will presume to be valid for the purposes of this application (subsection 43(2) of the Act). As such, if I believe Mr. Makar or Mr. Mech, then I would be satisfied that they contributed to the inventive concept of the patent.

[31] However, their evidence is expressly denied by Dr. Whitney and Mr. Sopory, who both say that nothing had really been established at the Glen Ellen meeting. Indeed, they say that Mr. Makar's and Mr. Mech's contributions were largely limited to marketing and reporting what attributes they would like the product to have. If that is true, then they would not have made any inventive contribution and they are not co-inventors.

[32] With respect to credibility, however, both parties overstate their cases. The respondent especially makes several dubious arguments. For instance, it claims that the similarities between the affidavits of Mr. Makar and Mr. Mech show that they either collaborated or that the language was selected by counsel. Indeed, Mr. Makar and Mr. Mech both candidly disclosed that some passages were drafted by counsel in consultation with them (see cross-examination of Mr. Makar, respondent's record, page 302, question 528; cross-examination of Mr. Mech, respondent's record, page 512, question 328).

[33] However, that hardly impugns their credibility. Lawyers commonly assist witnesses in preparing their affidavits. Often, counsel will cull out irrelevant details or use more precise language than would the witness if left to his or her own devices. However, that does not presumptively give me any reason to believe that either witness was lying when they swore that

their affidavits were true. Moreover, the respondent's witness, Mr. Sopory, also admitted during cross-examination that he did not write at least paragraph 8 of his affidavit (see cross-examination of Mr. Sopory, applicant's record, page 703). If Mr. Makar's or Mr. Mech's evidence must be rejected because he may not have chosen every word he used, so too must Mr. Sopory's. I would rather not do that and instead reject the respondent's argument.

[34] The respondent also argues that some changes in the wording between these affidavits and the affidavits filed with the Canadian Intellectual Property Office are significant. For example, in his earlier affidavit, Mr. Makar said that the purpose of the Glen Ellen meeting was to "discuss the design, development and marketing of the cable." In his present affidavit, he said it was to "discuss and detail the design, development and marketing" of the cable. Similarly, where he had earlier said he "put forward ideas in relation to using multiple resistance wires", he later said that he "put forward specific design approaches in relation to using multiple resistance wires".

[35] When confronted on cross-examination about this, Mr. Makar explained that his earlier affidavit did not purport to contain everything that could have pertained to the matter at hand (see cross-examination of Mr. Makar, respondent's record, page 250, question 294), that it generally conveyed the same information (see cross-examination of Mr. Makar, respondent's record, page 300, question 517) and that any changes he made were to ensure that the newer affidavit was more complete and accurate (see cross-examination of Mr. Makar, respondent's record, page 302, question 524).

[36] In my view, those explanations are valid. Notably, none of the examples cited by the respondent were actual inconsistencies. Generally, the changes simply made his testimony more detailed. For instance, “specific design approaches” is a narrower term than “ideas”, in that an idea could be a specific design approach but could also be many other things. I consider the changes between paragraph 8 of his earlier affidavit and paragraph 50 of his new affidavit to be of the same type (see cross-examination of Mr. Makar, respondent’s record, page 334, questions 664 to 668). Overall, I accept that Mr. Makar was just trying to make his testimony more specific and complete and was not lying to bolster his claim. By themselves, therefore, I do not view these changes as having any meaningful impact on credibility.

[37] Moreover, I do not draw any adverse inference against either of the applicant’s witnesses for their failure to mention their belief that they were inventors earlier. First, I am not confident that a title page identifying only Dr. Whitney and Mr. Sopory as inventors was circulated at the San Francisco meeting. While that could be true, neither Mr. Makar nor Mr. Mech recalled seeing a title page and neither the patent description nor its title page were listed as having been handed out in Dr. Whitney’s summary of the meeting (see affidavit of Dr. Whitney, Exhibit L). Further, if it was just something reviewed once in person, then the title page could have been overlooked given the trust between these men that had existed at the time (see cross-examination of Mr. Makar, respondent’s record, pages 374 and 375, questions 857 and 860).

[38] Of course, Mr. Mech had been named as an inventor on one of the patents for the variant he had proposed in San Francisco and he must have noticed that the process was different that time. However, I also accept that Mr. Mech raised concerns about inventorship before the rights

were assigned to Thermon. Although the e-mail from Mr. Mech to Dr. Whitney on November 1, 2009 mostly dealt with Mr. Mech's concerns about the variant he had proposed, he also said this: "I am slowly working through them [the patents] to identify those claims where either Makar or I may have contributed." The reference to Mr. Makar means that he cannot have exclusively meant his variant and thus, Mr. Mech, at least, felt that he had an inventorship interest beyond that.

[39] Further, given the discussions held in the months leading up to the assignment to Thermon, it was understandable not to advance that issue further at the time as it could have antagonized Dr. Whitney and Mr. Sopory and reduced the chance of a successful negotiation.

[40] As for the respondent's contention that Mr. Makar's testimony was evasive and "riddled with inconsistencies," (see respondent's record, page 604, paragraph 51). I disagree. There were a few occasions where he admitted to a lapse in memory (see cross-examination of Mr. Makar, respondent's record, pages 234 to 236, questions 226 to 234), but other criticisms leveled by the respondent are unfounded. Many rely on ambiguous language in Mr. Makar's affidavit that he freely clarified at the cross-examination (see eg affidavit of Mr. Makar at paragraph 35; cross-examination of Mr. Makar, respondent's record, pages 271 to 274, questions 376 to 384) and which I do not view as problematic.

[41] For another example, the respondent argues that: with respect to path redundancy, Makar retreated on cross-examination from his assertion in his affidavit that this had been "established"

going into the Glen Ellen meeting, admitting that this feature became “unestablished” at the Glen Ellen meeting.

[42] Read in context, however, I would hardly characterize this as a retreat. Though his words were arguably chosen poorly, his description that it intentionally became unsettled or unestablished was voluntarily given and not in response to a challenge on that point. By it, he meant that at the Glen Ellen meeting, “we decided to throw out for comment any possibilities, even if we realized in doing so we would probably quickly reject most of them” (see cross-examination of Mr. Makar, respondent’s record, pages 295 and 296, questions 491 to 493). That is a type of creative process and I do not take it as contradicting his affidavit.

[43] Overall, I think Mr. Makar’s testimony largely withstood cross-examination.

[44] With respect to Mr. Mech, here too some of the respondent’s criticisms are unfounded. When asked whether counsel had prepared a sentence in his affidavit, Mr. Mech answered that he had been assisted by counsel but could not remember if he had drafted that particular statement. Nevertheless, he swore that it was true. The respondent said this was evasive, but I do not see how.

[45] As well, the respondent criticizes Mr. Mech for not remembering if “Mr. Makar informed him that during the Subaru telephone conversation he had that he had advised Dr. Whitney that the design had to have electrical path redundancy.” However, that is a specific detail about a



second-hand conversation, so it is hardly surprising that he would not remember (see cross-examination of Mr. Mech, respondent's record, pages 477 and 478, question 193).

[46] That said, I agree that Mr. Mech's cross-examination revealed some problems. He was occasionally argumentative. Although some of his interjections could have been legitimate attempts to clarify the question (see eg cross-examination of Mr. Mech, respondent's record, page 491, question 249), many times it seemed like his interest in the result prevented him from giving a straight answer (see eg cross-examination of Mr. Mech, respondent's record, pages 557 and 558, question 498). More importantly, there were a few real contradictions in his evidence for which his answers and explanations were very confusing (see cross-examination of Mr. Mech, respondent's record, pages 429 to 531, questions 392 to 396).

[47] Moving then to the respondent's witnesses, the applicant's criticism of them was not particularly convincing either. The few contradictions it did point out were only parenthetically associated with the litigation. For instance, the applicant's counsel asked Dr. Whitney whether he respected Fujikura Inc. and after he said he did, he was confronted with an angry e-mail he wrote. When he was asked again whether he respected Fujikura Inc., his counsel instructed him not to answer the question (see cross-examination of Dr. Whitney, applicant's record, pages 795 to 798). Having given no explanation for the tone and content of the e-mail, I accept this is a contradiction, but it has no relevance to the issues.

[48] For some of the applicant's other examples, I disagree that there was any meaningful reluctance. For instance, Dr. Whitney was confronted with an e-mail conversation between him

and Mr. Makar. Mr. Makar described something Mr. Sopory had done and asked Dr. Whitney, “Is this what you meant by Umesh playing games?” Dr. Whitney responded “You got it! Now you understand what I meant.” When asked about this under cross-examination, Dr. Whitney refused to say whether his response specifically referred to Mr. Makar’s question (see cross-examination of Dr. Whitney, applicant’s record, page 810, lines 12 and 13). Although I agree with the applicant’s interpretation of the e-mail conversation, I do not draw any adverse inference against Dr. Whitney for refusing to answer since he did not specifically recall to what he was referring.

[49] The applicant also argues that Dr. Whitney improperly implied at paragraph 55 of his affidavit that the preferred heater design coming out of the Glen Ellen meeting was more akin to a predecessor cable they had worked on than the final product, but I do not consider paragraph 55 to have that implication.

[50] Despite that, I also disagree with the respondent that its witnesses were entirely “unshaken on cross-examination.” For instance, Mr. Sopory testified in his affidavit that “at the Glen Ellen meeting we did not discuss anything more than a number of possible features that we might wish to consider exploring.” However, the respondent has also argued that a memorandum Dr. Whitney prepared on July 24, 2007, accurately describes a preferred heater design coming out of the Glen Ellen meeting. When confronted with that memorandum on cross-examination, Mr. Sopory admitted that he did not recall discussing aspects of that preferred heater design at the Glen Ellen meeting (see cross-examination of Mr. Sopory, applicant’s record, page 696, lines 8 to 10) and other things in the memo he did not recall at all and was surprised to see them (see

cross-examination of Mr. Sopory, applicant's record, page 697, lines 2 to 13). That suggests to me that either the memorandum was not accurate or Mr. Sopory's memory of the meeting was faulty.

[51] Still, I ultimately am not convinced that Mr. Makar and Mr. Mech are co-inventors for a few reasons.

[52] First, their expertise was mostly in sales, while the expertise of Dr. Whitney and Mr. Sopory is in research, development and manufacturing. Although Mr. Makar and Mr. Mech both have enough experience in the industry that I expect they could plausibly make meaningful design contributions (and indeed, Mr. Mech did with the variant he proposed at the meeting in San Francisco), it seems to me more likely that they would divide the labour along the lines of their experience (see affidavit of Dr. Whitney at paragraph 51; affidavit of Mr. Sopory at paragraph 16). Further, I do not consider Mr. Sopory's statement in an e-mail on March 2, 2009, to be an admission that all four men invented the product. All he says is that they all initiated it and "pitched in and got it to a point where it is ready to be sold." That is equally consistent with the respondent's division of labour theory as it is with the applicant's co-inventorship theory.

[53] Second, Dr. Whitney provided a lot of contemporaneous documentation showing his design work in the days leading up to the Glen Ellen meeting. Moreover, Dr. Whitney circulated memorandums after the Glen Ellen meeting which supports his version of what happened. Although Mr. Makar says he probably challenged Dr. Whitney over the telephone about perceived inaccuracies, there is no documentary evidence to support that.

[54] The applicant argues that the e-mail from Steve Makar to the others on February 16, 2007, supports its claim, but I disagree. The product descriptor in that e-mail lists only the attributes of the cable, not its design and to me it reads more like a marketing pitch than anything else.

[55] Third, Dr. Whitney and Mr. Sopory showed that they were willing to credit Mr. Mech as an inventor for the variation he proposed at the San Francisco meeting. Therefore, I expect they would have been equally willing to do the same had Mr. Makar or Mr. Mech made any other inventive contributions.

[56] At least as the record stands, I would therefore prefer the evidence of Dr. Whitney and Mr. Sopory to that of Mr. Makar and Mr. Mech. Undoubtedly, Mr. Makar and Mr. Mech had useful input into the design of the cable, but the applicant has not proven that it was anything more than suggesting desired features and communicating feedback from potential customers. Although that is certainly helpful (see cross-examination of Mr. Sopory, applicant's record, pages 660 and 661), it is not inventive and I would not find that they are co-inventors.

[57] The applicant has not proven that Mr. Makar or Mr. Mech are probably co-inventors of the heating cable described by Canadian Patent No. 2,724,561. As such, I would dismiss this application and award costs to the respondent, Thermon Manufacturing Co.

**JUDGMENT**

**THIS COURT'S JUDGMENT is that** the application is dismissed with costs to the respondent, Thermon Manufacturing Co.

"John A. O'Keefe"

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Judge

ANNEX

**Relevant Statutory Provisions**

***Patent Act, RSC 1985, c P-4***

2. In this Act, except as otherwise provided,

...

“invention” means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter;

...

43.(2) After the patent is issued, it shall, in the absence of any evidence to the contrary, be valid and avail the patentee and the legal representatives of the patentee for the term mentioned in section 44 or 45, whichever is applicable.

...

52. The Federal Court has jurisdiction, on the application of the Commissioner or of any person interested, to order that any entry in the records of the Patent Office relating to the title to a patent be varied or expunged.

2. Sauf disposition contraire, les définitions qui suivent s’appliquent à la présente loi.

...

« invention » Toute réalisation, tout procédé, toute machine, fabrication ou composition de matières, ainsi que tout perfectionnement de l’un d’eux, présentant le caractère de la nouveauté et de l’utilité.

...

(2) Une fois délivré, le brevet est, sauf preuve contraire, valide et acquis au breveté ou à ses représentants légaux pour la période mentionnée aux articles 44 ou 45.

...

52. La Cour fédérale est compétente, sur la demande du commissaire ou de toute personne intéressée, pour ordonner que toute inscription dans les registres du Bureau des brevets concernant le titre à un brevet soit modifiée ou radiée.

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

**DOCKET:** T-374-13

**STYLE OF CAUSE:** DREXAN ENERGY SYSTEMS INC. v  
THE COMMISSIONER OF PATENTS and  
THERMON MANUFACTURING CO.

**PLACE OF HEARING:** VANCOUVER, BRITISH COLUMBIA

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**REASONS FOR JUDGMENT  
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**DATED:** SEPTEMBER 16, 2014

**APPEARANCES:**

Paul Smith  
Lawrence Chan

FOR THE APPLICANT

David W. Aitken

FOR THE RESPONDENT  
THERMON MANUFACTURING CO.

**SOLICITORS OF RECORD:**

Smiths IP  
Barristers and Solicitors  
Vancouver, British Columbia

FOR THE APPLICANT

Aitken Klee LLP  
Barristers and Solicitors  
Ottawa, Ontario

FOR THE RESPONDENT  
THERMON MANUFACTURING CO.