

Federal Court



Cour fédérale

Date: 20141124

Docket: T-1602-14

Citation: 2014 FC 1117

Ottawa, Ontario, November 24, 2014

PRESENT: The Honourable Mr. Justice Shore

BETWEEN:

DR. FALK PHARMA GMBH

Applicant

and

THE COMMISSIONER OF PATENTS

Respondent

JUDGMENT AND REASONS

I. Introduction

[1] This is an application pursuant to section 52 of the *Patent Act*, 1985, c P-4, wherein the Applicant, Dr. Falk Pharma GMBH, seeks to obtain an order to vary the entries in the records of the Patent Office relating to inventorship of a Canadian patent. Specifically, the Applicant seeks to add Mr. Peter Gruber to the list of inventors named in Canadian Patent 2,297,832 [the 832 patent], of which it is the owner.

[2] The application is uncontested, as the Respondent has decided not to appear in the proceedings.

II. Background

[3] The Applicant claims that Mr. Gruber does not currently appear on the list of inventors due to a clerical oversight.

[4] As it appears from the affidavits of Dr. Roland Greinwald and Mr. Norbert Otterbeck, the omission of Mr. Gruber's name from the list of inventors was inadvertent and due to an absence of knowledge of the different requirements for inventorship under German and Canadian laws.

[5] Although Mr. Gruber is not an inventor under German laws, it was recently discovered that Mr. Gruber's contribution is sufficient to entitle him to co-inventorship under Canadian and US laws. In this regard, the Applicant has filed a similar request to the *United States Patent and Trademark Office* to correct the omission.

[6] The Applicant further claims that the omission of Mr. Gruber's name to the list of inventors was not an attempt to delay the issuance of the 832 patent.

III. Legislative Provisions

[7] The Court's jurisdiction to issue the requested order is set out in the following legislative provision of the *Patent Act*:

Jurisdiction of the Federal Court

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.

Jurisdiction de la Cour fédérale

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.

IV. Analysis

[8] The only issue to be determined is whether the Applicant is entitled to the requested order to vary the entries in the records of the Patent Office relating to inventorship of the 832 patent, an order for which this Court has exclusive jurisdiction.

[9] The Applicant submits that the evidence at hand complies with Madam Justice Carolyn Layden-Stevenson's reasoning in *Micromass UK Ltd. v Canada (Commissioner of Patents)*, 2006 FC 117 [*Micromass*]. In this decision, which dealt with a similar case, Justice Layden-Stevenson found that section 52 of the *Patent Act* allows the Court to order the correction of clerical errors that appear in issued patents, including adding names that were inadvertently omitted from the list of inventors:

[12] After the patent has issued, the Commissioner has no discretion, under section 8 of the Act or otherwise, to amend the inventorship of an issued patent. Such action falls exclusively within the jurisdiction of the Federal Court. Specifically, section 52 of the Act provides that 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 the patent be varied or expunged.

[13] The word "title" in section 52 of the Act is broader than acquisition by assignment and covers matters relating to the root of title. The jurisdiction of the Court extends to correcting inadvertent errors relating to the naming of the inventors of an issued patent, including errors of a clerical nature relating to the transcribing of inventor names: *BF Goodrich v. Commissioner of Patents* (1960), 32 C.P.R. 122 (SEC.I) (Ex. Ct.).

[10] In *Micromass*, above, the Court allowed the request to vary all entries in the records of the Patent Office by adding the name of an individual to the inventor list based on evidence that:

- 1) the individual was a co-inventor;
- 2) the inventors names on the patent acknowledged the contribution of the co-inventor;
- 3) the co-inventor's name was omitted through inadvertence, and;
- 4) the individual's name was not left off the patent due to a desire to delay the patent prosecution (Applicant's memorandum, paragraph 17).

[11] The Court finds that the evidence supports the Applicant's position. In his affidavit, Mr. Norbert Otterbeck, who is the only inventor listed in the 832 patent at present, acknowledges that Mr. Gruber is an employee of Dr. Falk Pharma GMBH in the research and development department who has contributed to the invention named in the 832 patent. More precisely, Mr. Otterbeck claims that Mr. Gruber's expertise in regards of the invention relates to extrusion and spheronization technology as well as pellet development and that Mr. Gruber was in charge of experimental work dealing with materials and processes which contributed to the development of the invention. Mr. Otterbeck further adds that the omission of Mr. Gruber as a co-inventor was inadvertent and not aimed at delaying the issuance of the 832 patent. These above-stated facts are further corroborated by Mr. Roland Greinwald and Mr. Peter Gruber in their affidavits.

V. Conclusion

[12] The Court is satisfied that, in light of the above-cited jurisprudence, the evidence submitted supporting the inventive contribution of Mr. Gruber, and the inadvertence of the error, which was made in good faith, the Applicant is entitled to the requested order.

JUDGMENT

THIS COURT'S JUDGMENT is that

1. Pursuant to section 52 of the *Patent Act*, the Commissioner of Patents vary all entries in the records of the Patent Office with respect to the inventorship of Canadian Patent No. 2,297,832 by adding Peter Gruber as an inventor;
2. There shall be no order with respect to costs.

"Michel M.J. Shore"

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-1602-14

STYLE OF CAUSE: DR. FALK PHARMA GMBH v THE COMMISSIONER
OF PATENTS

**JUDICIAL REVIEW HELD VIA TELECONFERENCE ON NOVEMBER 20, 2014
FROM MONTRÉAL, QUEBEC**

REASONS AND JUDGMENT: SHORE J.

DATED: NOVEMBER 24, 2014

ORAL AND WRITTEN REPRESENTATIONS BY:

Alain Y. Dussault

FOR THE APPLICANT

N/A

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