



Chapter 8 – Other Attacks on Validity

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8.1 *Inadequate Disclosure*

8.1.1 The Legislative Basis

The *Patent Act* requires the applicant to particularly indicate and distinctly claim the part, improvement or combination that the inventor claims as his or her invention.¹ The *Patent Act* also requires that the specification end with a claim or claims stating distinctly and in explicit terms the things or combinations that the applicant regards as new and in which he or she claims an exclusive property or privilege.²

The applicant must define the nature of the invention and describe how it is put into operation. A failure to meet the first condition would invalidate it for ambiguity, while a failure to meet the second invalidates it for insufficiency.³

8.1.2 The Law

[Section 27](#) lies at the heart of the whole patent system. The grant of a monopoly is one half of the bargain the patent system strikes between the Government and the inventor. The description of the invention required by [section 27](#) represents the *quid pro quo* for the monopoly of the patent. The inventor has to disclose what he or she has invented in such a manner that someone skilled in the art could read the disclosure and construct or use the invention once the patent expires.⁴ Patent monopolies are granted to encourage people to make inventions and to make their nature and working of them known. Unless the description of them in the patent is full and fair, the patent ought not be valid.⁵

The question is whether a person skilled in the art could, with only the specification, put the invention to as successful a use as the inventor could himself.⁶ The patent need not show manufacturing instructions.⁷

¹ *Patent Act*, R.S.C. 1985 c. P-4, [s. 27\(3\)\(a\)](#).

² *Patent Act*, R.S.C. 1985 c. P-4, [s. 27\(4\)](#).

³ *Pioneer Hi-Bred Ltd. v. Canada (Commissioner of Patents)* (1989) 25 C.P.R. (3d) 257 (S.C.C. per Dickson C.J.) [at pp. 267-268](#).

⁴ *Consolboard Inc. v. MacMillan Bloedel (Sask) Ltd.*, (1981), 56 C.P.R. (2d) 145 (S.C.C. per Dickson J.) [at p. 154-155](#).

⁵ *American Cyanamid Co. v. Berk Pharmaceuticals, Ltd.*, [1976], R.P.C. 231 (Ch. per Whitford, J.) [at p. 234](#)

⁶ *The King v. American Optical Co.*, (1950) 13 C.P.R. 87 (per Thorson, P.) [at p. 110](#); See also: *Edison and Swan United Electric Light Co. v. Woodhouse and Rawson*, [1887] 4 R.P.C. 99 (C.A.) [at p. 108](#).

⁷ *Sakharam D. Mahurkar v. Vas-cath of Canada Limited et al*, (1988) 18 C.P.R. (3d) 417 (F.C.T.D. per Strayer J.) [at p. 440](#).

Where the reader must work out a problem or if a degree of luck is involved, there is not sufficient disclosure.⁸ The patent may require the reader to engage in some simple experimentation to use the invention⁹, but if it involves any inventive experimentation, the disclosure is lacking.¹⁰ Where testing would be required to determine the suitability of a component, the disclosure is insufficient.¹¹

Where the invention is an inventive combination of old elements or devices, it is sufficient to name the old elements, describe their mode of operation and the new useful result accomplished. If the applicant wants to claim invention for a subordinate element then he or she must claim that element separately to secure a patent on it.¹²

Some articles, when seen or described, speak for themselves and a further description as to function or purpose is unnecessary. There are cases, however, where the function is a part of the invention, and in such cases as description of the function must be included in the specification to maintain a valid claim.¹³

The disclosure must answer the question: What is your invention and how does it work?¹⁴

There is no requirement to describe every possible way in which the invention can be performed.¹⁵ A patentee need not describe in what respect the invention is new or in what way it is useful or nor extol the effect or advantage of it.¹⁶ Object clauses that set out the advantages of the invention need not incorporate those advantages into the claims.¹⁷

⁸ *Pioneer Hi-Bred Ltd. v. Canada (Commissioner of Patents)*, (1989) 25 C.P.R. (3d) 257 (S.C.C. per Dickson C.J.) [at p. 270](#).

⁹ *Mobil Oil Corporation et al v. Hercules Canada Inc.* (1995), 63 C.P.R. (3d) 473 (F.C.A. per Marceau J.A.) [at p. 482](#).

¹⁰ *Mobil Oil Corporation et al v. Hercules Canada Inc.* (1995), 63 C.P.R. (3d) 473 (F.C.A. per Marceau J.A.) [at pp. 484-485, 485-486](#).

¹¹ *Ductmate Industries Inc. v. Exanno Products*, (1985) 2 C.P.R. (3d) 289 (F.C.T.D. per Reed J.) [at p. 299-300](#).

¹² *Baldwin Int'l Radio Co. of Canada, Ltd. v. Western Electric Co., Inc & Northern Electric Co.*, [1934] S.C.R. 94 (S.C.C. per Rinfret J.) [at p. 105](#).

¹³ *The Mullard Radio Valve Co., Ltd. v. Philco Radio and Television Corporation of Great Britain, Ltd. and Others*, [1936] 53 R.P.C. 323 [at p. 352](#).

¹⁴ *Mineral Separation North America Corp. v. Noranda Mines, Ltd.* (1947), 12 C.P.R. 102 at p. 111; *Consolboard Inc. v. MacMillan Bloedel (Sask) Ltd.*, [1981] 1 S.C.R. 504 at p. 520-521; (1981), 56 C.P.R. (2d) 145 (S.C.C. per Dickson J.) [at p. 157](#).

¹⁵ *Quantel Ltd. v. Spaceward Microsystems Ltd.* [1990] R.P.C. 83 (Patents Court per Falconer J.) at p. 136, I 49-50.

¹⁶ *Consolboard Inc. v. MacMillan Bloedel (Sask) Ltd.* [1981] 1 S.C.R. 504 at p. 526; (1981) 56 C.P.R. (2d) 145 per Dickson J. (S.C.C.) **at about p. 160. See also *Beecham Canada Ltd. v.*

8.1.2.1 Nature Of The Attack

Attacks on the validity of a patent under [s. 27](#) of the *Patent Act* are technical and should not defeat a meritorious invention.¹⁸

Attacks on the patent must be precisely and explicitly pleaded to give fair notice of the nature of the attack.¹⁹ Insufficient disclosure - not clear or complete - is a plea which, by its very nature, requires to be supported by evidence.²⁰

Such attacks must be proven strictly. Where the defendant has taken the exact thing patented, exploited it, said to the inventor when challenged, "your patent is invalid", and then examined every line of it, suggesting to the court that one or two bad sentences should render the entire patent bad, they must prove such allegations strictly.²¹ The Courts should not be too astute or technical when construing claims and particularly when considering their sufficiency of disclosure. One construes the claims in light of what a person skilled in the art would understand them to cover. Where there is an insufficiency of description but a person skilled in the art would realize that it is a mere technical omission, the patent will not be invalidated.²²

8.1.2.2 Material Date to Examine Sufficiency

An old *Patent Act* patent is to be construed as of the date it issued.²³

8.1.2.3 Biotechnology Inventions

The deposit of a seed (the invention itself) was not sufficient disclosure.²⁴

Procter & Gamble Co. (1982) 61 C.P.R. (2d) 1 (F.C.A. per Urie J.A.) at p. 8 citing Duff, C.J. in *Western Electric Co. Inc. v. Baldwin Radio of Canada* [1934] S.C.R. 570 at p. 574.

¹⁷ *Reliance Electric Industrial Company et al v. Northern Telecom Limited*, (1992) 44 C.P.R. (3d) 161 (F.C.A. per Mahoney J.) at p. 164.

¹⁸ *Burton Parsons v. Hewlett Packard* (1975) 17 C.P.R. (2d) 97 (S.C.C. per Pigeon J.) at p. 106.

¹⁹ *TRW Inc. v. Walbar of Canada Inc.* (1991) 39 C.P.R. (3d) 176 (F.C.A. per Stone J.) [at p. 196](#).

²⁰ *Quantel Ltd. v. Spaceward Microsystems Ltd.* [1990] R.P.C. 83 (Patents Court per Falconer J.) at p. 136, l 10-16.

²¹ *The Edison Bell Phonograph Corporation, Limited v. Smith and Young*, [1894] 11 R.P.C. 389 [at p. 396](#).

²² *Xerox of Canada Ltd. et al v. IBM Canada Ltd.*, (1977), 33 C.P.R. (2d) 24 (F.C.T.D. per Collier J.) [at p. 44](#).

²³ *AlliedSignal Inc. v. Du Pont Canada Inc. et al.* (1995), 61 C.P.R. (3d) 417 (F.C.A. per Desjardins J.A.) [at p. 426](#) quoting the French version of *Burton Parsons v. Hewlett Packard* [1976] 1 S.C.R. 555 (S.C.C. per Pigeon) at p. 560

²⁴ *Pioneer Hi-Bred Ltd. v. Canada (Commissioner of Patents)*, (1989) 25 C.P.R. (3d) 257 (S.C.C. per Dickson C.J.)

8.1.2.4 Prior Art

It has never been part of the law that a patentee should find out about the prior art before patenting nor state the difference between the invention and the prior art. This would be an unmanageable burden on the patentee. They cannot be required to discover and compile the prior art to determine what inventive step they have contributed.²⁵

8.2 Inutility

The patentee is representing to the Government and to the public that if the directions of the patent are followed, a device will be created that will be useful in the sense that it works.²⁶

A claim cannot be construed to exclude claimed components which a skilled reader would know to be unsuitable. Such a claim is invalid.²⁷

8.3 Ambiguous Claims

[Section 27\(3\)](#) sets out what must be included in the specification. [Section 27\(4\)](#) of the *Patent Act* requires that a patent end with a claim or claims which state distinctly and in explicit terms that which the applicant regards as new and in which he claims an exclusive privilege or property.

[Section 53\(1\)](#) of the *Patent Act* states that a patent is void if any material allegation in the patent is false or if the specification or drawings contain more or less than is necessary for obtaining the end for which they purport to be made and the omission or addition is wilfully made for the purpose of misleading. [Section 53\(2\)](#) allows that if the Court finds that an omission or addition in the specification and drawings was not intentional, the remainder of the patent may be left intact and valid.

The *Patent Act* requires that an applicant file a specification including disclosure and claims, whereby everything that is essential for the invention to function properly is disclosed. To be complete it must meet two conditions: it must describe the invention and define the way it is produced or built; and define the nature of the invention and how to put it into operation. Failure to define the first would render the application invalid for ambiguity; failure to meet the second renders it invalid for insufficiency. The description must be complete enough to enable a person skilled in the art to produce the invention using only the disclosure in the patent.²⁸

²⁵ *British United Shoe Machinery Company Ltd v. A. Fussell & Sons Ltd.* (1908), 25 R.P.C. 631 (per Moulton, L.J.) [at pp. 651-652](#); followed in *Quantel Ltd. v. Spaceward Microsystems Ltd.* [1990] R.P.C. 83 (Patents Court per Falconer J.) at p. 139, l. 28-30.

²⁶ *Henriksen v. Tallon Limited*, [1965] R.P.C. 434 [at p. 441](#).

²⁷ *Henriksen v. Tallon Limited*, [1965] R.P.C. 434 [at p. 447](#); Yet see *Burton Parsons v. Hewlett Packard* (1975), 17 C.P.R. (2d) 97 (S.C.C per Pigeon J.) [at p. 104](#) where the Court gave the claim a common sense interpretation that would be given it by a skilled worker in the art, knowing what should or should not be used to achieve the desired purpose.

²⁸ *Pioneer Hi-Bred Ltd. v. Canada (Commissioner of Patents)* (1989) 25 C.P.R. (3d) 257 (S.C.C. per Lamer J.) [at p. 267-268](#).

In return for the privilege of a grant of monopoly, the patentee must state plainly what is the invention for which he or she asks protection, so that others will be advised of what is protected and its limits. A claim which is unclear as to its boundaries is invalid. If the skilled person in attempting to put a claim to use, or in trying to determine the boundaries which another method would not infringe, is given insufficient or obscure direction, then the claim is invalid.²⁹

The court should not be quick to find ambiguity and should refuse to do so where a claim can with some effort be construed in a meaningful way.³⁰

The language of a claim must not be vague, but can be general.

The language of the claims is to be given an "understandable meaning".³¹ The language of the claims must be read in light of the specification as a whole, although it is still only the language of the claims that determines the scope of the monopoly claimed.³²

A claim must be sufficiently explicit so as to inform the reader as to what is within and what is not within the claim.³³ If a claim could be interpreted in more than one way, it would be impossible for anyone to know, at least in advance, when a manufacture or use or sale of the patented product would be within the claim. Where the language is ambiguous, it may be that it is invalid for failing to inform a reader as to the scope of the claim, or it may be invalid upon an interpretation where it appears to claim more than was invented.³⁴

The standards for patent specifications are not the same as those in academic scientific literature. A lack of data that would serve to verify the product, desirable as that may be for one working in advanced sciences, is not a requirement of the law of patents.³⁵

The question to be asked is: could a person skilled in the art be able to make the invention from the information contained in the patent specification? Reliability of the method of measurement of a component of the claim goes to infringement, not to validity.³⁶

²⁹ *Xerox of Canada Ltd. v. IBM Canada Ltd.* (1977) 33 C.P.R. (2d) 24 (F.C.T.D. per Collier J.) at p. 82.

³⁰ *Procter & Gamble Co. v. Bristol Myers Canada Ltd.* (1979), 42 C.P.R. (2d) 33 at p. 37-38; *Reading & Bates Construction Co. et al v. Baker Energy Resources Corp. et al* (1986) 13 C.P.R. (3d) 410 (F.C.T.D. per Strayer J.) [at 430-431](#); *Lubrizol Corp. v. Imperial Oil Ltd.* (1990) 33 C.P.R. (3d) 1 (F.C.T.D.) [at p. 26](#).

³¹ *Reading & Bates Construction Co. et al v. Baker Energy Resources Corp. et al*, (1986) 13 C.P.R. (3d) 410 (F.C.T.D. per Strayer J.) [at p. 430](#), aff'd (1987) 79 N.R. 351 (F.C.A.).

³² *Smith Incubator Co. v. Seiling* (1937) S.C.R. 251 (S.C.C.) per Duff C. [at p. 255](#).

³³ *Smith Incubator Co. v. Seiling* (1937) S.C.R. 251 (S.C.C.) per Duff C. [at p. 255](#).

³⁴ *Apotex Inc. v. Hoffman-La Roche Ltd.* (1989) 24 C.P.R. (3d) 289 (F.C.A. per Thurlow D.J.A.) [at p. 299](#)

³⁵ *Wellcome Foundation Ltd. v. Apotex Inc.* (1991) 39 C.P.R. (3d) 289 (F.C.T.D. per MacKay J.) [at p. 366](#).

A phrase that can be properly interpreted using grammatical rules and common sense cannot be found to be ambiguous. Conflicts among experts interpretations of a phrase can sometimes be solved with a common sense grammatical reading of the phrase.³⁷

If a patentee uses language that, when fairly read, is avoidably ambiguous or obscure, the patent is invalid, whether due to design, carelessness or to want of skill. Where a patent is difficult to explain, due allowance will be made for any resulting difficulty in the language, but if the court suspects the patentee is using unclear language in an attempt to blur the boundaries of his claim, they will have little sympathy.³⁸

8.4 Claims broader than the invention

A patent claim which claims more than what was invented or disclosed can be found invalid for being overly broad.³⁹ This is sometimes referred to as “covetous claiming”.⁴⁰ A patentee must not fence in any property that is not his or her own, or he or she will lose everything.⁴¹

Overclaiming is prohibited by the Patent Act and Patent Rules. A patent is to end with claims that define distinctly and in explicit terms the subject-matter of the invention.⁴² The claims must be clear and concise and “shall be fully supported by the description independently of any

³⁶ *AlliedSignal Inc. v. Du Pont Canada Inc. et al*, (1995), 61 C.P.R. (3d) 417 (F.C.A. per Desjardins J.A.) at p. 431.

³⁷ *Mobil Oil Corporation et al v. Hercules Canada Inc.*, (1995), 63 C.P.R. (3d) 473 (F.C.A. per Marceau J.A.), at [pp. 483-484](#).

³⁸ *Procter & Gamble Inc. and The Procter & Gamble Company v. Unilever PLC, and Lever Brothers Limited* (1995), 61 C.P.R. (3d) 499 (F.C.A. per Stone J.A.) [at p. 519](#).

³⁹ *Farbwerke Hoechst A.G. Vormals Meister Lucius & Bruning v. Canada (Commissioner of Patents)* (1965), [1966] Ex. C.R. 91 (Can. Ex. Ct.), aff'd [1966] S.C.R. 604; *Leithiser et al. v. Pengo Hydra-Pull of Canada Ltd.*, [1974] 2 F.C. 954, 17 C.P.R. (2d) 110 at 118 (F.C.A.); *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2007 FCA 209, at paras. 115 & 116, leave to appeal to S.C.C. refused, [2007] S.C.C.A. No. 377; *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2008 FC 11, at para. 45. *Eli Lilly Canada Inc. v. Apotex Inc.*, 2008 FC 142, at para. 180.

⁴⁰ *Pfizer Canada Inc. v. Novopharm Ltd.*, 2005 FC 1299 at para. 84 citing *Abbott Laboratories v. Canada (Minister of Health)*, 2004 FC 1349; [2004] F.C.J. No. 1644 (QL).

⁴¹ *Biovail Pharmaceuticals Inc. v. Canada (Minister of National Health & Welfare)*, 2005 FC 9 at paras. 8 & 61 citing *Minerals Separation North American Corp. v. Noranda Mines Ltd.*, [1947] Ex. C.R. 306 at page 52, as quoted in *Free World Trust v. Électro Santé Inc. et al.*, (2001) 9 C.P.R. (4th) 168 (S.C.C. per Binnie, J.) at para. 14.

⁴² *Patent Act*, s. 27(4).

document referred to in the description.”⁴³ If the disclosures of the specification do not support the claims, then the claims are invalid.⁴⁴

Where the general description of the invention in the specification (not the description of the preferred embodiment) described a certain feature as being “an object of the invention”, the Court has concluded that it was an essential feature of the invention and its absence from the broadest claim rendered that claim invalid as being too broad.⁴⁵ Omission of a non-essential feature from a claim does not render the claim invalid.⁴⁶

8.5 Inventorship and s. 53: “Fraud on the Patent Office”

8.5.1 Inventorship

Ironically, the term “inventor” is not defined in the *Patent Act*, but his or her existence and characteristics can be inferred from elsewhere in the *Patent Act*.

The inventor is the person who conceived the “new and useful” art, process, machine, manufacture or composition of matter that constitutes the “invention” defined by s. 2 of the *Patent Act*.⁴⁷ The ultimate question is therefore: who was responsible for the inventive concept?⁴⁸ In the instance of a combination of elements, the question is not who contributed what element to the combination, but instead, who was responsible for the combination?⁴⁹

Because the invention must be sufficiently described in the patent disclosure to enable a skilled reader to make or use the invention,⁵⁰ the invention must have been reduced to a definite and

⁴³ *Patent Rules*, Rule 84.

⁴⁴ *Radio Corp. of America v. Raytheon Manufacturing Co.* (1957), 27 C.P.R. 1 at 12 (Ex. Ct.), as cited in *Leithiser et al. v. Pengo Hydra-Pull of Canada Ltd.*, [1974] 2 F.C. 954, 17 C.P.R. (2d) 110 (F.C.A.) at p. 112.

⁴⁵ *Amfac Foods Inc. et al v. Irving Pulp & Paper, Ltd.* (1987) 12 C.P.R. (3d) 193 (F.C.A. per Urie J.) at pp. 197 & 201-205.

⁴⁶ *VISX Inc. v. Nidek Co.*, [1999] F.C.J. No. 1971 (F.C.T.D.) at para. 145; *Stonehouse v. Batco Manufacturing Ltd.*, 2004 FC 1767 at para. 174 citing *Metalliflex Ltd. v. Wienerberger Aktiengesellschaft* (1960), 35 C.P.R. 49 (QL) per Taschereau J., *The King v. Uhlemann Optical Co.*, 15 C.P.R. 99, [1952] 1 S.C.R. 143 and *Can. Tire Corp. v. Samson-United of Can. Ltd.*, [1940] 3 D.L.R. 64, S.C.R. 386.

⁴⁷ *Apotex Inc. v. Wellcome Foundation Ltd.*, 2002 SCC 77, [2002] 4 S.C.R. 153 at para. 96.

⁴⁸ *Apotex Inc. v. Wellcome Foundation Ltd.*, 2002 SCC 77, [2002] 4 S.C.R. 153 at para. 97.

⁴⁹ *Apotex Inc. v. Wellcome Foundation Ltd.*, 2002 SCC 77, [2002] 4 S.C.R. 153 at para. 97 quoting with approval *Henry Bros. (Magherafelt) Ltd. v. Ministry of Defence and the Northern Ireland Office* [1997] R.P.C. 693 (Eng. Ch. Div. per Jacob J.) at p. 706.

⁵⁰ *Patent Act*, s. 34(1).

practical shape.⁵¹ It is the people who contributed to the conception rather than the implementation who are the inventors.⁵²

A person who contributes to the inventive concept may be a co-inventor without being the prime originator; a person who helps the invention to completion, but whose ingenuity is directed to verification is not.⁵³

To be an inventor, the invention must have originated in his or her own mind.⁵⁴ An inventor of an invention must be two things:

“(i) the person who first conceives of a new idea or discovers a new thing that is the invention; and

(ii) the person that sets the conception or discovery into a practical shape.”⁵⁵

A person is not an inventor if he or she borrowed the invention from someone else:

“That person [the inventor] must, however, be a true inventor, that is he must not have borrowed it from anyone else. This principle was laid down in Great Britain by the courts there as early as 1776, and is still accepted as expressing the law.”⁵⁶

Someone who carries out the instructions of others is not an inventor. Even the first person to make or use the invention is not an inventor if they merely learned what to do from the true inventor(s). When determining inventorship, the inventors are the people who came up with the invention. The tradespeople who actually machined it or the technician who first operates it are not inventors. For example, a certain breakfast cereal was invented by scientists or engineers at Kelloggs and not by the technicians who first operated the machine according to the designers' instructions.⁵⁷

⁵¹ *Apotex Inc. v. Wellcome Foundation Ltd.*, 2002 SCC 77, [2002] 4 S.C.R. 153 at para. 97; *The Permutit Company v. Borrowman* 43 R.P.C. 356: “It is not enough for a man to say that an idea floated through his brain, he must at least reduce it to a definite and practical shape before he can be said to have invented a process.”

⁵² *Apotex Inc. v. Wellcome Foundation Ltd.*, 2002 SCC 77, [2002] 4 S.C.R. 153 at para. 97.

⁵³ *Apotex Inc. v. Wellcome Foundation Ltd.*, 2002 SCC 77, [2002] 4 S.C.R. 153 at para. 99.

⁵⁴ *Comstock Canada v. Elected Ltd.* (1991) 38 C.P.R. (3d) 29 (F.C.T.D. per Muldoon J.) at para. 65.

⁵⁵ *Apotex Inc. v. Wellcome Foundation Ltd.* (2000) 10 C.P.R. (4th) 65 (F.C.A. per Sexton J.A., Rothstein and Malone J.J.A.) at para. 32.

⁵⁶ *Gerrard Wire Tying Machines Co. v. Cary Manufacturing Co.* [1926] Ex. C.R. 170 (Ex. Ch. per Maclean J.) at para. 23

⁵⁷ *Kellogg Company v. Helen L. Kellogg*, [1942] Ex. C.R. 87, at p. 97) related to whether Kellogg Jr. was an inventor. He operated the machine designed by others [at p. 97]:

If a person merely verifies another person's previous predictions, the person is not an inventor.⁵⁸

The person who merely presents a problem for solution, without having a significant role in solving the problem, is not an inventor.⁵⁹ Unless and until the invention works or predictably will work, there is no invention – failed experiments do not count. It is the first person to establish utility or have a sound basis for predicting utility who is the inventor.⁶⁰

8.5.2 s. 53

Although there is no provision under Canadian patent law regarding fraud on the Patent Office,⁶¹ section 53(1) of the *Patent Act* comes close:

“A patent is void if any material allegation in the petition of the applicant in respect of the patent is untrue, or if the specification and drawings contain more or less than is necessary for obtaining the end for which they purport to be made, and the omission or addition is wilfully made for the purpose of misleading.”

The section has been interpreted as having two parts:

“A patent is void:

(a) if any material allegation in the petition of the applicant in respect of the patent is untrue, or

“His [Kellogg Jr.’s] operation of the gun with Swartz, which they were directed to do, was purely a mechanical act, with an instrumentality purchased by the Kellogg company to do the very thing that was done by it. It seems to me utterly untenable to say that this of itself was invention, or was an element contributed by Kellogg Jr. in making the invention. It might well have happened that Kellogg Jr. would have been off duty at the important lunch hour in question here and replaced by some other of the Experimental Department staff, and there would not seem to be any reason why any one else could not have achieved the same result with the same gun. I can conceive of no ground whatever for suggesting that anything Kellogg Jr. did had any of the elements of invention in it.”

⁵⁸ *Apotex Inc. v. Wellcome Foundation Ltd.*, 2002 SCC 77, [2002] 4 S.C.R. 153 at para. 97; *Apotex Inc. v. Wellcome Foundation Ltd.* (2000) 10 C.P.R. (4th) 65 (F.C.A. per Sexton J.A., Rothstein and Malone J.J.A.) at [para. 33](#) citing *Re May & Baker Ltd. and Ciba Ltd.* (1948), 65 R.P.C. 255 (High Court per Jenkins J.) at [p. 281](#). The requisite “useful qualities” of an invention “must be the inventor’s own discovery as opposed to mere verification by him of previous predictions.”

⁵⁹ *Goldfarb v. W.L. Gore & Associates Inc.* (2001) 11 C.P.R. (4th) 129 (F.C.T.D. per Lemieux J.) at para. 116 citing *Procter & Gamble Co. v. Kimberley-Clark of Canada Ltd.* (1991), 40 C.P.R. (3d) 1 (F.C.T.D. per Teitelbaum J.) at p. 54.

⁶⁰ *Goldfarb v. W.L. Gore & Associates Inc.* (2001) 11 C.P.R. (4th) 129 (F.C.T.D. per Lemieux J.) at paras. 144, 149 and 156-158.

⁶¹ *Eli Lilly Canada Inc. v. Apotex Inc.*, 2009 FCA 97 at para 15.

(b) if:

(i) the specification and drawings contain more or less than is necessary for obtaining the end for which they purport to be made, and

(ii) the omission or addition is wilfully made for the purpose of misleading.”

The onus is on the party alleging an intention to mislead to prove it.⁶² The section must be pleaded with particularity⁶³

In contrast, there is no provision in the *Patent Act* that an untrue allegation, even amounting to a misrepresentation, made in the course of the prosecution of the application for the patent in the Canadian Patent Office, has any effect on the validity of the patent.⁶⁴

8.5.2.1 untrue material allegation in the petition

A plain reading of the first part of the section (dealing with “any material allegation in the petition”) does not require wilfulness.⁶⁵ Yet many judges have discussed wilfulness when considering this part of the section, in connection with the alleged mis-naming of inventors, both in obiter,⁶⁶ and in disposing of claims in respect of this part of the section.⁶⁷

⁶² *Eli Lilly Canada Inc. v. Novopharm Ltd.* 2007 FC 596 (2007), 58 C.P.R. (4th) 214 at para. 169

⁶³ 2009 FC 711 (F.C. per Hughes J.) at para. 196.

⁶⁴ Such as failing to failed to inform the Canadian Examiner that certain claims had been rejected by the U.S. Patent Office: *Eli Lilly & Co. v. Apotex Inc.* (1998) 80 C.P.R. (3d) 80 (F.C.T.D. per Richard J.) at para. 27.

⁶⁵ *Beloit Canada Ltd. v. Valmet Oy* (1984), 78 C.P.R. (2d) 1 (F.C.T.D. per Walsh J.) at pages 28-29 (reversed on other grounds *Beloit Canada Ltée/Ltd. v. Valmet Oy* (1986), 8 C.P.R. (3d) 289 (Fed. C.A.), at page 301):

“Even without the jurisprudence a careful reading of s.55(1) of the Patent Act, indicates that a patent can be void if any material allegation in the petition of the applicant is untrue. Since this phrase is followed by the word "or", and the concluding phrase "and any such omission or addition is wilfully made for the purpose of misleading" this clearly applies only to the second phrase as the first phrase does not deal with omissions or additions. Subsection (2) allows the court to find that the omission or addition was an involuntary error and to find that the patentee is entitled to the remainder of his patent. It, however, is only applicable to the second and third phrases of s-s. (1). What the court is required to find in the present case, which does not concern omissions or additions to the specifications or drawings, is whether the erroneous allegations in the petition are "material", no evidence of fraud or intent to mislead being necessary.”

⁶⁶

In *Procter & Gamble Co. v. Bristol-Myers Canada Ltd.* (1978), 39 C.P.R. (2d) 145 (F.C.T.D.), after holding that Mr. Gaiser was the only inventor, Addy J. further disposed of the subsection 53(1) (then subsection 55(1)) argument on the assumption that Purex people were joint inventors by concluding that the

failure to name the Purex people would not have rendered the patent void. He stated at pages 156-157:

“There is absolutely no evidence of any willful misleading of the Commissioner of Patents. I consider that, in such circumstances, it is really immaterial to the public whether the applicant is the inventor or one of two joint inventors as this does not go [sic] to the term or to the substance of the invention nor even to entitlement. In other words, I do not in such circumstances consider it to be a material allegation as contemplated by s. 55(1) of the *Patent Act*.”

Not naming an inventor from another company would go to the entitlement of the named patentee to the patent.

- In *Apotex Inc. v. Wellcome Foundation Ltd.* (1998) 79 C.P.R. (3d) 193, at para. 234, Justice Wetston found that the named inventors were entitled to the grant of the patent as true inventors. He agreed with the decision of Mr. Justice Addy in *Procter & Gamble Co. v. Bristol-Myers Canada Ltd.*, and found that the failure to name the co-inventors was not, in this case, a material allegation and, therefore, on this ground, insufficient to render the patent invalid. Moreover, he did not consider that, on the facts of the case, that there has been a false or misleading petition with respect to inventorship in this matter.

At the Supreme Court, in *Apotex Inc. v. Wellcome Foundation Ltd.* 2002 SCC 77, [2002] 4 S.C.R. 153, (2002), 219 D.L.R. (4th) 660, in *obiter*, after concluding that Drs. Broder and Mitsuya were not co-inventors, Binnie J., for the Court, observed as follows at paragraph 94:

“The appellants contend that Drs. Broder and Mitsuya were “co-inventors” and ought to have been so identified in the patent. For this argument to benefit the appellants (as opposed to Drs. Broder and Mitsuya), the appellants must further establish that this omission was a “material” misstatement that was “wilfully made for the purpose of misleading”. If so, the patent would be void pursuant to s. 53(1) of the *Patent Act*.”

Binnie J. expressly concluded, at paragraph 109, that it was not necessary to consider the issue of materiality under subsection 53(1).

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- In *671905 Alberta Inc. v. Q'Max Solutions Inc.*, 2003 FCA 241, [2003] 4 F.C. 713 per Stone J.A. at para. 32, the mis-naming of themselves as inventors was not done by the Flemings willfully for the purpose of misleading and therefore, s. 53(1) was not established.
- Similarly, in *DEC International, Inc. v. A.L. LaCombe & Associates Ltd.*, (1989), 26 C.P.R. (3d) 193 (F.C.T.D. per Martin J.), without citing or reviewing any case law, it was held that a patent should not be declared invalid pursuant to what is now section 53 of the *Patent Act* in circumstances where the corporate employer, in good faith, named the wrong employee as the inventor rather than the employee who was the true inventor, presumably because, under the circumstances, it was not material. At paras. 94-95:

“Finally, as counsel for the plaintiff correctly says, the plaintiff is the legal representative of the inventor, whether the inventor be Russell or Petranyi. Should it transpire that the inventor is Russell rather than Petranyi, then the plaintiff would be no less entitled to the patent so that the patent which did issue should have been issued in any event.

Given that result it is my view that the innocent error made by the plaintiff in the circumstances of this case should not be allowed to defeat the presumption of validity of the patent,

Based on the obiter statement of Justice Binnie in *Wellcome*,⁶⁸ Justice Stone of the Federal Court of Appeal held, in a case where the named inventors in the petition were not inventors and the true inventor was not named in the petition:

“Thus the position today is that an untrue "material allegation" that consists of a failure to name co-inventors in a petition for a patent will not render the patent void if the allegation was not "wilfully made for the purpose of misleading".”⁶⁹

However, subsequently, the Federal Court has allowed a party to plead that wilfulness is not an essential element of the test under s. 53(1) in circumstances where some but not all inventors were named in the petition.⁷⁰

The truth of the allegations in the patent must be considered as of the time of issue of the patent. It is at that moment that they become the basis on which patent rights are granted. If at that moment they are untrue and, if they are material, the basis for the grant of a patent is lacking and the patent is void. An untrue allegation made earlier, but corrected before issue of the patent, would not void the patent.⁷¹

The only allegations in a petition which are material are those which relate to the subject-matter of the claims of the patent as granted:

“Allegations in the petition respecting anything other than the subject matter of the claims in the patent as granted are not material. ... The material allegation of a petition in the form prescribed by the *Patent Rules* are thus, in my opinion, (1) the allegation that the applicant has made the invention of which a monopoly is granted, and (2) the allegation of facts that bring the application within the statutory prescriptions.”⁷²

assuming that there was an invention, and that it should not be declared invalid on that account.”

⁶⁸ *Apotex Inc. v. Wellcome Foundation Ltd.* 2002 SCC 77, [2002] 4 S.C.R. 153, (2002), 219 D.L.R. (4th) 660, at para. 94. Having decided that Drs. Broder and Mitsuya were not co-inventors, the Court then went on to state that if they were co-inventors:

“For this argument to benefit the appellants (as opposed to Drs. Broder and Mitsuya), the appellants must further establish that this omission was a "material" misstatement that was "wilfully made for the purpose of misleading". If so, the patent would be void pursuant to s. 53(1) of the *Patent Act*.”

⁶⁹ *671905 Alberta Inc. v. Q'Max Solutions Inc.*, 2003 FCA 241, [2003] 4 F.C. 713 (F.C.A. per Stone J.A.) at para. 31.

⁷⁰ *Zambon Group S.P.A. v. Teva Pharmaceutical Industries Ltd.* 2005 FC 1585 (F.C. per Hansen J.)

⁷¹ *Jules R. Gilbert Ltd. v. Sandoz Patents Ltd.*, (1970), 64 C.P.R. 14 (Can. Ex. Ct.) at para. 117, (reversed on other grounds *Sandoz Patents Ltd. v. Gilcross Ltd.*, *Sandoz Patents Ltd. v. Gilcross Ltd.* (1972), 8 C.P.R. (2d) 210 (S.C.C.)).

⁷² *Jules R. Gilbert Ltd. v. Sandoz Patents Ltd.*, (1970), 64 C.P.R. 14 (Can. Ex. Ct.) at p. 74, para. 118, (reversed on other grounds *Sandoz Patents Ltd. v. Gilcross Ltd.*, *Sandoz Patents Ltd. v. Gilcross Ltd.* (1972), 8 C.P.R. (2d) 210 (S.C.C.)).

8.5.2.2 *wilful omission or addition to mislead*

With respect to the second circumstance, where the omission or addition was the result of an involuntary error, the rest of the patent can be salvaged.⁷³

Proof of wilfulness is an essential element of this attack on a patent requiring either direct evidence or sufficient evidence from which intent to mislead can be inferred.⁷⁴ An intention to mislead was inferred recently in *Ratiopharm Inc. v. Pfizer Limited*⁷⁵ where:

- (a) misstatements were made in the disclosure to enhance the alleged uniqueness, outstanding characteristics and particular suitability of the invention, which characteristics were not true;
- (b) the words were the product of the patent draftperson, from whom the inventors distanced themselves;
- (c) the Court inferred that Pfizer knew there were problems with the patent as drafted and took no steps to do anything about it save to mount a vigorous defence.⁷⁶

Thus, a misstatement of inventorship in the petition, made knowing the named inventors were not the true inventors, would affect ownership of and therefore entitlement to a patent, and would trigger s. 53(1) and render the patent invalid. Where the misstatement was made innocently, according to the current construction of s. 53(1), the patent would not be invalid.

8.6 *Impeachment Proceedings*

Only an "interested person" under [s. 60\(1\)](#) of the *Patent Act* can commence an action to impeach a patent. This includes a person dealing with the same kind of product who is in competition with the patentee.⁷⁷

⁷³ s. 53(2) provides:

Where it appears to a court that the omission or addition referred to in subsection (1) was an involuntary error and it is proved that the patentee is entitled to the remainder of his patent, the court shall render a judgment in accordance with the facts, and shall determine the costs, and the patent shall be held valid for that part of the invention described to which the patentee is so found to be entitled.

⁷⁴ *Eli Lilly Canada Inc. v. Apotex Inc.*, 2007 FC 455 (F.C.T.D.) at para. 381.

⁷⁵ 2009 FC 711 (F.C. per Hughes J.) at para. 204.

⁷⁶ 2009 FC 711 (F.C. per Hughes J.) at paras. 199-201.

⁷⁷ *Wakefield Properties Corp. v. Teknion Furniture Systems Inc.*, (1992), 44 C.P.R. (3d) 474 (F.C.T.D. per Jerome A.C.J.)

In one case it was held to be sufficient to plead that the plaintiff is the owner of the patent in that the invention was made by its employee in the course of his employment and that the patent was obtained by the defendant in breach of the plaintiff's rights.⁷⁸

Where the person impeaching the patent is relying upon prior knowledge and use, it must provide particulars of when and in what manner the earlier knowledge and use occurred, and where the concept of the invention is alleged to have been described in earlier applications that resulted in patents.⁷⁹

8.7 Security For Costs

A person commencing impeachment proceedings must, pursuant to [s. 60\(3\)](#) of the *Patent Act* provide security for costs before proceeding with the action.

⁷⁸ *E.I. Dupont de Nemours & Co. et al v. Diamond Shamrock Corporation* (1980), 47 C.P.R. (2d) 204 (F.C.T.D. per Cattanach J.)

⁷⁹ *E.I. Du Pont de Nemours & Co. et al v. Diamond Shamrock Corp.* (1980), 46 C.P.R. (2d) 68 (F.C.T.D. per Cattanach J.)