

Federal Court



Cour fédérale

Date: 20200428

Docket: T-1813-19

Citation: 2020 FC 561

Ottawa, Ontario, April 28, 2020

PRESENT: Mr. Justice Sébastien Grammond

BETWEEN:

ALFASIGMA S.P.A.

Applicant

and

**THE ATTORNEY GENERAL OF CANADA
and THE COMMISSIONER OF PATENTS**

Respondents

JUDGMENT AND REASONS

[1] Alfasigma S.P.A. [Alfasigma] makes an application to correct Canadian patent no. 2,538,546 [the ‘546 patent] in order to add the name of Mr. Denis Severini to the list of inventors.

[2] The ‘546 patent relates to polymorphic forms of rifaximin, an antibiotic. Mr. Severini was a member of a team of researchers who discovered those polymorphic forms. Mr. Severini

was named as inventor on Italian patent no. MI2003A002144, to which the '546 patent claims priority. However, when an application was made under the Patent Cooperation Treaty, Mr. Severini's name was inadvertently omitted. As a result, Mr. Severini's name was also omitted on the '546 patent, as well as on similar patents in other jurisdictions.

[3] An application of this kind is governed by section 52 of the *Patent Act*, RSC 1985, c P-4. Section 52 states that this Court has jurisdiction to order the variation of any entry in the records of the Patent Office. Section 52 does not set out the circumstances in which such an order may be made. This Court has said, however, that the criteria found in section 31(4), which governs the addition of applicants to a patent application, are relevant to an application under section 52 (*Micromass UK Ltd v Canada (Commissioner of Patents)*, 2006 FC 117; *Plasti-Fab Ltd v Canada (Attorney General)*, 2010 FC 172). Section 31(4) allows further applicants to be joined where “the omission of the further applicant or applicants had been by inadvertence or mistake and was not for the purpose of delay.” Moreover, in *Gilead Sciences, Inc v Canada (Commissioner of Patents)*, 2019 FC 70, I suggested that it is useful to have evidence that there is no pending litigation concerning the patents at issue.

[4] I am satisfied, on the basis of the application record, that Mr. Severini's name has been omitted from the original application by inadvertence or mistake and that he should have been named as an inventor. Alfasigma's application is supported by affidavits of all the other inventors, who all consent to the proposed amendment. I also note that a similar application was made with respect to the corresponding American patent and was granted by the United States Patent and Trademark Office, and that Mr. Severini's name was added to corresponding patents

in several other countries. Alfasigma brought evidence that there is no pending litigation involving the '546 patent. It also gave notice of the application to the current Canadian licensees of the '546 patent. There is no evidence of any improper purpose.

[5] For those reasons, Alfasigma's application is granted.

JUDGMENT in T-1813-19

THIS COURT'S JUDGMENT is that:

1. The Commissioner of Patents shall, under section 52 of the Patent Act, vary all entries in the records of the Patent Office relating to Canadian Patent No. 2,538,546 issued on April 19, 2011, to correct the names of the inventors by adding Denis Severini as co-inventor.
2. No order as to costs.

“Sébastien Grammond”

Judge

FEDERAL COURT

SOLICITORS OF RECORD

DOCKET: T-1813-19

STYLE OF CAUSE: ALFASIGMA S.P.A. v THE ATTORNEY GENERAL OF
CANADA and THE COMMISSIONER OF PATENTS

APPLICATION CONSIDERED IN WRITING AT OTTAWA, ONTARIO

JUDGMENT AND REASONS: GRAMMOND J.

DATED: APRIL 28, 2020

WRITTEN REPRESENTATIONS BY:

Andrew Skodyn
Melanie K. Baird
Sean Jackson

FOR THE APPLICANT

SOLICITORS OF RECORD:

Blake, Cassels & Graydon LLP
Barristers and Solicitors
Toronto, Ontario

FOR THE APPLICANT