

Federal Court



Cour fédérale

Date: 20211213

Docket: T-240-21

Citation: 2021 FC 1394

Ottawa, Ontario, December 13, 2021

PRESENT: Mr. Justice Pentney

BETWEEN:

**H. LUNDBECK A/S and
TAKEDA PHARMACEUTICALS U.S.A.,
INC.**

Applicants

and

THE COMMISSIONER OF PATENTS

Respondent

JUDGMENT AND REASONS

[1] The Applicants, H. Lundbeck A/s (Lundbeck) and Takeda Pharmaceuticals U.S.A., Inc. (Takeda), seek an Order pursuant to section 52 of the *Patent Act*, RSC 1985, c P-4 [*Act*] relating to Canadian Patent No. 2,705,163 (the “163 Patent”). They seek to correct the listing of the names of the inventors by removing Jin Chon, Aneil Batra and Nicholas Moore as inventors, and to correct the listing of the owners by removing Takeda as co-owner of this patent.

[2] For the following reasons, this Application will be granted.

I. Background

[3] In the course of reviewing its patent portfolio, Lundbeck discovered a discrepancy between the '163 Patent in Canada and its equivalent patent in the United States. The following narrative derived from the affidavits filed by the individual inventors, as well as representatives of both Lundbeck and Takeda, explains how this discrepancy arose and why Lundbeck now seeks to correct the Patent Register.

[4] The Applicants are presently listed as co-owners of the '163 Patent. The '163 Patent was issued on February 12, 2013 from an application filed on November 12, 2008 (PCT Application No. PCT/DK2008/050271 or PCT Application). It claims priority from Denmark Patent Application No. PA 200701607 filed November 13, 2007; US Application 60/987,710 filed November 13, 2007; Denmark Application PA 200701788 filed December 14, 2007; US Application 61/013,722 filed December 14, 2007; Denmark Application PA 200801300 filed September 17, 2008; and US Application 61/097,840 filed September 17, 2008.

[5] The PCT Application named Marianne Dragheim, Nicholas Moore, and Aneil Batra as inventors and Jin Chon, Lundbeck and Takeda as applicants. Jin Chon was subsequently changed from an applicant to a named inventor during the prosecution of the 163 Patent. The national phase entry was prepared based on the published PCT Application; hence, Marianne Dragheim, Nicholas Moore, Aneil Batra, and Jin Chon were all listed as inventors on the 163 Application, with Lundbeck and Takeda as named applicants.

[6] Nicholas Moore and Marianne Dragheim each assigned their interests in the 163 Patent to Lundbeck, while Aneil Batra and Jin Chon each assigned their interest to Takeda. Accordingly, Lundbeck and Takeda are currently listed as the two owners of the 163 Patent, and Marianne Dragheim, Nicholas Moore, Aneil Batra, and Jin Chon are currently listed as co-inventors.

[7] On the Canadian national entry date, the PCT Application and the '163 Application comprised 30 claims. However, during the prosecution of the 163 Patent, the Patent Office issued an Office Action that raised a number of concerns with the Application as it then existed. In response, original claims 1-28 were cancelled, original claim 29 was renumbered as new claim 1, original claim 30 was renumbered as new claim 7, and new claims 2-6 and 8-18 were added. The new claim set 1-18 all related to treatment of depression, anxiety, abuse, or chronic pain in a patient who has previously received medication for the treatment of depression, anxiety, abuse, or chronic pain and the medication was ceased or reduced due to sleep or sexually related adverse events.

[8] Following the amendments, the invention claimed in the 163 Patent stemmed exclusively from Marianne Dragheim. However, by inadvertence, the inventorship and ownership listed in the Application were not amended during prosecution to reflect the new claim set. The 163 Patent subsequently issued with the new claims 1-18, but continued to list Marianne Dragheim, Nicholas Moore, Aneil Batra, and Jin Chon as co-inventors, and Lundbeck and Takeda as co-owners.

[9] Lundbeck and Takeda corrected the corresponding U.S. Patent No. 9,278,09 [US Patent] to include only Marianne Dragheim as the inventor and only Lundbeck as the owner. However,

the inventorship and ownership of the 163 Patent were mistakenly not amended and this discrepancy was only recently discovered during a review of Lundbeck's patent portfolio.

II. Issues

[10] The only issue raised is whether the correction of the inventorship and ownership of the 163 Patent should be granted, so that the records in the Patent Office would be amended to: remove the names of Nicholas Moore, Aneil Batra, and Jin Chon as inventors; and to remove Takeda as a co-owner.

III. Analysis

[11] Section 52 of the *Patent Act* provides that the "Federal Court has jurisdiction... to order that any entry in the records of the Patent Office relating to the title to a patent be varied or expunged." By virtue of this, this Court has "the jurisdiction to vary or expunge the title to a patent as reflected in the records of the Patent Office." (*Salt Canada Inc v Baker*, 2020 FCA 127 at para 8).

[12] The word "title" has been interpreted broadly to include matters relating to the root of title (*Micromass UK Ltd v Canada (Commissioner of Patents)*, 2006 FC 117 [*Micromass*] at para 13). This provision has been relied on both to correct the records regarding who is listed as an inventor or co-inventor (*Pharma Inc v Canada (Commissioner of Patents)*, 2019 FC 208 [*Pharma*] at para 4) and the ownership of a patent as a consequence of correcting inventorship (*Micromass* at para 14; *Imperial Oil Resources Ltd v Canada (Attorney General)*, 2015 FC 1218 [*Imperial Oil*] at para 19).

[13] By virtue of this, this Court has jurisdiction to deal with this matter.

[14] There is also no doubt that Lundbeck and Takeda are each a “person interested” pursuant to section 52 of the *Patent Act*, and thus have standing to bring this application. I note here that the Attorney General of Canada, on behalf of the Respondent the Commissioner of Patents, takes no position on the merits of the application and did not file any materials or otherwise participate.

[15] The *Act* does not specify a test for applications pursuant to section 52. In previous cases involving the addition or deletion of an inventor’s (or co-inventor’s) name, the Court has considered the test set out in subsections 31(3) and (4) of the *Act*, which relate to the addition or removal of applicants to a pending patent application (*Pharma* at para 5). This Court’s jurisprudence has endorsed the following test: Application,

[15] Subsection 31(3) of the *Act* sets out two criteria for the removal of named inventors:

- i. does it appear that one or more of the named inventors have no part in the invention?; and
- ii. has an affidavit been provided to satisfy the Court that the remaining inventors are the sole inventors? (*Imperial Oil* at para 15, cited in *Inguran LCC dba STgenetics v Canada (Commissioner of Patents)*, 2020 FC 338 [*Inguran*] at para 37).

[16] The evidence here provides clear answers to both questions. The affidavits of Nicholas Moore, Aneil Batra and Jin Chon state unequivocally that they took no part in the invention that is the subject of the 163 Patent as it is currently registered, and that they are not inventors thereof. The evidence also shows that these individuals were removed as co-inventors in the

corresponding US Patent. Further, in each of their affidavits, these individuals consent to their removal as a listed co-inventor of the 163 Patent.

[17] On the second question, the remaining inventor, Marianne Dragheim attests that she is the sole contributor to the subject matter of the claims in the PCT Application that went on to become the invention that is the subject matter of the 163 Patent as it was registered in Canada, and therefore she is the sole inventor of the 163 Patent.

[18] In addition, Marianne Dragheim attests that she assigned her legal rights in the 163 Patent to Lundbeck. In light of that, Lundbeck claims that the 163 Patent should be corrected to list it as the sole owner. Because Takeda itself consents to this change, this is also not in dispute.

[19] The evidence shows that the failure to make this request earlier was due to an oversight and not undue or unexplained delay. The request to change inventorship was filed with the US Patent Office in October 2010, and the evidence shows that the discrepancy between the two patents was only recently discovered. In some respects, this case is similar to *Inguran*, where a correction was ordered because several individuals were inadvertently listed as inventors after the Canadian Intellectual Property Office required a division of the patent. When the error was discovered, the owner applied under section 52 of the *Act*, and Justice Brown concluded that the evidence supported that the error was the result of an inadvertence.

[20] The only wrinkle that arises in this matter is that subsequent to filing its Motion Record in this matter, Lundbeck received a Notice of Allegation (NOA) in relation to the 163 Patent. The question is whether this constitutes “pending litigation” and as a consequence any other party should have been given notice of this proceeding. Lundbeck quite properly drew this to the

Court's attention. It asserts that the "detailed statement provided in the NOA, which sets out the various allegations pertaining to the 163 Patent, does not allege improper inventorship, improper ownership, nor does it allege invalidity via section 53(1) of the Patent Act." Therefore, Lundbeck argues that "while receipt of a NOA may arguably constitute 'pending litigation', the material facts – namely that no rights would be directly affected by the Order sought, and that no other party is required to be named in this Application – remain unchanged."

[21] I am not aware of any jurisprudence that addresses the specific question of an application for a correction being brought in the face of pending litigation. However, Justice Martineau dealt with a somewhat similar question in *Everlight Electronics Co, Ltd v Canada (Attorney General)*, 2017 FC 1108 [*Everlight*]. In that case, in granting an application under section 52 of the *Act*, Justice Martineau observed that prior cases had considered the fact that no third parties would be affected (citing *Micromass and Novartis AG v Canada (Attorney General)*, 2016 FC 229). He then indicated at paragraph 5 that "[t]he proposed variation will cause no prejudice to third parties, as no outsider is claiming an interest in the Patent, there is no ongoing infringement case, and the rest of the Assignment is immaterial to the public."

[22] In the instant case, the NOA does not impugn ownership or inventorship of the 163 Patent, and there is no indication as to how the results of this Application would prejudice the rights or interests of the parties to the NOA. Accordingly, in my view granting the application despite the NOA is appropriate because "[i]t is immaterial to the public whether there is one inventor or two joint inventors as this does not go to the term or to the substance of the invention nor even to entitlement" (*Micromass* at para 16). The same may be said about ownership of the

163 Patent, since there is no indication that this change is anything other than a correction of an oversight that could have been done long ago.

[23] On the evidence before me, there is no basis for any concern that any third party's interests are affected or that any other party should have been named in this proceeding even after the Notice of Allegation was received. I conclude, therefore, that the fact that a Notice of Allegation has been received does not affect the result here.

IV Conclusion

[24] For these reasons, the Applicant's Application to correct the name of the inventor and the name of the patent owner of the 163 Patent will be granted.

[25] No costs are requested, and none are ordered.

JUDGMENT in T-240-21

THIS COURT'S JUDGMENT is that:

1. The application pursuant to section 52 of the *Patent Act* to vary the records in the Patent Office relating to Canadian Patent No. 2,705,163, issued February 12, 2013, is granted.
2. The Patent Office shall vary the entry in the records to correct the names of the inventors listed in Canadian Patent No. 2,705,163 by removing Nicholas Moore, Aneil Batra and Jin Chon as co-inventors, leaving only the name of Marianne Dragheim as a listed inventor.
3. The Patent Office shall vary the entry in the records to correct the name of the owner listed in Canadian Patent No. 2,705,163 by removing Takeda Pharmaceuticals U.S.A. Inc., as co-owner.
4. No costs are awarded.

“William F. Pentney”

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-240-21

STYLE OF CAUSE: H. LUNDBECK A/S and
TAKEDA PHARMACEUTICALS U.S.A., INC. v
THE COMMISSIONER OF PATENTS

PLACE OF HEARING: N/A

DATE OF HEARING: N/A

JUDGMENT AND REASONS: PENTNEY J.

DATED: DECEMBER 13, 2021

APPEARANCES:

JOHN NORMAN FOR THE APPLICANT
ALEX GLOOR
REBECCA STILES

N/A FOR THE RESPONDENT

SOLICITORS OF RECORD:

Gowling WLG (Canada) LLP FOR THE APPLICANT
Ottawa, Ontario

N/A FOR THE RESPONDENT