

Federal Court



Cour fédérale

Date: 20240619

Docket: T-2200-23

Citation: 2024 FC 949

Ottawa, Ontario, June 19, 2024

PRESENT: The Honourable Madam Justice Tsimberis

BETWEEN:

**SMITH SPORT OPTICS, INC. AND
KOROYD SARL**

Applicants

and

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

Respondents

JUDGMENT AND REASONS

I. Background

[1] The Applicants, Smith Sport Optics, Inc. and Koroyd SARL [Koroyd], seek (a) to have John Lloyd, James Rogers, and Piers Storey added as inventors to Canadian Patent No. 2,858,707 [707 Patent], (b) to have Koroyd added as an owner to the 707 Patent, and (c) to have current owner “Smith Optics, Inc.” replaced with its correct legal name “Smith Sport Optics,

Inc.” as an owner to the 707 Patent, pursuant to section 52 of the *Patent Act*, RSC, 1985, c P-4 [*Patent Act*].

[2] The 707 Patent is entitled “Helmet with Shock Absorbing Inserts” and issued on March 21, 2017. The 707 Patent in the records of the Patent Office names Smith Optics, Inc. as the owner and James A. Chilson as the inventor.

[3] Both the inventorship and the ownership of the US equivalent to the 707 Patent, United States Patent No. 10,736,373 B2 [US Patent], has been corrected to add John Lloyd, James Rogers, and Piers Storey as co-inventors and to add Koroyd as a co-owner.

[4] James A. Chilson affirms in his affidavit dated July 19, 2021 that he is the named inventor of the 707 Patent and was an employee of Smith Optics, Inc., the named owner of the 707 Patent, to whom he assigned the rights in the invention in the 707 Patent on March 18, 2015. James A. Chilson attaches to his affidavit a copy of the assignment to Smith Optics, Inc.

[5] James A. Chilson also affirms and agrees that John Lloyd, James Rogers, and Piers Storey are co-inventors of the invention subject of the 707 Patent because it claims a shock absorbing insert at least partially aligned with a vent of the helmet.

[6] James A. Chilson also affirms that, through errors made by inadvertence and not for the purpose of delay, John Lloyd, James Rogers, and Piers Storey, were incorrectly omitted as inventors to the 707 Patent and by consequence, Koroyd was omitted as owner to the 707 Patent.

[7] John Lloyd and Piers Storey affirm in their affidavits dated March 9, 2022 that they are co-owners of Koroyd while James Rogers affirms in his affidavit dated March 10, 2022 that he is an independent contractor of Koroyd having been retained to provide design and development services. John Lloyd, James Rogers, and Piers Storey affirm that they contributed to the development of the claimed invention subject of the 707 Patent because it claims a shock-absorbing insert at least partially aligned with a vent of the helmet and that they are co-inventors of the 707 Patent and consent to their addition as named co-inventors of the 707 Patent.

[8] John Lloyd, James Rogers, and Piers Storey affirm that they have assigned their rights, title and interest in and to the invention subject of the 707 Patent to Koroyd on January 6, 2021 and attach a copy of their assignments to Koroyd.

[9] John Lloyd affirms that the omission to name him, James Rogers and Piers Storey as inventors was by inadvertence and was not for the purpose of delay.

[10] From reading the respective affidavits of James A. Chilson, John Lloyd, James Rogers, and Piers Storey, all of them are aware of this application before the Federal Court and acknowledge the roles of each other in the invention subject of the 707 Patent and consent to their additions as co-inventors to the 707 Patent.

[11] James A. Chilson and John Lloyd affirm that Smith Optics, Inc. and Koroyd have agreed that they will be co-owners of the 707 Patent because the subject matter of the invention was developed jointly by both companies.

[12] Lastly, John Lloyd affirms he is not aware of any litigation involving the 707 Patent.

[13] Giovanna Renna affirms in her affidavit dated October 11, 2022, that she is employed as the VP of Legal North American by the Safilo Group, of which the Applicant, Smith Sport Optics, Inc. is a member. She affirms that Smith Optics, Inc. is an assumed business name of Smith Sport Optics, Inc. in the transaction of business and attaches a Certificate of Assumed Business Name dated December 14, 2004 from the State of Idaho. She also affirms the true name of the company doing business under the assumed business name Smith Optics, Inc. is Smith Sport Optics, Inc. and affirms that Smith Optics, Inc. is not the name of any other person or legal entity.

[14] Giovanna Renna also affirms that the error of using their assumed business name of Smith Optics, Inc. when filing the Canadian patent application for the 707 Patent, rather than using their correct legal name Smith Sport Optics, Inc. was due to inadvertence and was not for the purpose of delay. Giovanna Renna affirms that since Smith Sport Optics, Inc. is the true name of the company, they are seeking to correct the ownership of the 707 Patent to name Smith Sport Optics, Inc. as co-owner of the 707 Patent with Koroyd.

[15] Any and all rights in and to the invention subject of the 707 Patent are co-owned by Smith Sport Optics, Inc. and Koroyd.

[16] The Respondents, the Commissioner of Patents and the Attorney General of Canada, were served with the Application and take no position and did not file material or participate in this Application.

II. Issue

[17] Should the Court order that the records of the Patent Office relating to the 707 Patent be amended to correct:

- a. the names of the inventors by adding Piers Storey, John Lloyd, and James Rogers as co-inventors;
- b. the names of the owners by adding Koroyd as co-owner; and
- c. the name of the currently listed owner, Smith Optics, Inc., such that it reflects the correct legal name of same, namely Smith Sport Optics, Inc.?

III. Analysis

A. *The Federal Court's jurisdiction to correct the records of an issued patent*

[18] Once a patent has issued, corrections to inventorship fall exclusively within the jurisdiction of the Federal Court (*Micromass UK Ltd. v Canada (Commissioner of Patents)*, 2006 FC 117 [*Micromass*] at para 12).

[19] Section 26 of the *Federal Courts Act* and section 52 of the *Patent Act* grant the Federal Court original jurisdiction and powers to vary or expunge any entry in the records of the Patent Office relating to the title of a patent, including errors related to inventorship and ownership (*Salt Canada Inc. v Baker*, 2020 FCA 127 at paras 5-8, 47-48). Section 52 of the *Patent Act* provides:

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 of a patent be varied or expunged.

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.

[20] The Federal Court has interpreted “title” in section 52 of the *Patent Act* broadly, to include the “root of the title” such as inventorship (*Micromass* at para 13, *Imperial Oil Resources Ltd. v Canada (Attorney General)*, 2015 FC 1218 [*Imperial Oil*] at para 12).

[21] A section 52 application may be brought by any interested person, with notice to the Commissioner of Patents. The person interested must notify any persons who are claiming an interest in the patent and, if there is a pending infringement case involving the patent at issue, any persons that may have a defence that could be affected by the order sought (*Micromass* at para 14, citing *Metalix Ltd. v Clopay Corp.* (1960), 34 CPR 232 (Can Ex Ct) aff’d 1961 (1961), 39 CPR 23 (SCC)).

[22] The Applicants are persons interested pursuant to section 52 of the *Patent Act* since they are the assignees and owners of the 707 Patent (*Clopay Corp. v Metalix Ltd.* (1960), 34 CPR 232 (Can Ex Ct) at para 11). The evidence is to the effect that there is no litigation involving the 707 Patent.

[23] The *Patent Act* does not specify the test to be applied to applications to the Court pursuant to section 52 of the *Patent Act*. However, on application to add an inventor, this Court

has considered subsection 31(4) of the *Patent Act*, which relates to the addition of inventors to a pending patent application, and has held that the Court follow the test for adding inventors in subsection 31(4) used by the Commissioner of Patents (*Qualcomm Inc. v Canada (Commissioner of Patents)*, 2016 FC 1092 at para 11, citing *Qualcomm Inc. v Canada (Commissioner of Patents)*, 2016 FC 499 at para 5, *Imperial Oil and Segatoys Co. v Canada (Attorney General)*, 2013 FC 98). Section 31(4) of the *Patent Act* provides:

31(4) Where an application is filed by one or more applicants and it subsequently appears that one or more further applicants should have been joined, the further applicant or applicants may be joined on satisfying the Commissioner that he or they should be so joined, and that the omission of the further applicant or applicants had been by inadvertence or mistake and was not for the purpose of delay.

31(4) Lorsque la demande est déposée par un ou plusieurs demandeurs et qu'il apparaît par la suite qu'un autre ou plusieurs autres demandeurs auraient dû se joindre à la demande, cet autre ou ces autres demandeurs peuvent se joindre à la demande, à la condition de démontrer au commissaire qu'ils doivent y être joints, et que leur omission s'est produite par inadvertance ou par erreur, et non pas dans le dessein de causer un délai.

B. *The Co-Inventors of the 707 Patent*

[24] The Supreme Court in *Apotex v Wellcome Foundation*, 2002 SCC 77 at paragraphs 96-99 held that inventorship requires an inventor to have contributed to the inventive concept applicable to the claims, which is to be contrasted to merely “help the invention to completion but whose ingenuity is directed to verification”, which is an insufficient contribution to be considered an inventor.

[25] The 707 Patent discloses and claims a shock-absorbing insert at least partially aligned with a vent of the helmet.

[26] John Lloyd, James Rogers, and Piers Storey have provided evidence that they contributed to the invention subject of the 707 Patent because it claims a shock absorbing insert at least partially aligned with a vent of the helmet and have provided affidavits to that effect, which are sufficient.

[27] The currently listed inventor James A. Chilson has provided an affidavit confirming he agrees that John Lloyd, James Rogers, and Piers Storey are co-inventors of the invention that is the subject matter of the 707 Patent and that he consents to their addition as co-inventors.

[28] John Lloyd, James Rogers, and Piers Storey affirm that they are co-inventors of the 707 Patent and consent to their addition as named co-inventors of the 707 Patent.

[29] James A. Chilson, John Lloyd, James Rogers, and Piers Storey all contributed to the invention subject of the 707 Patent, were named as co-inventors in the US corollary patent, and have assigned all their respective rights in and to the invention subject of the 707 Patent to Smith Optics, Inc. and Koroyd.

[30] Piers Storey, James Rogers and John Lloyd, were incorrectly omitted as inventors, due to inadvertence or mistake at the time of filing and during the Canadian prosecution of the 707 Patent. The mistake arose due to John Lloyd, James Rogers, and Piers Storey being inadvertently

omitted from the 707 Patent, which oversight is being corrected once the inventors of the corollary US patent were updated.

[31] It is therefore my conclusion that the affidavits provided by the Applicants satisfy the relevant requirements of section 31(4) of the *Patent Act*. Accordingly, I find that the records of the Patent Office relating to the 707 Patent should be amended as requested to add John Lloyd, James Rogers, and Piers Storey as inventors.

C. *The Co-Owners of the 707 Patent*

[32] This Court has jurisdiction to vary the records of a granted patent to reflect the ownership of the 707 Patent, as a consequence of correcting the inventors thereof. As referenced in *Imperial Oil* at paragraph 18:

[18] (...) I am satisfied that the present matter is not a case where ownership of the patent is at issue. Indeed, the Applicants do not contest ownership of the '481 Patent as they both agree that Imperial should be listed as the sole owner of the patent. Moreover, the sole co-inventors, Adeyinka, Myers, and Ghosh assigned their interest in the '481 Patent to Imperial alone. As such, I am of the view that the Court has jurisdiction to vary the ownership of the '481 Patent as a consequence of correcting the inventorship of the patent.

[33] The currently listed inventor, James A. Chilson, assigned the entirety of his rights, title and interest in the 707 Patent to Smith Optics, Inc. on March 18, 2015. The other three co-inventors, John Lloyd, James Rogers and Piers Storey, assigned the entirety of their rights, title and interest in the 707 Patent to Koroyd on January 6, 2021.

[34] As reproduced above at paragraph 23, section 31(4) allows that “further... applicants may be joined on satisfying the Commissioner that he or they should be so joined, and that the omission of the further... applicants had been by inadvertence or mistake and was not for the purpose of delay.” I am satisfied that Koroyd should be joined, and their omission arose by inadvertence or mistake. Accordingly, I find that Koroyd is a co-owner to the 707 Patent and that the records of the Patent Office relating to the 707 Patent should be amended as requested to add Koroyd as a co-owner thereof.

D. *The legal name of the currently listed owner of the 707 Patent*

[35] The evidence before me is that the currently listed owner of the 707 Patent, Smith Optics, Inc, is an assumed business name used by Smith Sport Optics, Inc. in the transaction business. The true name of the company doing business under the assumed name Smith Optics, Inc. is Smith Sport Optics, Inc., which is the same company.

[36] The evidence indicates that the error of using Smith Optics’ assumed name instead of its legal name when filing the application for the 707 Patent was due to inadvertence and was not for the purpose of delay.

[37] Section 52 of the *Patent Act* is very broad and empowers me to direct the Commissioner of Patents to correct the name of the owner of the 707 Patent from the assumed business name Smith Optics, Inc. to the correct legal name Smith Sport Optics, Inc. This would accomplish that which the Commissioner of Patents would have done had the correct legal name been registered prior to the grant of the 707 Patent (*Micromass* at para 15).

[38] Accordingly, I find that Smith Sport Optics, Inc. is the correct legal name of the currently listed co-owner the 707 Patent and that the records of the Patent Office relating to the 707 Patent should be amended as requested to reflect Smith Sport Optics, Inc. as the correct name of the co-owner of the 707 Patent.

E. *Costs*

[39] The Applicant sought no costs and the Attorney General of Canada, on behalf of the Commissioner of Patents asked that no costs be made against either of them, relying on section 25 of the *Patent Act*. No costs are awarded.

JUDGMENT in T-2200-23

THIS COURT'S JUDGMENT is that:

1. This application is granted.
2. Pursuant to section 52 of the *Patent Act*, the Commissioner of Patents shall vary all entries in the records of the Patent Office relating to Canadian Patent No. 2,858,707 [707 Patent] to correct:
 - a. the names of the inventors by adding Piers Storey, John Lloyd, and James Rogers as co-inventors of the 707 Patent;
 - b. the names of the owners by adding Koroyd SARL as co-owner of the 707 Patent;
 - c. the name of the current owner of the 707 Patent, Smith Optics, Inc., such that it reflects the correct legal name of same, namely Smith Sport Optics, Inc.
3. No costs are awarded on this application.

"Ekaterina Tsimberis"

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-2200-23

STYLE OF CAUSE: SMITH SPORT OPTICS, INC. AND
KOROYD SARL v COMMISSIONER
OF PATENTS AND THE ATTORNEY
GENERAL OF CANADA

DATE OF HEARING: APPLICATION CONSIDERED AT
OTTAWA, ONTARIO IN WRITING
PURSUANT TO RULE 369 OF THE
FEDERAL COURTS RULES

JUDGMENT AND REASONS: TSIMBERIS J.

DATED: JUNE 19, 2024

WRITTEN REPRESENTATIONS BY:

R. Nelson Godfrey
Nick James

FOR THE APPLICANTS

SOLICITORS OF RECORD:

Gowling WLG (Canada) LLP
Barristers & Solicitors

FOR THE APPLICANTS