

Federal Court



Cour fédérale

**Date: 20130930**

**Docket: T-948-12**

**Citation: 2013 FC 1001**

**Ottawa, Ontario, September 30, 2013**

**PRESENT: The Honourable Mr. Justice Roy**

**BETWEEN:**

**F. HOFFMANN-LA ROCHE AG**

**Applicant**

**and**

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

**Respondents**

**REASONS FOR JUDGMENT AND JUDGMENT**

[1] This is an application that is rather odd. It is presented by the applicant as “an application for an Order pursuant to section 20 of the *Federal Courts Act*, as well as other sections of that Act which this Honourable Court may deem appropriate, and subsection 53(2) of the *Patent Act*”.

[2] It is unclear how section 20 and subsection 53(2), on their own, can be of assistance in the circumstances. Section 20 of the *Federal Courts Act*, RSC 1985, c F-7, provides this Court with jurisdiction in the area of intellectual property, including patents, in some cases exclusively and in

others concurrently. It does not deal with remedies and how to get them. As for section 53 of the *Patent Act*, RSC 1985, c P-4, it does not provide for a procedural support either. It is substantive in nature, in that it voids patents in certain circumstances and provides for exceptions. The applicant invokes ss 53(2) alone. The section reads:

LEGAL PROCEEDINGS IN RESPECT OF  
PATENTS

PROCÉDURES JUDICIAIRES RELATIVES  
AUX BREVETS

Void in certain cases, or valid only for parts

Nul en certains cas, ou valide en partie seulement

**53.** (1) 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.

**53.** (1) Le brevet est nul si la pétition du demandeur, relative à ce brevet, contient quelque allégation importante qui n'est pas conforme à la vérité, ou si le mémoire descriptif et les dessins contiennent plus ou moins qu'il n'est nécessaire pour démontrer ce qu'ils sont censés démontrer, et si l'omission ou l'addition est volontairement faite pour induire en erreur.

Exception

Exception

(2) 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.

(2) S'il apparaît au tribunal que pareille omission ou addition est le résultat d'une erreur involontaire, et s'il est prouvé que le breveté a droit au reste de son brevet, le tribunal rend jugement selon les faits et statue sur les frais. Le brevet est réputé valide quant à la partie de l'invention décrite à laquelle le breveté est reconnu avoir droit.

Copies of judgment

Copies du jugement

(3) Two office copies of the judgment rendered under subsection (1) shall be furnished to the Patent Office by the patentee, one of which shall be registered and remain of record in the Office and the other attached to the patent and made a part of it by a reference thereto.

(3) Le breveté transmet au Bureau des brevets deux copies authentiques de ce jugement. Une copie en est enregistrée et conservée dans les archives du Bureau, et l'autre est jointe au brevet et y est incorporée au moyen d'un renvoi.

[3] It is in my view significant how the matter was framed by the applicant. We are not here dealing with an action for impeachment (s 60 *Patent Act*) or an action for infringement (s 54 *Patent Act*), where the issue of the validity of a patent would be debated between parties whose interest diverges.

[4] Rather, F. Hoffmann-La Roche AG, the applicant, brings an application that appears to be *sui generis*, and based not on s 53, but rather only on ss 53(2). There is no allegation that its patent is invalid, there is no party adverse in interest that challenges the position put forward by the applicant with respect to the nature of the error alleged by the applicant to have been made in its own patent or, for that matter, that makes allegations against the patent. It seeks as a remedy to either obtain a “declaration amending page 2 of the disclosure of Canadian Patent No. 2,103,324 ...” (the ‘324 Patent) or a “declaration striking a portion of the disclosure on page 2 of Canadian Patent No. 2,103,324 ...”.

[5] The respondents to this application, the Commissioner of Patents and the Attorney General of Canada, declare their interest in this application to be limited to the availability of ss 53(2) of the *Patent Act* in the circumstances. They take no view on the alleged error. There is no one arguing that the acknowledged error by the applicant constitutes a reason to declare the ‘324 Patent void. If such an argument exists, it has not been made before this Court. It is in that sense that it has been suggested by the respondents that this use of ss 53(2) would become an *ex parte* mechanism if the construction the applicant wishes to put on ss 53(2) were to be endorsed by the Court.

[6] For the reasons that follow, I have concluded that the application fails. The narrow reason, one to which the Court ought to confine itself, is that the applicant did not meet the minimal requirements of s 53 of the *Patent Act*. I will then offer some more general observations on the use that is proposed of that section.

### Facts

[7] I will confine myself to the facts that are directly relevant to the application currently before the Court. Suffice it to say that the validity of the '324 Patent was once challenged, but it is not the case any more (*Hoffmann-La Roche Limited v Teva Canada Limited and the Minister of Health and F. Hoffmann-La Roche AG*, File No T-1381-11, Prohibition Order issued on consent on April 3, 2012).

[8] The '324 Patent is entitled N-OXYCARBONYL SUBSTITUTED 5-DEOXY-5-FLUOROCYTIDINES. It contains claims to compounds which have anti-tumor effects as well as to processes to make the compounds.

[9] The '324 Patent was filed on November 17, 1993 and it will therefore expire on November 17, 2013 (s 44 *Patent Act*). The difficulty stems from one paragraph of the '324 Patent. The whole paragraph reads:

USP 4,966,891 discloses precursors of 5-FU which are improved in the above mentioned aspect of bioconversion efficiency and toxicities. They are converted to 5'-deoxy-5-fluorocytidine (5'-DFCR) by acylamidases, to 5'-deoxy-5-fluorouridine (5'-DFUR) by cytidine deaminase, and then to 5-FU by pyrimidine nucleotide phosphorylase in vivo which is preferentially localized in the liver, small intestine and tumor tissues. During intensive studies on the pharmacokinetic profiles of the precursors of 5-FU, particularly of

N<sup>4</sup>-(substituted-oxycarbonyl)-5'-deoxy-5-fluorocytidine derivatives, the inventors found that certain specific precursors are selectively converted into 5'-DFCR by an acylamidase isozyme that is preferentially located at the liver but not the other organs of humans, and exhibited more improved pharmacokinetic profiles than the other compounds tested. The further studies based on the above findings enabled the inventors of the present invention to identify that the specific N<sup>4</sup>-(substituted-oxycarbonyl)-5'-deoxy-5-fluorocytidine derivatives (hereinafter referred to as N<sup>4</sup>-(substituted-oxycarbonyl)-5'-DFCR) represented by the above mentioned general formula (I) have selectively improved pharmacokinetic profiles in monkeys, viz., 4 to 7 times higher maximum concentration (C<sub>max</sub>) of 5'-DFUR and 4 times larger higher area under the curve (AUC) of 5'-DFUR in blood than the other compounds, and less intestinal toxicity, and thus completed the present invention.

I have underlined the words that the applicant finds problematic.

[10] The concern the applicant has is to the effect that an allegation that could be made is that '324 Patent overstated the promised utility of all the claimed compounds.

[11] The difficulty turns, in the view of the applicant, on one abbreviation.

[12] That abbreviation is "viz.". *Black's Law Dictionary*, 7<sup>th</sup> edition, confirms that it is short for the Latin word "*videlicet*", which means "namely; that is to say". The *Canadian Oxford Dictionary* adds that "viz." is usually used for introducing a gloss or an explanation. The use of "viz." could therefore entail that the reference to "4 to 7 times higher maximum concentration (C<sub>max</sub>) of 5'-DFUR and 4 times larger higher area under the curve (AUC) of 5'-DFUR in blood than the other compounds" means that the patented compounds have these kinds of improvement.

[13] The applicant recognizes that if “viz.” is taken to mean “namely; that is to say”, this is not accurate. At best, if a Latin abbreviation had to have been used, it should have been preferable to use “e.g.”, an abbreviation for “*exempli gratia*”, or “for example”. It is not that the compounds have not improved pharmacokinetics profiles over the prior commercial candidate *galocitabine*. Indeed, they all did and some have shown the kind of improvement described following the abbreviation “viz.”. It is just that they did not all reach that plateau. Only some have “4 to 7 times higher maximum concentration ( $C_{max}$ ) of 5'-DFUR and 4 times larger higher area under the curve (AUC) of 5'-DFUR in blood than the other compounds”.

[14] Actually, the same document disclosed accurately the pharmacokinetic profiles in monkeys. The applicant argues, convincingly in the absence of a counter-argument, that the data accurately disclosed would simply not support the use of the abbreviation “viz.”. People versed in science would evidently rely on the data, not on some inadvertent statement. In a word, the use of “viz.” was a mistake because it overstates the case. But, the applicant argues, the mistake is clearly involuntary because the data offered by the applicant does not support the contention.

[15] As pointed out, the respondents did not take a position on the facts of this application. They only intervene for the purpose of arguing that ss 53(2) of the *Patent Act* is not open to the applicant.

### Arguments

[16] The applicant concedes that the impetus for bringing the application comes, in part, from one paragraph in this Court’s decision in *Ratiopharm Inc. v Pfizer Ltd*, 2009 FC 711, 350 FTR 250 [*Ratiopharm*]. The paragraph reads:

[201] This effort in distancing oneself from the patent draft and placing blame on a trainee not very competent in chemical matters, who now cannot be found, has left this Court with the clear impression that Pfizer knew that there were problems with the patent as drafted. That being the case, Pfizer has taken no steps to do anything about it save to mount a vigorous defence to this action.

[17] The argument seems to boil down to saying that if a patentee can be criticized for not having taken action to correct a mistake a patentee would know about, there has to be found in the statute a provision that would allow for such remedy. The applicant is familiar with the comment made in the appellate decision in *Ratiopharm* discussing, in one paragraph, the ss 53(2) defence to the action as “confined to the unique and particular circumstances of this matter. It has limited, if any, value as a precedent” (2010 FCA 204). Nevertheless, the applicant still contends that it must follow a precautionary principle and that there ought to be a way to act proactively.

[18] The concerns are amplified, it seems, by the evolving jurisprudence on the promise of the patent which creates, in the view of the applicant, uncertainty that could be resolved through its reading of ss 53(2) of the *Patent Act*.

[19] Subsection 53(2) is identified as a provision that could be construed as offering a remedy in a case where the patentee has simply been mistaken. The applicant considers the purpose of ss 53(2) as being “to allow” the Court “to correct a patent that contains an involuntary error to ensure the patent is held valid for the invention which the patentee is found to be entitled” (paragraph 45, applicant’s Memorandum of Fact and Law). There is no need for an adversarial proceeding argues the applicant. It can make an application to leave words struck from a patent without the patent being challenged. No authority is offered in support of that proposition.

[20] There are two remedies that are available to the patentee who wishes to amend a patent: the reissuing of a patent (s 47 *Patent Act*) and the disclaimer of the parts of the patent the patentee does not claim to hold by virtue of the patent (s 48 *Patent Act*). The correction of clerical errors, pursuant to s 8 of the *Patent Act*, does not appear to be a remedy the applicant would seriously consider.

Sections 47 and 48 read:

#### REISSUE OF PATENTS

Issue of new or amended patents

**47.** (1) Whenever any patent is deemed defective or inoperative by reason of insufficient description and specification, or by reason of the patentee's claiming more or less than he had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention, the Commissioner may, on the surrender of the patent within four years from its date and the payment of a further prescribed fee, cause a new patent, in accordance with an amended description and specification made by the patentee, to be issued to him for the same invention for the then unexpired term for which the original patent was granted.

Effect of new patent

(2) The surrender referred to in subsection (1) takes effect only on the issue of the new patent, and the new patent and the amended description and specification have the same effect in law, on the trial of any action thereafter commenced for any cause subsequently accruing, as if the amended description and specification had been originally filed in their corrected form before the issue of the original patent, but, in so far as the claims of the original and reissued patents are identical, the surrender does not affect any action pending at the time of reissue or abate

#### REDÉLIVRANCE DE BREVETS

Délivrance de brevets nouveaux ou rectifiés

**47.** (1) Lorsqu'un brevet est jugé défectueux ou inopérant à cause d'une description et spécification insuffisante, ou parce que le breveté a revendiqué plus ou moins qu'il n'avait droit de revendiquer à titre d'invention nouvelle, mais qu'il apparaît en même temps que l'erreur a été commise par inadvertance, accident ou méprise, sans intention de frauder ou de tromper, le commissaire peut, si le breveté abandonne ce brevet dans un délai de quatre ans à compter de la date du brevet, et après acquittement d'une taxe réglementaire additionnelle, faire délivrer au breveté un nouveau brevet, conforme à une description et spécification rectifiée par le breveté, pour la même invention et pour la partie restant alors à courir de la période pour laquelle le brevet original a été accordé.

Effet du nouveau brevet

(2) Un tel abandon ne prend effet qu'au moment de la délivrance du nouveau brevet, et ce nouveau brevet, ainsi que la description et spécification rectifiée, a le même effet en droit, dans l'instruction de toute action engagée par la suite pour tout motif survenu subséquemment, que si cette description et spécification rectifiée avait été originalement déposée dans sa forme corrigée, avant la délivrance du brevet original. Dans la mesure où les revendications du brevet original et du



any cause of action then existing, and the reissued patent to the extent that its claims are identical with the original patent constitutes a continuation thereof and has effect continuously from the date of the original patent.

Separate patents for separate parts

(3) The Commissioner may entertain separate applications and cause patents to be issued for distinct and separate parts of the invention patented, on payment of the fee for a reissue for each of the reissued patents.

#### DISCLAIMERS

Patentee may disclaim anything included in patent by mistake

**48.** (1) Whenever, by any mistake, accident or inadvertence, and without any wilful intent to defraud or mislead the public, a patentee has

(a) made a specification too broad, claiming more than that of which the patentee or the person through whom the patentee claims was the inventor, or

(b) in the specification, claimed that the patentee or the person through whom the patentee claims was the inventor of any material or substantial part of the invention patented of which the patentee was not the inventor, and to which the patentee had no lawful right,

the patentee may, on payment of a prescribed fee, make a disclaimer of such parts as the patentee does not claim to hold by virtue of the patent or the assignment thereof.

Form and attestation of disclaimer

brevet redélevé sont identiques, un tel abandon n'atteint aucune instance pendant au moment de la redélivrance, ni n'annule aucun motif d'instance alors existant, et le brevet redélevé, dans la mesure où ses revendications sont identiques à celles du brevet original, constitue une continuation du brevet original et est maintenu en vigueur sans interruption depuis la date du brevet original.

Brevets distincts pour éléments distincts

(3) Le commissaire peut accueillir des demandes distinctes et faire délivrer des brevets pour des éléments distincts et séparés de l'invention brevetée, sur versement de la taxe à payer pour la redélivrance de chacun de ces brevets redélevés.

#### RENONCIATIONS

Cas de renonciation

**48.** (1) Le breveté peut, en acquittant la taxe réglementaire, renoncer à tel des éléments qu'il ne prétend pas retenir au titre du brevet, ou d'une cession de celui-ci, si, par erreur, accident ou inadvertence, et sans intention de frauder ou tromper le public, dans l'un ou l'autre des cas suivants :

a) il a donné trop d'étendue à son mémoire descriptif, en revendiquant plus que la chose dont lui-même, ou son mandataire, est l'inventeur;

b) il s'est représenté dans le mémoire descriptif, ou a représenté son mandataire, comme étant l'inventeur d'un élément matériel ou substantiel de l'invention brevetée, alors qu'il n'en était pas l'inventeur et qu'il n'y avait aucun droit.

Forme et attestation de la renonciation

(2) A disclaimer shall be filed in the prescribed form and manner.

(3) [Repealed, 1993, c. 15, s. 44]

Pending suits not affected

(4) No disclaimer affects any action pending at the time when it is made, unless there is unreasonable neglect or delay in making it.

Death of patentee

(5) In case of the death of an original patentee or of his having assigned the patent, a like right to disclaim vests in his legal representatives, any of whom may exercise it.

Effect of disclaimer

(6) A patent shall, after disclaimer as provided in this section, be deemed to be valid for such material and substantial part of the invention, definitely distinguished from other parts thereof claimed without right, as is not disclaimed and is truly the invention of the disclaimant, and the disclaimant is entitled to maintain an action or suit in respect of that part accordingly.

(2) L'acte de renonciation est déposé selon les modalités réglementaires, notamment de forme.

(3) [Abrogé, 1993, ch. 15, art. 44]

Sans effet sur les actions pendantes

(4) Dans toute action pendante au moment où elle est faite, aucune renonciation n'a d'effet, sauf à l'égard de la négligence ou du retard inexcusable à la faire.

Décès du breveté

(5) Si le breveté original meurt, ou s'il cède son brevet, la faculté qu'il avait de faire une renonciation passe à ses représentants légaux, et chacun d'eux peut exercer cette faculté.

Effet de la renonciation

(6) Après la renonciation, le brevet est considéré comme valide quant à tel élément matériel et substantiel de l'invention, nettement distinct des autres éléments de l'invention qui avaient été indûment revendiqués, auquel il n'a pas été renoncé et qui constitue véritablement l'invention de l'auteur de la renonciation, et celui-ci est admis à soutenir en conséquence une action ou poursuite à l'égard de cet élément.

[21] Neither one of the remedies can be used, argues the applicant. The reissue is available only within the first four years from the date the patent was issued. It does not want to avail itself of the disclaimer provision because "(F)iling a disclaimer such that only the compounds which achieve both a 4-7 times improvement for  $C_{max}$  and 4 times improvement for AUC would result in disclaiming all but the best compounds, even though all the compounds are new, useful and unobvious. A disclaimer would deprive the inventors of the fruits of their labour and deny them the

ability to claim what they in good faith invented” (paragraph 72, applicant’s Memorandum of Fact and Law).

[22] In essence, the applicant contends that one remedy is unavailable because it is limited in time. It does not however explain why a remedy denied in legislation through a limited time period can morph into one where there is no such limitation. The only difference would be that one is issued by the Commissioner of Patents and the other by the Court, in spite of the fact that the test in ss 53(2) is substantially the same as in s 47. As for the disclaimer remedy, it is said to be too drastic.

[23] In the end, the applicant rests its case on one subsection. Because legislation must be deemed remedial (s 12 *Interpretation Act*, RSC1985, c I-21), it seems to argue that the lack of a remedy in the *Patent Act* makes it possible to use ss 53(2) to deal with the mistake that was committed many years ago.

[24] The respondents take issue with the use that the applicant seeks to make of ss 53(2) of the *Patent Act*. They argue that ss 53(2) serves a limited purpose by providing a patentee with a defence in cases where the patent may be declared void. A different reading of the subsection renders meaningless the four-year limit on patent reissue. The proposed interpretation of ss 53(2) creates an *ex parte* mechanism allowing patentees to amend the scope of patents where none exists. Not only is a proper reading of s 53 a complete bar to the interpretation given by the applicant to ss 53(2), but the scheme of the *Patent Act* does not allow for the reading the applicant wants to give ss 53(2).

Analysis

[25] The starting point of the analysis has to be s 53 of the *Patent Act*. The applicant has sought to focus on ss 53(2); it claims that its purpose is to allow the correction of a patent that contains an involuntary error. With respect, I cannot agree.

[26] A plain reading of the section in its entirety suggests strongly that subsection (2) must be read together with subsection (1). One cannot be divorced from the other. The reference to subsection (1) in the English version of subsection (2) makes it clear that it is where a patent would otherwise be declared void that the exception could be of assistance.

[27] Section 53 has been part of our law since at least 1872. Section 27 of *An Act respecting Patents of Invention*, (1872) 35 Victoria, cap. XXVI, reads:

**CAP. XXVI.****An Act respecting Patents of Invention.****NULLITY, IMPEACHMENT AND  
AVOIDANCE OF PATENTS.**

Patent may be declared void in certain cases, or valid only for part.

**27.** A patent shall be void, if any material allegation in the petition or declaration of the applicant be untrue, or if the specifications and drawings contain more or less than is necessary for obtaining the end for which they purport to be made, such omission or addition being wilfully made for the purpose of misleading; but if it shall appear to the Court that such omission or addition is simply an involuntary error, and it is proved that the patentee is entitled to the remainder of his patent *pro tanto*, the Court shall render a judgment in accordance with the facts,

**CAP. XXVI.****Acte concernant les Brevets d'Invention.****NULLITE, CONTESTATION ET  
DÉCHÉANCE DES BREVETS**

Le brevet pourra être annulé en tout ou en partie, en certains cas.

**27.** Le brevet sera nul, si la requête ou la déclaration de l'impétrant contient quelque allégation importante qui soit fausse, ou si la spécification et les dessins contiennent plus ou moins qu'il ne sera nécessaire pour atteindre le but dans lequel on les fera, cette addition ou cette omission étant faite volontairement dans l'intention d'induire en erreur; mais s'il appert au tribunal que cette omission ou cette addition est simplement une erreur involontaire, et qu'il soit prouvé que le breveté a droit au reste de son brevet *pro tanto*, le tribunal rendra jugement

and determine as to costs, and the patent shall be held valid for such part of the invention described; and two office copies of such judgment shall be furnished to the Patent Office by the patentee, one to be registered and to remain of record in the office, and the other to be attached to the patent, and made a part of it by a reference.

suivant les faits, et prononcera sur les frais, et le brevet sera réputé valable pour cette partie de l'invention décrite; et le breveté fournira au bureau des brevets deux copies de ce jugement, dont l'une sera enregistrée et gardée en dépôt au bureau, et l'autre sera annexée et, par une note de renvoi, incorporée au brevet.

[28] As passed by Parliament more than one hundred and forty years ago, one is struck by the flow of the provision. More modern drafting makes a greater use of subsections and paragraphs. Section 27 of the 1872 Statute suggests that the provision, read as a whole, does not contemplate a remedy other than where the patent risks being void. The remedy is not a stand alone, capable of being used in other circumstances than those found in the section.

[29] Central to the applicant's argument is the view that ss 53(2) can be considered as a stand alone remedy. The patent does not need to be in jeopardy of being declared void for ss 53(2) to kick in. The process is initiated by the patentee itself. Indeed, in the instant case the applicant truly does not concede that its patent is void and no one is making that argument.

[30] The legislative evolution of the provision would suggest that the subsection cannot be read alone. As Ruth Sullivan explains in *Sullivan and Driedger on The Construction of Statutes*, 4<sup>th</sup> ed. (Toronto: Butterworths, 2002), at page 476:

Where only formal change is intended, the amended version of the legislation has the same meaning as the previous version. This means that the previous version may be relied on to help clarify the connotation and application of the amended version.

[31] In spite of its long existence, the applicant acknowledges that ss 53(2) may not have been used proactively before or in the fashion it is now proposing. Rather, it has been used only as a defence to a claim under ss 53(1). The respondents argue that the proposed use is unprecedented. Neither have I been able to find a precedent that would put such a construction on the subsection or a learned author who would have suggested that the subsection could be used for the purpose proposed by the applicant.

[32] Once s 53 is read as a whole, it becomes apparent that, in order to qualify for the remedy of ss 53(2), the patentee must first fall under ss 53(1). It was also true in 1872. When read in context with the rest of section 53, but also in the broader context of the *Patent Act* as a whole, ss 53(2) cannot be taken in isolation for the purpose of creating a remedy. As has been said and repeated so many times:

Today there is only one principle or approach, namely, the words of an Act are to be read in their entire context, in their grammatical and ordinary sense harmoniously with the scheme of the Act, the object of the Act, and the intention of Parliament.

Elmer A. Driedger, *The Construction of Statutes* (Toronto: Butterworths, 1974) at 67

The same approach was nicely articulated in the context of intellectual property cases in *Re: Sound v Motion Picture Theatre Associations of Canada*, 2012 SCC 38, [2012] 2 SCR 376:

[32] This Court has reiterated on many occasions that the object of statutory interpretation is to establish Parliament's intent by reading the words of the provisions in question in their entire context and in their grammatical and ordinary sense, harmoniously with the scheme of the Act, the object of the Act and the intention of Parliament (*Rizzo & Rizzo Shoes Ltd. (Re)*, [1998] 1 S.C.R. 27, citing E.A. Driedger, *Construction of Statutes* (2nd ed. 1983), at p. 87).

[33] Although statutes may be interpreted purposively, the interpretation must nevertheless be consistent with the words chosen by Parliament. Moreover, the legislative history can be of great assistance in discerning Parliament's intent with respect to a particular wording in a statute.

To put it bluntly, the words of the subsection count, the context in which they are found counts and the scheme of the Act counts.

[33] The introductory words of ss 53(2) cannot be ignored. Not only do they refer directly to ss 53(1), but that reference also brings back the cases in which a patent could be found to be void. This is evidently a kind of relief that is meant to be narrow.

[34] Thus it does not suffice that an involuntary error has been alleged for the remedy in ss 53(2) to be available. It must be an error that relates back to ss 53(1). That subsection declares that a patent will be void if some conditions are met:

- a. if any material allegation in the petition is untrue, or
- b. if the specification and drawings contain more or less for obtaining the end for which they purport to be made.

Assuming that either one of those propositions is proven, the patent will be void if the omission or addition is wilfully made for the purpose of misleading. It is only if these conditions are met that a remedy could be found through the operation of ss 53(2).

[35] In the case at hand, there is no allegation before this Court that the '324 Patent is void. Quite the opposite. The applicant was careful to avoid even suggesting that the error was with respect to a material allegation in the petition or that the specifications contain more or less than is necessary.

There is no one before this Court to actually argue that the recognized error actually qualifies under the conditions to render a patent void.

[36] As a result, the applicant does not meet the basic requirements for the application of ss 53(2).

[37] There are other indicia that the application of ss 53(2) would be problematic in this case as the relief provided for in ss 53(2) cannot easily apply in the circumstances. Subsection 53(2) provides that the patentee continues to be “entitled to the remainder of his patent”. As pointed out by the respondents, that suggests that, in the first place, it has been shown that there was a material allegation that was shown to be untrue or that the specifications contain more or less than is necessary such that there is an impact on the patent. In this case, not only does the applicant not reckon that the patent may be in any kind of jeopardy, but no one before this Court seeks to make that case. Here, the applicant merely wants for those words in the patent that follow “viz.” to be struck from a portion of the disclosure.

[38] The applicant speaks in terms of amending its patent. Actually, that is not the remedy provided for in ss 53(2). Once it is established that the error was involuntary, “the patent shall be held valid for that part of the invention described to which the patentee is so found to be entitled”. As appears plain, ss 53(2) finds application to save that which would otherwise be void. It is not concerned with amendments to correct an involuntary error that would not, in any case, cause the patent to be void, as is contended by the applicant.



[39] Furthermore, the heading preceding s 53, “Legal Proceedings in Respect of Patents”, suggests that some proceedings exist that bring into play s 53. Thus the issue of the patent’s voidness, which arises during legal proceedings, can be made the subject of one exception under ss 53(2). The presence of the heading is obviously not determinative of the issue, but its use casts some light on the meaning of the provision to which it relates (see Sullivan and Driedger, *supra*, at pages 305 and following).

[40] The creation of a new remedy, as proposed by the applicant, also changes the balance found in the *Patent Act*. Because the applicant cannot rely on s 47 to reissue its patent given that the remedy is limited in time, and because it does not want to use the disclaimer provision (s 48) given that it finds it too drastic in the circumstances, it wants for the purpose of ss 53(2) to be recast as “to allow” the Court “to correct a patent that contains an involuntary error to ensure the patent is held valid for the invention which the patentee is found to be entitled” (paragraph 45, applicant’s Memorandum of Fact and Law). As a matter of policy, Parliament has chosen to limit remedies that can be initiated by a patentee to three. The reissue under s 47, the disclaimer under s 48 and the correction of clerical errors under s 8. These are the circumstances where a remedy sought by a patentee can be self-initiated. Section 53 can be used, on its face, where a patent would be void if the conditions of ss 53(1) are met, if it were not for ss 53(2).

[41] In spite of the able argument put forth by counsel for the applicant, I fail to see how the purpose of that provision can be recast without regard for the full context, which includes ss 53(1). The remedy in ss 53(2) is contemplated by Parliament, and appears to have been so since at least 1872, when a patent is in jeopardy because of a material allegation that is untrue or the specification

contains more or less than is necessary. Such is not the case in the scenario offered by the applicant. Accordingly, the application must fail and this suffices to dispose of the matter.

[42] I wish to add a few observations. The Attorney General argued his case, in view of his limited interest in the matter, on the basis that not only is the application of ss 53(2) argued for by the applicant unprecedented, but also that the time limitation for the reissue of a patent is significant. Section 47 (reissue) is the mechanism provided in law. The Attorney General argues that this new application of s 53 would render s 47 meaningless.

[43] I would not have readily concluded that s 47 is necessarily, without more, rendered meaningless by that kind of new remedy. To my way of thinking though, allowing an amendment to a patent under judicial supervision is a policy choice that can be made with proper safeguards. But the creation of safeguards is the more difficult issue.

[44] As pointed out by the Attorney General, allowing these kinds of *ex parte* applications could defeat imminent litigation. The section provides that the exception of ss 53(2) applies to cases where an “omission or addition referred to in subsection (1) was an involuntary error”; but who will argue that it was not an involuntary error? Indeed the balance of the Act would necessarily be altered. If a remedy that goes beyond what currently exists is to be included in the *Patent Act*, a framework including procedural guarantees and a determination of the scope of the remedy might well have to be created. With respect, that is for Parliament to make those policy determinations. If consequences of a profound nature are to be considered, it ought to be done in Parliament.

[45] The impetus for the application comes from the words of my colleague Justice Hughes in *Ratiopharm*, above at paragraph 15. No doubt pronouncements of that kind from such an authority carry weight. However, as noted, the Federal Court of Appeal chose to leave the comments as “confined to the unique and particular circumstances” and not carrying precedential value. At any rate, I did not see in the comments an invitation to read ss 53(2) in isolation of ss 53(1) and to change the true scope of the provision.

[46] Finally, the creative interpretation that the applicant tried to put on ss 53(2) ran into some difficulties from a procedural standpoint. The application is made under section 20 of the *Federal Courts Act*, which is a provision granting jurisdiction, and ss 53(2) of the *Patent Act*, and other sections of the *Federal Courts Act* as may apply. The applicant tried to argue that the procedural vehicle of an application is available, given that there are no infringement or impeachment proceedings, or for that matter any proceeding, pending.

[47] However, the real issue is rather whether ss 53(2) can be read independently of the rest of s 53, such that some *sui generis* motion can be launched. Subsection 53(2) is, for sure, remedial; but it provides a remedy once ss 53(1) is otherwise properly engaged. It appears to be meant as a shield, not a sword. The procedural difficulty disappears once the section is properly read as a whole and in context. Once appropriate legal proceedings have been launched, s 53 can be properly engaged. That procedural difficulty is a further manifestation that we are faced with the proverbial square peg in a round hole.

**JUDGMENT**

**THIS COURT’S JUDGMENT is that** the application, under section 20 of the *Federal Courts Act* and subsection 53(2) of the *Patent Act*, and other sections of the *Federal Courts Act*, for a declaration amending page 2 of the disclosure of Canadian Patent No. 2,103,324 or, in the alternative, for a declaration striking a portion of the disclosure on page 2 of Canadian Patent No. 2,103, 324, as may apply, is dismissed. There will not be any costs awarded.

“Yvan Roy”

---

Judge

**FEDERAL COURT**

**SOLICITORS OF RECORD**

**DOCKET:** T-948-12

**STYLE OF CAUSE:** F. HOFFMAN-LA ROCHE AG v THE  
COMMISSIONER OF PATENTS and THE  
ATTORNEY GENERAL OF CANADA

**PLACE OF HEARING:** Ottawa, Ontario

**DATE OF HEARING:** May 13, 2013

**REASONS FOR JUDGMENT  
AND JUDGMENT:** ROY J.

**DATED:** September 30, 2013

**APPEARANCES:**

Jay Zakaib  
Jennifer Wilkie

FOR THE APPLICANT

David Cowie

FOR THE RESPONDENTS

**SOLICITORS OF RECORD:**

Gowling Lafleur Henderson LLP  
Ottawa, Ontario

FOR THE APPLICANT

William F. Pentney  
Deputy Attorney General of Canada

FOR THE RESPONDENTS