

RE-EXAMINATION AND IMPEACHMENT: TWO WAYS TO OPPOSE A PATENT AFTER IT HAS BEEN ISSUED

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Canada, the *Patent Act* allows the opposition to a patent to be conducted in two ways, either by re-examination or by impeachment. The goal of the present article is to present each of these two procedures, their implications and the advantages and/or disadvantages of one in relation to the other.

Re-examination (*Patent Act*, sections 48.1 to 48.5)

The re-examination of a patent occurs following the filing of a request with the Commissioner of Patents. The re-examination may be requested by a third party, who has an interest, or by the patentee himself. The interested party can request the re-examination of the content and of the scope of one or more claims in the patent, but only on the basis of prior art documents consisting of patents, published patent applications or any other published document, which, preferably, was not cited during the initial examination of the application from which the patent was issued. The interested party bears the burden of proof to show that a new and important question was raised with regards to patentability by clearly discussing the relevance of each prior art document and by explaining the reasons for which one or certain claims may be anticipated and/or evident in light of the prior art document(s).

Following the receipt of the request, the Commissioner establishes a re-examination board which will handle the file. Within three months of its establishment, the board will first determine the relevance of the re-examination. If the board is of the opinion that the request for re-examination does not raise any substantial new question of patentability affecting any claim of the patent concerned, the board notifies the party who filed the request for such a decision and the file is closed. If the request for re-

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examination is accepted, the board sends out a notice to the patentee in order for him to present his position on the matter; the patentee has three months to reply to the notice and to present comments on the patentability of the claims. The patentee may therefore suggest modifications to the claims being re-examined, submit new claims or decide to cancel claims, as long as the scope of the claims is not broadened when compared to the scope of the claims in the original patent. The board will then examine the modifications proposed by the patentee and will render its decision by delivering a certificate within twelve months after the notification to the patentee. If the certificate cancels one or many claims, the patent is deemed to have been issued from its date of grant, but in its corrected form. If all the claims are cancelled, the patent is deemed never to have been issued. If a new claim is incorporated or amended, this claim is effective from the date of the certificate and will remain valid until the expiry of the patent term.

It is important to note that following the receipt of the certificate, the patentee, and only the patentee himself, has three months from the date of the certificate to file an appeal before the Federal Court concerning the decision rendered by the re-examination board.

Impeachment (*Patent Act*, section 60)

The proceedings for impeachment of a patent are brought before the Federal Court and may be instituted by the Attorney General of Canada or any interested person. At the end of the proceedings, the patent in its entirety or one or more of its claims may be declared void, or on the contrary, the patent may be held as valid.

It is important to note that the fact of declaring a claim void will not necessarily affect the validity of the other claims of the patent.

During the proceedings for impeachment, it is the responsibility of the interested person to prove that the patent or one or more of its claims are void. Many reasons may be invoked in an attempt to invalidate a patent, either based on prior art or on technical reasons linked to intrinsic defects in the patent. Generally, an interested person will attempt to prove that the claims lack novelty, inventiveness or utility, that they are ambiguous, that they are not supported by the description (i.e. that their scope is too broad with regards to the description, or that the description and the examples in the patent do not provide sufficient elements to allow the reproduction of the invention). Other reasons may also be alleged: overlap between two patents, disconformity between the issued patent and the patent application as originally filed or the priority application. Procedural grounds

such as, for example, an inappropriate statement of the inventors or incorrect information in the petition may also be raised, but most of the time, these procedural grounds are considered insufficient to impeach a patent.

Impeachment proceedings may be instituted by filing an action before the Federal Court. A defendant to an infringement action may also ask the Court to invalidate the patent by filing a counterclaim to the infringement action. During the Court proceedings, both the plaintiff and the patentee will be able to expose and defend their respective positions. At the end of the proceedings, the Federal Court renders its judgement and declares whether the patent or one or more of its claims are void, or if the patent is valid. Depending on the decision rendered by the Court, the plaintiff or the patent holder can appeal to the Federal Court of Appeal.

Advantages and Disadvantages

Impeachment proceedings may be time consuming and costly. However, such proceedings do have advantages since the party wishing to invalidate the patent can defend its allegations before the Court and will have the opportunity to lodge an appeal if the Court rules against it.

In contrast, the re-examination of a patent requested by a third party does not allow this party to defend its allegations or to lodge an appeal from the decision rendered by the re-examination board. Only the patentee has the privilege of lodging an appeal. However, the re-examination proceedings may present an advantage for a third party who wishes to obtain a decision more rapidly at a lower cost.

Also, as it has been explained previously, impeachment proceedings allow for the "attack" of a patent in many ways, either on the basis of prior art or for reasons linked to intrinsic defects in the application. However, Canadian Courts are generally not very receptive to arguments linked to intrinsic defects, and the plaintiff will be in a better position if the lack of novelty or inventiveness is raised and the arguments are tailored to this end. The re-examination of a patent may only be requested on the basis of lack of novelty and/or inventiveness, and the third party requesting the re-examination must prove that a new and important question was raised with regards to the patentability of one or more claims, by clearly discussing the relevance of each prior art document.

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