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## FILING OF WRONG DRAWINGS LEADS TO LOSS OF PATENT RIGHTS IN CANADA

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LAWYERS, PATENT AND TRADE-MARK AGENTS

The Federal Court of Canada recently dismissed an application for judicial review of a decision of the Commissioner of Patents who had refused to substitute new drawings to incorrect ones originally filed in support of the national phase entry of an international patent application. [*Scannex Technologies, LLC v. Attorney General of Canada*, October 21, 2009, Tremblay-Lamer, J.]

### The Facts

The Applicant, Scannex Technologies, LLC, is the owner of a patent issued in the United States. It also filed a corresponding international patent application under the Patent Corporation Treaty ("PCT") for the same invention. Upon the PCT application entering the national phase in Canada, the Applicant was advised that the figures submitted in support of its patent application were incorrect. The Applicant immediately requested permission to substitute new drawings to the incorrect ones pursuant to s. 8 of the *Patent Act* (R.S.C. (1985) c. P-4), which reads as follows in both English and French:

**8. Clerical errors in any instrument of record in the Patent Office do not invalidate the instrument, but they may be corrected under the authority of the Commissioner.**

**8. Un document en dépôt au Bureau des brevets n'est pas invalide en raison d'erreurs d'écriture; elles peuvent être corrigées sous l'autorité du commissaire.**

(our underlines)

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The Applicant submitted an affidavit to the effect that the mistake was due to the unintentional error of a clerk of the Applicant's US Patent Agents and it also filed a copy of the US Application which contained the correct figures.

Notwithstanding the Applicant's evidence and arguments, the Commissioner of Patents refused to accept the new drawings on the basis that it had no jurisdiction to substitute the incorrect figures for the appropriate ones under s. 8 of the *Patent Act*. The Commissioner was of the view that s. 8 of the *Patent Act* only permits the correction of errors which occur in the "mechanical process of typewriting or transcribing a document". According to the Commissioner, the submission of correct drawings was an inherent duty and responsibility of the agent involved in the prosecution of the patent application.

The Applicant served and filed an application for judicial review of the Commissioner of Patents' decision.

### **The Federal Court Judgment**

The Federal Court was seized of two questions, the first relating to the appropriate standard review of a decision of the Commissioner of Patents in cases involving the application of s. 8 of the *Patent Act*, and the second relating to the determination of the existence in this case of a reviewable error.

The Court began by reviewing the various approaches applied by the Federal Court in previous similar cases. One set of decisions applied a single step analysis, i.e. to determine whether there is an error and if so, whether the Commissioner's decision was reasonable notwithstanding the error. The second approach is a two-steps analysis, i.e. to determine whether the Commissioner correctly applied the legal definition of "clerical error" and if so, if the Commissioner's decision was reasonable according to the correct definition. The Court specifically reviewed a similar case where 9 pages of a US patent application had inadvertently not been inserted into the corresponding Canadian patent application for the same invention. In that case, the Court had concluded that the mistake was more than a clerical error. On the standard of review, the Court had deemed that questions of fact and law were inextricably mixed and the two-step approach was therefore used to determine whether the Commissioner had correctly decided on whether or not there was a clerical error and that the Commissioner had reasonably exercised his discretion not to correct this error, even if there was one.

Justice Tremblay-Lamer decided that if the term "clerical error" is contested, the Court will be first called to decide whether the definition of the term has been correctly applied by the Commissioner. If the Commissioner applied the correct definition, the application of such definition to the facts of the case becomes a question of mixed fact and law and reviewable of the standard of reasonableness. If

the Commissioner applied the wrong definition, then the Court is free to substitute its own “correct” definition to that of the Commissioner. Justice Tremblay-Lamer therefore adopted the two-step approach.

The Court noted that the term “clerical error” was more often associated with the act of writing. The case law was consistent on the scope of the definition of “clerical error”, which is one that is “mechanical in nature and made without thought”. To support this position, the Court also referred to the French version of s. 8 of the *Patent Act*. Justice Tremblay-Lamer concluded that the Commissioner had not erred in law by applying the narrow definition found in the jurisprudence, although she recognized that the definition of “clerical error” may be too narrow in this day and age. However, since a patent is a public document, Parliament clearly intended to limit the Commissioner’s discretion to retroactively correct documents submitted with an application and if Canadians find that the current interpretation of “clerical error” to be unjustified, it is up to Parliament to revise the law accordingly.

Justice Tremblay-Lamer concluded that the filing of incorrect figures was not a clerical error, in the narrow sense of the definition of the *Patent Act*. Therefore, the Commissioner’s determination that it had no jurisdiction to accept new drawings to replace the incorrect ones under s. 8 of the *Patent Act* was not unreasonable. The application for judicial review was dismissed, with costs to the Commissioner, since the Applicant had failed to appear before the Court.

## CONCLUSION

This case constitutes another harsh decision clearly placing the burden on patent Applicants and their agents to ensure that the patent application is complete and that there are no mistakes. Canadian patent law has a very low tolerance level regarding inadvertent mistakes. Patent Applicants and their agents should therefore diligently review each and every page of the patent application submission in order to ensure that it is compliant with the standards and laws of all countries, as inadvertent mistakes may lead to irremediable loss of rights.



