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## **INVENTOR RECEIVES RECOGNITION FOR CONTRIBUTION TO ISSUED PATENT**

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The Federal Court of Canada recently allowed an application to add the name of an inventor to two issued patents. [*Plasti-Fab Ltd. v. The Attorney General of Canada*, 2010 FC 172 (February 22, 2010, O’Keefe, J.)]

### **The Facts**

The Applicant, Plasti-Fab Ltd., is the owner of two Canadian patents relating to insulating concrete form systems. The Canadian patents are based on a priority application in the USA and this US application shows four inventors. However, in Canada, only three inventors are named: during the application process, one inventor, Mr. Gregory J. Doren, was left off the list of inventors.

The Applicant submitted in its Application that that the omission to name the fourth inventor was a mistake. The Applicant therefore requested that the Court amend the patent to add Mr. Doren as an inventor. The reason for applying to the Court directly, instead of requesting that the Commissioner of Patents rectify the record of the Patent Office, is that the Commissioner of Patents is without jurisdiction to correct an issued patent absent an order from the Court. The Attorney General of Canada, on behalf of the Respondent Commissioner of Patents, took no position as to whether the Court should grant the application or not.

### **The Judgment**

The Court first began by reviewing the facts, which were set out in detailed affidavits from Mr. Doren, as well as another named co-inventor. These affidavits served to explain to the Court why the Applicant failed to completely list the names of the

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inventors for each of the Canadian patents. It appeared from the evidence that the omission was the result of an ongoing dispute between the Applicant and two of the four inventors. When the dispute was finally resolved, the applications were incompletely amended to correct the names of the inventors. In light of this evidence, the Court accepted the Applicant's submission that the omitted inventor, Mr. Doren, had inadvertently been left off from the Canadian patents. It was only upon receiving legal counsel regarding the legal test for inventorship that the Applicant realized that the Mr. Doren's contribution to the inventions described in the patents meant that he should be listed as an inventor in each of the Canadian patent.

The Court then proceeded to analyze the relevant provisions of the *Patent Act*, (R.S.C. 1985 c. P-4), to ascertain the test for amending the patent register:

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.

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 in 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.

52. The Federal Court has jurisdiction on the application on the Commissioner or of any person interested, to order that any entry in the records of the Patent Office relating to the title to be a patent be varied or expunged.

The Court reiterated that section 8 of the *Patent Act* does not give the Commissioner of Patents the authority to add an inventor to an existing patent: in fact, the Commissioner's jurisdiction to add an inventor is limited to the period during which a patent is pending. Once a patent is issued, it is section 52 of the *Patent Act* that enables the Court to order the modification of entries made in the records of the Patent Office. In *Micromass UK Ltd. v. Canada (Commissioner of Patents)*, 2006 FC 117 (FC), the Federal Court of Canada concluded that under section 52 of the *Patent Act*, the jurisdiction of the Court extends to correcting inadvertent errors relating to the naming of inventors in an issued patent.

Subsection 31(4) of the *Patent Act* sets out the test to determine if an individual can be added as an inventor: the Court must be satisfied that this person should have been joined and that the omission of the applicant is inadvertent or a mistake, and not for the purpose of delay.

Returning to the evidence in this case, the Court noted that the affidavits revealed that the omitted inventor, Mr. Doren, had met with the other inventors prior to the

filing of the US application and he had discussed concepts that became incorporated into various embodiments of the invention disclosed in the patent. The Court was thus satisfied that Mr. Doren had provided the necessary inventive steps to meet the test for inventorship under Canadian patent law and that the omission at the time of filing the Canadian applications was not to cause any delay.

The Court concluded that the Applicant had met its burden and was entitled to the relief sought. The Application was granted, without costs, and it was ordered that all entries into the records of the Patent Office be varied to add the name of Mr. Doren to the list of inventors in both of the Applicant's Canadian patents.

## Conclusion

The present case demonstrates how the inadvertent omission to name an inventor can be corrected where the Commissioner of Patents has no jurisdiction to do so *proprio motu*. This case ends well for the inventors and the patentee, but it should be remembered that a modification of the Canadian patent records remains an exceptional measure. Throughout the application process, it is recommended that patentees carefully review their application and submissions and that corrections be made as soon as any mistake is uncovered to avoid the long and costly process of asking the Court to make such corrections.



