

CANADIAN PATENTS: NOT INVALID FOR LACK OF “GOOD FAITH”

WINTER 2012

This is a review of a recent decision of the Canadian Federal Court of Appeal, which has implications for patent law practitioners and Canadian patent owners.

The case is *Weatherford Canada Ltd. v. Corlac Inc.*

The facts are that Mr. Grenke (“Grenke”) filed a patent application naming himself and Mr. Torfs (“Torfs”) as co-inventors. Torfs died shortly after the petition was filed. Subsequently, Grenke swore an affidavit stating that he was the sole inventor of the patent.

The application eventually issued as the ‘937 patent. Grenke sublicensed the patent to Weatherford. When Corlac manufactured and sold a similar device, Weatherford brought an action against Corlac for patent infringement. At trial, the Federal Court found the patent was valid and had been infringed by Corlac.

On appeal, Corlac alleged the patent was invalid because Grenke, in his affidavit, breached Section 73 of the Canadian *Patent Act* by failing to respond in good faith to a requisition made by the Patent Office during the prosecution of the application within the six-month period.

Section 73(1)(a) requires an applicant to act in good faith when responding to any requisition made by an Examiner. Failure to comply with Section 73(1)(a) results in the patent application being deemed abandoned.

Corlac argued that Grenke’s non-compliance with Section 73 should have resulted in the patent application being deemed abandoned and the invalidation of any subsequently issued patent. Effectively, Corlac argued that a breach of Section 73 should apply to invalidate the patent, post-issuance.

The Federal Court of Appeal (the “FCA”) rejected Corlac’s argument and held that “the concept of abandonment in paragraph 73(1)(a) operates during the prosecution of an application for a patent. Its operation is extinguished once the patent issues.”

The FCA stated that post-issuance, a party wishing to allege misrepresentation is restricted to relying on Section 53(1), which provides, among other things, that a patent is void if any material allegation in the petition of the applicant in respect of the patent is untrue.

The FCA cited the recent U.S. case, *Therasense Inc. v. Becton, Dickinson and Company*, where the inequitable conduct doctrine was quoted as the “atomic bomb” of patent law.

The *Weatherford* decision provides some certainty on the state of Canadian patent law in the wake of recent Federal Court cases suggesting Canadian patents might be invalidated for lack of good faith prosecution.▲

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