BETWEEN:

E. I. DU PONT DE NEMOURS AND COMPANY ..... PLAINTIFF;

AND

ALLIED CHEMICAL CORPORATION .... DEFENDANT.

Ottawa 1967 Apr. 6

Patents—Conflict proceeding—Patent Act, R.S.C. 1952, c. 203, s. 45(8)—Allegation that defendant not entitled to patent—Jurisdiction.

In a conflict action under s. 45 of the *Patent Act* plaintiff, in addition to asking for a determination that its inventor and not defendant's joint inventors was first inventor asked alternatively for a determination that defendant was not entitled to a patent on the ground that only one and not both of its joint inventors was the true inventor.

Held, the court has no jurisdiction to entertain an action for the alternative relief sought though such relief can be granted where plaintiff seeks an adjudication that it is entitled to the claim in conflict.

Plaintiff, the assignee of an application for a Canadian patent for an invention of Carl F. Irwin, commenced conflict proceedings in this court on March 10th 1967 following the decision of the Commissioner of Patents that Chao Shing Cheng and Richard G. Spaunburgh were the prior inventors of the invention for which a patent application was also pending in the patent office. Defendant is the assignee of Chao Shing Cheng and Richard G. Spaunburgh.

The concluding paragraphs of plaintiff's statement of claim are:

5. The plaintiff says and the fact is that as between the parties Carl F. Irwin and not Chao Shing Cheng and Richard G. Spaunburgh was the first inventor of the subject matter of conflict claims C1, C2 and C3.

1967

E. I. DU PONT DE NEMOURS AND CO. v. ALLIED CHEMICAL CORP.

6. The plaintiff says and the fact is that the subject matter of claims C1, C2 and C3 was not invented jointly by Chao Shing Cheng and Richard G. Spaunburgh before it was invented by Carl F. Irwin

THE PLAINTIFF THEREFORE CLAIMS:

(a) That it may be ordered and adjudged that as between the parties Carl F. Irwin was the first inventor of the subject matter of Claims C1, C2 and C3 and the Plaintiff is entitled to a patent containing Claims C1, C2 and C3.

(b) That it may be ordered and adjudged that the Defendant is not entitled to a patent containing Claims C1, C2 and C3 as assignee of Chao Shing Cheng and Richard G. Spaunburgh.

(c) Such other and further relief as to this Court may seem meet and just.

(d) Its costs of this action.

Defendant applied for an order striking out paragraph 6 of the statement of claim and paragraph (b) of the prayer for relief on the ground that these were irrelevant to the issue of priority and outside the jurisdiction of the court in these proceedings.

Russel S. Smart, Q.C. for plaintiff.

David Watson for defendant.

JACKETT P. (orally):—This is an application by the defendant to strike out paragraph 6 of the Statement of Claim and paragraph (*b*) of the Prayer for Relief in the Statement of Claim.

In effect, by the portions of the Statement of Claim in question, after seeking the normal relief in a conflict proceeding, namely, a determination that the plaintiff's inventor, and not the defendant's joint inventors, is the first inventor of the invention covered by the conflict claims, the plaintiff seeks a determination, in the alternative, that the defendant's *joint* inventors did not invent such invention before the plaintiff's inventor did, and an adjudication, therefore, that the defendant is not entitled to the conflict claims as an assignee of its joint inventors.

In my view, what this Court is authorized to deal with under section 45(8) of the *Patent Act* is a claim by a party who has failed to obtain a favourable decision from the Commissioner that he is entitled, as against the person who obtained the favourable decision, to the issue of a patent including the conflict claims, "*as applied for by him*" (paragraph (*d*) of section 45(8)). This requires that evidence be placed before the Court by the plaintiff designed

to show that the plaintiff's inventor did invent the invention, and when he invented it, and either that the defendant's inventor did not invent it or that he did but at a time subsequent to the making of the invention by the plaintiff's inventor. The defendant, of course, is entitled to adduce evidence in relation to the same matters. The upshot of all the evidence may be that the Court is convinced that it cannot adjudicate in favour of either of the parties under section 45(8)(*d*), but

(a) that there is in fact no conflict, in which case it adjudicates under section 45(8)(*a*), or

(b) that none of the parties is entitled to the issue of a patent containing the claims in conflict as applied for by him, in which case it adjudicates under section 45(8)(*b*).

I reiterate that I do not regard either of such latter possible classes of judgment as being the purpose of section 45(8) proceedings. I regard them as judgments arising incidentally in the course of proceedings designed to obtain a judgment under section 45(8)(*d*).

Coming then to the plaintiff's alternative position in this action, it is based on the hypothesis that, as the result of the evidence adduced with respect to the question whether the plaintiff's inventor is the first inventor, it may be made to appear that one of the defendant's joint inventors, and not the two inventors acting together, was the true inventor and invented the invention before the plaintiff's inventor.

In the event that the evidence indicates that conclusion, in my view, the plaintiff should be entitled to submit that the Court's decision should *not* be that the defendant is entitled as against the plaintiff to the issue of a patent containing the conflict claims "as applied for by him" (section 45(8)(*d*)) because he did apply for it as the invention of a single inventor, but rather that the judgment should be that none of the applicants is entitled to the issue of a patent containing the claims "as applied for by him" (section 45(8)(*b*)).

However, if the Court comes to that conclusion, in my view, the matter should then go back to the Commissioner —not on the basis that the matter is closed—but on the

1967

E. I. DU PONT DE NEMOURS AND CO. v. ALLIED CHEMICAL CORP.

Jackett P.

understanding that he may still see fit to deal with the matter under section 33(3), which reads as follows:

> (3) Where an application is filed by joint applicants, and it subsequently appears that one or more of them has had no part in the invention, the prosecution of such application may be carried on by the remaining applicant or applicants on satisfying the Commissioner by affidavit that the remaining applicant or applicants is or are the sole inventor or inventors.

On the above view of the matter, the Court has no jurisdiction to entertain an action for the relief sought by the alternative claim even though it may grant such relief in an appropriate case where the relief sought is an adjudication that the plaintiff is entitled to the conflict claims.

The application is granted with costs to the defendant in any event of the cause.