1968

*Jan. 30, 31
June 24

SOCIÉTÉ DES USINES CHIMIQUES RHONE-POULENC and CIBA, S.A., (*Plaintiffs*) ..... APPELLANTS;

AND

JULES R. GILBERT LIMITED *et al.* (*Defendants*) ..... RESPONDENTS.

ON APPEAL FROM THE EXCHEQUER COURT OF CANADA

Patents—Infringement—Validity of patent—Chemical process—Anti-histamines—Claim too broad in respect of utility—Claim invalid for want of subject-matter—Patent Act, R.S.C. 1952, c. 203.

The plaintiffs, as owners and licensees respectively of a patent, instituted an action against the defendants for infringement of claim 18 of that patent. The claim in question is for processes which, among others, include several particular chemical reactions, anyone of which might be a step in a process for the synthesis of a substance which has become known by the generic name tripelennamine. That substance is one of a group of drugs which have been found to be useful in blocking the effects of histamines in the body and which have become known as anti-histamines. The Exchequer Court held that claim 18 was invalid and dismissed the action for infringement. The plaintiffs appealed to this Court. It was conceded that claim 18 covers some substances which have no therapeutic value. It was also conceded that if claim 18 was valid the defendants had infringed.

Held: The appeal should be dismissed.

Claim 18 was invalid. It was too broad in its terms in respect of utility. The claim was also bad for want of subject-matter since the claim covered substances which were not useful. The claim being invalid, there could be no infringement.

Brevets—Contrefaçon—Validité du brevet—Procédé chimique—Antihistamines—Revendication trop étendue quant à son utilité—Revendication nulle faute d'objet—Loi sur les brevets, S.R.C. 1952, c. 203.

Les demandereses, étant respectivement les titulaires et les licenciées d'un brevet, ont institué une action contre les défenderesses pour violation de la revendication 18 du brevet. Il s'agit d'une revendication de procédés qui, entre autres, comportent plusieurs réactions chimiques spécifiques, dont l'une quelconque peut être un échelon dans le procédé pour obtenir la synthèse d'une substance connue sous le nom générique de tripelennamine. Cette substance fait partie d'un groupe de produits pharmaceutiques dont on a découvert l'utilité pour arrêter les effets de l'histamine dans le corps et que l'on appelle des antihistamines. La Cour de l'Échiquier a statué que la revendication 18 était nulle et a rejeté l'action en contrefaçon. Les demanderesses en ont appelé à cette Cour. Il fut admis que la revendication 18 couvrait des substances qui n'ont pas de valeur thérapeutique. Il fut aussi admis que si la revendication 18 était valide, les défenderesses l'avaient violée.

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*PRESENT: Fauteux, Martland, Hall, Spence and Pigeon JJ.

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Arrêt: L'appel doit être rejeté.

La revendication 18 était nulle. Dans ses termes elle était trop étendue en regard de son utilité. La revendication était aussi défectueuse faute d'objet puisqu'elle couvrait des substances qui n'étaient pas utiles. La revendication étant nulle, il ne pouvait pas y avoir contrefaçon.

APPEL d'un jugement du Juge Thurlow de la Cour de l'Échiquier du Canada[1], rejetant une action en contrefaçon. Appel rejeté.

APPEAL from a judgment of Thurlow J. of the Exchequer Court of Canada[1], dismissing an action for infringement. Appeal dismissed.

Christopher Robinson, Q.C., and *R. S. Smart, Q.C.,* for the plaintiffs, appellants.

I. Goldsmith, for the defendants, respondents.

The judgment of the Court was delivered by

HALL J.:—This is an action for alleged infringement by the respondents of claim 18 of Canadian Patent no. 474637 granted to the appellant Société des Usines Chimiques Rhone-Poulenc on June 19, 1951, for an invention entitled "Substituted Diamines". Claim 18 is, in substance, for processes which, among others, include several particular chemical reactions, any one of which might be a step in a process for the synthesis of a substance which has become known by the generic name tripelennamine.

The first named appellant sues as owner of the patent and the appellant Ciba as exclusive licensee under it. Their claim is that claim 18 of the patent has been infringed by the respondent, Gilbert Surgical Supply Co. Ltd. and by the other respondents. It is conceded that if claim 18 of the patent is valid the respondents have infringed.

The issues were narrowed in the Exchequer Court[1] by an agreement as to facts providing that for the purposes of the action the parties agreed:

1. That the process claimed in claim 18 of Canadian patent No. 474,637 consists in the application of methods which were known

[1] (1967), 35 Fox Pat. C. 174.

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on June 22, 1943, to substances which were also known on the said date, though the said methods had never at the said date been applied to the said substances except by the inventor named in the said patent.

2. That the substance referred to in paragraphs 6 and 7 of the re-amended Statement of Defence was not manufactured in Canada and was imported from outside Canada.

3. That none of the defendants has any knowledge as to the process by which the said substance was prepared or produced.

Tripelennamine is one of a group of drugs which have been found to be useful in blocking the effects of histamine in the body and which have become known as anti-histamines.

The specification in Canadian Patent No. 474637 is, in part, as follows:

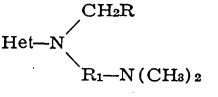
TO ALL WHOM IT MAY CONCERN:

BE IT KNOWN THAT I, RAYMOND JACQUES HORCLOIS, of 31 Rue du Chalet, Malakoff (Seine), France, a citizen of France, having made an invention entitled: "IMPROVEMENTS IN OR RELATING TO SUBSTITUTED DIAMINES", the following is a full, clear and exact disclosure of the nature of the same invention and of the best mode of realizing the advantages thereof:—

The present invention relates to new chemical compounds and to processes of producing the same. More particularly, this invention is concerned with new substituted diamines.

It is the main object of the present invention to provide new tertiary diamines having exceptionally powerful anti-histaminic action. It is a further object of this invention to provide processes for the production of these new diamines.

The new therapeutically active ditertiary diamines of the present invention conform to the general formula:—



where "Het" represents a monocyclic, heterocyclic nucleus, for example, pyridine, piperidine, furane, tetrahydrofurane, thiazole and pyrimidine, R represents a radical selected from the class consisting of aralkyl, aryl and monocyclic heterocyclic groups and aryl substituted in the nucleus by a member of the class consisting of alkyl and alkoxy groups, and R_1 is a lower alkylene group having at least two carbon atoms. Substances in this class possess an exceptionally powerful antihistaminic action.

and includes details set out in the reasons of Thurlow J. not necessary to repeat here. Thirteen examples are given in the specification but only those numbered I, IX and XIII represent separate methods of preparing tripelennamine, example XIII being the method involved in claim 18.

The disclosure portion of the specification concludes:

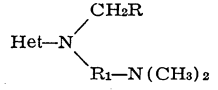
> It will be understood that, without departing from the spirit of the invention or the scope of the claims, various modifications may be made in the specific expedients described. The latter are illustrative only and not offered in a restricting sense, it being desired that only such limitations shall be placed thereon as may be required by the state of the prior art.

Claim 18, the claim in question in this action, reads:

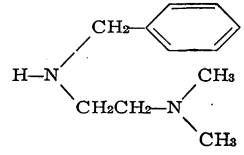
> 18. A process as defined in claim 8 in which R is phenyl.

Reference to claim 8 brings in successive references to claim 7 and claim 3 the result of which, on the references being incorporated, is that claim 18 reads:

A process for the preparation of new therapeutically valuable tertiary diamines being compounds of the general formula



where Het is pyridine, R is phenyl and R_1 is $—CH_2CH_2—$ and their salts, by reacting a secondary tertiary diamine of the formula



with a compound of the formula

pyridine-X

where X is a halogen atom.

The validity of claim 18 was challenged on a number of grounds, all of which were dealt with by Thurlow J. in his comprehensive reasons now under review. In my view only one of these grounds needs to be considered. If this ground is valid, as I think it is, that concludes the matter adversely to the appellants. This ground has two aspects which are interrelated, the first aspect being that claim 18 is too broad in its terms in respect of utility and for the reasons given in *Hoechst Pharmaceuticals of Canada Limited and Farbwerke Hoechst Aktiengesellschaft Vormals Meister Lucius & Bruning v. Gilbert & Company, Gilbert Surgical Supply Co. Limited, Jules R. Gilbert Limited*[2] is invalid. In *Hoechst* Thurlow J. is quoted with approval at p. 193 as follows:

> As a matter of interpretation however it is in my opinion clear that the claim refers to every mathematically conceivable sulphonyl urea of

[2] [1966] S.C.R. 189, 32 Fox Pat. C. 56, 50 C.P.R. 26.

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the class for I can see no basis upon which anyone who might contrive to make a substance of the class, however inconceivable the preparation of such a substance may have been at the time of the drafting of the claim, could successfully maintain that his substance was not within the class. But even if the claim were read as referring only to those members of the class which as a matter of chemistry or even of commercial manufacture could conceivably be made, I see no reason to doubt that it would refer to a class many thousands strong.

It is obvious and conceded by appellant that claim 18 of the patent in suit covers at least twelve different substances, namely the alpha, beta and gamma isomers and their four hydrohalide salts. On the other hand, it is equally clear that the beta and gamma isomers are not shown to be therapeutically valuable anti-histamines, the effective antihisme, tripelennamine, being the alpha isomer. It is also established that at least one of the hydrohalide salts cannot be safely used as oral medication, namely the hydrofluoride. This is sufficient to bring the case within the principle of the decision *Re May & Baker Ltd. v. Boots Pure Drugs Co. Ltd.*[3], which is referred to by Thurlow J. and was applied by this Court in *Commissioner of Patents v. Ciba*[4]. This principle is stated as follows in that case by Martland J. at p. 381:

> Although the two named thiazoles were of considerable therapeutic value, there was no evidence that this was true of any other derivatives covered by the claims, and accordingly the patent was bad for want of subject-matter, since the claims covered substances which were not useful.

As this is sufficient to dispose of the case, I prefer to express no opinion as to the consequence of having claimed, in addition to the substances obtained by the process described in claim 18, the salts of those substances. Similarly, I prefer to express no opinion as to whether the rare radioactive halogen element atastatine is to be considered as included in claim 18 in addition to the four usual halogens. I also prefer to express no opinion as to whether the claim should be read as implying that the alpha isomer may be prepared by the process described otherwise than by using alpha material in the reaction.

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[3] (1950), 67 R.P.C. 23; (1949), 66 R.P.C. 8; (1948), 65 R.P.C. 255.

[4] [1959] S.C.R. 378, 19 Fox Pat. C. 18, 30 C.P.R. 135, 18 D.L.R. (2d) 375.

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The appeal should, accordingly, be dismissed with costs. The request of the respondents that their costs should include the costs of preparing and printing the appeal case for appeal No. 10393 between these same parties is refused.

Appeal dismissed with costs.

Solicitors for the plaintiffs, appellants: Smart & Biggar, Ottawa.

Solicitors for the defendants, respondents: Duncan, Goldsmith & Caswell, Toronto.