1966
*Feb. 22, 23, 24
Apr. 26

FARBWERKE HOECHST AKTIEN-GESELLSCHAFT VORMALS MEISTER LUCIUS & BRUNING. ..... APPELLANT;

AND

THE COMMISSIONER OF PATENTS ... RESPONDENT;

AND

JULES R. GILBERT LIMITED ..... INTERVENANT.

ON APPEAL FROM THE EXCHEQUER COURT OF CANADA

Patents—Application for re-issue—Whether mistaken view of law a mistake within s. 50 of the Patent Act, R.S.C. 1952, c. 203.

Appeals—Application for re-issue of patent refused—Whether appeal lies to Exchequer Court—Patent Act, R.S.C. 1952, c. 203, ss. 2(a), 42, 44, 50.

The appellant surrendered a patent issued to it in 1959 in respect of a drug used to lower blood sugar levels, and petitioned the Commissioner of Patents, under s. 50 of the *Patent Act*, R.S.C. 1952, c. 203, for the

* PRESENT: Taschereau C.J. and Fauteux, Martland, Ritchie and Hall JJ.

re-issue of the patent. In its petition, it sought to add five new claims to the patent, as previously issued, but did not seek to make any change in the original disclosure, nor to abandon any of the claims contained in the original patent. The petition for re-issue was refused by the Commissioner. On appeal to the Exchequer Court, the Commissioner contended that the Court was without jurisdiction to hear an appeal from a decision made under s. 50 of the Act. The Exchequer Court found it unnecessary to determine this point and ruled against the appellant on the merits of the appeal. The appellant appealed to this Court.

Held: The appeal should be dismissed.

The wording of s. 44 of the *Patent Act* permits an appeal to the Exchequer Court in cases coming within s. 50 of the Act.

The appellant claimed that its patent was defective or inoperative by reason of its not having claimed that which it had a right to claim and that such error arose from mistake. The appellant believed that to comply with s. 41(1) of the *Patent Act* all that was necessary was that a product claim be dependent on a claim for a process by means of which the substance could be prepared and it was not realized that a claim for a specific product should be dependent upon a process claim specifically defining the production of that substance. The question to be determined was therefore whether that alleged mistake was a mistake within the meaning of s. 50 of the Act. That section deals only with a patent which is defective or inoperative. It contemplates the existence of a valid patent which requires re-issue in order to become fully effective and operative. In this case, the patent for which re-issue is sought has been held by this Court to be invalid (ante p. 189). Furthermore, assuming, without deciding, that a mistake of law could constitute that kind of mistake which is contemplated by s. 50, the section can only operate if the patentee can satisfy the Commissioner that, because of his mistake, the patent fails to represent that which the inventor truly intended to have been covered and secured by it. The appellant has not met that test. The mistake which is alleged is a failure, in the light of existing understanding of the law, to appreciate that a process claim of the kind here in question would not be sufficient to support the claim to the product under the requirements of s. 41(1) of the Act. A mistake of that kind does not fall within s. 50 of the Act.

Brevets—Requête pour redélivrance—Une erreur concernant la loi est-elle une erreur dans le sens de l'art. 50 de la Loi sur les Brevets, S.R.C. 1952, c. 203.

Appels—Requête pour la redélivrance d'un brevet, refusée—Y a-t-il appel devant la Cour de l'Échiquier—Loi sur les Brevets, S.R.C. 1952, c. 203, arts. 2(a), 42, 44, 50.

Ayant abandonné un brevet qui lui avait été émis en 1959 relativement à un produit pharmaceutique utilisé pour diminuer le contenu du sucre dans le sang, l'appelante a présenté une requête au Commissaire des Brevets, sous le régime de l'art. 50 de la *Loi sur les Brevets*, S.R.C. 1952, c. 203, pour obtenir la redélivrance du brevet. Dans sa requête, l'appelante a cherché à ajouter cinq nouvelles revendications au brevet, tel qu'émis préalablement, mais n'a pas cherché à faire de changements dans la divulgation originale et n'a pas cherché non plus à abandonner

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aucune des revendications contenues dans le brevet original. La requête pour redélivrance fut refusée par le Commissaire. Sur appel à la Cour de l'Échiquier, le Commissaire a soutenu que la Cour était sans juridiction pour entendre un appel d'une décision rendue sous le régime de l'art. 50 du statut. La Cour de l'Échiquier n'a pas jugé nécessaire de déterminer ce point et a donné raison au Commissaire sur les mérites de l'appel. D'où le pourvoi de l'appelante devant cette Cour.

Arrêt: L'appel doit être rejeté.

La phraséologie de l'art. 44 de la *Loi sur les Brevets* permet un appel à la Cour de l'Échiquier dans les causes tombant sous le régime de l'art. 50 du statut.

L'appelante prétend que son brevet était défectueux ou inopérant en raison du fait qu'elle n'avait pas revendiqué ce qu'elle avait le droit de revendiquer et que cette erreur a été commise par méprise. L'appelante croyait que pour se conformer à l'art. 41(1) de la *Loi sur les Brevets* tout ce qui était nécessaire était que la revendication du produit dépende de la revendication du procédé au moyen duquel la substance pouvait être préparée, et il ne fut pas réalisé qu'une revendication pour un produit spécifique devait dépendre d'une revendication du procédé délimitant spécifiquement la production de cette substance. La question à être déterminée était donc de savoir si l'erreur alléguée était une erreur dans le sens de l'art. 50 du statut. Cet article traite seulement d'un brevet qui est défectueux ou inopérant. Il envisage l'existence d'un brevet valide qui requiert redélivrance pour devenir complètement effectif et opérant. Dans le cas présent, le brevet dont on recherche la redélivrance a été jugé être invalide par cette Cour (voir p. 189). Bien plus, en assumant, sans le décider, qu'une erreur de droit peut constituer une erreur de la sorte qui est envisagée par l'art. 50, l'article ne peut entrer en jeu que si le breveté peut satisfaire le Commissaire que, à cause de son erreur, le brevet ne représente pas ce que l'inventeur avait vraiment l'intention de couvrir et d'obtenir. L'appelante n'a pas rencontré cette exigence. L'erreur que l'on allègue est le défaut, à la lumière de la loi telle qu'elle était alors comprise, d'apprécier qu'une revendication de procédé de la sorte dont il est question ne serait pas suffisante pour supporter la revendication du produit selon les exigences de l'art. 41(1) du statut. Une telle erreur ne tombe pas sous l'art. 50 du statut.

APPEL d'un jugement du Juge Thurlow de la Cour de l'Échiquier du Canada[1], confirmant une décision du Commissaire des Brevets. Appel rejeté.

APPEAL from a judgment of Thurlow J. of the Exchequer Court of Canada[1], affirming a decision of the Commissioner of Patents. Appeal dismissed.

Christopher Robinson, Q.C., and *James D. Kokonis*, for the appellant.

[1] [1966] Ex. C.R. 91, 31 Fox Pat. C. 64.

G. W. Ainslie, for the respondent.

I. Goldsmith, for the intervenant.

The judgment of the Court was delivered by

MARTLAND J.:—This is an appeal from the judgment of Thurlow J. in the Exchequer Court[1], which dismissed an appeal by the appellant from the refusal by the respondent to reissue Canadian Patent No. 582,623 which had been granted to the appellant on September 1, 1959.

On July 15, 1960, the appellant and Hoechst Pharmaceuticals of Canada Limited brought an action against Gilbert & Company, Gilbert Surgical Supply Co. Limited and Jules R. Gilbert Limited claiming infringement of this and several other patents. The last named company is an intervenant in the present appeal. The action was dismissed in the Exchequer Court by Thurlow J., and an appeal to this Court[2] from that judgment was dismissed on December 14, 1965.

The reasons for judgment in this Court, delivered by my brother Hall describe the nature of the invention in respect of which Patent No. 582,623 and the other patents involved in the case were granted, and the legal issue involved, as follows:

> All the patents relate to defined new sulfonyl ureas, each patent claiming a different process of producing them. Each of the processes produces the new substances by known methods from known materials, with the result that the patentability of the process depends on the possession of unexpected utility by the new substances produced. The unexpected utility stated in the patents is the capacity of lowering blood sugar levels, this being referred to as hypoglycemic activity. The process in each patent is claimed in claim 1 in relation to the production of all the new sulfonyl ureas. Each patent contains a claim (claim 10 in all but the last patent and claim 13 in the last patent) to a specific new sulfonyl urea, tolbutamide, whenever obtained by the process claimed in claim 1 of the patent. It is upon this claim to tolbutamide in each patent that the appellant founded its action for infringement.
>
> It is conceded that tolbutamide, standing by itself, could have been the subject matter of a valid patent if claimed as such when prepared or produced by the methods or processes of manufacture particularly described and claimed in the patent or by their obvious chemical equivalent. It possessed the previously undiscovered useful quality as defined in *Re May & Baker Ltd. and Ciba Limited,* 65 R.P.C. 255 and adopted by this Court in *Commissioner of Patents v. Ciba,* (1959) S.C.R. 378. However, the

[1] [1966] Ex. C.R. 91, 31 Fox Pat. C. 64.
[2] [1966] S.C.R. 189.

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respondents say that the process claims in each of the patents in question are invalid as being too broad in their terms, and, in consequence, the claim to the substance tolbutamide cannot stand for that reason.

His conclusion is stated as follows:

In challenging the validity of the patents in question, counsel for the respondents put his case upon the footing that no one could obtain a valid patent for an unproved and untested hypothesis in an uncharted field. This is what the appellant has tried to do in claim 1 of each of the patents. It has sought to cover, in the words of Thurlow J., "every mathematically conceivable sulphonyl urea of the class" and has consequently overclaimed, and, in so doing, invalidated claim 1 in each patent.

He then went on to hold, applying the decisions of this Court in *C. H. Boehringer Sohn v. Bell-Craig Limited*[1] and *Commissioner of Patents v. Winthrop Chemical Company Incorporated*[2], that the claims to the product tolbutamide (claim 10 in the patent now in question) fell because they could not stand except upon the foundation of a valid process claim, which did not exist.

Prior to the delivery of the judgment of Thurlow J. in its infringement action, the appellant, in August 1963, had petitioned for the issue of a new patent, and had surrendered Patent No. 582,623. The petition was based upon s. 50 of the *Patent Act*, R.S.C. 1952, c. 203, which provides as follows:

50. (1) Whenever any patent is deemed defective or inoperative by reason of insufficient description or specification, or by reason of the patentee claiming more or less than he had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention, the Commissioner may, upon the surrender of such patent within four years from its date and the payment of the further fee hereinafter provided, cause a new patent, in accordance with an amended description and specification made by such patentee, to be issued to him for the same invention for the then unexpired term for which the original patent was granted.

(2) Such surrender takes effect only upon the issue of the new patent, and such new patent and the amended description and specification have the same effect in law, on the trial of any action thereafter commenced for any cause subsequently accruing, as if such amended description and specification had been originally filed in their corrected form before the issue of the original patent, but in so far as the claims of the original and reissued patents are identical such surrender does not affect any action pending at the time of reissue nor abate any cause of action then existing, and the reissued patent to the extent that its claims are identical with the original patent constitutes a continuation thereof and has effect continuously from the date of the original patent.

[1] [1963] S.C.R. 410, 25 Fox Pat. C. 36, 41 C.P.R. 1, 41 D.L.R. (2d) 611.
[2] [1948] S.C.R. 46, 7 Fox Pat. C. 183, 7 C.P.R. 58, 2 D.L.R. 561.

(3) The Commissioner may entertain separate applications and cause patents to be issued for distinct and separate parts of the invention patented, upon payment of the fee for a reissue for each of such reissued patents.

The relevant portions of the petition are as follows:

1. THAT Your Petitioner is the patentee of Patent No. 582,623 granted on September 1st 1959, for an invention entitled MANUFACTURE OF NEW SULPHONYL-UREAS.

2. THAT the said Patent is deemed defective or inoperative by reason of the patentee having claimed more or less than he had a right to claim as new.

3. THAT the respects in which the patent is deemed defective or inoperative are as follows:

Claims 1, 3 and 4 of the patent cover the production of new compounds of a general formula in which certain substituents are not exhaustively defined.

The patent contained claims directed to the production of the new compounds when prepared by the process of claim 1 and to certain specific products when prepared by the process of claim 1 but did not contain claims to specific products when prepared by specific processes.

4. THAT the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention in the following manner: Applicant on the advice of his attorneys believed at the time the application was pending that for compliance with Section 41(1) all that was required was that a product claim be dependent on a process claim by means of which the specific claimed substance could be prepared, whereas on March 21, 1962, it was pronounced in a judgment of the Exchequer Court of Canada that for compliance with Section 41(1) a claim covering a specific product should be dependent on a process claim which defines specifically the production of that substance.

THAT at the time the application was pending, applicant also believed that for the production of a medical substance, broad terms of theoretically unlimited scope would not result in any defect in the claims, whereas following a judgment in the Exchequer Court of Canada on March 21, 1962, it became apparent that the validity of such claims was in doubt.

5. THAT knowledge of the new facts in the light of which the new claims have been framed was obtained by Your Petitioner on or about April 1962 when the fact and effect of the said judgments of the Exchequer Cour was communicated to Your Petitioner by its Canadian patent agents, whereupon the specification of the Patent was reviewed carefully for the presence of these and other defects.

In the petition, the appellant sought to add five new claims to the patent, as previously issued. Three of these purported to restrict the substituent group of the general formula. The other two contained a specific claim for the substance tolbutamide and for a specific process for its preparation. The appellant did not seek to make any change in the original disclosure, nor to abandon any of the claims contained in the patent as originally issued. In fact,

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as has already been noted, the appellant persisted in its infringement action, notwithstanding the filing of the petition.

The petition was refused by the respondent. The material portions of his decision are as follows:

> Careful consideration has been given to the admissibility of this reissue application for prosecution in the Office.
>
> Whether an application for reissue is acceptable for prosecution before the Office depends on the reasons given in the petition for wanting to correct what is said to be the defect or inoperativeness of the patent.
>
> Section 50 of the Patent Act is the governing section. The reasons for reissue are insufficiency of description or specification or claiming more or less than what the patentee had the right to claim. I do not believe that the patentee in this case can rightly invoke any of these reasons.
>
> In addition to the reasons the section is conditional on certain circumstances which occurred or were present at the time of issue. The error must have arisen from inadvertence, accident or mistake at that time.
>
> Here there was no inadvertence, accident or mistake at the time of issuing the patent. The applicant was satisfied to obtain his patent with claims submitted and was satisfied on the advice of his agent that the provisions of section 41 subsection 1 has been complied with. There was no defect that the applicant had in mind and failed through inadvertence to correct, (1936 S.C.R. 649 at page 661 Northern Electric Company Limited v. Photo Sound Corporation). It is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification. It must appear from the face of the instrument that what is covered by the reissue was intended to have been covered and secured by the original, (In re Sawyer 624 O.G. 960, 81 USPQ 374, Decisions of the Commissioner 1949 at page 343).
>
> I do not believe that a change in the legislation or a different interpretation of the legislation was ever contemplated to be a reason for reissue. In this case the courts interpreted the sufficiency of the claims in a patent in a manner different from the generally accepted views of the patent agents and patentees, thereby creating a situation which did not exist at the time of issue of the original patent.
>
> My ruling is that the present application for reissue cannot be entertained.

From this refusal, the appellant appealed to the Exchequer Court[1]. The respondent contested the right of the appellant to appeal the respondent's decision under s. 50, contending that the Court was without jurisdiction to hear it. Thurlow J., in view of his decision on the merits of the appeal, found it unnecessary finally to determine this point, though stating that he was inclined to the view that a right of appeal did exist.

[1] [1966] Ex. C.R. 91, 31 Fox Pat. C. 64.

The relevant section of the *Patent Act* is s. 44, which provides as follows:

> 44. Every person who has failed to obtain a patent by reason of a refusal or objection of the Commissioner to grant it may, at any time within six months after notice as provided for in sections 42 and 43 has been mailed, appeal from the decision of the Commissioner to the Exchequer Court and that Court has exclusive jurisdiction to hear and determine such appeal.

Section 43 is not relevant in relation to this issue. Section 42 reads as follows:

> 42. Whenever the Commissioner is satisfied that the applicant is not by law entitled to be granted a patent he shall refuse the application and, by registered letter addressed to the applicant or his registered agent, notify such applicant of such refusal and of the ground or reason therefor.

It was the contention of the respondent that, when these sections are read together, it cannot be contemplated that s. 44 provided for a right of appeal in respect of the refusal by the Commissioner of Patents to issue a new patent under s. 50. It was submitted that an application under s. 50 was not the kind of application contemplated by s. 42. Reliance was placed on the definition of an "applicant" in s. 2(*a*) of the *Act*, i.e.:

> 2.(*a*) "applicant" includes an inventor and the legal representatives of an applicant or inventor;

as indicating that a patentee, surrendering his patent and seeking the granting of a new patent, was not an applicant within the meaning of s. 42.

It should be observed, however, that the definition of "applicant" in s. 2(*a*) is not an exclusive one, and that the word "application", as defined in s. 2(*c*) of the *Patent Rules*, means, "except in sections 96 to 116, an application for a patent or an application for a reissue of a patent".

Section 12(2) of the *Act* provides that any rule or regulation made by the Governor in Council is of the same force and effect as if it had been enacted in the *Act*.

In the light of these circumstances, in my opinion the wording of s. 44 of the *Act* permits an appeal in cases coming within s. 50.

This being so, it is necessary to consider the refusal by the respondent of the appellant's petition upon the merits.

I interpret the reasons for that refusal as being twofold:

1. That the appellant could not rightly invoke any of the reasons justifying the reissue of a patent

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under s. 50, i.e., insufficiency of description or specification or the claiming of more or less than the appellant had the right to claim.

2. In any event there had been no inadvertence, accident or mistake causing the alleged error.

On the appeal from the decision of the respondent, pleadings were ordered and the parties agreed upon a statement of facts. Paragraph 4 of the statement reads as follows:

> 4. The parties hereto agree that if this Honourable Court should find:
>
> (*a*) that an appeal lies from the ruling by the Respondent, and
>
> (*b*) that the error in relation to Patent No. 582,623 arose from inadvertence, accident or mistake without any fraudulent or deceptive intention,
>
> then the application for reissue should be referred back to the Respondent for further consideration and, *inter alia,* for consideration as to whether the amended specification attached to the petition for reissue is for the same invention as the said Patent No. 582,623.

Having reached the conclusion that an appeal did lie to the Exchequer Court, I propose to consider the issue raised in subpara. (*b*) of para. 4 above.

It is clear from the fact that in the petition for reissue no change was made in the disclosure, and no claims previously made were abandoned, that the appellant did not allege error, within s. 50, by reason of insufficiency of description or specification or by reason of its having claimed more than it had a right to claim. It is also clear from the petition that the appellant did not allege that the error arose from inadvertence or accident.

What the appellant claims, therefore, is that its patent was defective or inoperative by reason of its not having claimed that which it had a right to claim and that such error arose from mistake.

The mistake which is relied upon is that the appellant, on the advice of its attorneys, believed that to comply with s. 41(1) of the *Patent Act* all that was necessary was that a product claim be dependent on a claim for a process by means of which the substance could be prepared and it was not realized that a claim for a specific product should be dependent upon a process claim specifically defining the production of that substance. This, it is claimed, was not

discovered until the reasons for judgment of the Exchequer Court in *Boehringer v. Bell-Craig*[1] were issued.

It is also claimed that, prior to that time, the appellant believed that, for the production of a medical substance, broad terms of theoretically unlimited scope would not result in any defect in the claims.

In essence what the appellant is saying is that the appellant's attorneys made a mistake of law in respect of the product tolbutamide in having failed to make a process claim specifically defining the production of that substance. The question to be determined is, therefore, whether that alleged mistake is a mistake within the meaning of s. 50.

Counsel for the appellant pointed out that the reissue provision of the *Patent Act* is drawn from legislation in the United States. The American provision is similar to that in Canada, subject, however, to some material differences. The word "deemed" does not appear in the American statute. Instead of the words "defective or inoperative" it uses the words "inoperative or *invalid*". It does not refer to a patentee claiming less than he had a right to claim. Furthermore, where the required conditions exist, it provides that the Commissioner "shall" cause a patent to be reissued, whereas our Act uses the word "may".

In the result, the American statute requires the Commissioner to reissue a patent, in the events defined, even in cases where the initial patent is invalid. The Canadian Act creates a discretion, and only in cases where the initial patent is "deemed defective or inoperative".

The first Canadian *Patent Act*, that of the Province of Canada, 12 Vict., c. 24, did use the words "inoperative or invalid". The forerunner of the present s. 50, which uses the words "defective or inoperative", is found in s. 19 of the Statutes of Canada, 1869.

The view of the Supreme Court of the United States regarding the purpose of the American provision as to reissue was stated as being "to provide that kind of relief which courts of equity have always given in cases of clear accident and mistake in the drawing up of written instruments". *Mahn v. Harwood*[2]. This statement was cited, with

[1] [1962] Ex. C.R. 201, 22 Fox Pat. C. 190. [2] (1884), 112 U.S. 354 at 363.

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approval, in *Sontag Chain Stores Co. v. National Nut Company of California*[1].

Used in this sense, the word "mistake" means that a written instrument does not accord with the true intention of the party who prepared it. A person relying upon a mistake under s. 50 would have to establish that the patent which was issued did not accurately express the inventor's intention with respect to the description or specification of the invention or with respect to the scope of the claims which he made. This view appears to me to coincide with that expressed by Chief Justice Duff, in relation to the word "inadvertence" in *Northern Electric Company Ltd. v. Photo Sound Corporation*[2], cited by the respondent in his reasons for the refusal of the appellant's petition.

In *General Radio Co. v. Allen B. DuMont Laboratories, Inc.*[3], the Circuit Court of Appeals, Third Circuit, held that the failure of the patent applicants to foresee that the application was based upon an error of judgment by the patentee's solicitors in the drafting of the claims.

The appellant relied upon the reasoning of the Court of Appeals, Ninth Circuit, in the case of *Moist Cold Refrigerator Co. v. Lou Johnson Co.*[4]. In that case the Court held that the failure of the patent applicants to foresee that the original patent would be declared invalid as functional was an error through "inadvertence or mistake" where the applicant drafted claims in good faith, without intent to cover any means of producing the result, and where the functional nature of the claims was a very close question.

The Court pointed out that in s. 251 of the *Patent Act* of 1952, governing the reissue of patents, the words "inadvertence, accident or mistake" had been deleted, but held that the test as to the type of error required remained the same as before.

Two points should be noted in respect of this decision. The first is that in this case a reissue had been granted in respect of a patent which had been held to be invalid. As has been pointed out earlier, the American statute in terms permits the reissue of an invalid patent in certain specified circumstances. The Canadian Act, however, does not so

[1] (1940), 310 U.S. 281 at 290.
[2] [1936] S.C.R. 649 at 661, 4 D.L.R. 657.
[3] (1942), 129 F. 2d 608.
[4] (1954), 217 F. 2d 39.

provide. Section 50 deals only with a patent which is defective or inoperative. In my opinion it contemplates the existence of a valid patent which requires reissue in order to become fully effective and operative. In the present case, in so far as the substance tolbutamide is concerned, the patent for which reissue is sought has been held by this Court to be invalid.

The second point is that, while the Court considered an error on a question of law could be one which could be corrected by reissue if it arose through inadvertence or mistake, the test applied does not actually depart significantly from that defined by the Supreme Court of the United States in the cases previously cited. The Court did find on the evidence that the patentee's intent was to take proper steps only to protect its invention and not to cover any and all means of producing the result. Its failure to accomplish that intent resulted from a mistake in framing its claims so as not to render them functional in character within the legal requirements and the earlier decision that they had not done so was a close question.

The learned trial judge, in the present case, left open the question as to whether inadvertence, accident or mistake in relation to a question of law could come within s. 50. He was inclined to the view that such cases might arise.

It is not necessary to express a final view with respect to that question in the present case. Assuming, without deciding, that a mistake of law could constitute that kind of mistake which is contemplated by s. 50, in my opinion the section can only operate if the patentee can satisfy the Commissioner that, because of his mistake, the patent fails to represent that which the inventor truly intended to have been covered and secured by it. I do not think that the appellant has met that test.

The parties to this appeal agreed to the following stated facts:

(*a*) Process claims 1 and 2 in Patent No. 582,623, to which claims 3 to 19 inclusive refer, are claims to processes for the manufacture of a large class of substances, and the number of mathematically conceivable substances embraced in the class defined in claims 1 and 2 is infinite.

(*b*) Claims 1 and 2 do not state specifically the starting materials from which tolbutamide and the other specific substances defined in claims 10 to 19 inclusive may be made.

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(c) The disclosure in Patent No. 582,623 does not purport to be one of an invention of tolbutamide alone, or of any of the other specific substances defined in claims 10 to 19 and a process or processes for their preparation, but on the contrary, relates to a class of sulphonyl ureas of which tolbutamide and the other specific substances defined in claims 10 to 19 are members; and the disclosure proceeds to outline in general terms the methods by which ureas of the class may be produced, and asserts utility for the substances of the class. Tolbutamide and the other specific substances defined in certain of the claims are mentioned from time to time in the disclosure as examples, but not until one reaches claims 10 to 19 is there any indication that the invention is concerned with anything but a whole class of substances and general methods of producing them.

(d) The method used in process claims 1 and 2 was not new, nor were the starting materials which were used new.

(e) The great bulk of conceivable substances embraced within the class defined in claims 1 and 2 have not, in fact, been produced or tested and nothing is, in fact, known of what their pharmacological effects or usefulness may be; pharmacological effects of new and untried substances are not generally predictable or, if predictable at all, are not predictable to any great extent.

(f) It is highly improbable that all, or substantially all, of the infinitely large class of substances produced by processes within the scope of claims 1 and 2 have either the blood sugar lowering activity to a useful extent or the freedom from toxicity or harmful side effects necessary to render them useful; and it cannot be predicted that all or substantially all of the substances produced by the process claimed in claim 1 have advantages for lowering and controlling the blood sugar level of patients suffering from diseases such as diabetes, over the known methods of (1) dieting, and (2) the administration of insulin.

There is the further fact that the petition for reissue made no change in the disclosure and abandoned none of the claims contained in the patent originally issued.

In the light of these facts, it would appear to me that the conclusion of the learned trial judge with respect to claims 1, 3 and 4, referred to in the appellant's petition for reissue, is fully warranted.

I should say a word, however, with respect to what was put forward as an explanation of the alleged error in claims 1, 3 and 4. The Commissioner plainly did not accept it. The explanation was that the alleged error arose through inadvertence, accident or mistake in that at the time the application was pending the applicant believed that for the production of a medical substance broad terms of theoretically unlimited scope would not result in any defect in the claims whereas after a judgment of this Court it became apparent that the validity of such claims was in doubt. Assuming this to be true (which is a matter of some difficulty in view of the fact that the *May & Baker* case had already been decided and had been considered

and in some respects adopted in this country in *Commissioner of Patents v. Ciba,* (1959) S.C.R. 378) I do not see how the Commissioner could have been expected to accept it as showing that the alleged failure to define certain substituents exhaustively arose from inadvertence, accident or mistake for it shows on its face that the applicants knew their alleged invention was limited to substituents that required to be more exhaustively defined but refrained from so defining them not by inadvertence, accident or mistake but deliberately so as to claim and thus get a monopoly under the statute on something which on the admitted facts they had not invented and must have known they had not invented and which was not in fact an invention at all. This is not a case of the applicants having claimed more than they were entitled to claim as new through inadvertence, accident or mistake but one of their having deliberately set out to monopolize what was for the most part an unexplored field of organic chemistry so as to prevent others during the life of the patent from exercising their right to search in that field for, and if successful to put on the market, new substances which might turn out to be as useful or more useful than the several specific substances in that field which the applicants had found to be useful.

The claim to the substance, tolbutamide, claim 10, is one which falls within the requirements of s. 41(1) of the *Patent Act,* which provides:

> 41.(1) In the case of inventions relating to substances prepared or produced by chemical processes and intended for food or medicine, the specification shall not include claims for the substance itself, except when prepared or produced by the methods or processes of manufacture particularly described and claimed or by their obvious chemical equivalents.

The process claim relied upon for compliance with this subsection was claim 1. There is no suggestion in the petition that the appellant had intended to include in its original patent a claim of the kind defined in the new claim 23 specifically defining the production of tolbutamide. It is clear that judgment was exercised and a decision reached to rely upon the process claim which is claim 1, which, as already noted, was a claim described by Thurlow J. in the infringement action and adopted by this Court as seeking to cover "every mathematically conceivable sulphonyl urea of the class".

There was, therefore, no mistake in the sense that the original patent failed to represent the true intent of the appellant. The mistake which is alleged is a failure, in the light of existing understanding of the law, to appreciate that a process claim of this kind would not be sufficient to support the claim to the product tolbutamide under the requirements of s. 41(1).

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Martland J.

I do not think that a mistake of that kind falls within s. 50. Even if the *Moist Cold Refrigerator Co.* case were to be accepted as an accurate statement of the law in Canada in so far as a mistake of law is concerned, which I do not necessarily accept, the present case would not fall within it since here the appellant deliberately elected to make a process claim in the widest possible terms and had no intention of restricting its invention solely to the production of tolbutamide.

Nor do I agree that the decision of Thurlow J. in *C. H. Boehringer Sohn v. Bell-Craig Limited, supra,* could be regarded as being an unexpected change of view as to the state of the law. This Court in *Commissioner of Patents v. Winthrop Chemical Co. Inc., supra,* had held that a claim for a substance alone could not be entertained if it was of the kind defined in s. 41(1) and that the applicant must describe in his specification the method or process by which the substance is prepared or produced and claim such process.

The English decision of *May v. Baker*[1], which had been approved by Thorson P., [1956-1960] Ex. C.R. 142, and by this Court, [1959] S.C.R. 378, in relation to one aspect in *Commissioner of Patents v. Ciba,* had dealt with a broad process claim of the kind made in claim 1 and had held, to quote from the headnote:

> That 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
>
> That accordingly the patent was bad for want of subject matter since the claims covered substances which were not useful.

At the very least, this decision constituted a warning that there might be doubt as to the validity of claim 1 upon which, under s. 41(1), the appellant elected to rely in claiming the substance tolbutamide.

In the *Boehringer* case this Court held that an invalid process claim could not support a claim to a substance under s. 41(1), and this was repeated in the decision in the infringement action in relation to claim 10 of the patent under consideration here. Such a conclusion merely stated what I think was implicit in the *Winthrop* case.

[1] (1948), 65 R.P.C. 255.

In the light of the foregoing, I think there was ample justification for the exercise by the Commissioner under s. 50 of his discretion in the manner which he did. He was sustained in his decision by the judgment in the Court below, and in my opinion his decision should not be disturbed by this Court. It is my view that this appeal should be dismissed with costs to be paid by the appellant to the respondent.

Appeal dismissed with costs.

Solicitors for the appellant: Smart & Biggar, Ottawa.

Solicitor for the respondent: E. A. Driedger, Ottawa.

Solicitors for the intervenant: Duncan, Goldsmith & Caswell, Toronto.