BETWEEN:

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

Ottawa 1965
June 21-23
July 16

AND

THE COMMISSIONER OF PATENTS .... RESPONDENT.

Patents—Application for reissue—Patent for process and class of substances —Proposed new claim for specific substance made by particular process —Whether disclosed in original patent—Defects in original patent—Whether error inadvertent—Whether mistaken view of law is inadvertence—Decision of Commissioner of Patents—Appeal—Patent Act, ss. 36, 38(1), 41(1), 42, 44, 50.

Appeals—From Commissioner of Patents—Dismissal of application for reissue patent—Whether appeal lies—Patent Act, ss. 36, 44.

In September 1959 a patent was issued to appellant for an invention entitled "Manufacture of New Sulphonyl Ureas". The patent contained two process claims for the manufacture of a class of substances, a claim for the whole class of substances made by such processes, and a number of claims for specific substances of the class, amongst them tolbutamide The specifications and process claims were broad enough to cover an infinite number of substances, and a statement in the specifications that experiments demonstrated that the products of the invention substantially lowered the blood sugar level and were therapeutically useful was incorrect as the great bulk of conceivable substances covered by the patent had not been produced or tested and nothing was known of their pharmacological effects or usefulness.

In August 1963 appellant applied under s. 50 of the *Patent Act* for a reissue patent on the ground that the original patent claimed more or less than appellant had a right to claim as new and that the error arose from inadvertence, accident or mistake. By its amended specification appellant made five further claims: one for a process for the manufacture of substances of a sub-class of the broad class, two for such substances and their salts when produced by that process, one for a particular process for making tolbutamide and one for tolbutamide when so made. Appellant gave two grounds for deeming the original patent defective: (1) that it did not exhaustively define certain substituents of substances of the class, and (2) that it did not claim specific products when prepared by specific processes; and the application stated that the error resulted from legal advice shown to be wrong by a decision pronounced by the Exchequer Court in 1962 that a specific product claim must be dependent upon a process claim which defines specifically the production of that substance.

Held, affirming the decision of the Commissioner of Patents, the application must be refused.

1. The original patent was defective but not for the reason put forward by appellant, *viz:* failure to define the substituents of the class more exhaustively. The original patent was defective because the description of the invention in the patent was false. An application for a reissue patent under s. 50 assumes that the patentee was entitled to a patent.

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Moreover the alleged error in the original patent did not in fact arise through inadvertence, accident or mistake.

2 The original patent was not defective because of its failure to contain a claim for tolbutamide when prepared by specific processes. That was a different invention from the invention of the class of substances described in the patent, and s. 38(1) of the *Patent Act* would have prohibited its inclusion in the original patent.

Quaere, whether a defect in a patent due to an erroneous view of the law can be regarded as due to inadvertence within the meaning of s. 50 of the *Patent Act.*

Semble, section 44 of the *Patent Act* confers a right of appeal to the Exchequer Court from a refusal by the Commissioner of Patents of an application under s. 50 for a reissue patent.

[*Hoechst v. Gilbert* [1965] 1 Ex. C.R. 710; *Re May & Baker Ltd. et al,* 65 R.P.C. 255; 66 R.P.C. 8; 67 R.P.C. 23, discussed.]

APPEAL from dismissal of application for reissue patent under s. 50 of *Patent Act.*

Chistopher Robinson, Q.C. and *Russell S. Smart* for appellant.

George W. Ainslie and *M. A. Mogan* for respondent.

THURLOW J.—This is an appeal taken pursuant to s. 44 of the *Patent Act*[1] from a refusal by the Commissioner to entertain an application by the appellant for a reissue of Canadian patent number 528,623 granted to the appellant on September 1, 1959 in respect of what is therein referred to as an invention entitled "Manufacture of New Sulphonyl Ureas".

The application for a reissue patent was made under s. 50(1) of the Act which reads 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.

The principles affecting the right of a patentee to obtain a reissue patent are discussed in the judgment of the Supreme Court in *Northern Electric Company Limited v. Photo Sound Corporation*[2] and it is unnecessary for present purposes to repeat what is there set out beyond reiterating that reissue is a form of relief which is available only

[1] R.S.C. 1952, s. 203. [2] [1936] S.C.R. 649.

within the limits of the statutory provision therefor. While the provision has been enlarged in one important respect since the judgment in that case, that is to say in making reissue available in cases where a patent is deemed defective or inoperative by reason of the patentee having claimed less than he was entitled to claim as new, the provision for relief is still strictly limited to cases in which the patent is deemed to be 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". As will presently appear the present is a case in which the application for reissue was based on the patent being deemed to be "defective or inoperative" not by reason of "insufficiency of description or specification" as in the *Northern Electric* case, but by reason of the applicant having claimed "more or less than he had a right to claim as new". It will also appear that the Commissioner refused to entertain the appellant's application on two grounds the first of which was that the appellant could not rightly invoke any of the reasons for reissue open under the terms of the statute, that is to say, either insufficiency of description or specification or claiming more or less than the applicant was entitled to claim as new, and the other of which was that there was no inadvertence, accident or mistake from which the alleged errors arose. The question whether the application for reissue was in respect of the same invention was not dealt with by the Commissioner and the parties have agreed that if the appeal succeeds the application should be referred back to him 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 patent in question.

The patent in question is one of the ten patents involved in the action in this Court numbered 162,296[1] brought by the appellant against Gilbert and Company and others for alleged infringement of the patents by selling a substance known as tolbutamide which is useful for its blood sugar lowering effect in the treatment of diabetes and which is one of a large class of substances known as sulphonyl ureas referred to and claimed in the patents. For the purposes of this appeal the parties have agreed to admit as facts all the facts found in the reasons for judgment in that action and

[1] [1965] 1 Ex. C.R. 710.

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that *inter alia* certain facts, which are set out later in these reasons were found. The latter are therefore to be taken as facts for the purposes of this appeal though as stated they purport to relate in part to claims which were not in issue and which were not considered in the reasons for judgment in the action.

The specification of the patent is described in some detail in the reasons for judgment in that action and for the present purpose a brief outline of it will be sufficient. It begins by referring to the inventors having made an invention entitled "Manufacture of new Sulphonyl-ureas" and proceeds to state that the disclosure which follows contains a correct and full description of the invention and of the best mode known to the inventors of taking advantage of the same. It next refers to certain sulphonyl compounds known to have blood sugar lowering effect and then states that "the present invention provides sulphonyl ureas" of a general formula the scope of which as defined is broad enough to include an infinitely large number of such sulphonyl ureas. Next it sketches a number of general methods each consisting of a well known type of chemical reaction between known types of chemical compounds by which sulphonyl ureas of this broad class may be prepared. It is then stated that:

> As has been demonstrated by experiments on animals and in clinical tests, the products of the invention produce a substantial lowering of the blood sugar level. They may be used as such or in the form of their salts, or in the presence of substances that cause salt formation. For salt formation there may be used, for example, ammonia, an alkaline substance such as an alkali metal or alkaline earth metal hydroxide, an alkali metal carbonate or bicarbonate, or a physiologically tolerated organic base. The compounds can be made up, inter alia, into preparations suitable for oral administration and lowering the blood sugar in the treatment of diabetes

This is followed by data concerning the results of tests of some of the substances of the class on animals and then by the statement that:

> Clinical tests performed on a large number of patients have fully established the efficacy of the products of the present invention, for example, N-(4-methyl-benzene-sulphonyl)-N'-(n-butyl)-urea and N-(4-methyl-benzene-sulphonyl)-N'-isobutyl-urea, in lowering the blood sugar level. For example, the first named compound lowers the blood sugar level of healthy human beings by an average of 20-40 mg/per cent. In the case of certain diabetics a lowering, for example, of about 300 mg/per cent to the normal value of about 120 mg/per cent has been observed. The products of the invention have been tested as anti-diabetics in light and severe cases of diabetes mellitus.

The substance first mentioned as an example in this passage is the substance known as tolbutamide. This is followed by a number of further references to the use, administration and effects of what are variously called "the products of the invention" or "the compounds of the invention" and in several places the use, administration and effects of tolbutamide and of some of the other substances of the class are cited by way of example.

Some fifty-three examples of processes for the preparation of sulphonyl ureas of the class are then given and the specification then concludes with nineteen claims. Of these the first two are process claims and the remaining seventeen are product claims.

Claim 1 is for a process for the production of all the substances of the class by a particular chemical reaction being one of the known general chemical reactions mentioned earlier in the specification. Claim 2 is for a process for the production of salts of the substances of the class.

The product claims are all for substances when made by the process of claim 1 or the obvious chemical equivalent thereof. Of these the first seven, that is to say, claims 3 to 9 inclusive are claims for classes of substances when produced by that process. Claim 3 embraces the whole class of substances when so produced. Claim 4 embraces the salts of all the substances of the class. Claims 5 to 9 inclusive embrace substances of different sub-classes of the broad class and their salts when so produced. Each of the remaining ten claims is for a particular substance of the broad class and of these claim 10 is for the substance known as tolbutamide.

The facts which, as previously mentioned, the parties have agreed were *inter alia* found in the reasons for judgment in *Hoechst v. Gilbert*[1] action and are to be taken as facts in the present appeal are as follows:

(*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.

[1] [1965] 1 Ex. C.R. 710.

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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.

It may be useful to pause and consider for a moment what monopoly could properly be claimed on the basis of the disclosure of this specification. Assuming the statements in it to be true it would I think warrant claims in respect of an invention of the whole class of substances falling within the definition of claim 1 and thus avail to protect to the patentee during the life of the patent every substance within the class when produced by the processes claimed. There would, on that assumption, as I view it be no occasion to add a claim or claims in respect of any specific substance of the class. On the other hand if any of the material statements respecting the testing and utility of the substances of the class defined in the specification are untrue, and on the admitted facts that, in my opinion, is the situation, both with respect to the statement that the products of the invention have been tested and that they are all therapeutically useful for their blood sugar lowering

effects, no claim at all in respect of the alleged invention of the class is warranted for no such invention has been made. The alleged invention is nothing but an unproved and untrue hypothesis. So preposterous are the assertions in the specification that the products of this alleged invention (grammatically the expression embraces all the substances of this infinitely large class) have been tested and found to have the therapeutic qualities of those cited as examples that no one skilled in the art would consider for a moment believing the statements in that sense, but that is the sense in which these statements must be true if this alleged invention of a class is to constitute a true and patentable invention. Since the specification is to be considered as addressed to those skilled in the art it may be possible to explain the statements on the basis that such persons would understand them as meaning that the inventors having prepared and tested some of the substances were expressing a theory as to the characteristics and utility of the others and were seeking to monopolize both the class and the sub-classes on the basis of a hypothesis or hypotheses, however tenuous, as to their utility and the specific substances as well on the basis of actual preparation and testing.[1] On any other approach to their meaning the assertions of the specification with respect to the testing and utility of the class appear to me to be not only false but unexplainable as well, otherwise than as being fraudulent, but whether interpreted as a mere hypothesis or as something which is falsely described in such a way as to make it appear to be an invention no monopoly for the alleged invention of a class of substance can properly be obtained under the statute. Moreover, as the alleged invention of a class of substances is the only matter which in the disclosure portion of the specification is particularly indicated and distinctly claimed as the invention, there is no basis upon which claims (under s. 36(2)) in respect of any other or different invention which may incidentally be revealed by the disclosure though not described and claimed as an invention as required by the concluding words of s. 36(1) could properly be included.

[1] *Vide* Lord MacDermott in *Re May & Baker et al.* (1950) 67 R P C. at page 51, lines 9 to 44.

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In the reasons for judgment in the *Hoechst v. Gilbert* action it was held *inter alia* that as a matter of interpretation this specification should be regarded as purporting to disclose several different inventions, one or more pertaining to a class or classes of substances, another to the single substance known as tolbutamide and several others to the particular substances claimed in claims 11 to 19 inclusive. The features of the specification which led to this conclusion are stated in subparagraph (*c*) above of the agreed statement of facts precisely as they are stated in the reasons for judgment in the action and the reasoning upon which such interpretation was adopted was that set out in the reasons for judgment of this Court in *C. H. Boehringer Sohn v. Bell Craig Limited*[1] at pages 209 to 215. The reasoning is supported in my opinion by the judgments therein mentioned in *Re May & Baker Limited et al*[2] in all three Courts. In the *May & Baker* case the problem was whether a proposed amendment would make the specification claim an invention "substantially different" from that described in the unamended specification. The unamended specification described and claimed an alleged invention of a large class of substances which were claimed to have therapeutic value and on the patent being attacked it was held invalid for a number of reasons among which was lack of subject matter since the substances did not all have the utility claimed. That the patent was bad for this reason was not seriously contested. The patentee, however, sought leave to amend the specification so as to make it describe the invention of two members of the large class which were of proven utility and so as to claim only those two substances. Leave to make the amendment was refused on the ground that the amendment would make the specification claim a substantially different invention from that claimed in the unamended specification. That the inventions were different was scarcely open to doubt but as I understand the judgments and particularly those of Jenkins, J.[3], at the trial, Lord Green, M.R. and Evershed, L.J.[4], in the Court of Appeal and Lord Simonds, Lord Normand and

[1] [1962] Ex. C.R. 201. [2] 65 R.P.C. 255; 66 R.P.C. 8; 67 R.P.C. 23.
[3] 65 R.P.C. 255 at p. 294, line 30 to p. 295, line 21.
[4] 66 R.P.C. 8 at p. 15, line 23 to p. 24, line 8 and p. 21, lines 11 to 22.

Lord MacDermott[1] in the House of Lords the difference was not regarded as being merely one of breadth or scope of the respective inventions but as a difference in their character and quality as well, corresponding to the difference in

[1] 67 R.P.C. 23 at p. 32, lines 19 to 29 LORD SIMONDS said:

Is there then a difference in the inventions claimed in the original and amended specifications? On the one hand a vast range of possible compounds, a fragment no doubt in the whole sphere of organic chemistry yet so numerous that the number becomes meaningless, within which no one can say what hidden things might be brought to light, what benefits discovered for the relief of humanity. On the other hand two specific drugs Are these inventions the same or different inventions? My Lords, I hesitate to appeal to common sense, lest others should take a different view of the case Yet in the consensus of opinion of all the learned judges who have dealt with this matter I find justification for the view which I most emphatically hold that it is plain common sense to say that the inventions are not the same but different: and I think that, if they are different, the substantial difference could not be denied.

At p. 33, lines 20 to 32 LORD SIMONDS also said:

If a drug, which falls within the genus generally described, has a therapeutic value which depends on its unique characteristic, then the invention of it must be different from the invention of the genus It cannot in this respect, because it is given a name and used as an illustration, be distinguished from its anonymous brethren in the same genus. But then it is said that by definition "invention" includes an alleged invention, and that it follows that the Court must, in comparing the inventions claimed in the old and new specifications respectively, assume the truth of what is alleged It must proceed on the basis that all members of a certain group of chemical compounds have therapeutic value, and that sulphathiazole, being a member of that group, therefore has therapeutic value: a perfect syllogism, which precludes all further enquiry, and requires the Court to ignore two facts which have been clearly proved or admitted, first, that not all members of the group have therapeutic value; and secondly, that the therapeutic value of sulphathiazole depends on special features which are not common to the group.

At p. 38, lines 27 to 47 LORD NORMAND said:

Whether the invention asserted in the amended specification differs substantially from the invention asserted in the unamended specification, becomes, after the construction of the two specifications has brought us to the point at which the two terms of the comparison have been ascertained, a question of fact and degree

But it is said that Jenkins, J., and not only he but the Court of Appeal also, have misdirected themselves by contrasting the inventive steps required for the inventions instead of the inventions themselves. It is true that in the Courts below the inventive step which is the basis of the discovery that an enormous range of substances having a common chemical characteristic have therapeutic virtue as a generic property was said to be substantially different from the inventive step underlying the discovery that each of two specific substances has therapeutic value. I think myself that the difference between the two inventive steps and the difference between the two inventions are in this case really the same thing. The difference between the two inventions is to my mind obvious. In the one case the inventor is saying that every

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the character and quality of the inventive steps leading to them, the invention claimed in the unamended specification being one resulting from a discovery of a characteristic common to members of a class making the class useful in the patent sense and the other being one resulting from a discovery of useful characteristics of particular substances not as common to any such class but as peculiar to the particular substances. The invention with respect to any of

member of a certain genus is therapeutic. From that it follows that further tests of any substances that can be made within the genus by experiments on mice or on men are superfluous. In the other case he is saying nothing like that, but merely that two new drugs have the therapeutic virtue. When the Appellants put their pen through the genus they deleted the whole invention, and when they wrote in the two specific substances they wrote into the specification an invention different in kind from that which they had deleted. The amendment is not a means of reducing too broad an alleged invention to a part of it, or even to a narrow invention of the same kind.

At p. 52, lines 5 to 29 LORD MACDERMOTT said:

The question, then, is whether the inventions claimed by the amended and original specifications, and based on what I have held to be the true inventive steps, are substantially different. That they are different admits, in my opinion, of no real doubt once the inventive steps have been ascertained and contrasted. But is the difference substantial? The Appellants contended that all that required assessment in this connection was a difference in quality and not in size. "Substantially larger than", it (was) pointed out, constituted a distinct test, and so an amendment would not, it was said, be claiming an invention substantially different merely because it was substantially smaller. Up to a point there is force in that argument. Quantity and quality cannot, however, be entirely disassociated and I think *Jenkins*, J., was entitled, on this issue, to take into account, as he did, the extent of the disclaimer which, on any reading of the evidence, was of such magnitude that it might reasonably be considered as marking more than a difference in size. Another contention advanced by the Appellants, and which in one aspect is akin to that just considered, may be mentioned conveniently here, though I do not find it easy to classify. It was said that if the original specification has included a claim limited to the two named drugs the amendment now sought would necessarily have been within the power of the Court to grant under Sec. 22 for, as it was put, one could always "amend down" so as to shed all but a narrow claim to the preferred embodiment. If the views I have already expressed as to the nature of the inventive steps underlying the amended and original specifications are well founded this argument, in my opinion, really begs the question and can lead nowhere. The process of amending down to which reference is made does not, as I understand it, involve any change in the nature of the inventive step which remains intact and available to support the narrow claim. But that is not the position here, for the amendment sought is based on a different inventive step, and the issue of competence arises directly and must be settled according to the terms of Sec. 22.

the specific substances was thus not something lying within the bounds of the alleged class invention.

This distinction between the two inventions as I understand it, flows from the fact, which in the present case is admitted, that the pharmacological effects of new substances are not predictable but must be ascertained by empirical methods. The discovery that any particular new substance has therapeutically useful characteristics is thus a discovery on its own for while speculation may thereby be generated as to the possible characteristics of other substances of similar or related chemical structure it is not possible in the state of the art to predict from any such discovery that other similarly constituted substances will have the therapeutic characteristics of the particular substance or to say what the therapeutic properties of such other substances may be until they have been made and tested and their therapeutic properties have been thus ascertained.[1]

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[1] Compare the remarks of Lord Simonds in *Re May & Baker Limited et al* 67 R.P.C. 23 at p. 29, lines 7 to 30. At lines 18 to 30 he said:

> There is no doubt that the discovery of these drugs has been a valuable contribution to the therapeutic art. But it must be said at once that the general character of the methods to be employed in producing derivatives of compounds such as sulphanilamide was known before 1938, and that the production of any particular derivative such as sulphathiazole would not in itself involve invention, although considerable work of a routine character would be necessary in working out the details of a satisfactory process. And it must be emphasised (for this may go to the root of the matter) that it is only by empirical methods that the therapeutic value of any particular drug can be ascertained. I quote a pregnant passage from the evidence of Sir *Lionel Whitby*, a witness for the Appellants, whose pre-eminence in the science of chemo-therapy is unchallenged. "There is no theory", he said, and later "the chemo-therapeutic value (if any) of any particular substance could only be assessed by careful tests of that substance first upon animals . . . and secondly on human beings."

The remarks of Lord MacDermott at p. 50 are to the same effect. At lines 32 to 50 he said:

> Before proceeding to consider the original specification and the nature of the invention it claims it will be appropriate to mention two matters which, while this particular art remains in an empirical state, appear to me to be necessary consequences of that characteristic. In the first place an invention in this chemo-therapeutic field must be in respect of a substance which has actually been produced. There cannot be an empirical discovery in respect of a bare formula. And secondly, the discovery of each new compound having a therapeutic value is a separate invention. If the inventor is bound to say—"I have made a new substance which I find has therapeutic value, but I cannot be

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For similar reasons I reached the conclusion both in the *Boehringer* case and in the *Hoechst v. Gilbert* case that the alleged invention of a class of substances is to be treated as a different invention from that of the particular substance or substances the utility of which had been established even though such substances are members of the class. In each of these cases, however, the specification differed from both the unamended and the proposed amended specification considered in the *May & Baker* case in that both the Boehringer and Hoechst specifications while describing in each case only an alleged invention of a class included claims not only with respect to the class but claims with respect to a specific substance or to specific substances as well. This led me to conclude that as a matter of interpretation the Boehringer specification should be construed as purporting to disclose more than one invention, that is to say, a class invention and a specific substance invention.

It also led me to conclude that the Hoechst specification should be construed as purporting to disclose a multiplicity of inventions some of which are class inventions and others of which, including that of tolbutamide, are specific substance inventions. Further pursual of the judgments in the *May & Baker* case and further consideration of the matter has served to confirm me in the opinion that this is the proper construction of these specifications. It may be worth mentioning at this point, however, that the question whether what is contained in either the Boehringer or the Hoechst specifications with respect to any specific substance invention would satisfy the requirements of s. 36(1) with respect to such invention without recasting the specification (as was proposed in the *May & Baker* case) so as to assert it as the invention or one of the inventions

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certain that any other substance, no matter how similar its molecular structure, will have such a value until I make and test it" then, as it seems to me, the inventive step he has taken must attach to the single substance he has made and to it alone. And if he has made and proved several such substances the position must, I think, remain the same for, while the art retains its empirical nature, the worth of each new substance is a new discovery. But when the inventor can say that his inventive step is such that each of the various new products which manifest it must have therapeutic value, and that although some of them have never been made, then, as I see the matter, the state of the art will have changed. It will have lost its empirical nature, at least to some extent, and the chemist will have found some law or principle by which he may predicate therapeutic effect in advance.

(which latter would have shown that s. 38(1) was being contravened), was not determined in either case. Without such a recasting of the specification such a claim "does not fit the character of the invention asserted in it".[1] But whether the inventions disclosed are so described as to comply with s. 36(1) or not the specification in question in these proceedings in my opinion on its proper interpretation purports to disclose a plurality of inventions that is to say several with respect to alleged inventions of classes of therapeutically valuable substances and several with respect to alleged inventions of specific substances alleged to be therapeutically useful. For present purposes, however, two only of these need be considered, *viz.*, that of the class of substances referred to in claims 1, 3 and 4 and that of the specific substance known as tolbutamide referred to in claim 10.

The amended specification upon which the appellant prayed for a reissue patent consisted of the whole of the original specification unchanged except by the addition of five new claims. The first of these, which is numbered 20, is a claim for a process for the manufacture of substances of a sub-class of the broad class and salts thereof; the second is a claim for the substances of the sub-class whenever prepared or produced by the processes defined in claim 20 or the obvious chemical equivalent thereof and the third is a claim for the salts of the substances of the sub-class whenever so prepared. The other two additional claims relate only to tolbutamide. The first of these (claim 23) is a claim for a process for making that substance by a particular type of chemical reaction consisting of reacting a particular substance with any member of a large class of substances and the second (claim 24) is for the substance itself when so made.

The material portions of the appellant's petition for the reissue patent stated 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.

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[1] *Vide* Lord Normand in *Re May & Baker Limited et al* 67 R.P.C. at p. 37, lines 40 to 48.

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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 Court 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.

. . .

8. Your Petitioner therefore surrenders the said original patent and prays that a new patent may be issued to it in accordance with the amended specification herewith, for the unexpired term for which the original patent was granted.

It will be observed that paragraph 3 of the petition describes two separate respects in which the patent is said to be deemed defective or inoperative the first of which relates to claims 1, 3 and 4 and consists in alleged failure to define exhaustively certain substituents of new substances of the general formula embraced within these claims and the other of which relates to the specific product claims and consists in failure to claim them when prepared by specific processes. As the only proposed change with respect to any specific substance claim is the addition of claims 23 and 24 relating to the specific substance known as tolbutamide this alleged failure may I think be treated as concerned only with defectiveness or inoperativeness in the claim or claims in respect of the invention of that substance that is to say

claim 10 of the patent. It follows, however, that there are two separate subject matters involved in the application for reissue and thus to be considered in the present appeal, one relating to alleged defects in claims 1, 3 and 4 and the other relating to alleged defects in claim 10. As different considerations apply to each I find it more convenient to deal with them separately but the Commissioner dealt with them jointly and as his reasons for refusing the application are involved in what follows I shall set them out before dealing with the matters on which the application was based.

The Commissioner's decision was expressed in a letter to the appellant's patent attorneys dated March 1, 1965 the body of which reads 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 had 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 UBPQ 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.

Turning now to the matters alleged with respect to claims 1, 3 and 4, for the reasons which I have already

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discussed, claims 1, 3 and 4 are in my opinion invalid and for that reason inoperative. But I am unable to understand in what way any of the substituents of the new compounds of the general formula set out in those claims can be said to be not defined exhaustively or how lack of more exhaustive definitions of such substituents renders these claims inoperative either as claiming more or as claiming less than the inventors had a right to claim as new. There are two fundamental limitations on the extent of the monopoly which an inventor may validly claim. One is that it must not exceed the invention which he has made, the other is that it must not exceed the invention he has described in his specification. If it be assumed that what is set out in the specification with respect to the alleged invention of a class of substances is true and constitutes in fact an invention of that class of substances, as it purports to do, I can see nothing about the definition of the substituents which would afford a basis upon which claims 1, 3 and 4 could reasonably be deemed, either by the appellant or by the Commissioner, to be defective or inoperative as claiming more or less than the inventors had a right to claim as new. On the other hand if the description is false and what has been described as an invention is in fact not an invention at all there is no basis whatever for an application for reissue since s. 50(1) assumes that the patent to be reissued is one for a *de facto* invention in respect of which the patentee was entitled to obtain a patent. The latter in my opinion on the admitted facts is the situation with respect to claims 1, 3 and 4. While in one sense these claims claim more than the inventors had a right to claim as new they do so not because the substituents of the substances of the class are not defined more exhaustively but because the inventors had made no invention whatever of the class of substances which the specification describes as their invention and they were therefore not entitled to any patent with respect thereto. In the amended specification no change in the description of the invention has been proposed and the effect of adding the proposed new claims 20, 21 and 22, as I view the matter, would be to cause the patent to claim not merely yet another and different invention of a class but one which would be supported neither by a description of it as the invention nor by so much as an assertion that it was in fact

an invention. Moreover, the invention represented by these proposed new claims, if indeed it can be taken to have been an invention, in my opinion cannot be regarded as a narrower but included part of the invention as described because of the empirical nature of any such invention. I am therefore of the opinion that with respect to the alleged defectiveness or inoperativeness of claims 1, 3 and 4 s. 50(1) does not apply and that the Commissioner was right in deciding that the appellant could not rightly invoke any of the statutory reasons.

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*[1]) 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

[1] [1959] S.C.R. 378.

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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.[1]

I therefore agree with the conclusion of the Commissioner on this question as well.

The other matter put forward in the petition for reissue as a reason for deeming the patent defective or inoperative as claiming more or less than the applicant had a right to claim as new relates to what appears to have been in fact a very good invention of the specific substance known as tolbutamide and is that the patent does not contain a claim for that substance when prepared by specific processes. That invention, however, was not described in the specification as the invention. If it had been described as the invention the fact would have been apparent that this

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[1] *Vide* Lord Simonds in *Re May & Baker Limited* 67 R.P.C. at p. 34, lines 26 to 31:

> It is a field in which as a rule empirical research industriously pursued will win the prize, and it may well be, as learned Counsel for the Appellants was inclined to urge, that the inventive chemist will obtain inadequate protection for his empirical discovery, if he cannot make a general claim and, upon challenge, amend it to a narrower one. That may be so, but it will not justify the Court in applying to a case like the present words used in relation to a wholly different subject matter.

In the Court of Appeal Lord Greene, M.R., had said, 66 R.P.C. at p. 12, lines 47 to 50, p. 13, lines 1 to 9:

> The patent was obtained on the faith of the assertion in the original specification that the compounds described—all of them—had certain favourable chemo-therapeutic qualities. This statement may, at the time, have been a useful scientific hypothesis; but patents are not granted for mere scientific hypotheses, nor can an unproved hypothesis form sufficient subject matter to support a patent. In this case when the validity of the assertion was challenged, the Appellants at once abandoned any attempt to support it. A scientific hypothesis, particularly in a branch of science in which, according to Sir *Lionel Whitby*, "there is no theory" and "the chemo-therapeutic value (if any) of any particular substance could only be assessed by careful tests of that substance first upon animals and secondly . . . on human beings", could not, on any view, justify the assertion in question; and the danger of making such assertions in regard to the unknown action of new drugs, possibly of a highly toxic nature, is obvious, and may be thought to deserve every discouragement in any case where a discretion falls to be exercised.

See also Somerville, L.J., at p. 19, lines 10 to 19; and Evershed, L.J. at p. 20, line 32 to p. 21, line 10.

was not a preferred embodiment of the alleged invention of a class of substances[1] as indeed it was not, but was a different invention which could not properly be included in the same patent with that of the alleged invention of a class of substances because it would have been obvious that two different inventions or alleged inventions were being described and that their inclusion in the same patent would contravene the prohibition of s. 38(1) of the Act. As the disclosure portion of the specification stood the applicant was therefore not entitled to have claim 10 included in it[2]

[1] The opinion of Lord Morton of Henryton 67 R P C at p. 41 to 42 which treated the specific substances as preferred embodiments of the class invention was not that of the majority.

Vide Lord Simonds 67 R P.C. at p 32, line 51 *et seq* ; Lord Normand at p. 37, lines 40 to 48; Lord MacDermott at p. 51, lines 9 to 44.

[2] *Vide* Lord Simonds in *Re May & Baker et al* 67 R P.C. at p. 34, lines 1 to 10:

> My Lords, I do not think that the Appellants get any help from this somewhat tentative observation In the first place, as I have already pointed out, no claim was made for the two specific drugs and no explanation was offered why a patentee, who was by no means *inops consilii,* did not make it. In the second place it is a sheer begging of the question to say that in this case "the claims could originally have been separated up without difficulty", if by that is meant that the *Comptroller,* having the knowledge of this art and of the facts which this case has disclosed, ought to have treated the invention of a group having a general therapeutic value as the same thing as the invention of a specific drug having a particular therapeutic value, and ought accordingly to have granted one patent to cover them both. I am clearly of opinion that he ought to have done no such thing.

Lord Normand said at p. 37, lines 35 to 48:

> It was said for the Appellants that this was "mere draftsmanship", an error of omission which could be rectified by supposing that such a claim had been made, and that the specification might be construed as if it contained the claim. Specifications like other documents must be construed as they are, not as they might have been The absence of a claim of this particular kind, which is almost a matter of style where it is appropriate, cannot be dismissed as a negligible inadvertence The addition of a claim for the two specific substances would involve the recasting of the specification, for the claim would not fit the character of the invention asserted in it as it stands. That invention is a generic invention in which the utility is a generic property invariably associated with the chemical characteristics of the genus. It is really not possible to read the specification as a compendious manner of claiming a vast number of substances, each of which has been found to have therapeutic virtue, and of claiming among them the two specific substances as especially satisfactory or effective examples. Such a claim if made would be rejected by the least sceptical of qualified addressees as a gross and palpable falsehood.

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nor to have the proposed new claims 22 and 23 included, both because they relate to a different invention from that described in the specification as the invention and their presence makes the patent a patent for more than one invention and because the invention of tolbutamide had not been described and claimed as the invention. As the appellant for these reasons is not entitled to have claims in respect of the invention of tolbutamide included in this specification I do not think it can invoke s. 50(1) to require the Commissioner to insert them.

The conclusions which I have expressed are sufficient to dispose of the appeal but as the remaining question whether the alleged error with respect to the tolbutamide claim was due to inadvertence, accident or mistake within the meaning of s. 50 was also argued I should mention it before parting with the case. The explanation offered was that the error arose from inadvertence, accident or mistake in that the applicant on the advice of his attorneys believed at the time the application was pending that for compliance with s. 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 later it was held by this Court that compliance with s. 41(1) required that a claim covering a specific product should be dependent on a process claim which defines specifically a process for the production of that substance. What was in fact held in the judgment mentioned[1] was that the claim sued on was invalid for several reasons one of which was that compliance with s. 41(1) requires that a claim for a specific new substance be accompanied by and be limited to the substance when prepared by a process claim which is a process claim in respect of the specific substance and that limiting the product claim to the product when produced by the process of a claim which was in respect of a different invention would not serve the purpose. The point submitted in the present appeal was that inadvertence may consist in an erroneous view of the law and that here an erroneous view of the law was the reason for the patentee having claimed more or less than he was entitled to claim as new.

[1] *C. H. Boehringer Sohn v. Bell Craig Limited* [1962] Ex. C.R. 201 at pp. 234 to 237.

While, in view of the conclusion I have reached on the matters already discussed no concluded opinion on this question either in general or as applied to the facts of this case appears to be necessary, as at present advised I am not persuaded that cases cannot arise in which a defect due to an erroneous view of the law could be regarded as due to inadvertence within the meaning of s. 50 and, if the reasons of the Commissioner are intended to be to the contrary, in this Court the question should I think be regarded as an open one.

The appeal therefore fails and it will be dismissed with costs.

As the appellant is not entitled to succeed on the merits of its appeal it is also unnecessary to express a concluded opinion on the question whether or not there is any right of appeal to this Court from a decision of the Commissioner refusing an application for a reissue patent, but as this question as well was argued at some length I shall add some comments on it.

Sections 42 and 44 provide that:

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.

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 2(*a*) provides that the expression "applicant" "includes an inventor and the legal representatives of an applicant or inventor" and s. 2(*e*) provides that the expression "legal representatives" includes "heirs, executors, administrators, guardians, curators, tutors, assigns and all other persons claiming through or under applicants for patents and patentees of inventions".

The patent in question in these proceedings was issued to the appellant on September 1, 1959 and the appellant filed its petition surrendering the patent and praying for a reissue patent on August 30, 1963. By the letter dated March 1, 1965 already referred to the Commissioner ruled that the application for reissue could not be entertained. Whether or not the letter was registered does not appear

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but no question was raised on that detail and the argument proceeded on the basis of the Commissioner having refused the application.

The submission put forward on behalf of the Commissioner was that though there are express provisions in a number of sections of the *Patent Act*, (notably, ss. 19, 33(6), 41(4) and 73) for appeals to this Court from decisions of the Commissioner made in the exercise of particular functions committed to him under various sections of the Act to which such provisions refer, there is no general right of appeal to this Court from decisions made by him in the carrying out of his functions under the Act, that in cases of refusal by him to issue patents an appeal is provided by s. 44 but that this applies only in cases of refusal of original applications for patents and not in cases of refusal of applications for reissue patents and that since there is no other provision for such an appeal no right of appeal to this Court from the refusal of such an application exists and the Court is without jurisdiction to entertain such an appeal.

There is not much to be found either in the statute or in the legislative development of its various provisions to indicate clearly that a right of appeal to this Court in a case of this kind has been conferred and the matter is therefore not free from doubt, but there are several features of the statute which suggest to me that the right of appeal conferred by s. 44 applies in a case of this kind.

First, it is, I think, clear that the requirements for the specification for a reissue patent are those set out in s. 36 which apply to the specification for any patent. If there could be any doubt on this point it would I think be dissipated by the fact that s. 36(3) contains an express reference to reissue patents. It therefore appears to me that nothing turns on the fact that in the scheme of the statute the provisions of s. 50 with respect to reissue patents follow those with respect to original applications for patents including s. 44 which provides for an appeal to this court from refusal to grant such applications.

Next it is I think also clear that the provisions of ss. 37, 38, 39, 40 and 41 are just as applicable in cases of applications for reissue patents as for original patents. An application for a reissue patent is in fact an application for a

patent of the same nature as that which may be granted on an original application and so it seems to me that a reissue application despite its special features involving as they do the surrendering of a patent already held by the applicant falls within the ordinary meaning of the term "application" as used in s. 42 and that having regard to the definitions of "applicant" and "legal representatives" in ss. 2(*a*) and 2(*e*) a patentee (at least where he is the person to whom the patent issued) seeking a reissue patent also falls within the meaning of the term "applicant" as used in s. 42. If this is the correct view it would follow that the patentee has a right of appeal under s. 44.

The third feature is that s. 50 while authorizing the Commissioner to grant reissue patents does not prescribe any particular procedure to be followed by the Commissioner either in granting or refusing applications therefor and this suggests to me that the legislative intention was that the procedure with respect to original applications for patents should apply. This as well leads to the conclusion that the refusal of such an application is to be carried out in accordance with s. 42 and that there is a right of appeal under s. 44.

Finally, it is noteworthy that while the appeals provided for by ss. 19, 33(6), 41(4) and 73 are all expressed as being appeals from decisions under particular sections of the Act, s. 44 is not so expressed but applies in the case of "Every person who has failed to obtain a patent by reason of a refusal or objection of the Commissioner to grant it."

Accordingly, I am inclined to the view that in the present case the appellant had a right to appeal to this Court under s. 44 from the refusal by the Commissioner pursuant to s. 42 to entertain its application for a reissue patent and if it were necessary to reach a firm conclusion on the point I would so hold. As already mentioned, however, I do not think a concluded opinion on the point is necessary in view of the result of the appeal on its merits.

Appeal dismissed.