

BETWEEN :

SOCIÉTÉ DES USINES CHIMIQUES
RHONE-POULENC and CIBA, S.A.

PLAINTIFFS;

AND

JULES R. GILBERT LIMITED, *et al.* . . . DEFENDANTS.

Ottawa
1961

June 26-30,
July 4-6

1965

May 3-7,
10-14

June 16

Patents—Infringement—New substance—Presumption of production by patented process—Patent containing three process claims—Infringement of one process only—Patent Act, s. 41(2)—“Invention”, meaning of—Patent Act s. 2(d).

Plaintiffs’ patent described and claimed three processes for producing a class of chemical substances. Defendants imported and sold in Canada tablets said to contain one of these substances. Plaintiffs sued for infringement of one of the processes claimed in their patent.

Section 41(2) of the *Patent Act* provides:

“In an action for infringement of a patent where the invention relates to the production of a new substance, any substance of the same chemical composition and constitution shall, in the absence of proof to the contrary, be deemed to have been produced by the patented process.”

Section 2(d) of the Act defines “invention” as meaning:

1965
SOCIÉTÉ
DES USINES
CHIMIQUES
RHONE-
POULENC
et al.
v.
JULES R.
GILBERT LTD.
et al.

“any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter;”

Neither plaintiffs nor defendants had any knowledge of how the tablets complained of were prepared or produced.

Held, the action must be dismissed. While the presumption might arise under s. 41(2) that the defendants' tablets were produced by one or other of the three processes described and claimed in plaintiffs' patent no presumption arose that the tablets were made by any particular one of them.

The word “invention” in s. 41(2) could not be restricted to the invention described in a particular process claim relied on by a plaintiff in an infringement action but meant the invention for which the patent was granted. The invention disclosed by the patent in suit was not merely the process described in the claim relied on but consisted both of new and useful substances and of the processes for their production. The various subject-matters of invention described in s. 2(d) could be read collectively where a particular invention consisted of both a new product and a process for producing it.

Re May & Baker Ltd. (1948) 65 R.P.C. 255 at 281; *Ciba v. Comm'r of Patents* [1959] S.C.R. 378; *Auer Incandescent Light Mfg. Co. v. O'Brien* (1897) 5 Ex. C.R. 243 at 286-288, referred to.

Patent Act, R.S.C. 1952, c. 203, s. 2(d) and s. 41(2)

ACTION for infringement of a patent.

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

I. Goldsmith and *R. S. Caswell* for defendants.

THURLOW, J.:—In this action the plaintiffs claim an injunction and other relief in respect of alleged infringement by the defendants of claim 18 of Canadian patent number 474,637 which was granted to the first named plaintiff on June 19, 1951. The second named plaintiff sues as the exclusive licensee of the first named plaintiff under the patent.

The invention of the patent is entitled “Improvements in or relating to substituted diamines” and claim 18 thereof is a claim for a process for the production of a class of substituted diamines and their salts by reacting a particular secondary-tertiary diamine with any one of the compounds of a class numbering at least twelve known as pyridyl halides. The products of the process and their salts would thus number, theoretically, at least twelve multiplied by the number of known acids. One substance the production of which by this process, (whether with or without additional steps) would be within the claim is the

monohydrochloride salt of tripeleannamine. Tripeleannamine is the generic name of a particular substituted diamine having a complex molecular structure and a considerable number of lengthy but equally accurate chemical names.

The plaintiffs' complaint is that the defendant Jules R. Gilbert Limited by importing into and selling tripeleannamine hydrochloride in Canada, and the other defendants by selling tripeleannamine hydrochloride in Canada have infringed the claim in suit. By paragraph 6 of their defence the defendants admit the supplying by Gilbert Surgical Company Limited, which carries on business also under the firm name of Gilbert Surgical Supply Company, to the Department of Defence Production of tablets designated as tripeleannamine hydrochloride and the supplying by the defendant Jules R. Gilbert Limited to the other defendant of tablets designated as tripeleannamine hydrochloride but they deny that they have infringed the claim sued on and in particular they deny that any substance contained in the said tablets was produced by any one or more of the processes claimed in claim 18 of the patent in suit. In another paragraph they also plead that claim 18 is invalid for a number of reasons.

1965
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 SOCIÉTÉ
 DES USINES
 CHIMIQUES
 RHONE-
 POULENC
 et al.
 v.
 JULES R.
 GILBERT LTD.
 et al.
 ———
 Thurlow J.
 ———

For the purposes of this action the parties have agreed:

1. That the process claimed in claim 18 of Canadian patent No. 474,637 consists in the application of methods which were known on June 22nd, 1943, to substances which were also known on the said date, though the said methods had never at the said date been applied to the said substances except by the inventor named in the said patent.
2. That the substance referred to in paragraphs 6 and 7 of the reamended Statement of Defence was not manufactured in Canada and was imported from outside Canada.
3. That none of the defendants has any knowledge as to the process by which the said substance was prepared or produced.

I should add that counsel for the plaintiffs stated at an early stage of the trial that the plaintiffs as well had no knowledge of the process by which the tablets complained of were prepared or produced and no evidence was led on the point, the plaintiffs' case being based entirely on the application of s. 41(2) of the *Patent Act*¹. That subsection provides that:

41. (2) In an action for infringement of a patent where the invention relates to the production of a new substance, any substance of the same chemical composition and constitution shall, in the absence of proof to the contrary, be deemed to have been produced by the patented process.

¹ R.S.C. 1952, c. 203.

1965
 SOCIÉTÉ
 DES USINES
 CHIMIQUES
 RHONE-
 POULENC
 et al.
 v.
 JULES R.
 GILBERT LTD.
 et al.
 Thurlow J.

It follows from paragraph 1 of the agreed statement of facts that there can be no patentable invention involved in or corresponding to the process claimed in claim 18 unless the process results in the production of substances which are both new and useful in the patent sense and that the essence of the invention of the process is the unexpected utility of its products. *Re May & Baker Limited*¹ and *Ciba v. Commissioner of Patents*². There thus can be no invention of such a process without or apart from the invention of the substances as well. For the purpose of considering the question of infringement, I shall assume, as I think it is necessary to do for this purpose, that such novelty and utility of the products of the process of claim 18 exist and that the claim is valid.

But the question arises as to what is to be taken as the "invention" referred to in s. 41(2) of the *Patent Act*. Mr. Smart, in his able argument on behalf of the plaintiffs urged that the term refers only to the invention of the particular process claim or claims on which the plaintiff in an infringement action chooses to rely but I am unable to see the justification for so strained an interpretation of the words of the subsection. The subsection itself does not appear to me to refer to the particular claim relied on by a patentee but to the invention for which the patent has been granted. While it may be arguable that the scope of the subsection is now somewhat broader than it was when the enactment first appeared in the statute as a proviso³ to what is now s-s. (1) of s. 41 the provision is still tied to situations in which a new substance has been invented and its object still is to afford to a patentee a means of discharging the onus of proof of the use of his patented process only where the invention relates to the production of a new substance. Its prime application originally was and still is to aid the proof of infringement of a claim for a production which is limited to that product when produced by a particular process or by particular processes.

By s. 2(d) of the Act the term "invention" is defined as meaning:

¹ (1948) 65 R P C 255 at 281. ² [1959] S C.R. 378.

³ S. of C. 1923, c. 23, s. 17.

any new and useful art, process¹, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter;

but while these expressions may I think be read distributively I see no reason why they cannot or should not also be read collectively where a particular invention consists of both a new product and a process for producing it. No doubt a process claim such as the one here in suit may by itself be taken as defining an invention of the process, but the expression "the invention" in s. 41(2) in my opinion refers not to what may be embraced in any particular claim but to the "invention" of the patent for the infringement of which the action is brought.

The inventive act which the patent in suit purports to disclose with respect to the substituted diamines which may be produced by the process of claim 18 is not confined to the process of claim 18. It consists in the devising of the new substances and of methods for producing them and of the discovery of their useful properties but it is the discovery of their useful properties which turns what would otherwise be a fruitless laboratory exercise into an invention. This discovery may be viewed and described as a discovery of the useful properties which the new substances produced by the processes possess or it may be viewed and described as a discovery that the processes produce new substances which have useful properties but whichever way it is viewed and described, the discovery is the same and the inventive act resulted in a single invention consisting of both the new and useful substances and of the processes for their production.² For the sake of simplicity in this discussion the invention here in question may I think be treated as being concerned only with tripeleennamine but for the purpose of s. 41(2) that "invention" must in my opinion be taken as consisting both of that substance and of the methods for producing it which the inventor has disclosed and patented.

¹ The word "process" was added to the definition at the same time as the enactment of what is now s. 41(2). *Vide* S. of C. 1923, c. 23. Prior to that the definition of invention had remained in the form in which it appears in R.S.C. 1886, c. 61.

² *Vide: The Auer Incandescent Light Manufacturing Co. v. O'Brien* (1897) 5 Ex. C.R. 243 at pp. 286-288.

1965
 SOCIÉTÉ
 DES USINES
 CHIMIQUES
 RHONE-
 POULENC
et al.
 v.
 JULES R.
 GILBERT LTD.
et al.
 Thurlow J.

1965
 SOCIÉTÉ
 DES USINES
 CHIMIQUES
 RHONE-
 POULENC
et al.
 v.
 JULES R.
 GILBERT LTD.
et al.
 Thurlow J.

When s. 41(2) is so read it is clear that the plaintiffs' action must fail for the patent itself discloses and claims not one but three processes for producing tripeleennamine of which claim 18 embraces only one and while s. 41(2) might conceivably apply to raise the presumption that the tablets in question were produced by some one or another of these three processes (if the fact of their containing tripeleennamine hydrochloride should be regarded as established, as to which I have some doubt) I am unable to read the subsection as raising a presumption that the tablets were made by any particular one of them and there is thus no case for holding that the tablets were made by the process of claim 18.

In the course of the argument counsel for the defendants also raised a number of other contentions on the issue of infringement and made a strong attack on the validity of the claim in suit but in view of the conclusion which I have expressed it does not appear to me to be necessary to deal with the matters so raised.

The action will be dismissed with costs.

Action dismissed.