

**Hercules Inc. et al (Plaintiffs) v. Diamond Shamrock Corp. et al
(Defendants)**

Jackett J.—Ottawa, December 4, 23, 1969.

Patents—Impeachment—Defendant sued for infringement of some but not all patent claims—Defendant competitor of plaintiff—Whether defendant “interested person” as to all claims—Motion to strike out pleadings—Patent Act, s. 62.

Plaintiffs, suing for infringement of two patents for a certain product, alleged infringement by defendants of some but not all of the claims in their patents. Defendants, alleging that they competed with plaintiff in the manufacture and sale of products of the same class, counterclaimed under s. 62 of the *Patent Act* for a declaration that the patents were invalid or void.

Held on plaintiffs’ motion to strike out portions of defendants’ pleadings, defendants were not restricted to impeachment only of those claims allegedly infringed.

(1) A person who is in the business of manufacturing or trading in goods of the same general class as those covered by a patent is an “interested person” under s. 62 of the *Patent Act* in respect of all the claims in the patent.

Bergeon v. De Kermor Electric Heating Co. [1926] S.C.R. 72; *Refrigerating Equipment Ltd v. Waltham System Inc.* [1930] Ex.C.R. 154; *Hall Development Co. of Venezuela v. B. & W. Inc.* [1952] Ex.C.R. 347; *E. I. Du Pont de Nemours and Co. et al. v. Montecatini-Societa Generale* [1966] Ex.C.R. 959, considered.

(2) The explanation for a multiplicity of claims in a patent is that they are different attempts at defining the one invention or closely related inventions arising out of the same factual situation. Thus, even if each claim in a patent may be regarded as defining an independent invention, a person sued for infringing one claim must be assumed to be a person with a sufficient interest to attack all the other claims to make him an “interested person” for that purpose within the meaning of s. 62 unless it can be clearly demonstrated that there is no justification for that assumption.

Société des Usines Chimiques Rhone-Poulenc et al. v. Jules R. Gilbert Ltd [1966] Ex.C.R. 59 at pp. 62-63, referred to.

MOTION.

Miss Joan Clark for plaintiffs, applicants.

K. H. E. Plumley for defendants, *contra*.

JACKETT P.—This is an application which, with the acquiescence of counsel, was treated during argument as an application to strike out certain paragraphs in the statement of defence and counterclaim on terms that the defendant be allowed to submit new paragraphs of a more limited character.

The pleadings are long and complicated and I propose to endeavour to summarize them with no more detail than is necessary to set up what has to be decided. As I do not intend to make any order disposing of the application until after the parties have had an opportunity of considering these reasons, I shall be able to reconsider my conclusions in the light of any correction in my summary of the matter that counsel may bring to my attention.

This is an action for infringement of two patents for “defoamers” (products used to eliminate “the entrained air or foam” from liquids). Each patent has several claims, some of them being in respect of products (product claims) and some in respect of methods for making one or more of such products (process claims). There is a counterclaim under section 62 of the *Patent Act* for a declaration that such patents are invalid or void. The counterclaim is, in effect, an impeachment action under section 62 of the *Patent Act*.

In effect, the plaintiffs’ motion is to restrict the impeachment action to the claims upon which the plaintiffs base their infringement action.

The primary position of counsel for the plaintiffs is that the principal action is based on allegations that the defendants have infringed some only of the claims in each of the two patents (hereinafter referred to as the “claims in suit”) and that there is no suggestion that the defendants have in any way infringed the other claims (hereinafter referred to as the “claims not in suit”). Counsel for the defendants challenges this position but, as the plaintiffs can amend the statement of claim to produce such result, and have indicated that they intend to do so, counsel have agreed that I should consider the problems that otherwise arise on the assumption that the statement of claim has been so amended.

On that assumption, the plaintiffs’ position¹ is that a proceeding to impeach a patent under section 62 is only open to either of these defendants if it is an “interested person” within the meaning of those words in section 62 and that, while the action against the defendants establishes that they are interested persons for the purpose of seeking to have the claims in suit

¹ During argument, counsel for the plaintiffs withdrew from an alternative position based on an offer of an undertaking not to invoke against the defendants the claims not in suit.

declared invalid, there are no facts pleaded from which it can be concluded that the defendants are interested persons for the purpose of seeking to have the claims not in suit declared invalid.

One answer that counsel for the defendants makes to this contention is, in effect, that, when an action is brought against a person for infringement of a patent, the defendant thereby becomes an "interested person" within the meaning of those words in section 62 for the purpose of seeking a declaration that the patent in its entirety is invalid even though the plaintiff expressly restricts his claim to infringement of some, and not all, of the claims in the patent. Counsel for the plaintiffs concedes that such cases as there are with reference to the meaning of the words "interested person" in provisions such as section 62 have dealt with the matter as though the only question was whether a person had status to seek to impeach the whole of a patent. She contends, however, that no question was raised in any of the decided cases as to whether the person seeking to impeach the patent was an "interested person" in respect of only some, and not all, of the claims in the patent and that the decisions should not, therefore, be taken to have dealt with the point.

The other answer that counsel for the defendants makes to the contention put forward on behalf of the plaintiffs is that it is clear on the face of the statement of claim that the defendants are engaged in the type of business in which products of the same class as the products covered by the patents in suit are manufactured and sold and that that, under the authorities, gives them the necessary interest to make them interested persons in respect of all the claims in the patents. When he attempted to make out this claim, however, counsel had to admit that the allegations in the statement of claim on which he relied were allegations which were, in effect, denied or not admitted by the statement of defence not because they were not substantially true but because they were not stated precisely as the defendants would have liked to have had them stated. (Counsel was quick to admit that his difficulty arose from a failure to comply with Rule 96 of the Rules of this Court which requires that a defendant who denies a pleading "answer the point of substance" and not do so "evasively".) In the circumstances, counsel agreed that I should deal with this application as though the counterclaim contained a paragraph that counsel for the defendants would send to the Registry in draft form. Counsel for the defendants has now sent forward a draft of an "Amended Counterclaim" that reads in part as follows:

43. The defendants (plaintiffs by counterclaim) say and the facts are that since at least as early as 1960 and continuously throughout that period until the present the defendants have manufactured and sold defoamers or anti-foaming compositions in direct competition with the plaintiffs herein and are traders in articles similar to the alleged invention of Canadian Patent 662,736 and have carried on business in the same general field as the plaintiffs herein. Such defoamers have included Defoamer Nopco DF-176, Defoamer Nopco DF-160-N and Defoamer Nopco DF-160-L alleged to infringe Canadian Patent 662,734 and 662,736 herein. Further, the defendants have carried out methods of controlling foaming in aqueous systems in Canada similar to the alleged inventions of Canadian Patent 662,734 since at least as early as 1960 by adding thereto their defoaming or anti-foaming compositions including Defoamer Nopco DF-176, Defoamer Nopco DF-160-N and Defoamer Nopco DF-160-L. The defendants have also manufactured, used and sold their defoaming compositions in Canada.

44. The defendants (plaintiffs by counterclaim) say and the facts are that they have been sued as alleged infringers with respect to some of the claims of Canadian Patent 662,734 and 662,736. The defendants have reason to believe that they may be sued with respect to the remaining claims of these patents in the future. The defendants say and the facts are that their right to do business in Canada has been and is now prejudicially affected by reason of this law suit and the threat of an additional law suit under both of these Canadian patents.

45. The defendants say and the facts are that Diamond Shamrock Corporation, one of the defendants herein, is the owner and patentee of the following Canadian patents each of which relates to either defoamers or methods of using same;

420,397	501,900	501,901
502,951	513,513	553,379
568,202	598,483	605,042
706,357	730,661	775,079

that from time to time in the past the defendants have engaged in selling the compositions and practising and using the processes described and taught in such patents, and the defendants believe that their rights to trade in this field and assert their patent rights in respect of the above patents therein are seriously impaired by the plaintiffs' two patents in suit.

46. The defendants (plaintiffs by counterclaim) say and the facts are that each of the defendants herein is an "interested person" within the provisions of s. 62(1) of the *Patent Act*. The defendants say and the facts are that the plaintiffs and the defendants compete directly in the same field in Canada. The defendants have reasonable cause to believe that the defoaming compositions sold by them in Canada and the methods of controlling foaming in aqueous systems practised by the defendants in Canada might be alleged by the plaintiffs herein to constitute an infringement under the remaining claims of Canadian Letters Patent 662,734 and 662,736.

47. The defendants (plaintiffs by counterclaim) say and the facts are that Canadian Patent 662,734 is invalid and void and that claims 1 to 8 inclusive are invalid and void and further that Canadian Patent 662,736 is invalid and void and that claims 1 to 10 inclusive are invalid and void on the grounds and for the reasons set out in the Particulars of Objection delivered herewith.

It is understood that the defendants will apply for leave to amend their pleadings accordingly if the outcome of this application makes it expedient that they do so.

Section 62(1) of the *Patent Act* reads as follows:

62. (1) A patent or any claim in a patent may be declared invalid or void by the Exchequer Court at the instance of the Attorney General of Canada or at the instance of any interested person.

The earliest decision to which my attention has been drawn concerning the meaning of "interested person" in a context such as section 62 is *Bergeon v. De Kermor Electric Heating Co.*² In that case Duff J., delivering the judgment of the Supreme Court of Canada, first held that certain patents that were not put in evidence for a special reason should have been looked at and that they clearly established that the appellant was an "interested person". He then went on to hold that the appeal should succeed on another ground. It was clear on the evidence that "At the time of the trial" the plaintiff had a status

² [1926] S.C.R. 72.

to impeach by reason of a patent for which he had applied before instituting the impeachment action and which had been granted to him before the trial. Duff J. assumed for the purpose of this second point that such patent did not make the appellant an interested person within the requirement of the provision because it did not give him a status at the time the action was launched. He then put his alternative ground by stating that the appellant was, when the action was commenced, "engaged in the design and manufacture of electric steam generators or water heaters" and was a trader in articles similar to the alleged invention that was the subject of the patents under attack, and he said ". . . the existence of the patents attacked was calculated directly to affect the appellant prejudicially in his business as a manufacturer and trader, and both in the prosecution of his application and in respect of the protection to be afforded him by his patent if his application for a patent should be successful". He concluded that "In these circumstances, there seems little room for doubt that the appellant possessed a sufficient 'interest', within the meaning of rule 16, to qualify him to maintain the action . . ."

In *Refrigerating Equipment Ltd v. Waltham System Inc.*,³ at page 157, Maclean J. dealt with the question of "interested person" in a passage that reads as follows:

At the trial, the defendants urged that the plaintiff was without status to institute these proceedings. It will be convenient here to dispose of this point. By sec. 25 of the *Exchequer Court Act*, the Exchequer Court has jurisdiction, in actions to impeach or annul a patent; and by rule 16 of the Exchequer Court Rules, such action may be instituted by a statement of claim filed by any person interested. I think the plaintiff is a party interested. It is pleaded and not denied, that the plaintiff and the defendants are manufacturing and selling to the public, what is practically the same thing, refrigerating apparatuses. If, as the plaintiff alleges, Canadian Folger was described in the three United States Folger Patents, and other publications, more than two years prior to the application for letters patent for Folger in Canada, then Canadian Folger is invalid; and if the plaintiff believes it to be invalid, then, in the circumstances of this case, it is a person interested. Where an individual is using an invention, in respect of which another person claims to have a patent, which the unlicensed user believes to be invalid; or where a person is desirous of using anything described in a patent, but which patent he has reason to believe is void, then he has such an interest as to qualify him to initiate proceedings to annul such letters patent. I think therefore that the plaintiff is possessed of sufficient interest to qualify it to institute this action.

The point raised by the defendants' second answer to the plaintiffs' application arose in an incidental, but necessary, way in *Hall Development Company of Venezuela v. B. & W. Inc.*⁴ That was an application to stay an impeachment action. One ground was that certain United States proceedings might establish that the plaintiff had no rights in the applications and inventions referred to in the statement of claim and was not, therefore, an "interested person" and that, for that reason, the action in this court should be stayed pending the outcome of such United States proceedings. Thorson, P.

³ [1930] Ex.C.R. 154.

⁴ [1952] Ex.C.R. 347.

rejected this contention by saying that it was not necessary that the plaintiff should be entitled to the invention or application claimed by it for, he said, "It is enough to show . . . that it was engaged in dealing with the same kind of thing as the defendant and was in competition with it".

Finally, in *E. I. Du Pont de Nemours and Co. et al. v. Montecatini-Soci ta G n rale*,⁵ my brother Gibson, after reviewing the above authorities and others, held that a pleading that a patent under attack in impeachment proceedings "overlaps" the subject matter of a patent belonging to one of the plaintiffs and "prejudicially affects the trading right and trading interest" of the other plaintiff was a sufficient plea to support the plaintiffs' status to bring impeachment proceedings under section 62.

In the light of that review of the decisions, I am of opinion that I must uphold the defendants' second answer to the plaintiffs' application which is, in effect, that a person who is in a business of manufacturing or trading in goods of the same general class as those covered by the patent in question is an "interested person" for the purpose of launching impeachment proceedings under section 62.

I turn now to the first answer made by the defendants to the plaintiffs' application which is, in effect, that, when an action is brought against a person for infringement of a patent, the defendant thereby becomes an "interested person" within the meaning of those words in section 62 for the purpose of seeking a declaration that the patent in its entirety is invalid even though the plaintiff expressly restricts his claim to infringement of some, and not all, of the claims in the patent.

This contention makes it necessary to re-examine the basic provisions of the *Patent Act* with a view to attempting to appreciate a little more clearly exactly what is the role of a "claim" in a patent granted under that Act. If, on the one hand, there is only one invention in a patent and each claim is in relation thereto, there would not seem to be any possible basis for the contention that a person who is sued for infringement of one claim has no interest in the validity of the entire patent. On the other hand, if each claim in a patent represents an invention independent of the other claims, the contention deserves much greater consideration.

I commence by setting out the various provisions of the *Patent Act* that seem to have some bearing on the problem. These are as follows:

2. In this Act, and in any rule, regulation or order made under it,

* * *

(d) "invention" means 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;

* * *

28. (1) Subject to the subsequent provisions of this section, any inventor or legal representative of an inventor of an invention that was

(a) not known or used by any other person before he invented it,

⁵ [1966] Ex.C.R. 959.

- (b) not described in any patent or in any publication printed in Canada or in any other country more than two years before presentation of the petition hereunder mentioned, and
- (c) not in public use or on sale in Canada for more than two years prior to his application in Canada,

may, on presentation to the Commissioner of a petition setting forth the facts (in this Act termed the filing of the application) and on compliance with all other requirements of this Act, obtain a patent granting to him an exclusive property in such invention.

* * *

35. The applicant shall, in his application for a patent, insert the title or name of the invention, and shall, with the application, send in a specification in duplicate of the invention and an additional or third copy of the claim or claims.

* * *

36. (1) The applicant shall in the specification correctly and fully describe the invention and its operation or use as contemplated by the inventor, and set forth clearly the various steps in a process, or the method of constructing, making, compounding or using a machine, manufacture or composition of matter, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most closely connected, to make, construct, compound or use it; in the case of a machine he shall explain the principle thereof and the best mode in which he has contemplated the application of that principle; in the case of a process he shall explain the necessary sequence, if any, of the various steps, so as to distinguish the invention from other inventions; he shall particularly indicate and distinctly claim the part, improvement or combination which he claims as his invention.

(2) The specification shall end with a claim or claims stating distinctly and in explicit terms the things or combinations that the applicant regards as new and in which he claims an exclusive property or privilege.

* * *

38. (1) A patent shall be granted for one invention only but in an action or other proceeding a patent shall not be deemed to be invalid by reason only that it has been granted for more than one invention.

(2) Where an application describes and claims more than one invention the applicant may, and on the direction of the Commissioner to that effect shall, limit his claims to one invention only, and the invention or inventions defined in the other claims may be made the subject of one or more divisional applications, . . .

39. (1) In the case of a machine, or in any other case in which the invention admits of illustration by means of drawings, the applicant shall also with his application, send in drawings in duplicate, showing clearly all parts of the invention; each drawing shall bear the signature of the inventor, or of the applicant, or of the attorney of such inventor or applicant, and shall have written references corresponding with the specification, but the Commissioner may require further drawings or dispense with any of them as he sees fit.

40. (1) In all cases in which the invention admits of representation by model, the applicant, if required by the Commissioner, shall furnish a model of convenient size exhibiting its several parts in due proportion; and when the invention is a composition of matter, the applicant, if required by the Commissioner, shall furnish specimens of the ingredients, and of the composition, sufficient in quantity for the purpose of experiment.

* * *

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.

(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.

* * *

45. (1) Conflict between two or more pending applications exists

(a) when each of them contains one or more claims defining substantially the same invention, or

(b) when one or more claims of one application describe the invention disclosed in the other application.

46. Every patent granted under this Act shall contain the title or name of the invention, with a reference to the specification, and shall, subject to the conditions in this Act prescribed, grant to the patentee and his legal representatives for the term therein mentioned, from the granting of the same, the exclusive right, privilege and liberty of making, constructing, using and vending to others to be used the said invention, subject to adjudication in respect thereof before any court of competent jurisdiction.

* * *

57. (1) Any person who infringes a patent is liable to the patentee and to all persons claiming under him for all damages sustained by the patentee or by any such person, by reason of such infringement.

* * *

60. When in any action or proceeding respecting a patent that contains two or more claims, one or more of such claims is or are held to be valid, but another or others is or are held to be invalid or void, effect shall be given to the patent as if it contained only the valid claim or claims.

Reading sections 2(d), 28(1), 35, 36(1) and 46 together, the general scheme of the Act is relatively simple. An inventor of an "invention" which, by definition, is *inter alia* a new and useful "art, process, machine, manufacture or composition of matter",⁶ or a new and useful improvement in any such thing, may, on filing with the Commissioner an application to which there is attached a "specification . . . of the invention" that correctly and fully describes the invention and indicates and distinctly claims the part, improvement or combination which he claims "as his invention", and on complying with the other requirements of the Act, obtain a patent granting to him an exclusive property "in such invention" (*i.e.*, the one described in the specification) which entitles him for a specified period to the exclusive right of making, constructing, using and vending to others to be used "the said invention". Everything in such provisions, and particularly section 36(1), seems to

⁶ I shall, hereafter, use the word "product" to mean "a manufacture or composition of matter".

assume that a patent under the Act is granted in respect of a single invention and that such invention will be a "process", a "machine" or a "manufacture or composition of matter".⁷ When one turns, however, to section 36(2), one finds that the "specification" is to end with a "claim" or "claims" stating distinctly and in explicit terms the "things or combinations" that the applicant regards as new and in which he claims an exclusive property or privilege. It is well established, as section 36(2) itself seems clearly to contemplate, that a "claim" put at the end of a specification pursuant to that subsection must contain a definitive description of a thing or combination in respect of which the applicant claims a patent in such way as to constitute the legal definition of a monopoly granted by the patent when and if one is granted.⁸ When, therefore, section 36(2) requires that a specification end with "a claim" or "claims", it raises a question in one's mind as to whether, notwithstanding the reference to an application for "an invention" and to the description of "the invention" in the specification, these provisions are to be read, with the aid of section 26(7) of the *Interpretation Act*, as authorizing one application for a patent in respect of two or more inventions. If not, why the authority to end the specification with more than one claim? This possible interpretation of the statute seems, however, to be negated by section 38(1) which says that "A patent shall be granted for one invention only . . ."

There are at least two different ways of explaining these, to me, difficult provisions in the *Patent Act*. The two that I have in mind are—

1. The statute means what it says when it says that a patent shall be granted for only one "invention" but an invention may be either a single process, machine, or product, or it may be some combination of processes, machines or products that are the subject of a single discovery or inventive act and the "claims" define the different aspects (things or combinations) of such an invention in respect of which an exclusive property or privilege may be granted by a patent.

2. Each new and useful "process", "machine" or product is a separate "invention", but, notwithstanding the first part of section 38(1), there may be a grant of a patent for more than one invention and each claim in respect of which a patent is granted defines a patented invention (subject to adjudication as to its validity).

The view that there is a single "invention" described in a patent even though there are several "claims" that may be valid monopolies is that that appears in the following passage from the judgment of my brother Thurlow in *Société des Usines Chimiques Rhone-Poulenc et al. v. Jules R. Gilbert Ltd.*⁹

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

⁷ I do not overlook the words "art" and "or any new and useful improvement . . .", but it simplifies the discussion to leave out any reference to them without affecting, in my view, the soundness of the views outlined.

⁸ *Noranda Mines Ltd. v. Mineral Separation North American Corp.* [1950] S.C.R. 36.

⁹ [1966] Ex.C.R. 59 at pp. 62-63.

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. 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.

If that view, which was not discussed by the Supreme Court of Canada in the same case,¹⁰ is the correct view as to the sense in which the word "invention" is used in the statute and if, of necessity, each claim is, therefore, the result of the same discovery and the same inventive act, there would seem to be little or no room for argument that, when a person is sued for infringement of one claim in a patent, he has an interest, for the purpose of section 62 of the *Patent Act*, in attacking the validity of the patent in its entirety.

The other view of the use of the word "invention" in the *Patent Act*—that there may be a grant of a patent for more than one invention and, indeed, that each claim in respect of which a patent is granted defines a patented "invention" (subject to adjudication as to its validity)—requires somewhat greater explanation as to the operation of the various provisions in the statute. This view may be developed as follows:

In the outset, this view is based on a reading of section 2(d) of the *Patent Act* as meaning that an "invention" is "any" new and useful "process", "machine", "manufacture" or "composition of matter". It takes strength from the fact that sections 28(1) and 46 contemplate the grant of an exclusive property in an "invention" and the fact that it is well established, as already

¹⁰ [1967] S.C.R. 45.

indicated, that each claim defines a monopoly. Moreover it would seem to have received recognition from the way in which section 41 of the *Patent Act* has been applied in such cases as *Continental Soya Co. v. J. R. Short Milling Co. (Canada)*,¹¹ *Com'r of Patents v. Winthrop Chemical Co.*,¹² *F. Hoffmann-La Roche & Co. v. Com'r of Patents*,¹³ *Com'r of Patents v. Ciba Ltd*,¹⁴ *C. H. Boehringer Sohn v. Bell-Craig Ltd*,¹⁵ *Soci  t   des Usines Chimiques Rhone-Poulenc et al v. Jules R. Gilbert Ltd et al*.¹⁶ Furthermore, on the view that there is only one invention although there are several claims, the words in section 41(1), "inventions relating to substances prepared . . ." and the words in section 41(2) "where the invention relates to the production of a new substance . . .", when applied to the same patent, would refer to the same "invention". On the view that there are as many patented inventions as there are claims, section 41(1) refers to inventions described in product claims in a patent and "the invention" referred to in section 41(2) is the invention described in the process claim that is the subject matter of the action for infringement of the patent. In my opinion, the latter view is, and the former view is not, consistent with the decision of the Supreme Court of Canada in *Soci  t   des Usines Chimiques Rhone-Poulenc et al. v. Jules R. Gilbert Ltd et al*.¹⁶

The principal difficulty with the second view is the prohibition in section 38 of the *Patent Act* against having more than one "invention" in a patent.

While it is true that the opening portion of section 38(1) seems to prohibit absolutely the granting of a patent for more than one invention when it says, "A patent shall be granted for one invention only . . .", that prohibition is qualified by the remainder of section 38(1) when it goes on to say, ". . . but in an action or other proceeding a patent shall not be deemed to be invalid by reason only that it has been granted for more than one invention". The result is that, notwithstanding the express prohibition of more than one invention in a patent, when there comes before the court a patent by which monopolies appear to be granted in respect of a multitude of different products or processes, or both, the question as to whether the patent has been granted for more than one invention does not arise, at least as a ground of invalidity. A further difficulty arises from the fact that one finds, on studying section 41(1) and the decisions with regard thereto, that, in the cases covered thereby, a specification shall not include a claim for a "substance" except when prepared or produced by a "method" which is also "claimed" in the same application, and, indeed, it has been held that in such a case there cannot be a patent for a monopoly in respect of a "substance" unless the same patent also grants a monopoly for a "method" whereby that substance is made.¹⁷ Read with section 38(1), section 41 seems to regard these separate monopolies as flowing from one invention.

¹¹ [1942] S.C.R. 187.

¹² [1948] S.C.R. 46.

¹³ [1955] S.C.R. 414.

¹⁴ [1959] S.C.R. 378.

¹⁵ [1963] S.C.R. 410.

¹⁶ [1967] S.C.R. 45.

¹⁷ *C. H. Boehringer Sohn v. Bell-Craig Ltd.*, [1963] S.C.R. 410.

If, therefore, the view that each claim that is patented is a separate patented invention is the correct one, we are forced to the position that the net effect of the statute, having regard particularly to section 38(2) when read with section 38(1), is that there has been conferred on the Commissioner an implied discretion to grant a patent for several different inventions notwithstanding the express prohibition in section 38(1) against such a grant. If this is the result, it must not, of course, be taken as meaning an unfettered power to grant a patent for two or more unrelated inventions. As I understand it, what the Commissioner does in fact, and it may be that it is all that he can properly do, even on the view that he has an implied discretion under section 38(2), is, on the one hand, to allow alternative claims (*i.e.*, ways of defining the invention in respect of which the monopoly is sought) and, on the other hand, two or more related claims in the sense that, while they are for different monopolies and can exist together as independent monopolies, they both arise out of the same factual discovery or inventive act.¹⁸

I might attempt to explain, in a somewhat different way, my understanding as to how it arises that patents are normally issued under the *Patent Act* with several different claims even under the view that each claim is for a different invention. Section 36(1) requires that the main part of the "specification" (which becomes an integral part of the patent by virtue of section 46) correctly and fully describe "the invention" and its operation or use as contemplated by the inventor and that it shall set forth clearly—

... the various steps in a process, or the method of constructing, making, compounding, or using a machine, manufacture or composition of matter, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most closely connected, to make, construct, compound or use it; in the case of a machine he shall explain the principle thereof and the best mode in which he has contemplated the application of that principle; in the case of a process he shall explain the necessary sequence, if any, of the various steps, so as to distinguish the invention from other inventions; he shall particularly indicate and distinctly claim the part, improvement or combination which he claims as his invention.

Having thus described his "invention" or discovery in words that would enable his colleagues in his particular branch of learning or of the art to make use of it, the inventor is faced with the requirement in section 36(2) that he shall state in "explicit" terms the things or combinations in which he claims an exclusive property. This is the point at which he must put forward the legal definition of the monopoly that he is seeking. If he frames

¹⁸ Compare *Commissioner of Patents v. Ciba Ltd.*, [1959] S.C.R. 378, where the discovery of "utility" in a chemical compound was sufficient to entitle the inventor to a patent for the product and the process whereby it was manufactured.

his claim so as to embrace areas that he did not cover by his actual invention, he will risk having his whole patent declared invalid. If he frames his claim so that it does not cover the whole of what he discovered, others will be able to take advantage of his disclosure without infringing the monopoly that he seeks. This problem certainly puts an inventor and his advisers in a position where they must be very careful to establish precisely what he did and did not invent, or it would do so if the permissiveness of section 38 did not allow the Commissioner an implied discretion to permit inventors to "claim" in effect in the alternative. With the Commissioner's acquiescence, what happens, in at least some cases, is that, in the first instance, a claim is made in the widest terms possible for the subject matter described in the specification and then, by what seems to be an infinite variety of changes in the terms of the first claim, the inventor makes additional claims by which the invention is variously described by adding additional limiting factors not included in the initial claim. If the first claim is not attacked or is upheld when attacked, no resort need be made to the other claims. If, on the other hand, a court finds the first claim invalid because, for example, it does not show the application of inventive ingenuity, an attempt can be made, nevertheless, to support one or more of the other claims on the ground that the additional factors tacked on in them have resulted in a description of a real "invention". As nearly as I can tell from my limited experiences with Canadian patents, some variety of such a technique, much more sophisticated than I have made it appear, is the explanation, in a large proportion of cases, for the fact that there is a multiplicity of claims notwithstanding section 38(1). Another somewhat different, but more obvious, case arises out of the fact that the same section 36(1) specification will frequently support claims under section 36(2) for both a product and a process and the statute recognizes that the same patent can have both a product and a patent claim (section 41) and, on the view that each claim represents a separate invention, this creates an implied exception to section 38(1).

As it would seem to me then, if the view that each claim represents a different invention is correct, when one finds a multiplicity of claims in a patent, the explanation is that they are different attempts at defining what is the real invention to be found in a particular factual situation or they are two or more closely related inventions arising out of the same factual situation. Unless some such close relationship exists between different claims (inventions), I doubt that the Commissioner would be justified in permitting a patent to issue for two or more claims and I think it is a fair assumption, in any particular case, unless the contrary has been established, that he has not done so.

Turning now to section 62 and the present application, it seems to me that if my attempt to appraise the circumstances in which several claims are found in the same patent is reasonably accurate, it must follow that, even though each claim may be regarded as defining an independent invention, where a person has been sued for infringing one claim he must be assumed

to be a person with a sufficient interest to attack all the other claims to make him an "interested person" for that purpose unless it can be clearly demonstrated that, in the peculiar circumstances of the particular patent, there is no justification for that assumption. Certainly a person who uses a process to make a product is not lacking in interest, when sued under a process claim, to attack not only the process claim but the product claim. It would also appear that a person who imports or sells a product may be liable under a process claim even though the product claim has been held to be invalid or does not exist.¹⁹ When one turns to the other general class of multiplicity of claims, it is difficult to conceive of a case where a person who is sued for infringement of one claim can be quite sure that all he needs to do to protect himself against further trouble from that patent is to impeach that claim even though there are various other claims some of which may be more general and some of which may be more specific. It may be that, if it were possible to frame claims so that they could be readily understood, a court could say, in some cases, at a preliminary stage, that the defendant who has been sued for infringement of certain claims can have no possible interest in having the other claims declared invalid. If such a case exists, this is not such a case. No serious attempt was made to show me that it was clear, by reference to the words of the claims, that the defendants have no interest in having the claims not in suit declared invalid.

For the above reasons, I am of opinion, subject to anything further that the parties may have to say, that if the parties, or either of them, wish me to dispose of the motion, the order should be that it be dismissed. Having regard to an agreement by counsel, the cost of the day taken to argue the motion will be costs in the cause whether or not an order is otherwise sought disposing of the motion.

¹⁹ Compare *F. Hoffmann-La Roche & Co. v. Commissioner of Patents*, [1955] S.C.R. 414.