



[2022] 2 F.C.R. D-29

PATENTS

Application by Secure Energy (Drilling Services) Inc. (Secure) for declaration Simon Levey true inventor of 2624834 patent ('834 Patent), declaration Secure owner thereof, order under *Patent Act*, R.S.C., 1985, c. P-4 directing Commissioner of Patents to vary Patent Office records accordingly — Secure also bringing motion for summary judgment on application — Listed owner of patent respondent Canada Energy Services L.P. (CES), listed inventor John Ewanek — '834 Patent addressing problem that occurs when drilling for oil in formations containing heavy crude oil, bitumen-rich oil sands — '834 Patent asserting inventor discovered that using water-based drilling fluid comprising a non-ionic or anionic polymer significantly reduces accretion of bitumen or heavy oil to drilling components during drilling process — CES opposing application and motion by Secure, bringing motion to strike application as abuse of process — CES had previously commenced action in Alberta Court of Queen's Bench seeking declaration that it was owner of '834 Patent, that Secure had infringed it — Alberta Court of Queen's Bench ultimately rendering decision, appeal therefrom dismissed by Alberta Court of Appeal — CES describing application by Secure as abuse of process, collateral attack on Alberta decisions, or that application prohibited based on issue estoppel — Those arguments rejected herein — Alberta Court of Appeal's reasons very clear it was not making any decision on ownership of '834 Patent, that Secure not precluded from advancing application under *Patent Act*, s. 52 before Federal Court — Issues herein inventorship, ownership of '834 Patent; whether Secure's application statute barred; whether release signed by Secure's predecessor preventing it from seeking declaration Levey true, proper inventor — With respect to inventorship, on balance of probabilities, Levey alone made invention captured by '834 Patent — He had the idea and established the utility of the invention — As to the purported limitations defence, it did not apply — CES argued that the *Limitations Act*, R.S.A. 2000, c. L-12, s. 3(1) prevents any remedial order more than "2 years after the date on which the claimant first knew, or in the circumstances ought to have known" or "10 years after the claim arose" whichever period expires first — Secure sought only a declaration as to the inventor of the subject matter disclosed by the '834 Patent and its owner — That is a matter of a public nature, not a private cause of action — No limitation applied — As to the release signed by Secure's predecessor, it did not prevent Secure from seeking declaration that Levey is true, proper inventor because that did not fall within the phrase "all manner of actions, causes of actions, suits, contracts, claims, demands, and damages of any kind whatsoever ... against John Ewanek in respect of any matter, cause or thing existing up to the present date" found in the release — Although Secure's application named Ewanek as respondent, this was not a "claim" against him or the other respondent *per se* — It was not a claim or a cause of action but an application for a declaration — The release could not be raised to prohibit a party from seeking a declaration as to the true and proper inventor of a patent — Declarations issued that Levey is true, proper inventor of subject matter disclosed in '834 Patent; that Secure is proper owner of '834 Patent — No order directing Commissioner of Patents to vary records is required as such order unnecessary when declaration of inventorship issued — Application allowed.

SECURE ENERGY (DRILLING SERVICES) INC. V. CANADIAN ENERGY SERVICES L.P. (T-1534-20, 2023 FC 906, Zinn J., reasons for judgment dated June 28, 2023, 28 pp.)