Date: 20080204

Docket: A-261-07

Citation: 2008 FCA 44

CORAM: **DESJARDINS J.A.**
NOËL J.A.
PELLETIER J.A.

BETWEEN:

APOTEX INC.

Appellant
(Respondent)

and

ELI LILLY CANADA INC.

Respondent
(Applicant)

and

THE MINISTER OF HEALTH

Respondent
(Respondent)

and

ELI LILLY AND COMPANY LIMITED

Respondent/Patentee
(Respondent/Patentee)

Heard at Montréal, Quebec, on February 4, 2008.

Judgment delivered from the Bench at Montréal, Quebec, on February 4, 2008.

REASONS FOR JUDGMENT OF THE COURT BY: Noël J.A.

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NOËL J.A.

[1] The only issue to be decided in the appeal is whether Gauthier J. (the applications judge) erred in law when she held that the sufficiency of the disclosure in '113 patent was not properly before her since Apotex Inc. (Apotex) had not raised this issue in its Notice of Allegation (NOA).

[2] We are satisfied that the applications judge committed no error in this regard. Apotex' argument is based on the premise that the sufficiency of the disclosure is a matter which only arose as a result of Eli Lilly Canada Inc. (Eli Lilly) having characterized the '113 patent as a valid selection patent in its application for an order of prohibition. Hence, the applications judge had the duty to assess the sufficiency of the disclosure in light of the fact that it was a selection patent, just as it had to review the allegations of anticipation, obviousness and double patenting based on Eli Lilly's assertion that the '113 patent was a selection patent.

[3] We disagree. In our view, the applications judge correctly held that the sufficiency of the disclosure is a stand alone ground which ought to have been raised in the NOA. It is a distinct allegation that is different in character from the allegations which were made. Contrary to the case of anticipation, obviousness or double patenting, what is in issue where the sufficiency of the disclosure is challenged is not whether the alleged invention was novel, but whether the words used by the inventor to disclose it were sufficient.

[4] Apotex strongly argued that the applications judge's refusal to consider the issue of the sufficiency of the disclosure denied it procedural fairness. In our view, the applications judge correctly held that while Apotex was entitled to challenge Eli Lilly's claim that the '113 patent was a valid selection patent, it was only entitled to do so on the grounds raised in the NOA, namely the asserted grounds of anticipation, obviousness and double patenting. The applications judge carefully canvassed these grounds in the light of Eli Lilly's claim that the '113 patent was a valid selection patent, and found against Apotex on each of them.

[5] To the extent that Apotex wished to raise as an issue the sufficiency of disclosure in the '113 patent, it had to do so in its NOA. This is not a case where Apotex was compelled to anticipate theoretical defences. Apotex' allegation of double patenting by its nature invited consideration of the '113 patent as a selection patent from the outset.

[6] The appeal will be dismissed with costs.

"Marc Noël"

J.A.

FEDERAL COURT OF APPEAL

NAMES OF COUNSEL AND SOLICITORS OF RECORD

DOCKET:	A-261-07
APPEAL FROM A JUDGMENT OF JUSTICE GAUTHIER DATED APRIL 27, 2007, DOCKET NOS. T-156-05 AND T-787-05.	
STYLE OF CAUSE:	APOTEX INC. and ELI LILLY CANADA INC. and THE MINISTER OF HEALTH and ELI LILLY AND COMPANY LIMITED
PLACE OF HEARING:	Montréal, Quebec
DATE OF HEARING:	February 4, 2008
REASONS FOR JUDGMENT OF THE COURT BY:	Desjardins, Noël, Pelletier JJ.A.
DELIVERED FROM THE BENCH BY:	Noël J.A.

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