

Date: 20080115

Docket: A-456-05

Citation: 2008 FCA 21

**CORAM: LÉTOURNEAU J.A.
PELLETIER J.A.
TRUDEL J.A.**

BETWEEN:

MAYNE PHARMA (CANADA) INC.

Appellant

and

AVENTIS PHARMA ET AL

Respondents

Heard at Ottawa, Ontario, on January 15, 2008.

Judgment delivered from the Bench at Ottawa, Ontario, on January 15, 2008.

REASONS FOR JUDGMENT OF THE COURT BY:

PELLETIER J.A.

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BETWEEN:

MAYNE PHARMA (CANADA) INC.

Appellant

and

**AVENTIS PHARMA INC. and
THE MINISTER OF HEALTH**

Respondents

REASONS FOR JUDGMENT OF THE COURT
(Delivered from the Bench at Ottawa, Ontario, on January 15, 2008)

PELLETIER J.A.

[1] At the commencement of the hearing of this appeal from an order of prohibition, we were advised that the patent which was the subject of the Notice of Allegation had been de-listed, that the de-listing had been upheld by the Federal Court and that the appeal period had expired without an appeal being taken from the decision of the Federal Court.

[2] In light of this state of affairs, the appellant seeks to reinstate its motion for an order setting aside the order of prohibition on the ground that there is no longer a substrate for the order. The

respondent contends that the basis for the prohibition order is the infringement of the patent which, notwithstanding the de-listing, remains valid and in force.

[3] We are of the view that we should intervene. The prohibition order is a remedy which is only available to a patent holder in the context of the *Patented Medicines (Notice of Compliance) Regulations* (PM(NOC) Regs.). If the prohibition order is allowed to stand, the respondent will have the benefit of a remedy which is not available outside the context of the PM(NOC) Regs in a case where no basis exists under those regulations for the remedy.

[4] The respondent seeks to meet this argument by pointing out that the foundation of the order is the patent which, as noted, remains valid and in force. The respondent cannot invoke the PM(NOC) Regs in order to obtain a prohibition order and then argue the PM(NOC) Regs are irrelevant to that order. The respondent's remedy is by way of an infringement action.

[5] While the matter was raised by motion, we are of the view that it goes to the merits of the appeal. Accordingly, for the reasons stated, the appeal will be allowed, the decision of the Federal Court granting the prohibition order will be set aside as of this date and the application for a prohibition order will be dismissed as of this date. The order for costs in the Federal Court will not be disturbed. The appellant is entitled to the costs of the appeal.

"J.D. Denis Pelletier"

J.A

FEDERAL COURT OF APPEAL

NAMES OF COUNSEL AND SOLICITORS OF RECORD

DOCKET: A-456-05

STYLE OF CAUSE: MAYNE PHARMA (CANADA)
INC. and SANOFI-AVENTIS
CANADA INC. and MINISTER OF
HEALTH

PLACE OF HEARING: Ottawa, Ontario

DATE OF HEARING: January 15, 2008

REASONS FOR JUDGMENT OF THE COURT BY: LÉTOURNEAU J.A.
PELLETIER J.A.
TRUDEL J.A.

DELIVERED FROM THE BENCH BY: PELLETIER J.A.

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