

**Federal Court of Appeal**



**Cour d'appel fédérale**

**Date: 20141029**

**Docket: A-242-14**

**Citation: 2014 FCA 247**

**CORAM: TRUDEL J.A.  
WEBB J.A.  
NEAR J.A.**

**BETWEEN:**

**GILEAD SCIENCES, INC., GILEAD  
SCIENCES CANADA, INC. AND GILEAD  
PHARMASSET LLC**

**Appellants**

**and**

**IDENIX PHARMACEUTICALS, INC.**

**Respondent**

Heard at Toronto, Ontario, on October 29, 2014.  
Judgment delivered from the Bench at Toronto, Ontario, on October 29, 2014.

**REASONS FOR JUDGMENT OF THE COURT BY:**

**WEBB J.A.**

Federal Court of Appeal



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**REASONS FOR JUDGMENT OF THE COURT**  
(Delivered from the Bench at Toronto, Ontario, on October 29, 2014).

**WEBB J.A.**

[1] Gilead Sciences, Inc., Gilead Sciences Canada, Inc. and Gilead Pharmasset LLC (Gilead) have appealed the order and reasons of Mactavish J. (2014 FC 391) who allowed the appeal of Idenix Pharmaceuticals Inc. (Idenix) from the Order of Prothonotary Tabib (T-1156-12). Idenix had brought a motion before the Prothonotary to amend its Amended Statement of Defence and

Counterclaim. The Prothonotary granted leave for Idenix to make certain amendments to its pleadings but denied leave to amend its pleadings related to section 53 of the *Patent Act*, R.S.C. 1985, c. P-4 and the identity of the inventors of the patent, as set out in paragraphs 58A to 58F of its notice of motion. On appeal, Mactavish J. granted Idenix leave to amend its Amended Statement of Defence and Counterclaim as set out in these paragraphs.

[2] In *Merck & Co. v. Apotex Inc.*, [2003] FCA 488; [2004] 2 F.C.R. 459, this Court noted that the standard of review applicable when a Judge is considering an appeal of a discretionary order of a prothonotary, is that a judge should not interfere with such order unless:

- (a) the prothonotary has made an error in law, including the exercise of his or her discretion based upon a wrong principle or upon a misapprehension of the facts;  
or
- (b) the order raises a question that is vital to the final issue of the case.

[3] In *Merck v. Apotex*, this Court also noted that the Supreme Court of Canada in *Z.I. Pompey Industrie v. Ecu-Line N.V.*, (2003), 224 D.L.R. (4<sup>th</sup>) 577 held that:

the Federal Court of Appeal may only interfere with the decision of the applications judge where the judge "had no grounds to interfere with the prothonotary's decision or, in the event such grounds existed, if [the judge's] decision was arrived at on a wrong basis or was plainly wrong"

[4] In this case the Federal Court Judge noted that the parties had agreed that "whether Idenix's proposed amendment to its pleading raises a reasonable cause of action is a question of law that is reviewable on the standard of correctness and maybe considered on a *de novo* basis".

Having considered this on a *de novo* basis, the Federal Court Judge concluded that the question of whether the disclosure of the names of the inventors of the patent as made by Gilead in its petition in respect of the patent in issue, in this case, is a material allegation for the purposes of subsection 53(1) of the *Patent Act* is a matter that should be considered by the trial judge who will be able to consider all of the facts that will be proven at the hearing.

[5] We are not persuaded that the decision of the Federal Court Judge “was arrived at on a wrong basis or was plainly wrong”. As a result, the appeal will be dismissed with costs.

“Wyman W. Webb”

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J.A.

**FEDERAL COURT OF APPEAL**

**NAMES OF COUNSEL AND SOLICITORS OF RECORD**

**DOCKET:** A-242-14

**STYLE OF CAUSE:** GILEAD SCIENCES, INC.,  
GILEAD SCIENCES CANADA,  
INC. AND GILEAD  
PHARMASSET LLC v. IDENIX  
PHARMACEUTICALS, INC.

**PLACE OF HEARING:** TORONTO, ONTARIO

**DATE OF HEARING:** OCTOBER 29, 2014

**REASONS FOR JUDGMENT OF THE COURT BY:** TRUDEL J.A.  
WEBB J.A.  
NEAR J.A.

**DELIVERED FROM THE BENCH BY:** WEBB J.A.

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