

## **IP monitor**

### **Quebec Superior Court dismisses application for disavowal of admissions of patent invalidity**

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**October 13, 2020**

#### **Patents**

The plaintiffs in a patent infringement proceeding before the Quebec Superior Court sought to disavow several statements made during trial by their patent counsel involving one of the two patents in suit. The patent counsel acknowledged exceeding the scope of his mandate by making the impugned statements. Failing to raise this issue at the first opportunity, the court found, was sufficient to dismiss the motion.

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#### **Background**

The plaintiffs sued the defendants for infringement of two patents: Canadian Patent No. 2 423 830 and Canadian Patent No. 2 712 715 (the 715 Patent). The trial started in November 2019 with hearing dates also scheduled in March and September 2020.

During the November portion of the trial, the plaintiffs' patent counsel asserted that the 715 Patent was invalid. He also objected that cross-examination questions by the defendants concerning the 715 Patent were no longer relevant. Several days into the trial, plaintiffs' trial counsel submitted an amended originating application wherein the allegations pertaining to the 715 Patent were withdrawn. The plaintiffs' infringement evidence was declared closed on November 15, 2019.

On March 8, 2020, the plaintiffs brought an application to disavow admissions made by their patent counsel in accordance with section 191 of the Quebec Code of Civil Procedure. The plaintiffs alleged they were never consulted about, and did not consent to, patent counsel's statements about the invalidity of the 715 Patent. The plaintiffs also claimed that patent counsel was never authorized to renounce their rights in the 715 Patent and they were prejudiced by this renunciation.

#### **Patent counsel's admission of patent invalidity was ratified and was not prejudicial to the plaintiffs**

For an application for disavowal to succeed under Quebec law, each of the following conditions must be met: (1) the disavowed act(s) must not have been authorized by the applicant; (2) the disavowed act(s) must not be ratified; and (3) the applicant must be prejudiced by the disavowed act(s).

The first condition of the test was met by patent counsel admitting to having exceeded the scope of his mandate by making the impugned statements during the disavowal hearing.

With regard to the second condition, the court held that the admission of the 715 patent's invalidity had been ratified. The disavowal had not been raised in clear and unequivocal terms at the first opportunity. The application was brought more than four months after the trial began and after the plaintiffs' evidence on infringement was declared closed. The plaintiffs and their trial counsel failed to intervene and explicitly object to the impugned statements being made by patent counsel on multiple occasions, including three instances when the court invited the parties to clarify their position on the validity of the 715 Patent.

While failure to meet the second condition was enough to dispense with the application for disavowal, the court went on to consider whether the plaintiffs were prejudiced by the impugned statements. The plaintiffs testified that patent counsel's admission of the 715 Patent's invalidity dispelled any chance of selling it or receiving royalty payments. This testimony, which the court qualified as "short, vague and hypothetical," did not meet the burden of proof for the third condition of the test.

The case is: [Hamel et al. v. Robitaille Équipement Inc. et al., 200-17-023821-168](#)

Shantelle LaFayette  
Brian Daley

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