Full particulars are required when pleading misrepresentation under s. 53 of the Patent Act

August 19, 2024

The Federal Court recently ruled on a motion to amend pleadings. The Defendant sought to include additional allegations to its previously pleaded defence that the patent was void pursuant to s. 53 of the *Patent Act* (the Act) due to representations made by the Plaintiffs during prosecution of the patent application. The Court's analysis centered on the particularity needed for pleadings in support of such allegations.

The Court reiterated that "section 53 has been described as the Act's 'fraud provision'" (para 19) and further held, that as allegations pursuant to s. 53 are allegations of misrepresentation, they must comply with Rule 181(1) of the *Federal Courts Rules*.

The Court cited jurisprudence from the Ontario Courts that requires a pleading of misrepresentation to identify what the misrepresentation is, and how it is false. The Court concluded that when misrepresentation is plead as a defence pursuant to s. 53, it must contain the essential elements of the defence required by the Act, and the particulars of a misrepresentation required in a civil proceeding. The Court set them out as follows:

A) Essential elements required by section 53 of the Act:

a) the identification of the impugned statements;

b) the establishment that they were untrue;

c) the demonstration that they were material;

d) that they were made in the drafting of the patent with wilful intent to mislead; and,

e) that the impugned statement would likely mislead the skilled person.

and,

B) Particulars required by Rule 181(1):

a) the identity of the representor;

b) the identity of the representee;

c) when, where and how the representation was made;

d) the actual words, figures, or information that are alleged to constitute the misrepresentation(s);

e) how the representation is untrue or false;

f) that the representor knew that the representation was untrue or false when made to the representee; and,

g) that the misrepresentation was made with the intention that the representee rely upon it. (para 31)

On the motion, the Court held that leave should be granted for most of the proposed amendments. However, when considering whether the interests of justice would be served in allowing the amendments, the Court refused to allow the addition of a bare list of additional prior publications and uses. The Court held that a list of publications without pinpoints does not provide sufficient particulars of a misrepresentation defence and would complicate the Court's determination of this issue.

Key takeaways

Parties should note that the Court appears to be taking steps toward recognizing that the fraud-like nature of s. 53 of the *Patent Act* means pleadings must be properly particularized to enable the patentee to know the case they have to meet.

By

Beverley Moore, Chantal Saunders

Expertise

Intellectual Property, Patents, Disputes

BLG | Canada's Law Firm

As the largest, truly full-service Canadian law firm, Borden Ladner Gervais LLP (BLG) delivers practical legal advice for domestic and international clients across more practices and industries than any Canadian firm. With over 800 lawyers, intellectual property agents and other professionals, BLG serves the legal needs of businesses and institutions across Canada and beyond – from M&A and capital markets, to disputes, financing, and trademark & patent registration.

blg.com

BLG Offices

Calgary

Centennial Place, East Tower
520 3rd Avenue S.W.
Calgary, AB, Canada
T2P 0R3

T 403.232.9500
F 403.266.1395

Ottawa

World Exchange Plaza
100 Queen Street
Ottawa, ON, Canada
K1P 1J9

T 613.237.5160
F 613.230.8842

Vancouver

1200 Waterfront Centre
200 Burrard Street
Vancouver, BC, Canada
V7X 1T2

T 604.687.5744
F 604.687.1415

Montréal

1000 De La Gauchetière Street West
Suite 900
Montréal, QC, Canada
H3B 5H4

T 514.954.2555
F 514.879.9015

Toronto

Bay Adelaide Centre, East Tower
22 Adelaide Street West
Toronto, ON, Canada
M5H 4E3

T 416.367.6000
F 416.367.6749

The information contained herein is of a general nature and is not intended to constitute legal advice, a complete statement of the law, or an opinion on any subject. No one should act upon it or refrain from acting without a thorough examination of the law after the facts of a specific situation are considered. You are urged to consult your legal adviser in cases of specific questions or concerns. BLG does not warrant or guarantee the accuracy, currency or completeness of this publication. No part of this publication may be reproduced without prior written permission of Borden Ladner Gervais LLP. If this publication was sent to you by BLG and you do not wish to receive further publications from BLG, you may ask to remove your contact information from our mailing lists by emailing unsubscribe@blg.com or manage your subscription preferences at blg.com/MyPreferences. If you feel you have received this message in error please contact communications@blg.com. BLG's privacy policy for publications may be found at blg.com/en/privacy.

© 2026 Borden Ladner Gervais LLP. Borden Ladner Gervais LLP is an Ontario Limited Liability Partnership.