

Overbreadth

13TH ANNUAL UNIVERSITY OF TORONTO PATENT COLLOQUIUM

Overbreadth: Test

A claim is invalid if it is broader than:

- a) the invention disclosed; or
- b) the invention made or contemplated

Is Overbreadth Redundant?

- Often overlaps with other grounds of invalidity
- Often a claim is overbroad *because* it is invalid on some other ground – i.e., covers subject matter that is not new, obvious or not useful, or subject matter that is not sufficiently described
- Can overbreadth ever be a standalone ground of invalidity?

Proslide Technology v. Whitewater West Industries

2024 FC 1439 (Manson J)

Proslide alleged infringement of four patents over “water slides” and “water rides” by Whitewater’s Aquasphere, Orbiter and Tailspin products

- The 601 Patent was invalid for inutility
- The 552 Patent family was invalid for overbreadth because the **claims were broader than the invention made or contemplated**

Proslide: Overbreadth Issue

- There is **no dispute** about whether the claims are broader than the **invention disclosed**
- There is **no dispute** about whether the claims are broader than the **invention made**
- **Issue:** are the claims broader than the **invention contemplated?**

Proslide: Overbreadth Analysis

1. What were key aspects of the invention **as contemplated by the inventor**?
 - Based on inventor testimony
2. What would the **skilled person understand** were the key aspects of the invention **as contemplated by the inventor**?
 - Based on extrinsic evidence: minutes from Proslide design review meetings, “Design specification” documents re Proslide’s FlyingSAUCER, emails between inventor and others

Points For Discussion

- Key aspects of the invention as contemplated by the inventor based on inventor testimony
- Key aspects of the invention as contemplated by the inventor based on extrinsic evidence
- Is it based in statute or in the “patent bargain”?

Points For Discussion

- **Key aspects of the invention as contemplated by the inventor based on inventor testimony**
 - Subjective – uncertain and unpredictable
 - What about multiple inventors? Is each inventor's testimony now relevant?
 - When does the inventor have to contemplate their invention?

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Free World Trust v. Électro Santé Inc.

2000 SCC 66

Principles of claims construction

- ...The **non-essential elements may be substituted or omitted** without having a material effect on either the structure or the operation of the invention described in the claims (at paragraph 20).
- The identification of elements as essential or non-essential is made **without resort to extrinsic evidence of the inventor's intention** (at paragraph 31(e)(v)).
- To allow such extrinsic evidence for the purpose of defining the monopoly would undermine the public notice function of the claims, and increase uncertainty as well as fuelling the already overheated engines of patent litigation.

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- **Is it based in statute or in the “patent bargain”?**

Patent Act, sections 27(3)(a) & 27(4)

- **S. 27(3)(a):** The specification must correctly and fully describe the invention and its operation or use **as contemplated by the inventor**
- **S. 27(4):** The specification must end with a claim or claims defining distinctly and in explicit terms **the subject-matter of the invention** for which exclusive privilege or property is claimed

Patent Bargain

The inventor discloses something new, useful and non-obvious in exchange for a monopoly over that thing.