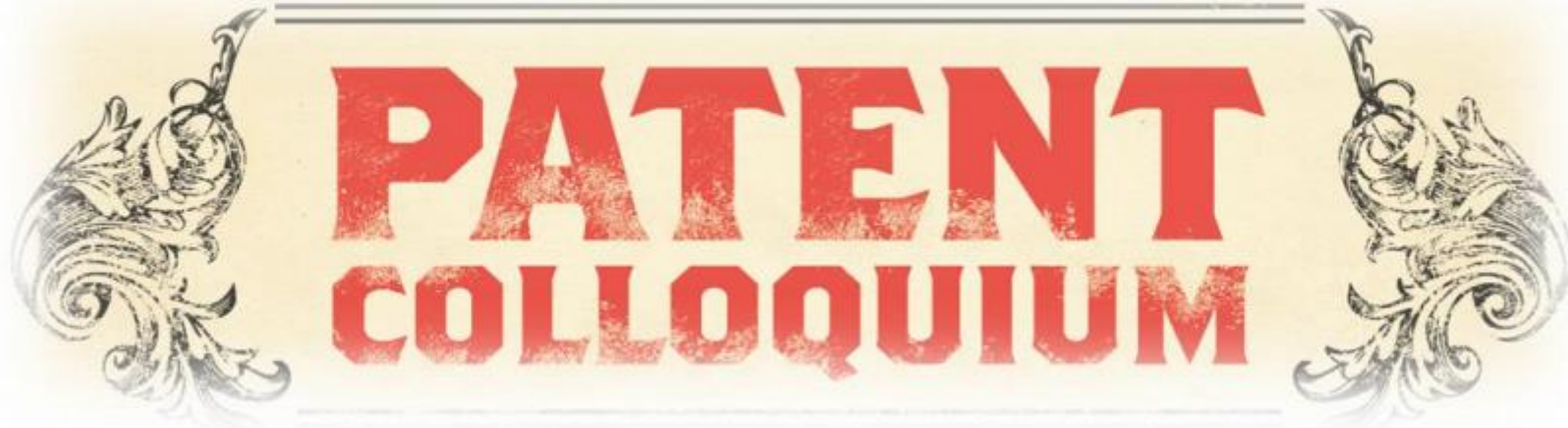


10TH ANNUAL

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Claim Construction Issues

Justice Angela Furlanetto, *Federal Court of Canada* (Moderator)

Melanie Baird, *Blake, Cassels & Graydon*

Jason Markwell, *Faskens*

Jenna Wilson, *Wilson Lue*

Claim construction in patent drafting and prosecution

Why is claim construction different?

- ~~Different evidence concerning the knowledge of the relevant art (*Canada (Attorney General) v. Amazon.com, Inc.*, 2011 FCA 328 at para 73)~~
- ~~Scope of the claims is subject to change~~
- ~~A “quite limited budget for preparing a patent application” (*Bauer Hockey Ltd. v. Sport Maska Inc. (CCM Hockey)*, 2020 FC 624 at para 62)~~

Patent drafting is backwards

- Patent specifications are often drafted claims-first
 - initial decision to file a patent application often based on rough claims drafted after prior art review
 - used to determine whether claimed invention will have commercial value
- Once the claims have been written, the disclosure follows

Inventions are retrofitted

- In response to prior art objections
- In response to patentable subject matter objections
- In recognition of a broader inventive concept

However, there is no substitute for trying to get things right from the beginning.

William L. Hayhurst, Q.C., “The Art of Claiming and Reading a Claim” in Gordon F. Henderson, ed., Patent Law of Canada (Toronto: Thomson, 1994) at 213

Construction by inductive reasoning

- Claim differentiation is heavily used in amendments during prosecution
 - addition of limitation in dependent claim to imply greater breadth of antecedent claim

Example: description only identifies carrageenan as possible viscosity modifier

Claim 1 ... further comprising a viscosity modifier in an amount of from 30 to 60 percent by weight of the dosage form.

Claim 1 ... further comprising a viscosity modifier in an amount of from 30 to 60 percent by weight of the dosage form.

Claim 2 ... wherein the viscosity modifier is carrageenan

Construction by inductive reasoning

- Claim differentiation is convincing in prosecution (*Patent Rules*, subsection 63(1))

63(1) Subject to subsection (2), a claim that includes all the features of one or more other claims (referred to in this section as a “dependent claim”) must refer by number to the other claim or claims and must state the additional features claimed.

- ... but potentially weak post-grant (Bauer Hockey Ltd. v. Sport Maska Inc. (CCM Hockey), 2020 FC 624)

[70] In reality, if claims differentiation were a hard-and-fast rule instead of a rebuttable presumption, unscrupulous patentees could be tempted to include in their applications a dependent claim that would cover, as its additional feature, something that is merely a synonym of a feature of the independent claim... the patentee could then rely on the claims differentiation principle to argue that the independent claim must cover more than what was contemplated when it applied for the patent, typically embracing its competitors’ products ex post facto. Courts do not allow themselves to be so cornered. This is one reason why interpretive principles remain flexible.

Those patents were not drafted here

- Only about 13% of patent applications filed in Canada originate from Canadian applicants
 - all other applications were likely drafted outside Canada
- In 2021, only about 20% of patent infringement/impeachment/PM(NOC) actions commenced in Federal Court involved patents drafted in Canada
- Canadian prosecuting agent often takes direction from foreign/in-house counsel concerning amendments/arguments

Examiners are not persons skilled in the art

- Examiners apply the law

As delegated representatives of the Commissioner of Patents [section 6 of the *Patent Act*], patent examiners are responsible for implementing the *Patent Act* and *Patent Rules*.

Actions taken by an examiner will be done within a legal context. It is therefore necessary that the examiner know and apply the law as specified by the *Patent Act* and *Patent Rules*.

Examiners are not persons skilled in the art

- Examiners read for errors, not with “judicial anxiety to support a really useful invention”

Examination is a task that requires the collection and analysis of technical and historical data in order to determine the patentability of an application. One of the steps of examination is to communicate to the applicant the nature of the defects that are barring an application’s allowance.

Basic Training Manual, SG-PAT-04 Qualification Course, May 2021, s. 5.1.1

Examiners are not persons skilled in the art

- Some interpretation rules are mandatory, even if a skilled person may not interpret the term the same way

By definition, a composition comprises more than one component. Therefore, a composition claim must define at least two components.

• • •

Expressions containing a combination of indefinite terms, for example, “at least about” or “about at least” are inherently ambiguous, especially when used in a range, and are considered defects.

Basic Training Manual, SG-PAT-04 Qualification Course, May 2021, s. 4.3.7.10, 4.3.10.6

Claim constructions are inferred

- Discussion of actual meaning of claim terminology uncommon in the context of anticipation or obviousness defects
 - more likely to have discussion of meaning when an indefiniteness defect is identified

In most cases, an examiner reading a claim will automatically ascribe appropriate meanings to the terms of a claim in light of the teachings of the description and the examiner's technical expertise. It is not necessary to explain these conclusions in a report, unless it becomes apparent that there is some relevant disagreement between the examiner and the applicant as to the significance of certain terms. In such instances, it is only necessary to explicitly address the construction of the contested terms.

Manual of Patent Office Practice, s. 12.02.03 (June 2015)

A brief and recent history of claim construction in CIP0

A brief and recent history

- 2008: Apotex Inc. v. Sanofi-Synthelabo Canada Inc., 2008 SCC 61
- 2009: *Re Amazon.com Inc.*, CD 1290
- 2009: *Practice Notice on Obviousness*
- 2010: Amazon Inc. v. Canada (Attorney General), 2010 FC 1011
- 2011: *Practice Subsequent to the Amazon.com Decision*, PN2011-04
- 2011: Canada (Attorney General) v. Amazon.com, Inc., 2011 FCA 328
- 2012: *Statutory Subject Matter under the Patent Act (DRAFT)*
- 2013: *Examination Practice Respecting Purposive Construction*, PN2013-02
- 2020: Choueifaty v. Canada (Attorney General), 2020 FC 837
- 2020: *Patentable Subject-Matter under the Patent Act*

2009: *Sanofi* guidance

The inventive concept of a claim, at this step of the inquiry, is identified without regard to the prior art. It is the essence of the claimed invention and can generally be identified by approaching the matter of the claim as a solution to whatever problem the inventors have set out to address, and relates to those elements of the claim that were described, or which would be recognized by the person skilled in the art, as providing the solution to a given problem. In identifying the problem that the inventors set out to address, and the solution proposed through the invention, guidance will generally be found in the description, in accordance with paragraph 80(1)(d) of the *Patent Rules*.

Practice Notice on Obviousness, November 2, 2009

2009: *Amazon* Commissioner's Decision

- inspired (in part) by the contribution approach in *Aerotel Ltd v Telco Holding Ltd and others*, and *Neal William Macrossan's application* [2006] EWCA Civ 1371

2011: Revised guidance

Practice Guidelines

obviousness ← inventive concept

monopoly, and 2) what the inventors actually invented

subject matter ← inventive concept

the application is defective and is not to be allowed.

• • •

The Office takes the position that the *actual invention* is equivalent to the *inventive concept* of a claim, when the *inventive concept* is identified in accordance to the guidance set forth in the appendix to this document.

Practice Subsequent to the Amazon.com Decision, PN2011-04, August 1, 2011

2011: *Amazon FCA*

[42] This formulation of the issues to be considered does not mean that the Commissioner cannot ask or determine what the inventor has actually invented, or what the inventor claims to have invented. On the contrary, these are **relevant and necessary questions** in a number of contexts, including novelty, obviousness, and **patentable subject matter**. It may also arise in relation to other issues, for example, the determination of the identity of the inventor.

[43] However, it seems to me that the jurisprudence of the Supreme Court of Canada, in particular *Free World Trust* and *Whirlpool*, requires the Commissioner's identification of the actual invention to be grounded in a purposive construction of the patent claims....

2012: New draft guidance

The first step in determining whether the subject matter defined by a

obviousness ← inventive concept

subject matter ← inventive concept must

physical existence or manifests a discernible effect or change and that provides a solution to a technical problem...

An element of a claimed invention that is identified as essential for establishing the fences of the monopoly under purposive construction is not necessarily part of the inventive concept of the claim...

2013: New *Amazon* guidance

Inventive concept analysis relabeled as purposive construction

- invoking *Amazon*’s FCA test to determine if a claim is obviousness ← inventive concept

Thus, for example, what appears on its face to be a claim for an “art”
subject matter ← essential elements

mathematical formula and therefore not patentable subject matter. That
essential elements ← inventive concept

Canada (Attorney General) v. Amazon.com, Inc., 2011 FCA 328 at para 44

- in this “new” purposive construction, only those elements belonging to the “inventive solution” are essential
- CIPPO’s “inventive concept” continues to be a solution discerned from the disclosure

2013: New *Amazon* guidance

Use of the “disjunctive” interpretation of *Free World Trust*

- applicant’s intent to make computer essential did not matter because the computer could be replaced by mental steps

Second, to require the application of the *Improver* questions in construction would be contrary to the guidance in *Free World Trust* wherein the “material effect” and “intent” factors (see points (iii) and (iv) at para 18, above) are described in the alternative; see *Bauer Hockey Corp v Easton Sports Canada Inc*, 2011 FCA 83 at para. 33 and 40.

Re IGT, CD 1346 at para 30

2020: *Choueifaty*

Decision based strictly on “purposive construction”

- apply conjunctive test

[39] As Justice Locke, then of this Court, noted in *Shire Canada Inc v Apotex Inc*, 2016 FC 382 at paras 134-143, in order “to establish that a claim element is non-essential, it must show both (i) that on a purposive construction of the words of the claim it was clearly not intended to be essential, and (ii) that at the date of publication of the patent, the skilled addressees would have appreciated that a particular element could be substituted without affecting the working of the invention” [emphasis in original]. The problem-solution approach to claims construction focuses only on the second aspect above, it fails to respond, as taught in *Free World Trust*, to the issue of the inventor’s intention.

2020: New *Choueifaty* guidance

- Conjunctive test → presumed essential

obviousness ← inventive concept

all elements set out in a claim are presumed essential, unless

subject matter ← inventive concept

- “Actual invention” – inventive concept, restricted to the manual and productive arts

essential elements ← conjunctive

subsection 27(8) of the Patent Act, the subject-matter defined by a claim must be limited to or narrower than an actual invention that either has physical existence or manifests a discernible physical effect or change and that relates to the manual or productive arts...



now with
manual &
productive
arts!

We all have the same questions...

- What subject matter (inventive concept, essential elements?) is evaluated for each patentability criterion?
- Which version of the test should be used for essential/non-essential elements?
- What is the role of the disclosure in construing the claims?