



# Use of the prosecution file history to construe claims in Canadian litigation

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## Overview

- What is a prosecution file history?
- What claims construction issues could the prosecution history relate to?
- Admissibility of the prosecution history at common law in Canada
- Section 53.1 of the *Patent Act*
- *Canmar Foods Ltd v TA Foods Ltd*

## Prosecution file history, aka “file wrapper”

- File maintained by the patent office
- Patent Application
- All written correspondence between the applicant and the patent office
  - Office actions and responses made by the patentee
  - Claim amendments
  - Disclaimers
  - Re-examination

## Purposive claims construction

- What do the words in the claim mean?
- What was the common knowledge of the worker skilled in the art?
- Was it obvious to the skilled reader that a variant would not make a difference to the way in which the invention works?
- What was the intent of the inventor, expressed or inferred from the claims, that a particular element is essential irrespective of its practical effect?

## **“... without, however, resort to extrinsic evidence of the inventor's intention.”**

- Extrinsic evidence is inadmissible at common law:
  - Inventor testimony and notes
  - Out of court statements by the inventor
  - Other patents and prior art
  - Prosecution file history

## Why not look at the prosecution history?

“...what happened in another country under a different system of law could not affect the validity or invalidity of the claims in a Canadian patent.”

*O’Cedar of Canada Ltd v Mallory Hardware Products Ltd*, [1956] ExCR 299 para 38

“...[E]xtrinsic evidence is inadmissible for the purpose of construing a patent specification.”

*Lovell Manufacturing Co v Beatty Bros Ltd* (1962), 41 CPR 18 at 39 (ExCt)

“The members of the public have no knowledge of what may have been said to the examiners in the course of the prosecution of the application for the patent... **They are entitled to know that the forbidden field is defined by the language of the claims of the patent and that they need not look elsewhere.**”

*Lovell Manufacturing Co v Beatty Bros Ltd* (1962), 41 CPR 18 at 39 (ExCt)

## Well established common law prohibition

“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. The current emphasis on purposive construction, which keeps the focus on the language of the claims, seems also to be inconsistent with opening the Pandora's box of file wrapper estoppel.”

*Free World Trust v Électro Santé Inc*, 2000 SCC 66 para 66

## “Objective fact exception” for a change in the wording of a claim?

“A change in the wording of a claim as a result of an objection from the Patent Office is an objective fact from which an inference may be drawn, and is not the same as representations made to the Patent Office. A purposive construction should obviously focus on the wording of a claim, obviously, but this is a far cry from saying that nothing else should be considered.”

*Distrimedica v. Dispill*, 2013 FC 1043 para 210



## *Pollard Banknote v. Babn Technologies, 2016 FC 883*



- “... entirely opposite to the position it took before the Examiner”
- “remarkable”
- “breathtaking”
- “would never have made it to a trial in the US”

## Questioning the rationale?

“The SCC also did not explain how the patent gives public notice of the claims, but the prosecution history, which is likewise available to the public, does not. I note also that, unlike in 2000, when the *Free World Trust* decision was released, prosecution histories in many jurisdictions (including Canada) are now available on the internet. **This raises the question whether it is time to revisit the rule against using extrinsic evidence in claim construction.**”

*Pollard Banknote v. Babn Technologies*, 2016 FC 883 para 80

**“This case highlights a potential risk in taking a simpler approach to claim construction by ignoring extrinsic evidence**, such as the prosecution history of the patent in suit. As revealed in my analysis above, excluding such extrinsic evidence resulted in a very different construction of the phrase “a removable continuous scratch-off coating covering both the printed indicia in said play area and the bar code” than would otherwise have been the case”

*Pollard Banknote v. Babn Technologies*, 2016 FC 883 para 239

## Legislative intervention needed

“If a party or parties believe that a different course should be taken on this front in Canada, such that doctrines like the United States doctrine of file wrapper estoppel should be applied in this country, the Court is not the appropriate forum to effect that change—**legislative amendments would be required.**”

*Meda AB v Canada (Minister of Health) 2016 FC 1362*

## Section 53.1 of the *Patent Act*

- Came into force December 31, 2018
- Applies in respect of any action or proceeding that has not been finally disposed of
- Creates an exception to the common-law prohibition on the use of extrinsic evidence for claims construction

## Prosecution file “may be admitted into evidence to rebut”

53.1 (1) In any action or proceeding respecting a patent, a written communication, or any part of such a communication, may be admitted into evidence to rebut any representation made by the patentee in the action or proceeding as to the construction of a claim in the patent if

(a) it is prepared in respect of

(i) the prosecution of the application for the patent,

(ii) a disclaimer made in respect of the patent, or

(iii) a request for re-examination, or a re-examination proceeding, in respect of the patent;

and

(b) it is between

(i) the applicant for the patent or the patentee; and

(ii) the Commissioner, an officer or employee of the Patent Office or a member of a re-examination board.

## Elements of s. 53.1

- Written communication
- Relating to prosecution, disclaimer or re-examination of a patent
- Between the patentee and the Patent Office
- To rebut any representation made by the patentee in the proceedings

## Application: *Canmar Foods Ltd v TA Foods Ltd*

- Patent infringement litigation between roasted flax seed manufactures
- Motion for summary judgment
- Issue of construction of two claim elements not present in the defendant's process:
  1. Heating oil seed “in a stream of air”
  2. Transferring the heated oil seed in an “insulated or partially insulated roasting chamber or tower”

## Prosecution history as evidence of inventor's intention

“With the introduction of section 53.1, purposive construction of patent claims in Canada now includes three prongs: (1) the claims themselves; (2) the disclosure; and (3) **the prosecution history in Canada, when used to rebut a representation made by the patentee as to the construction of a claim in the patent.**”

*Canmar Foods Ltd v TA Foods Ltd*, 2019 FC 1233 para 68

“This communication to the Patent Office is clear evidence of the inventor’s express intention that these two elements, introduced to advance novel and non-obvious subject matter, are essential (*Free World Trust* at para [31](#)).”

*Canmar Foods Ltd v TA Foods Ltd*, 2019 FC 1233 para 87



## Foreign prosecution history admissible under s. 53.1 in extraordinary circumstances

“In the extraordinary circumstance that prosecution of the foreign application is made part of the prosecution history of the Canadian patent, that foreign prosecution history, where relevant to limitations made to Canadian claims, should be admissible to aid in a purposive construction of the claims of the Canadian patent.”

*Canmar Foods Ltd v TA Foods Ltd*, 2019 FC 1233 para 77

## Comments on *Canmar Foods*

- Court's reasons relating to the US prosecution history are *obiter*
  - No reference to the US prosecution in the reasons on construction of the disputed claim elements
  - **“Regardless of the US Application prosecution history,** I do not see how the process described in the Popowich Affidavit could possibly constitute heating the oil seed “in a stream of air”...”
- Under appeal: Federal Court of Appeal may revisit whether section 53.1 can be used to admit a foreign prosecution history for construction

## Conclusions

- Parliament has carved out an exception
- Available in limited circumstances to “rebut”
- No apparent floodgates for other extrinsic evidence
- May hear from the FCA on the admissibility of foreign prosecution histories



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