

# Computer-Implemented Inventions in Canada

*12th Annual U of T Patent Colloquium*

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# Computer-Implemented Eligibility

- **Overview:** Recent cases addressing the eligibility of subject matter
  - *Attorney General of Canada v. Benjamin Moore*, 2023 FCA 168
  - *Choueifaty v. Canada (Attorney General)*, 2020 FC 837
- Disputes arising between applicants and CIPO
  - Examination based on Manual of Patent Office Procedure (MOPOP)
  - CIPO's guidance to examiners departed from jurisprudence

- *A different construction for CIPPO examiners?*
- MOPOP distinguished the purposive construction in *Whirlpool* and *Free World Trust* from that to be used by patent examiners
  - (*Choueifaty* at para 33)
- Justice Zinn found that this was wrong in view of *Amazon* (2011 FCA 328)
  - “*I would refer the construction of the patent claims back to the Commissioner for re-examination.*”

[73] Anyone who undertakes a purposive construction of a patent must do so on the basis of a foundation of knowledge about the relevant art, and in particular about the state of the relevant art at the relevant time.

For the Commissioner, that assistance comes in the form of submissions from the patent applicant and, I assume, from staff at the patent office with the appropriate experience.

Courts, however, generally require the expert evidence of persons skilled in the art (Whirlpool, at paragraph 49).

# Benjamin Moore (FCA)

- Patent applications already remitted for re-examination
- Only the mandatory test assigned by the Federal Court remained in issue
- Test overturned by FCA
- CIPO to construe claims in accordance with *Free World Trust* and *Whirlpool*
  - *Déjà vu?*

## “Physicality Requirement”

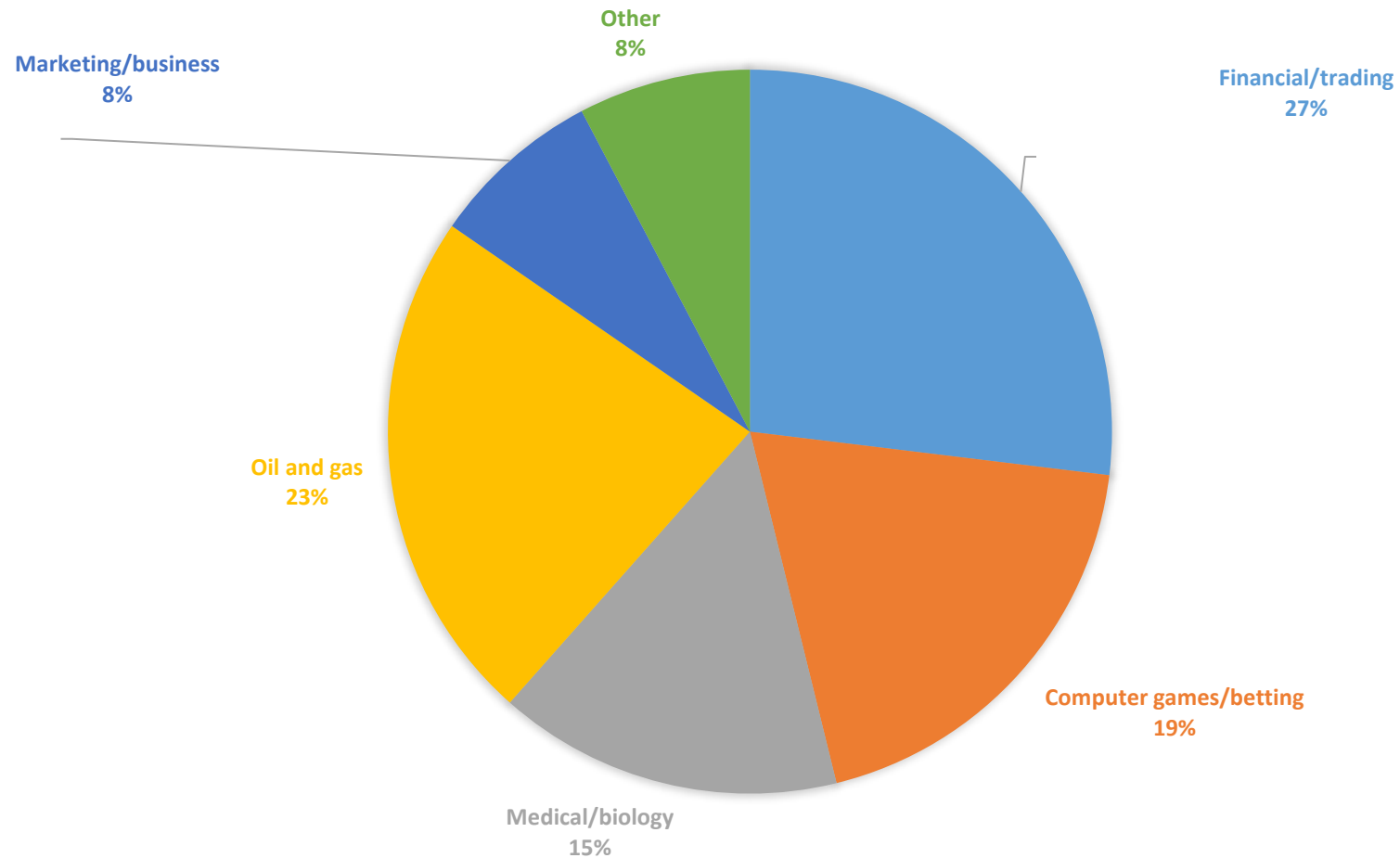
[66] ...it is implicit in the definition of “invention” that patentable subject-matter must be something with physical existence, or something that manifests a discernible effect or change.

...

[68] If these statements are meant to suggest that our understanding of the nature of the “physicality requirement” as described in paragraph 66, above, may change because of advances in knowledge, then I would agree. Nothing in the jurisprudence excludes such a possibility.

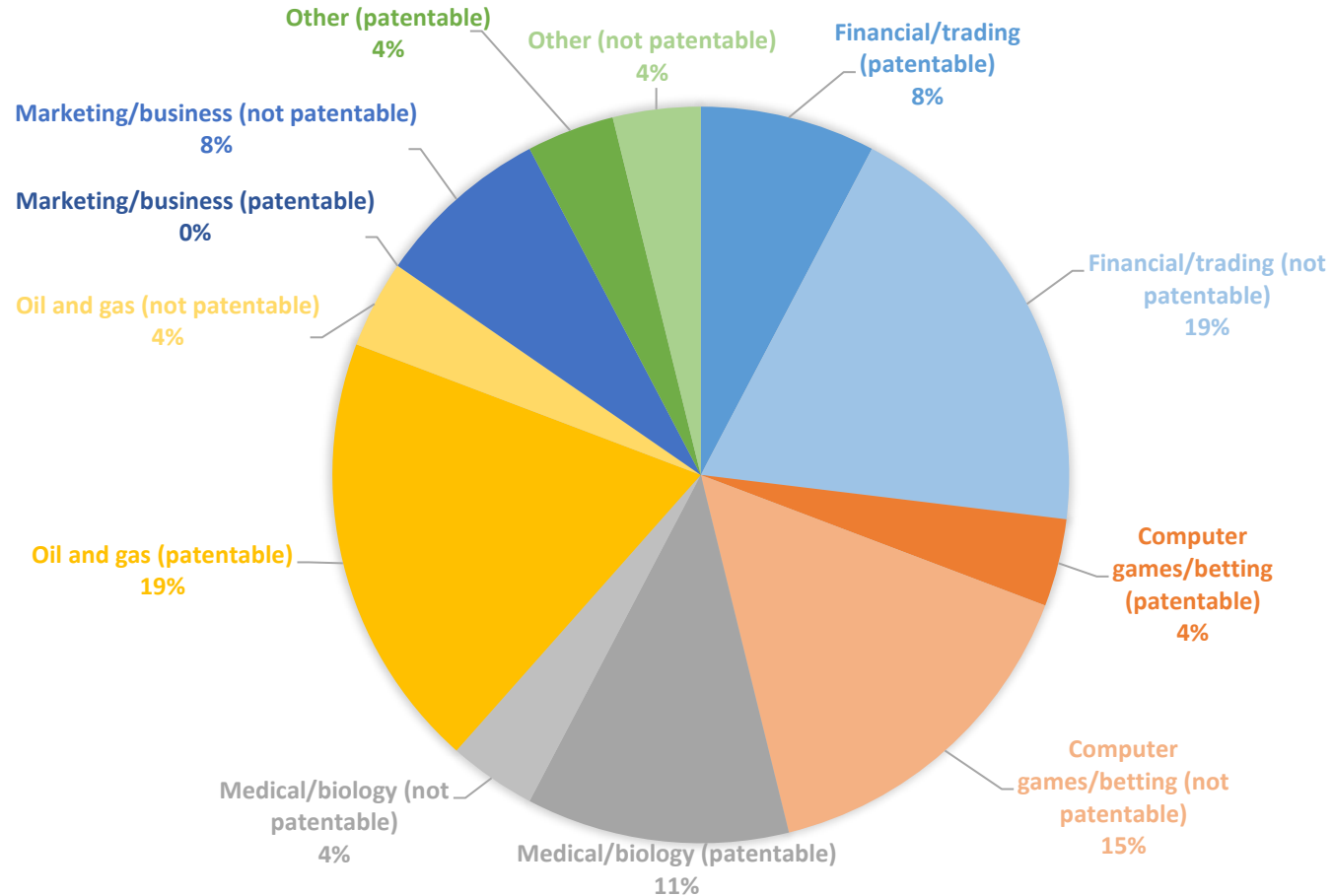
# CIPO Post-*Choueifaty*

ELIGIBILITY OF APPLICATIONS *CONSIDERED*, BY INDUSTRY



# CIPO Post-*Choueifaty*

ELIGIBILITY OF APPLICATIONS *DETERMINED* BY INDUSTRY





# *Schlumberger*

- 1982 FCA case – predates *Free World Trust* and *Whirlpool* by nearly 20 years; much more detail in underlying Commissioner’s decision
- Detailed analysis, cited with approval by FCA in *Amazon*
- Some nonetheless argue that *Schlumberger* analysis is fundamentally inconsistent with *Free World Trust* and *Whirlpool*
- *When will a computer-implemented case make it to the Supreme Court of Canada?*

# Case List

- *Attorney General of Canada v. Benjamin Moore*, 2023 FCA 168
- *Choueifaty v. Canada (Attorney General)*, 2020 FC 837
- *Attorney General of Canada v. Amazon.com*, 2011 FCA 328
- *Progressive Games v. Commissioner of Patents*, 2000 CanLII16577 (FCA)
- *Schlumberger v. Commissioner of Patents*, 1981 CanLII 4718 (FCA)
- *Schlumberger, Well Logging Data Processing Methods*, 1978 (Commissioner's Decision)