

TABLE OF CONTENTS

VOLUME 1

| | |
|---|------|
| <i>Preface to the Fifth Edition</i> | P-1 |
| <i>Table of Cases</i> | TC-1 |

CHAPTER 1 INTRODUCTION

| | |
|---|------|
| 1:1 PATENTS | 1-2 |
| 1:2 THE NATURE AND PURPOSE OF PATENTS | 1-2 |
| 1:3 THE NATURE OF THE PATENT MONOPOLY | 1-5 |
| 1:4 PATENT RIGHTS ARE OBTAINED ON APPLICATION AND ARE TERRITORIALLY LIMITED TO THE JURISDICTION GRANTING THE PATENT | 1-7 |
| 1:5 PATENTS ARE GOVERNED BY THE <i>PATENT ACT</i> | 1-7 |
| 1:6 HISTORY OF PATENTS IN ENGLISH LAW | 1-9 |
| (a) Patents and Monopolies | 1-9 |
| (b) Monopolies and the Law Courts | 1-11 |
| (c) <i>Darcy v. Allin</i> | 1-11 |
| (d) The Book of Bounty | 1-13 |
| (e) <i>Clothworkers of Ipswich Case</i> | 1-13 |
| (f) <i>Statute of Monopolies</i> | 1-14 |
| (g) British Patents Acts | 1-16 |
| 1:7 CANADIAN <i>PATENT ACT</i> | 1-17 |
| (a) Overview | 1-17 |
| (b) <i>Patent Act, 1869</i> | 1-19 |
| (c) <i>Patent Act Amendments, 1872-1923</i> | 1-21 |
| (d) <i>Patent Act, 1923</i> | 1-22 |
| (e) <i>Patent Act Amendments, 1924-1932</i> | 1-23 |
| (f) <i>Patent Act, 1935</i> | 1-24 |
| (g) War Measures — 1939-1945 | 1-24 |
| (h) <i>Patent Act Amendment Act, 1947</i> | 1-25 |
| (i) <i>Patent Act Amendment, 1949</i> — Newfoundland Joins Canada | 1-26 |
| (j) <i>Supreme Court Act Amendment, 1949</i> | 1-27 |

CANADIAN LAW OF PATENTS

| | | |
|---------------------------------|---|------------|
| (k) | <i>Patent Act</i> , R.S.C. 1952 | 1-27 |
| (l) | <i>Patent Act</i> Amendments, 1954-1969 | 1-27 |
| (m) | <i>Patent Act</i> , R.S.C. 1970 | 1-28 |
| (n) | <i>Patent Act</i> Amendments, 1970-1985 | 1-28 |
| (o) | <i>Patent Act</i> , R.S.C. 1985 | 1-28 |
| (p) | “ <i>Patent Act, 1985</i> ” — the “ <i>Old Act</i> ” | 1-28 |
| 1:8 | THE <i>PATENT ACT</i> SINCE 1989..... | 1-30 |
| (a) | Amendments to the <i>Patent Act</i> effective October 1, 1989..... | 1-30 |
| (b) | <i>Patent Act Amendment, 1992</i> | 1-33 |
| (c) | <i>Patent Act Amendment, 1993</i> | 1-34 |
| (d) | NAFTA..... | 1-36 |
| (e) | “ <i>Patent Act, 1996</i> ” | 1-36 |
| (f) | Other Amendments..... | 1-40 |
| 1:9 | WHICH <i>PATENT ACT</i> APPLIES — TRANSITION PROVISIONS..... | 1-41 |
| (a) | Patent Applications Filed Before October 1, 1989..... | 1-41 |
| (b) | Patents Issued Before October 1, 1989..... | 1-41 |
| (c) | Patents Issued on or After October 1, 1989 on the Basis of Previously Filed Applications..... | 1-41 |
| (d) | Conflicts Between an <i>Old Act</i> Application and a Later Application | 1-42 |
| (e) | Patent Applications Filed on or After October 1, 1989, but Before October 1, 1996..... | 1-42 |
| (f) | Patents Issued on or After October 1, 1989 Based on Applications Filed on or After October 1, 1989, but Before October 1, 1996..... | 1-42 |
| (g) | Patent Applications Filed on or After October 1, 1996..... | 1-42 |
| (h) | Patents Issued on or After October 1, 1996..... | 1-42 |
| 1:10 | THE <i>PATENT RULES</i> | 1-43 |
| 1:11 | <i>PATENTED MEDICINES (NOTICE OF COMPLIANCE)</i> <i>REGULATIONS</i> | 1-45 |
| 1:12 | <i>STATUTE OF MONOPOLIES</i> IN CANADA | 1-47 |
| CHAPTER 2 INVENTION..... | | 2-1 |
| 2:1 | PATENT GRANTED FOR INVENTION..... | 2-1 |
| 2:2 | “INVENTION” | 2-1 |
| 2:3 | “INVENTION” AS DEFINED AND USED IN THE <i>PATENT</i> <i>ACT</i> | 2-2 |
| 2:4 | “INVENTION” — INVENTIVE INGENUITY, NOT OBVIOUS | 2-3 |
| 2:5 | THE INVENTIVE ACT | 2-4 |
| 2:6 | THE IDEA LEADING TO AN INVENTION | 2-5 |
| 2:7 | DISCOVERY AND INVENTION | 2-6 |
| 2:8 | ACCIDENTAL DISCOVERY | 2-8 |
| 2:9 | MAKING AN INVENTION — MERE CONCEPTION IS INSUFFICIENT..... | 2-9 |

TABLE OF CONTENTS

| | | |
|--|---|------------|
| 2:10 | DATE OF INVENTION..... | 2-10 |
| 2:11 | INVENTOR..... | 2-16 |
| | (a) Historical Background..... | 2-16 |
| | (b) “Inventor” Under the Current <i>Patent Act</i> | 2-18 |
| CHAPTER 3 THE SUBJECT MATTER OF PATENTS | | 3-1 |
| 3:1 | INTRODUCTION..... | 3-2 |
| | (a) Patentable Subject-Matter..... | 3-3 |
| | (b) Statutory Provisions..... | 3-4 |
| | (c) Patentability of the Claimed Subject-Matter..... | 3-5 |
| 3:2 | DEVELOPMENT OF THE REQUIREMENTS FOR PATENTABLE SUBJECT-MATTER..... | 3-6 |
| | (a) Introduction..... | 3-6 |
| | (b) Development of U.K. Requirements for Patentable Subject-Matter..... | 3-7 |
| | (c) Development of U.S. Requirements for Patentable Subject-Matter..... | 3-12 |
| | (d) Development of Requirements for Patentable Subject-Matter in Canadian Law..... | 3-17 |
| 3:3 | “ART”, “PROCESS”, “MACHINE”, “MANUFACTURE”, “COMPOSITION OF MATTER”..... | 3-23 |
| | (a) “Art”..... | 3-23 |
| | (b) “Process”..... | 3-31 |
| | (c) “Machine”..... | 3-33 |
| | (d) “Manufacture”..... | 3-33 |
| | (e) “Composition of Matter”..... | 3-34 |
| 3:4 | PRINCIPLES AND THEOREMS..... | 3-36 |
| | (a) A Mere Principle is Not Patentable, but a Practical Application of a Principle can be Patentable Subject- Matter..... | 3-36 |
| | (b) Knowledge of the Scientific Principle Underlying an Invention is Unnecessary..... | 3-38 |
| 3:5 | COMBINATIONS..... | 3-38 |
| | (a) General..... | 3-38 |
| | (b) Common Result Essential..... | 3-39 |
| | (c) Combination and Aggregation Distinguished..... | 3-41 |
| | (d) Novelty of Elements Immaterial..... | 3-44 |
| | (e) Omission and Addition..... | 3-45 |
| | (f) Arrangement of Parts..... | 3-47 |
| 3:6 | PROCESS..... | 3-47 |
| | (a) General Statement..... | 3-47 |
| | (b) New or Old Result..... | 3-48 |
| | (c) Addition, Omission and Variation..... | 3-49 |
| | (d) New Use..... | 3-49 |
| | (e) Analogous Purposes..... | 3-50 |
| | (f) Chemical Processes..... | 3-51 |

CANADIAN LAW OF PATENTS

| | | |
|-----------------------------------|---|------------|
| (g) | Mental Steps | 3-51 |
| (h) | Professional Skills | 3-52 |
| (i) | Method of Medical or Surgical Treatment..... | 3-53 |
| (j) | Non-Medical Treatment of Humans | 3-60.1 |
| 3:7 | PRODUCTS AND SUBSTANCES | 3-60.1 |
| (a) | General | 3-60.1 |
| (b) | Non-Obviousness, Novelty, Utility | 3-62 |
| (c) | Products Intended for Food and Medicine..... | 3-62 |
| (d) | Signals | 3-63 |
| 3:8 | BIOTECHNOLOGY..... | 3-63 |
| (a) | Biochemical and Biological Inventions..... | 3-63 |
| (b) | Lower Life Forms | 3-67 |
| (c) | Higher Life Forms..... | 3-69 |
| (d) | The Line Between Lower Life Forms and Higher Life Forms..... | 3-70 |
| (e) | Animals..... | 3-70 |
| (f) | Plants..... | 3-72 |
| 3:9 | COMPUTER PROGRAMS — DATA PROCESSING SYSTEMS | 3-76 |
| 3:10 | OTHER MATHEMATICAL FORMULAS | 3-82.1 |
| 3:11 | BUSINESS METHODS, PLANS AND SYSTEMS..... | 3-83 |
| 3:12 | SELECTION | 3-91 |
| 3:13 | IMPROVEMENTS | 3-101 |
| 3:14 | UNPATENTABLE MATTER | 3-102 |
| 3:15 | INDUSTRIAL DESIGNS | 3-103 |
| 3:16 | COPYRIGHT | 3-104 |
| 3:17 | INTEGRATED CIRCUIT TOPOGRAPHIES | 3-106 |
| 3:18 | TRADE MARKS | 3-106 |
| 3:19 | CONCLUSION RE DESIGNS, COPYRIGHT, TOPOGRAPHIES, TRADE MARKS | 3-107 |
| 3:20 | DANGEROUS INVENTIONS, ETHICALLY QUESTIONABLE INVENTIONS, IMMORAL OBJECTS | 3-107 |
| CHAPTER 4 OBVIOUSNESS..... | | 4-1 |
| 4:1 | OVERVIEW | 4-3 |
| 4:2 | OBVIOUSNESS IS DIFFERENT FROM ANTICIPATION..... | 4-5 |
| 4:3 | DEVELOPMENT OF THE REQUIREMENT FOR NON-OBVIOUSNESS | 4-8 |
| (a) | Development of the Requirement for Non-Obviousness — Introduction | 4-8 |
| (b) | Development of United Kingdom Requirement for Non-Obviousness — Overview | 4-9 |
| (c) | Development of the U.S. Requirement for Obviousness | 4-16 |
| (d) | Development of the Requirement for Obviousness in Canadian Law | 4-20 |

TABLE OF CONTENTS

| | | |
|------|---|------|
| 4:4 | TEST FOR OBVIOUSNESS OR LACK OF INVENTION UNDER THE <i>OLD ACT</i> | 4-32 |
| | (a) Test is Obviousness | 4-32 |
| | (b) <i>Old Act</i> Test as a Series of Questions | 4-33 |
| 4:5 | STATUTORY TEST FOR OBVIOUSNESS UNDER THE CURRENT <i>ACT</i> | 4-36 |
| | (a) <i>Patent Act</i> , Section 28.3 | 4-36 |
| | (b) Obviousness Test Under Section 28.3 as a Series of Questions..... | 4-37 |
| 4:6 | THE SUBJECT-MATTER DEFINED BY THE CLAIM IN ISSUE | 4-39 |
| 4:7 | THE RELEVANT DATE FOR OBVIOUSNESS UNDER THE <i>OLD ACT</i> — DATE OF INVENTION | 4-40 |
| | (a) Proof of Actual Date of Invention | 4-41 |
| | (b) Constructive Date of Invention — Filing Date or Priority Date..... | 4-41 |
| 4:8 | RELEVANT DATE FOR OBVIOUSNESS UNDER THE CURRENT <i>ACT</i> — CLAIM DATE..... | 4-42 |
| 4:9 | PRIOR ART TO BE CONSIDERED UNDER THE <i>OLD ACT</i> | 4-44 |
| 4:10 | PRIOR ART TO BE CONSIDERED UNDER THE CURRENT <i>ACT</i> | 4-44 |
| | (a) Information Disclosed More than One Year Before the Filing Date By or From the Applicant..... | 4-44 |
| | (b) Information Disclosed Before the Claim Date By Other Persons..... | 4-46 |
| | (c) Disclosed in such a Manner that the Information Became Available to the Public..... | 4-46 |
| 4:11 | OTHER ISSUES REGARDING THE ART TO BE CONSIDERED IN DETERMINING OBVIOUSNESS | 4-50 |
| | (a) Disclosure as Understood by a Person Skilled in the Art | 4-50 |
| | (b) All of the Relevant Art..... | 4-52 |
| | (c) Art Cited in the Patent | 4-55 |
| | (d) Art Cited During the Prosecution of the Patent Application | 4-56 |
| | (e) Post-Art — Art After the Relevant Date..... | 4-56 |
| | (f) Information Outside the Field of the Person Skilled in the Art | 4-57 |
| | (g) Age of the Prior Art | 4-60 |
| | (h) Paper References..... | 4-61 |
| | (i) Relevance of a Diligent Search | 4-62 |
| | (j) How the Art Was Located | 4-65 |
| | (k) Tests Concerning the Prior Art | 4-66 |
| 4:12 | EXPERT EVIDENCE AS TO THE PRIOR ART | 4-66 |
| 4:13 | THE PERSON SKILLED IN THE ART | 4-68 |
| | (a) Identify the Person Skilled in the Art..... | 4-68 |

CANADIAN LAW OF PATENTS

| | | |
|------|--|---------|
| | (b) A Notional Person | 4-68 |
| | (c) Qualities and Capabilities of the Person Skilled in the Art | 4-72 |
| | (d) Expert Evidence as to the Qualities and Capabilities of the Person Skilled in the Art | 4-78 |
| 4:14 | COMMON GENERAL KNOWLEDGE IN THE ART | 4-79 |
| | (a) Relevance of the Common General Knowledge in the Art | 4-79 |
| | (b) What is the Common General Knowledge in the Art | 4-80 |
| 4:15 | CONSTRUE THE CLAIM AND IDENTIFY THE INVENTIVE CONCEPT OF THE CLAIM WHERE APPROPRIATE..... | 4-85 |
| | (a) “Inventive Concept” in U.K. Law | 4-86 |
| | (b) The Introduction of “Inventive Concept” into Canadian Law | 4-87 |
| | (c) The Inventive Concept — General Principles | 4-89 |
| | (d) Step 2 in Relation to Patents Governed by the <i>Old Act</i> | 4-94 |
| | (e) Step 2 in Relation to Patents Governed by Section 28.3 of the <i>Current Act</i> | 4-94 |
| 4:16 | DIFFERENCES BETWEEN THE STATE OF THE ART AND THE CLAIM AS CONSTRUED AND THE INVENTIVE CONCEPT WHERE APPROPRIATE..... | 4-94 |
| 4:17 | DETERMINATION OF OBVIOUSNESS..... | 4-97 |
| | (a) Overview of Determination of Obviousness | 4-97 |
| | (b) An Objective Test | 4-100 |
| | (c) There Must be Invention | 4-103 |
| | (d) Obvious to Try | 4-105 |
| | (e) Directly and Without Difficulty | 4-112.1 |
| | (f) Other Statements of the Test of Obviousness..... | 4-113 |
| | (g) Question of Fact | 4-117 |
| | (h) Mechanical Skill | 4-119 |
| | (i) Obviousness is to be Determined at the Relevant Date..... | 4-120 |
| | (j) Caution Concerning Hindsight..... | 4-121 |
| | (k) Relevance of Other Factors | 4-124 |
| 4:18 | VARIOUS FACTORS AND THEIR RELEVANCE TO THE DETERMINATION OF OBVIOUSNESS..... | 4-125 |
| | (a) Is it More or Less Self-Evident that What is Being Tried Ought to Work?..... | 4-125 |
| | (b) Motive to find the Solution the Patent Addresses | 4-126.1 |
| | (c) The Manner of Making the Invention | 4-130 |
| | (d) The Extent, Nature and Amount of Effort Required to Achieve the Invention | 4-135 |
| | (e) Simplicity | 4-138 |
| | (f) Utility | 4-141 |
| | (g) The Climate in the Art — Teaching Away or Prejudice | 4-142 |
| | (h) If Obvious, Why Was it Not Done Before?..... | 4-144 |
| | (i) Commercial Success | 4-148 |
| | (j) Activities of Others and the Reception of the Invention..... | 4-162 |
| | (k) Meritorious Awards and Industry Praise | 4-166 |

TABLE OF CONTENTS

| | |
|--|------------|
| (l) Patents | 4-166 |
| (m) Combination of Factors | 4-167 |
| 4:19 RELEVANCE OF THE FILE RECORD OR FILE WRAPPER | 4-169 |
| 4:20 EXPERT EVIDENCE AS TO OBVIOUSNESS | 4-170 |
| 4:21 SOME SPECIFIC APPLICATIONS OF THE TEST FOR OBVIOUSNESS | 4-172 |
| (a) Combinations | 4-172 |
| (b) New Product or Other New Result Produced by a Known Process Using Known Materials..... | 4-177 |
| (c) Process..... | 4-179 |
| (d) Application of Known but Recently Disclosed Technology..... | 4-180 |
| (e) Obviousness of a Member of a Claimed Class..... | 4-180 |
| (f) New Use for an Old Product or Process | 4-181 |
| (g) Product for a New Use..... | 4-182 |
| (h) Selection..... | 4-183 |
| (i) Omission | 4-189 |
| (j) Size, Shape, Material, Proportions | 4-189 |
| (k) Composition..... | 4-191 |
| (l) Idea | 4-191 |
| CHAPTER 5 NOVELTY..... | 5-1 |
| 5:1 THE REQUIREMENT OF NOVELTY — ESSENTIAL NATURE OF NOVELTY..... | 5-3 |
| 5:2 ANTICIPATION, LACK OF NOVELTY, IS DIFFERENT FROM OBVIOUSNESS..... | 5-6 |
| 5:3 DEVELOPMENT OF THE REQUIREMENTS FOR NOVELTY | 5-8 |
| (a) Development of the Requirements for Novelty in the Laws of the United Kingdom | 5-8 |
| (b) Development of the Requirements for Novelty in Canadian Law | 5-11 |
| 5:4 STATEMENTS OF THE TEST FOR ANTICIPATION | 5-13 |
| 5:5 THE STATUTORY REQUIREMENTS FOR NOVELTY UNDER THE CURRENT ACT | 5-18 |
| 5:6 REFERENCE CONSIDERED INDIVIDUALLY — NO MOSAIC | 5-19 |
| 5:7 THE SUBJECT MATTER DEFINED BY THE CLAIM IN ISSUE..... | 5-20 |
| 5:8 THE RELEVANT DATES | 5-22 |
| 5:9 THE PERSON SKILLED IN THE ART | 5-23 |
| 5:10 COMMON GENERAL KNOWLEDGE IN THE ART | 5-24 |
| 5:11 DISCLOSURE IN SUCH A MANNER THAT THE SUBJECT-MATTER BECAME AVAILABLE TO THE PUBLIC..... | 5-24 |
| (a) Available to the Public..... | 5-24 |
| (b) Art Cited in The Patent | 5-30 |

CANADIAN LAW OF PATENTS

| | | |
|------|---|--------|
| | (c) Enabling Disclosure | 5-30 |
| 5:12 | DISCLOSURE..... | 5-31 |
| | (a) Disclosure — General Considerations | 5-31 |
| | (b) The Same Invention..... | 5-32 |
| | (c) What Would Infringe if Later Will Anticipate if Earlier | 5-37 |
| | (d) Disclosure as Understood by a Person Skilled in the Art | 5-39 |
| | (e) Without Experimentation | 5-40 |
| | (f) Without Invention | 5-41 |
| 5:13 | ENABLEMENT..... | 5-42 |
| 5:14 | DISCLOSURE BY PUBLIC USE OR SALE..... | 5-45 |
| | (a) Public Use or Sale..... | 5-46 |
| | (b) Same Invention..... | 5-49 |
| | (c) Analogous Use | 5-51 |
| | (d) Enabling Disclosure..... | 5-52 |
| | (e) Impractical or Inoperable Device..... | 5-53 |
| | (f) Secret Use | 5-53 |
| | (g) Experimental Use | 5-54 |
| | (h) Method or Result | 5-62 |
| | (i) Accidental Use | 5-62 |
| 5:15 | DISCLOSURE BY A PATENT, PUBLICATION OR OTHER DESCRIPTION | 5-62.2 |
| | (a) Prior Description | 5-62.2 |
| | (b) Public Accessibility | 5-70 |
| | (c) No Mosaic of Documents | 5-71 |
| | (d) Language | 5-74 |
| | (e) Construction | 5-74 |
| | (f) Photograph or Drawing | 5-77 |
| | (g) Oral Disclosure | 5-78 |
| | (h) Same Invention..... | 5-79 |
| | (i) Sufficiency of Description..... | 5-81 |
| | (j) Experiments | 5-83 |
| | (k) Exact Prior Description | 5-85 |
| | (l) Directions Which Will Inevitably Result in Claimed Subject-Matter | 5-86 |
| | (m) Enabling Disclosure..... | 5-90.1 |
| | (n) Similarity of Language..... | 5-92 |
| | (o) Use Unnecessary..... | 5-93 |
| | (p) “Paper Anticipation”..... | 5-94 |
| | (q) A Document Which is Not an Anticipation May Provide Evidence of Obviousness..... | 5-96 |
| 5:16 | DISCLOSURE BY APPLICANT MORE THAN ONE YEAR BEFORE FILING DATE..... | 5-97 |
| | (a) “Applicant”..... | 5-97 |
| | (b) One Year before Filing Date | 5-98 |
| | (c) Disclosure..... | 5-99 |
| 5:17 | CO-PENDING PATENT APPLICATIONS — SECTION 28.2(1)(c),(d) | 5-100 |

TABLE OF CONTENTS

| | | |
|------|---|------------|
| 5:18 | CONSIDERATION OF NOVELTY IN SPECIFIC SITUATIONS..... | 5-101 |
| | (a) Combinations | 5-101 |
| | (b) Process..... | 5-102 |
| | (c) Chemical Product..... | 5-102 |
| | (d) Claims to a Product Made by a Particular Process, Machine or Instrument..... | 5-103 |
| | (e) New Use | 5-105 |
| | (f) Product for a New Use..... | 5-106 |
| | (g) Enantiomers | 5-108 |
| | (h) Selection Patents | 5-109 |
| | (i) Novelty in Part | 5-114 |
| | (j) Re-Discovery..... | 5-115 |
| | (k) Confidential Communications..... | 5-116 |
| | (l) Alternatives..... | 5-117 |
| 5:19 | EVIDENCE OF NOVELTY | 5-117 |
| 5:20 | THE STATUTORY REQUIREMENTS FOR NOVELTY UNDER THE <i>OLD ACT</i> | 5-119 |
| 5:21 | KNOWLEDGE OR USE PRIOR TO THE INVENTION — <i>OLD ACT</i> SECTIONS 27(1)(a) AND 61 | 5-122 |
| | (a) Invention Date..... | 5-123 |
| | (b) Knowledge or Use Prior to Invention Date | 5-124 |
| | (c) Section 61..... | 5-126 |
| | (d) Disclosure so Available to the Public Before Filing Date — Section 61(1)(a)..... | 5-127 |
| | (e) Prior Actual or Notional Co-pending Application as to which Conflict Should Have Been Directed — Section 61(b) and (c)..... | 5-127 |
| | (f) When Section 61(1) Does Not Apply — Section 61(3)..... | 5-131 |
| 5:22 | DESCRIPTION IN A PATENT OR PRINTED PUBLICATION TWO YEARS BEFORE CANADIAN FILING DATE — SECTIONS 27(1)(B) AND 28(2)..... | 5-132 |
| | (a) Printed Publication | 5-132 |
| | (b) Anticipation Under Sections 27(1)(b) and 28(2)..... | 5-134 |
| 5:23 | PUBLIC USE OR ON SALE IN CANADA TWO YEARS BEFORE CANADIAN FILING DATE — SECTIONS 27(1)(C) AND 28(2)..... | 5-136 |
| 5:24 | PRIOR FOREIGN GRANT — SECTION 27(2)..... | 5-139 |
| 5:25 | THE STATUTORY REQUIREMENTS FOR NOVELTY FOR APPLICATIONS FILED BETWEEN OCTOBER 1, 1989 AND SEPTEMBER 30, 1996 AND PATENTS THEREFROM..... | 5-141 |
| | CHAPTER 6 UTILITY | 6-1 |
| | 6:1 INTRODUCTION | 6-1 |
| | 6:2 HISTORICAL | 6-3 |

CANADIAN LAW OF PATENTS

| | | |
|---|---|------------|
| 6:3 | UTILITY OF THE INVENTION AS DESCRIBED AND CLAIMED..... | 6-4 |
| 6:4 | UTILITY TO BE ASSESSED AT THE FILING DATE | 6-6 |
| 6:5 | UTILITY | 6-7 |
| 6:6 | QUANTUM..... | 6-10 |
| 6:7 | DISADVANTAGES OR DANGEROUS RESULT | 6-11 |
| 6:8 | IMMORAL OBJECTS | 6-12 |
| 6:9 | UTILITY AS SPECIFIED | 6-13 |
| 6:10 | PROMISED RESULTS..... | 6-16 |
| 6:11 | STATEMENT OF ADVANTAGES | 6-24 |
| 6:12 | UTILITY IN PART..... | 6-25 |
| 6:13 | UTILITY AT THE FILING DATE | 6-26 |
| | (a) Demonstrated Utility..... | 6-29 |
| | (b) Sound Prediction of Utility | 6-31 |
| 6:14 | CLAIM IN-UTILITY..... | 6-44.2 |
| | (a) Claims to a Class Containing Products or Processes Which are Not Useful..... | 6-45 |
| | (b) Claims to a Broad Class..... | 6-49 |
| | (c) Claim to a Product or Process which Omits an Essential Element..... | 6-52 |
| 6:15 | IMPROVEMENT PATENTS | 6-53 |
| 6:16 | SELECTION PATENTS | 6-53 |
| 6:17 | EVIDENCE OF UTILITY | 6-56 |
| | (a) In General..... | 6-56 |
| | (b) Infringement as Evidence of Utility | 6-57 |
| | (c) Commercial Success | 6-57 |
| CHAPTER 7 THE SPECIFICATION..... | | 7-1 |
| 7:1 | INTRODUCTION | 7-2 |
| 7:2 | HISTORICAL | 7-3 |
| | (a) Development of the Requirement for a Specification in the U.K. | 7-3 |
| | (b) Evolution of Canadian Statutory Provisions as to the Specification..... | 7-5 |
| 7:3 | STATUTORY PROVISIONS..... | 7-9 |
| 7:4 | PERSON SKILLED IN THE ART..... | 7-11 |
| 7:5 | COMMON GENERAL KNOWLEDGE IN THE ART | 7-14 |
| 7:6 | RELEVANT DATE..... | 7-14 |
| 7:7 | THE SPECIFICATION | 7-17 |
| 7:8 | DESCRIPTION OF THE INVENTION AND ITS OPERATION AND USE | 7-19 |
| | (a) General Principles | 7-19 |
| | (b) Nature of the Invention | 7-26 |
| | (c) Operation and Use of the Invention | 7-32 |
| | (d) Standards for Disclosure..... | 7-38 |
| | (i) General Points | 7-38 |

TABLE OF CONTENTS

| | | |
|-------|--|--------|
| (ii) | As Contemplated by the Inventor | 7-41 |
| (iii) | Best Mode — Machines | 7-46 |
| (iv) | Best Mode — Other Inventions | 7-47 |
| (e) | Necessity for Experiments..... | 7-49 |
| (f) | Reference to Previous Documents | 7-58 |
| (g) | Clarity..... | 7-58 |
| (i) | Ambiguity..... | 7-60 |
| (ii) | Errors and Inaccuracies | 7-64 |
| (iii) | Definition of Materials | 7-66 |
| (iv) | Proportions of Ingredients..... | 7-64 |
| (h) | Good Faith..... | 7-69 |
| (i) | Misleading Matter | 7-72 |
| (j) | Failure to Meet the Disclosure Requirements..... | 7-73 |
| 7:9 | DESCRIPTION REQUIREMENTS IN SPECIFIC SITUATIONS | 7-74 |
| (a) | Description of Known Matter | 7-74 |
| (b) | Matter Necessarily Implied..... | 7-75 |
| (c) | Size or Shape | 7-75 |
| (d) | Utility | 7-75 |
| (e) | Sound Prediction of Utility | 7-80 |
| (f) | Selection Patents | 7-81 |
| (g) | Biological Material | 7-84 |
| (h) | Distinction Between Old and New Matter..... | 7-87 |
| (i) | Principle..... | 7-88 |
| 7:10 | THE DRAWINGS..... | 7-89 |
| 7:11 | THE CLAIMS | 7-91 |
| (a) | The Nature and Function of the Claims..... | 7-91 |
| (b) | Clarity of Language..... | 7-94.1 |
| (c) | Definition of the Ambit of the Monopoly | 7-102 |
| (d) | Claims Broader than the Invention | 7-107 |
| (i) | General Principle..... | 7-107 |
| (ii) | Claims Broader than the Invention Made..... | 7-108 |
| (iii) | Claims Broader than the Invention Disclosed in the Specification..... | 7-111 |
| (iv) | Claims Broader than the Scope Enabled | 7-116 |
| (v) | Consistory Clauses or Aspects Paragraphs | 7-120 |
| (vi) | Claims Too Broad for Other Reasons | 7-121 |
| 7:12 | THE ABSTRACT | 7-123 |

VOLUME 2

| | | |
|------------------|--|------------|
| CHAPTER 8 | CONSTRUCTION OF A PATENT..... | 8-1 |
| 8:1 | THE FIRST DUTY OF THE COURT IS TO CONSTRUE THE PATENT | 8-3 |
| 8:2 | CONSTRUCTION OF THE PATENT IS AN ISSUE OF LAW FOR THE COURT | 8-5 |

CANADIAN LAW OF PATENTS

| | | |
|-----|---|------|
| 8:3 | CONSTRUCTION OF A PATENT IS SIMILAR TO BUT DISTINCT FROM THE CONSTRUCTION OF OTHER WRITTEN INSTRUMENTS..... | 8-7 |
| 8:4 | HISTORICAL DEVELOPMENT OF THE RULES OF CONSTRUCTION OF PATENTS..... | 8-10 |
| | (a) Development of the Rules of Construction of Patents in the United Kingdom Prior to 1981 | 8-10 |
| | (b) Further Development of the Rules of Construction of Patents in the United Kingdom..... | 8-15 |
| | (c) Further Development of the Rules of Construction of Patents in Canada | 8-27 |
| 8:5 | GENERAL PRINCIPLES | 8-33 |
| | (a) Approach to Patent Construction..... | 8-33 |
| | (b) The Role of the Description and Any Drawings..... | 8-34 |
| | (c) The Abstract is Not to be Considered in Construing the Patent..... | 8-34 |
| | (d) The Function of the Claims..... | 8-35 |
| 8:6 | RULES OF CONSTRUCTION..... | 8-37 |
| | (a) A Patent is to be Construed as at the Date of Publication of the Patent..... | 8-38 |
| | (b) A Patent is to be Construed on the Basis that the Addressee is a Person of Ordinary Skill in the Art and the Knowledge that Such Person is Expected to Possess is to be Taken into Consideration | 8-40 |
| | (i) A Patent is to be Construed on the Basis that the Addressee is a Person of Ordinary Skill in the Art | 8-40 |
| | (ii) The Person Skilled in the Art | 8-42 |
| | (iii) The Common General Knowledge in the Art at the Material Date..... | 8-44 |
| | (iv) The Appropriate Approach in Light of Expert Evidence as to the Understanding of the Skilled Person..... | 8-46 |
| | (v) Some Examples of Application of this Rule..... | 8-47 |
| | (c) A Patent is to be Construed Having Regard to the Factual Matrix at the Publication Date of the Patent..... | 8-48 |
| | (d) A Patent Specification is to be Read and Construed as a Whole | 8-49 |
| | (e) A Patent is to be Construed Objectively | 8-51 |
| | (f) A Patent is to be Construed Without Reference to Extrinsic Evidence..... | 8-52 |
| | (g) The Same Principles of Construction Apply to All Patents | 8-57 |
| | (h) A Patent is to be Given a “Purposive Construction” | 8-57 |
| | (i) A Patent is to be Read Fairly with a Mind Willing to Understand..... | 8-60 |
| | (j) The Language of the Patent Specification Should be Interpreted in its Context Having Regard to the Meaning of Technical Terms, the Ordinary Meaning of Non-Technical Words and any Particular Definitions Provided by the Inventor in the Patent..... | 8-66 |

TABLE OF CONTENTS

| | | |
|-----|--|---------|
| (k) | If Possible, a Patent is to be Construed to Avoid an Absurd or Unreasonable Result | 8-69 |
| (l) | The Whole of Each Claim is to be Considered | 8-70 |
| (m) | The Claims are to be Construed in Light of the Whole Specification, but Plain Language is not to be Expanded or Restricted By Stray References in the Disclosure | 8-72 |
| (n) | There Should be Consistency of Interpretation Amongst the Claims. Each Claim is, if Possible, to be Given a Distinct Meaning | 8-86 |
| (o) | The Claims Language Will, on a Purposive Construction, Show that Some Elements of the Claimed Invention are Essential While Others are Non-Essential | 8-88 |
| | (i) Purposive Construction..... | 8-88 |
| | (ii) Purposive Construction — Consideration of Variants..... | 8-90 |
| | (iii) Essential Elements..... | 8-91 |
| | (iv) Examples of Determination of Essential and Non-Essential Elements..... | 8-95 |
| | (v) Different Direction in U.K. Law Since <i>Kirin-Amgen</i> | 8-106 |
| (p) | The Court Must Construe the Claims, Not Redraft Them | 8-107 |
| (q) | What is Not Claimed is Disclaimed..... | 8-108 |
| 8:7 | SOME ISSUES CONCERNING CONSTRUCTION OF THE SPECIFICATION..... | 8-110 |
| | (a) The Promise of the Patent, if Any | 8-110 |
| | (b) New Result or New Method of Producing a Known Result | 8-114.1 |
| | (c) Single or Multiple Inventions | 8-116 |
| | (d) Alternatives..... | 8-120 |
| | (e) Reference Numbers in the Claims | 8-123 |
| | (f) Dependent Claims | 8-124 |
| | (i) Reference to Antecedent Claims..... | 8-124 |
| | (ii) Included Element or Additional Element | 8-126 |
| | (g) Other Claims Which Refer to Another Claim | 8-127 |
| | (h) Numerical Limitations in the Claims..... | 8-128 |
| | (i) New Technology..... | 8-132 |
| 8:8 | TYPES OF CLAIMS | 8-134 |
| | (a) Product Claims | 8-134 |
| | (b) Product by Process Claims..... | 8-135 |
| | (c) “Swiss” Form Claims | 8-136 |
| | (d) Jepson Claims | 8-138 |
| | (e) “Markush” Claims | 8-139 |
| 8:9 | SPECIFIC TERMS..... | 8-140 |
| | (a) “About” | 8-140 |
| | (a.1) “Approximately” | 8-141 |
| | (b) “Comprising” | 8-142 |
| | (c) “For” | 8-142 |
| | (d) Functional Claims | 8-145 |
| | (e) “Obvious Chemical Equivalent” | 8-146 |
| | (f) Pharmaceutical Preparation..... | 8-148 |

CANADIAN LAW OF PATENTS

| | |
|--|-------------|
| (g) “Treatment” | 8-148 |
| (h) Relative Terms | 8-149 |
| 8:10 THE ROLE OF EXPERTS IN THE CONSTRUCTION OF A PATENT..... | 8-150 |
| 8:11 CONSIDERATION OF PATENT CONSTRUCTION ON APPEAL | 8-158 |
| 8:12 PATENT CONSTRUCTION WHERE THE PATENT WAS CONSTRUED IN A PRIOR DECISION | 8-159 |
| CHAPTER 9 APPLICATION FOR A PATENT | 9-1 |
| 9:1 INTRODUCTION | 9-3 |
| 9:2 THE PATENT OFFICE AND THE COMMISSIONER OF PATENTS | 9-4 |
| (a) The Patent Office and the Commissioner of Patents | 9-4 |
| (b) Manual of Patent Office Practice (“MOPOP”)..... | 9-6 |
| (c) Communications with the Patent Office..... | 9-6 |
| 9:3 PATENT AGENTS | 9-11 |
| PART I — APPLICATIONS FILED ON OR AFTER OCTOBER 1, 1989..... | 9-12 |
| 9:4 APPLICATION BY THE INVENTOR OR THE INVENTOR’S LEGAL REPRESENTATIVE..... | 9-12 |
| 9:5 THE INVENTOR AND THE INVENTOR’S LEGAL REPRESENTATIVES..... | 9-14 |
| (a) Inventor..... | 9-14 |
| (b) Legal Representative..... | 9-15 |
| 9:6 JOINT INVENTORS AND APPLICANTS..... | 9-16 |
| (a) Effect of Refusal of a Joint Inventor to Proceed with an Application | 9-16.3 |
| (b) Procedure When it Appears that One Joint Applicant Had No Part in the Invention..... | 9-17 |
| (c) Joining Persons Who Should Have Been Joined as Applicants..... | 9-17 |
| (d) Power of the Commissioner to Permit a Beneficial Owner of an Invention to Proceed with an Application | 9-17 |
| (e) Power of the Commissioner to Permit One Joint Applicant to Proceed with an Application..... | 9-18 |
| (f) Appeal from a Decision of the Commissioner Under Section 31..... | 9-18 |
| (g) Ownership Rights of Joint Inventors | 9-18 |
| (h) Consequences of Mis-naming Inventors..... | 9-18 |
| (i) Changing the Inventors Named in an Issued Patent | 9-21 |

TABLE OF CONTENTS

| | | |
|------|--|------|
| 9:7 | APPOINTMENT OF PATENT AGENTS..... | 9-22 |
| 9:8 | APPOINTMENT OF A REPRESENTATIVE BY A NON-RESIDENT APPLICANT..... | 9-23 |
| 9:9 | TIME..... | 9-24 |
| 9:10 | FEES | 9-27 |
| | (a) General | 9-27 |
| | (b) Fees for “Small Entity” Applicants..... | 9-29 |
| | (1) Reduced Fees for a “Small Entity” | 9-29 |
| | (2) <i>Dutch Industries v. Commissioner of Patents</i> and Legislative Correction | 9-30 |
| | (3) Current Status for Small Entities | 9-31 |
| | (c) Maintenance Fees..... | 9-32 |
| | (d) <i>Patent Act</i> , Section 3.1..... | 9-37 |
| 9:11 | THE APPLICATION..... | 9-38 |
| | (a) General Requirements | 9-38 |
| | (b) Petition..... | 9-39 |
| | (c) Abstract..... | 9-40 |
| | (d) Specification..... | 9-41 |
| | (1) Description..... | 9-41 |
| | (2) Claims..... | 9-47 |
| 9:12 | FILING DATE | 9-48 |
| 9:13 | CLAIM DATE | 9-49 |
| | (a) Requirements for a Claim Date..... | 9-49 |
| | (b) Prior Canadian Application | 9-50 |
| | (c) Prior Convention or Treaty Application..... | 9-50 |
| | (d) Prior Application was Filed by the Applicant or by the Applicant’s Legal Representative or Predecessor in Title | 9-50 |
| | (e) The Prior Application Discloses the Subject Matter Defined by the Claim..... | 9-51 |
| | (f) Filing Date within Twelve Months after the Filing Date of the Prior Application..... | 9-54 |
| | (g) Applicant has Made a Request for Priority..... | 9-54 |
| | (h) Effect of Multiple Priorities on Claim Date and Conflicting Applications | 9-55 |
| 9:14 | REQUESTING PRIORITY | 9-55 |
| | (a) Request for Priority | 9-55 |
| | (b) Withdrawal of a Request for Priority | 9-56 |
| | (c) When Priority Application Deemed Never Filed | 9-57 |
| 9:15 | COMPLETING THE APPLICATION..... | 9-57 |
| 9:16 | PUBLICATION OF THE APPLICATION..... | 9-59 |
| | (a) Confidentiality Period | 9-59 |
| | (b) Significance of the Publication Date | 9-60 |
| | (c) Secret Applications and Patents | 9-61 |
| 9:17 | EXAMINATION | 9-63 |
| | (a) Request for Examination | 9-63 |
| | (b) Expedited Examination..... | 9-64 |
| | (c) Examination and Prosecution of the Application | 9-64 |

CANADIAN LAW OF PATENTS

| | | |
|--|---|---------|
| (d) | Timely Response in Good Faith to Requisitions..... | 9-68 |
| 9:18 | AMENDMENTS..... | 9-69 |
| (a) | Application can be Amended..... | 9-69 |
| (b) | New Matter is not to be Introduced by Amendment | 9-69 |
| (c) | Amendments to Include Sequence Listings | 9-74 |
| (d) | Limitation on Amendments after Rejection | 9-74 |
| (e) | Amendments after Allowance..... | 9-74 |
| 9:19 | CORRECTIONS..... | 9-75 |
| 9:20 | PATENT TO BE GRANTED FOR ONE INVENTION ONLY..... | 9-75 |
| 9:21 | DIVISIONAL APPLICATIONS | 9-78 |
| 9:22 | ISSUES OF GOOD FAITH IN PATENT PROSECUTION | 9-81 |
| (a) | Historical — Pre-October, 1993..... | 9-81 |
| (b) | Introduction of Section 73(1)(a) Effective October 1, 1996..... | 9-84 |
| (c) | <i>G.D. Searle v. Novopharm</i> and <i>Lundbeck v. Ratiopharm</i> | 9-84 |
| 9:23 | ABANDONMENT..... | 9-88 |
| (a) | Circumstances in which Application Deemed Abandoned..... | 9-88 |
| (b) | Reply in Good Faith to a Requisition of the Examiner or of the Commissioner..... | 9-89 |
| (c) | Timely Completion of the Application | 9-90 |
| (d) | Timely Payment of Maintenance Fees..... | 9-91 |
| (e) | Timely Request for Examination..... | 9-91 |
| (f) | Timely Payment of the Fees Stated to be Payable in a Notice of Allowance..... | 9-91 |
| (g) | Other Types of Abandonment..... | 9-92 |
| 9:24 | REINSTATEMENT..... | 9-93 |
| 9:25 | MISREPRESENTATION | 9-94 |
| 9:26 | THIRD PARTY FILING PRIOR ART AND PROTEST..... | 9-103 |
| 9:27 | CONFLICTING APPLICATIONS | 9-104 |
| 9:28 | APPEAL TO THE PATENT APPEAL BOARD FROM EXAMINER'S REJECTION..... | 9-105 |
| 9:29 | ALLOWANCE OF AN APPLICATION | 9-107 |
| 9:30 | GRANT OF A PATENT | 9-108 |
| 9:31 | REFUSAL TO GRANT A PATENT | 9-108 |
| 9:32 | APPEAL FROM A DECISION OF THE COMMISSIONER..... | 9-109 |
| (a) | Appeal to Federal Court..... | 9-109 |
| (b) | Procedure on Appeals from Decisions of the Commissioner..... | 9-109 |
| (c) | Standard of Review | 9-112 |
| (d) | Powers of the Federal Court..... | 9-114.1 |
| (e) | Appeal Decisions | 9-115 |
| 9:33 | JUDICIAL REVIEW OF OTHER DECISIONS OF THE COMMISSIONER | 9-116 |
| 9:34 | POSTAL SERVICES INTERRUPTION RELIEF..... | 9-123 |
| PART II — “ <i>OLD ACT</i> ” APPLICATIONS — APPLICATIONS | | |
| | FILED BEFORE OCTOBER 1, 1989 | 9-124 |
| 9:35 | <i>OLD ACT</i> APPLICATIONS — INTRODUCTION | 9-124 |

TABLE OF CONTENTS

| | | |
|------|---|-------|
| 9:36 | <i>OLD ACT</i> APPLICATIONS — PRIORITY DATE | 9-125 |
| (a) | Convention Priority can be Claimed in Accordance with <i>Old Act</i> Section 28..... | 9-125 |
| (b) | Foreign Application Regularly Filed in a Convention or Treaty Country | 9-126 |
| (c) | “An Application for a Patent for the Same Invention” | 9-127 |
| (d) | Canadian Application in Canada filed within 12 months of the Earliest Corresponding Foreign Application | 9-129 |
| (e) | The Benefit of Convention Priority Must be Requested..... | 9-129 |
| (f) | Significance of Priority Date Under the <i>Old Act</i> | 9-130 |
| 9:37 | “ <i>OLD ACT</i> ” APPLICATIONS — NOT OPEN TO PUBLIC INSPECTION..... | 9-130 |
| 9:38 | <i>OLD ACT</i> APPLICATIONS — APPLICATIONS FOR SUBSTANCES INTENDED FOR FOOD OR MEDICINE..... | 9-131 |
| 9:39 | “ <i>OLD ACT</i> ” APPLICATIONS — EXAMINATION..... | 9-132 |
| 9:40 | <i>OLD ACT</i> APPLICATIONS — AMENDMENTS | 9-134 |
| (a) | No New Matter..... | 9-134 |
| (b) | Supplementary Disclosure..... | 9-134 |
| 9:41 | “ <i>OLD ACT</i> ” APPLICATIONS —CONFLICTING APPLICATIONS | 9-135 |
| (a) | When Conflict Exists | 9-135 |
| (b) | Conflict Proceedings in the Patent Office..... | 9-136 |
| (c) | Conflict Proceedings in the Federal Court..... | 9-138 |
| 9:42 | <i>OLD ACT</i> APPLICATIONS — CONFLICT WITH AN ISSUED PATENT | 9-147 |

CHAPTER 10 INTERNATIONAL PATENT PROTECTION, INCLUDING THE PATENT COOPERATION TREATY 10-1

| | | |
|------|--|-------|
| 10:1 | INTRODUCTION | 10-1 |
| 10:2 | PARIS CONVENTION..... | 10-2 |
| 10:3 | PATENT COOPERATION TREATY (“PCT”) | 10-4 |
| (a) | International Application..... | 10-5 |
| (b) | The International Search..... | 10-20 |
| (c) | Third Party Observations | 10-22 |
| (d) | Amendment of the Claims before the International Bureau | 10-23 |
| (e) | International Publication | 10-23 |
| (f) | International Preliminary Examination..... | 10-25 |
| (g) | Right to Practice Before International Authorities..... | 10-28 |
| (h) | Time Limits | 10-28 |
| (i) | National Phase Entry — PCT Provisions..... | 10-29 |
| (j) | National Phase Entry into Canada | 10-32 |
| 10:4 | NORTH AMERICA FREE TRADE AGREEMENT (“NAFTA”) | 10-33 |
| 10:5 | TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS (“TRIPS”)..... | 10-34 |
| (a) | TRIPS and Patents | 10-34 |

CANADIAN LAW OF PATENTS

| | |
|---|-------|
| (b) TRIPS Disputes | 10-38 |
| 10:6 PATENT LAW TREATY (“PLT”) | 10-40 |
| 10:7 STRASBOURG AGREEMENT..... | 10-40 |
| 10:8 CANADA-EUROPEAN UNION: COMPREHENSIVE ECONOMIC AND TRADE AGREEMENT (“CETA”)..... | 10-41 |

**CHAPTER 11 THE PATENT GRANT AND THE VALIDITY OF
PATENTS..... 11-1**

| | |
|---|-------|
| 11:1 GRANT | 11-1 |
| 11:2 THE NATURE OF THE GRANT..... | 11-2 |
| 11:3 THE TERM OF THE GRANT | 11-3 |
| 11:4 THE GRANT IS SUBJECT TO ADJUDICATION | 11-4 |
| 11:5 PRESUMPTION OF VALIDITY..... | 11-5 |
| 11:6 NATURE OF A CHALLENGE TO THE VALIDITY OF A PATENT | 11-7 |
| 11:7 INVALID CLAIMS DO NOT AFFECT VALID CLAIMS..... | 11-11 |
| 11:8 GROUNDS OF INVALIDITY | 11-12 |
| 11:9 EVIDENCE RELEVANT TO ISSUES OF VALIDITY OR INVALIDITY..... | 11-15 |
| (a) General | 11-15 |
| (b) Proof of Patents and Other Official Documents Concerning Patents | 11-15 |
| (c) The Record File..... | 11-15 |
| (d) Commercial Success | 11-17 |
| 11:10 PRIOR GRANT OR DOUBLE PATENTING..... | 11-17 |
| (a) Historical and Statutory Basis..... | 11-17 |
| (b) Application of the Prior Grant or Double Patenting Prohibition | 11-21 |
| (c) Double Patenting and Selection Patents | 11-29 |
| (d) Application of the Prior Grant or Double Patenting Prohibition to Divisional Applications..... | 11-30 |
| (e) Other Situations | 11-32 |
| (f) <i>Patent Act (Old Act)</i> Section 41 and Section 61(2)..... | 11-33 |
| 11:11 THE GRANT IS SUBJECT TO CONDITIONS | 11-34 |
| 11:12 MAINTENANCE FEES | 11-34 |
| 11:13 MARKING OF PATENTED ARTICLES | 11-35 |
| (a) Canadian Law Does Not Require Marking..... | 11-35 |
| (b) Marking of Patented Articles May Have Some Benefit | 11-35 |
| (c) Offences for False Marking of Articles as Patented | 11-36 |
| (d) False Representations in Relation to Patents..... | 11-37 |

**CHAPTER 12 REISSUE DISCLAIMER, CORRECTION,
RE-EXAMINATION AND DEDICATION..... 12-1**

| | |
|-----------------------------------|------|
| 12:1 REISSUE | 12-2 |
| (a) History — United Kingdom..... | 12-2 |

TABLE OF CONTENTS

| | | |
|------|--|---------|
| (b) | History — United States..... | 12-3 |
| (c) | History — Canada..... | 12-6 |
| (d) | Statutory Provisions for Reissue..... | 12-7 |
| (e) | Purpose and Nature of Reissue | 12-8 |
| (f) | Jurisdiction of Commissioner | 12-9 |
| (g) | “Deemed”..... | 12-10 |
| (h) | Defective or Inoperative by Reason of Insufficient Description and Specification, or by Reason of the Patentee’s Claiming More or Less than he had a Right to Claim as New | 12-11 |
| (i) | Must the Patent be Valid or Invalid? | 12-11 |
| (j) | Error — Insufficient Description or Specification, or Claiming More or Less than Entitled..... | 12-14 |
| (k) | “Inadvertence, Accident or Mistake” | 12-15 |
| (l) | “Same Invention”..... | 12-18 |
| (m) | No New Matter..... | 12-20 |
| (n) | Application for Reissue | 12-21 |
| (o) | Effect of Reissue..... | 12-23 |
| (p) | Litigation Involving a Reissued Patent — Infringement..... | 12-24 |
| (q) | Litigation Involving a Reissued Patent — Validity of the Reissue..... | 12-26 |
| 12:2 | DISCLAIMER..... | 12-29 |
| (a) | History — United Kingdom..... | 12-29 |
| (b) | History — United States..... | 12-29 |
| (c) | History — Canada..... | 12-31 |
| (d) | Statutory Provisions..... | 12-32 |
| (e) | United States Authorities | 12-38.1 |
| (f) | British Authorities | 12-38.1 |
| (g) | Extent of Disclaimer | 12-41 |
| (h) | Function of Disclaimer..... | 12-43 |
| (i) | Form of Disclaimer | 12-44 |
| (j) | Effect of a Disclaimer | 12-45 |
| 12:3 | CERTIFICATE OF CORRECTION FOR CLERICAL ERRORS | 12-47 |
| 12:4 | CORRECTION BY THE COURT | 12-52 |
| 12:5 | RE-EXAMINATION | 12-54.2 |
| (a) | Introduction..... | 12-54.2 |
| (b) | Request for Re-Examination..... | 12-54.2 |
| (c) | Establishment of a Re-Examination Board and Determination of Whether the Request Raises a Substantial New Question of Patentability | 12-55 |
| (d) | A Substantial New Question of Patentability | 12-56 |
| (e) | Re-Examination Proceeding | 12-56 |
| (f) | Appeals | 12-57 |
| (g) | Re-Examination and Patent Litigation | 12-58 |
| (h) | Advantages and Disadvantages of Re-Examination..... | 12-59 |
| 12:6 | DEDICATION TO THE PUBLIC..... | 12-60 |
| (a) | Dedication | 12-60 |
| (b) | Reasons for Dedication | 12-61 |

CANADIAN LAW OF PATENTS

| | |
|--|--------------|
| (c) Effect of Dedication..... | 12-62 |
| CHAPTER 13 INFRINGEMENT | 13-1 |
| 13:1 INTRODUCTION | 13-3 |
| 13:2 HISTORICAL | 13-3 |
| (a) Purposive Construction Replaces Infringement in Substance | 13-3 |
| (b) Current U.K. Law has Some Significant Differences from Canadian Law | 13-7 |
| 13:3 LIABILITY FOR INFRINGEMENT | 13-7 |
| (a) Current <i>Act</i> | 13-7 |
| (b) <i>Old Act</i> | 13-8 |
| 13:4 INFRINGEMENT | 13-9 |
| (a) Infringement —Interference with the Patentee’s Exclusive Right | 13-9 |
| (b) Three Aspects of Patent Infringement | 13-9 |
| (c) Burden of Proof of Infringement..... | 13-10 |
| PART I — THE SUBJECT MATTER ASPECT OF INFRINGE- MENT..... | 13-10 |
| 13:5 GENERAL | 13-10 |
| 13:6 CONSTRUCTION OF THE PATENT..... | 13-11 |
| 13:7 INFRINGEMENT OF THE CLAIMS AS CONSTRUED..... | 13-13 |
| (a) Approach to Infringement..... | 13-13 |
| (b) Intention..... | 13-23 |
| (c) Combinations | 13-24 |
| (d) Proof of Infringement..... | 13-28 |
| (e) Presumption in the Case of a New Product..... | 13-30.1 |
| (f) Common Law Presumption..... | 13-36 |
| 13:8 “GILLETTE DEFENCE”..... | 13-39 |
| PART II — THE ACTIVITY ASPECT OF INFRINGEMENT..... | 13-42 |
| 13:9 THE STATUTORY GRANT | 13-42 |
| 13:10 INFRINGING ACTS IN GENERAL | 13-42 |
| 13:11 ACTIVITY DURING THE PATENT TERM | 13-42 |
| (a) Patent Term | 13-42 |
| (b) Articles Acquired Prior to Filing, Publication or Grant..... | 13-43 |
| (i) Introduction..... | 13-43 |
| (ii) Articles Acquired Prior to the Issue Date of an <i>Old Act</i> Patent — <i>Old Act</i> , Section 56..... | 13-43 |
| (iii) Articles Acquired Prior to the Claim Date | 13-49 |

TABLE OF CONTENTS

| | | |
|-------|---|---------|
| | (iv) Articles Acquired Prior to Publication of the Application | 13-50 |
| | (v) Articles Acquired After Publication of the Application but Prior to the Issue of the Patent | 13-51 |
| | (c) Reissue, Disclaimer, Correction, Re-Examination, Dedication | 13-51 |
| | (i) Reissue..... | 13-52 |
| | (ii) Disclaimer | 13-52 |
| | (iii) Correction..... | 13-52 |
| | (iv) Re-Examination | 13-52 |
| | (v) Dedication | 13-53 |
| | (d) Effect of Expiry of the Patent..... | 13-53 |
| | (e) <i>Pendente Lite</i> | 13-53 |
| | (f) <i>Quia Timet</i> — Threatened Infringement..... | 13-54 |
| 13:12 | MAKING, CONSTRUCTING, USING AND SELLING | 13-56 |
| | (a) <i>Patent Act</i> , Section 42..... | 13-56 |
| | (b) Make and Construct..... | 13-57 |
| | (c) Use..... | 13-59 |
| | (d) Sale | 13-61 |
| | (e) Possession, Exhibition..... | 13-62 |
| | (f) Repairs to Patented Articles | 13-64 |
| | (g) Import and Export | 13-68 |
| | (h) Transport | 13-69 |
| | (i) Significance of Other Patents..... | 13-71 |
| 13:13 | INFRINGEMENT OF A CANADIAN PATENT MUST OCCUR IN CANADA..... | 13-71 |
| 13:14 | SALE OR USE OF A PRODUCT MADE USING A PATENTED INVENTION..... | 13-75 |
| 13:15 | INDUCING INFRINGEMENT AND RELATED ISSUES..... | 13-78 |
| | (a) Inducing Infringement..... | 13-78 |
| | (b) Supplying a Product Capable of Use for Infringement | 13-84.1 |
| | (c) Supplying a Product for Use with an Infringing Product, Process of Machine | 13-89 |
| | (d) Affiliated Companies | 13-90 |
| | (e) Common Design | 13-92 |
| | (f) Aiding and Abetting | 13-96 |
| | (g) Vicarious Liability..... | 13-96 |
| 13:16 | INFRINGEMENT BY OFFICERS AND DIRECTORS | 13-98.2 |
| 13:17 | NON-INFRINGEMENT DEFENCES | 13-102 |
| | (a) Experimental and Developmental Manufacture and Use | 13-102 |
| | (b) Manufacture, Use and Sale for Regulatory Purposes..... | 13-105 |
| | (c) Licence or Other Agreement | 13-107 |
| | (d) Use and Sale of a Product Sold by the Patentee or by a Licensee | 13-108 |
| | (e) Use in Foreign Vessel, Aircraft or Land Vehicle Entering Canada Temporarily..... | 13-111 |
| | (f) Limitation Period | 13-112 |

CANADIAN LAW OF PATENTS

| | |
|--|---------------|
| (g) Defence — Laches and Acquiescence | 13-117 |
| (h) Patent Misuse | 13-120 |
| 13:18 CROWN RIGHT TO USE..... | 13-120 |
| | |
| PART III — THE TITLE ASPECT OF INFRINGEMENT..... | 13-121 |
| 13:19 LIABILITY FOR PATENT INFRINGEMENT..... | 13-121 |
| 13:20 PATENTEE | 13-121 |
| 13:21 ASSIGNEE | 13-122 |
| 13:22 LICENSEE | 13-122 |
| 13:23 OTHER PERSONS CLAIMING UNDER THE PATENTEE | 13-125 |
| 13:24 ASSIGNMENT OF A CAUSE OF ACTION FOR PATENT INFRINGEMENT | 13-125 |
| | |
| CHAPTER 14 REMEDIES | 14-1 |
| 14:1 INTRODUCTION | 14-2 |
| (a) Preventive Remedies..... | 14-3 |
| (b) Compensatory Remedies..... | 14-3 |
| (c) Declaration..... | 14-4 |
| (d) Punitive Remedies..... | 14-4 |
| (e) Costs | 14-4 |
| (f) Claims of Particular Parties | 14-5 |
| (i) Patentee..... | 14-5 |
| (ii) Licensee | 14-5 |
| (iii) Claim of Parent for Losses of Subsidiary..... | 14-8 |
| 14:2 ELECTION OF DAMAGES OR AN ACCOUNT OF PROFITS..... | 14-8 |
| (a) Damages and an Account of Profits Compared..... | 14-9 |
| (i) Causation..... | 14-11 |
| (ii) Damages and an Account of Profits are Alternatives..... | 14-12 |
| (b) Discretion of the Court as to Whether to Permit an Election | 14-13 |
| (c) Choosing the Remedy | 14-18 |
| (d) When is the Election of Remedy Made?..... | 14-19 |
| 14:3 DAMAGES..... | 14-20 |
| (a) General Principles | 14-20 |
| (b) Measure of Damages — Practical Working Rules | 14-26 |
| (c) The Issue is the Plaintiff’s Loss, Not the Infringer’s Profits | 14-26 |
| (d) Irrelevant that Infringer Could Have Avoided Infringement..... | 14-27 |
| (e) Effect of Licences | 14-29 |
| (f) Absence of Licences | 14-32 |
| (g) Damages from the Use of a Patented Machine or a Patented Process..... | 14-34 |
| (h) Loss of Profit on Lost Sales..... | 14-35 |

TABLE OF CONTENTS

| | | |
|-------|--|--------|
| (i) | Lost Sales | 14-35 |
| (ii) | Lost Sales Outside Canada | 14-38 |
| (iii) | Cheaper Infringing Article | 14-39 |
| (iv) | Articles Partially Infringing | 14-39 |
| (v) | Lost Sales of Non-Patented Products or Services Arising from Infringement | 14-45 |
| (vi) | Capacity | 14-47 |
| (vii) | Lost Profits on Lost Sales | 14-47 |
| (i) | Lost Profits Due to Price Reduction and Other Market Disruption | 14-50 |
| (i) | Price Reduction | 14-50 |
| (ii) | Market Disruption | 14-51 |
| (iii) | Post Infringement Losses | 14-52 |
| (j) | Sales Patentee Would Not Have Made | 14-53 |
| (k) | Damages — Reasonable Royalty | 14-55 |
| (l) | Mitigation and Loss due to Mitigation | 14-59 |
| (m) | Alternatives | 14-60 |
| (n) | Recovery of the Plaintiff’s Damages | 14-61 |
| 14:4 | REASONABLE COMPENSATION FOR DAMAGES FOR PRE-GRANT USE | 14-63 |
| 14:5 | ACCOUNT OF PROFITS | 14-68 |
| (a) | General Principles | 14-68 |
| (b) | Account Involving Multiple Parties | 14-71 |
| (c) | Measure of Profits | 14-72 |
| (i) | Full Cost Approach | 14-73 |
| (ii) | Differential Cost Approach | 14-74 |
| (iii) | Modified Differential Profits Approach — “Opportunity Cost” | 14-76 |
| (iv) | Differential Profits Approach | 14-79 |
| (d) | Proof of the Expenses to be Deducted | 14-84 |
| (e) | Expenses That May Not Be Deducted | 14-85 |
| (f) | Apportionment | 14-85 |
| (g) | Indirect Profits | 14-90 |
| (h) | Accounting for the Benefit of Having the Money — Interest | 14-91 |
| (i) | Condonation | 14-92 |
| 14:6 | PUNITIVE OR EXEMPLARY DAMAGES | 14-93 |
| 14:7 | INTEREST | 14-100 |
| (a) | Pre-judgment Interest | 14-100 |
| (b) | Post-judgment Interest | 14-104 |
| 14:8 | CURRENCY CONVERSION | 14-105 |
| 14:9 | EFFECT OF INCOME TAX | 14-106 |
| 14:10 | INJUNCTION | 14-106 |
| 14:11 | DELIVERY UP OR DESTRUCTION ON OATH | 14-112 |
| 14:12 | DECLARATION | 14-115 |
| 14:13 | PROCEDURAL CONSIDERATIONS | 14-116 |

CANADIAN LAW OF PATENTS

| | | |
|--------------|---|--------|
| (a) | Directions in the Liability Judgment and Other Considerations | 14-116 |
| (b) | Conduct of the Compensation Phase | 14-117 |
| (c) | Effect of a Judgment in a Subsequent Case Revoking the Patent..... | 14-118 |
| 14:14 | APPEALS..... | 14-121 |
| <i>Index</i> | | I-1 |