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FOX ON THE CANADIAN LAW OF PATENTS, FIFTH EDITION

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Publisher's Special Release Note 2021

The pages in this work were reissued in December 2021 and updated to reflect that date in the release line. Please note that we did not review the content on every page of this work in the December 2021 release. We will continue to review and update the content according to the work's publication schedule. This will ensure that subscribers are reading commentary that incorporates developments in the law as soon as possible after they have happened or as the author deems them significant.

Changes to chapter and heading numbering may have occurred. Please refer to the Correlation Table in the front matter if you wish to confirm references.

Fox on the Canadian Law of Patents, Fifth Edition is the pre-eminent text for patent lawyers and agents in Canada. The fourth edition was repeatedly cited by courts including the Supreme Court of Canada. However, since its publication in 1969, there have been significant changes in Canadian patent law, including major statutory revisions in 1989 and 1996. The new edition brings the statement of the law up to date while retaining the jurisprudence as compiled by Dr. Fox to the extent that it remains relevant. Topics covered in this edition include: Invention, Subject Matter of Patents, Obviousness, Nov-

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elty, Utility, Application for a Patent, International Patent Protection, Dedication and Re-Examination, and Infringement and Remedies for Infringement.

This release features updates and additions to the commentary and case law in Chapters 3 (Subject Matter of Patents), 4 (Obviousness), 5 (Novelty), 6 (Utility), 7 (The Specification), 8 (Construction of a Patent), 11 (Grant and Validity of Patents), 13 (Infringement), 14 (Remedies) and 15 (Actions for Threats of Patent Infringement).

Case Law Highlights

Subject Matter of Patents

The issue of patentable subject matter was addressed by the Patent Appeal Board and the Commissioner of Patents in relation to a diagnostic method in *BIO-RAD Laboratories, Inc.'s Patent Application 2,759,416*, 2022 CACP 4, in relation to the issue of whether dosage claims covered a method of medical treatment in *Biogen MA Inc.'s Patent Application 2,477,178*, 2022 CACP 2 and *Merz Pharma GMBH & Co. KGAA's Patent Application 2,654,214*, 2022 CACP 3, , and in relation to computer-implemented systems and methods in *Eisenlohr's Patent Application 2,749,285*, 2021 CACP 50, *Landmark Graphics Corporation's Patent Application 2,874,728*, 2021 CACP 51, *Novomatic AG's Patent Application 2,823,991*, 2021 CACP 52, *NYSE GROUP, INC.'s Patent Application 2,876,128*, 2022 CACP 1, *Optuminsight Inc's Patent Application 2,737,278*, 2022 CACP 5, *The Dun and Bradstreet Corporation's Patent Application 2,757,232*, 2022 CACP 6, and *Novomatic AG's Patent Application 2,821,804*, 2022 CACP 7.

Obviousness

Issues as to obviousness and the related issues of person skilled in the art and citable art were considered by the Federal Court in *Allergan v. Apotex*, 2022 FC 260 and by the England and Wales Patents Court in *Teva Pharmaceutical Industries v. Bayer Healthcare*, [2021] EWHC 2690 (Pat). The decision of the England and Wales Patents Court in *Lufthansa Technik v. Astronics Advanced Electronic Systems*, [2020] EWHC 1968 (Pat), which discussed obviousness issues, was affirmed by the England and Wales Court of Appeal in [2022] EWCA Civ 20.

There is a discussion of what information discoverable on a diligent search forms part of the common general knowledge.

Reference is made to the discussion by the Australian Federal Court of prior art published shortly before the priority date in *Pharmacia v. Juno Pharmaceuticals*, [2022] FCA 92.

Novelty

Issues as to novelty were considered by the Federal Court in *Allergan v. Apotex*.

Utility

Issues as to utility were considered by the Federal Court of Appeal in *Allergan*

v. Apotex.

The Specification

A brief section was added to address the description of embodiments of an invention.

Issues as to the specification were considered by the Federal Court in *Allergan v. Apotex* and by the Federal Court of Appeal in *Seedlings Life Science Ventures v. Pfizer Canada*, 2021 FCA 154.

A quotation from the Federal Court of Appeal decision in *Western Oilfield Equipment Rentals v. M-I LLC*, 2021 FCA 24 was expanded in view of the reference to it in *Seedlings v. Pfizer*.

Construction of a Patent

The discussion of prior art referred to in the patent in issue was reorganized for clarity.

Issues as to construction of a patent were considered by the Federal Court in *Allergan v. Apotex*.

The decision of the England and Wales Patents Court in *Lufthansa v. Astronics Advanced Electronic Systems* which also discussed construction issues, was affirmed by the England and Wales Court of Appeal as noted above.

Reference is made to the discussion by the Australian Federal Court of the interpretation of “about” in relation to a numerical parameter in *Pharmacia v. Juno Pharmaceuticals*.

Infringement

Infringement issues were considered by the Federal Court in *Allergan v. Apotex*.

The decision of the England and Wales Patents Court in *Lufthansa v. Astronics Advanced Electronic Systems* which also discussed infringement issues, was affirmed by the England and Wales Court of Appeal as noted above.

The discussion has been expanded somewhat regarding the amendment of s. 55.2(6) of the *Patent Act*, relating to a defence of experimental use, by the *Budget Implementation Act, 2018, No. 2* to limit that section.

Remedies

The principles relating to the discretion to allow an election of an account of profits and relating to injunctions were considered by the Federal Court in *Farmobile, LLC v. Farmers Edge Inc.*, 2022 FC 22.

The principles relating to a claim for punitive damages were considered by the Federal Court in *Sony Music Entertainment Canada v. Suva Beauty*, a copyright pleading decision.

An application for leave to appeal from *Apotex v. Eli Lilly*, 2021 FCA 149 was

refused by the Supreme Court of Canada.

Reference is made to the discussion by the Australian Federal Court of whether to grant an injunction when the patent would expire shortly in *Pharmacia v. Juno Pharmaceuticals*.

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