

Chapter 12 Fundamentals of Examination

12.01 Examination - April 2018

The purpose of examination is, at each stage, to perform a thorough analysis of the patent application to determine whether it complies with the requirements of the *Patent Act* and *Patent Rules*. After receiving a request for examination an examiner will analyse the application taking into consideration the originally filed application and any amendments that have been received in the Patent Office.

After having performed this analysis, the examiner will either allow the application in accordance with subsection 86(1) of the *Patent Rules* or issue a report detailing the application's defects in accordance with subsection 86(2) of the *Patent Rules*. Where a report is to be issued, it should be as comprehensive as possible, to enable the applicant to make informed decisions regarding the continued prosecution of their application and, if possible, to place the application in a condition for allowance [see [Chapter 25](#)]. In some cases, the examiner may initiate a [telephone interview](#), in lieu of issuing a report, where such an interview may advance the prosecution expeditiously.

Note that an application for which examination has been requested may be examined prior to being laid open to public inspection under section 10 of the *Patent Act*, but an examiner will not approve an application for allowance until it has been laid open.

12.01.01 Examination of the abstract, description and drawings

A detailed discussion regarding examination of the abstract, description and drawings can be found in chapters [13](#), [14](#) and [15](#) of this manual, respectively.

12.02 Examination of the claims using purposive construction - REVISED

Subsection 27(4) of the *Patent Act* requires that the specification end with a claim or claims defining distinctly and in explicit terms the subject-matter of the invention for which an exclusive privilege or property is claimed.

The subject-matter defined by a claim is determined on the basis of a purposive construction of the claim conducted in accordance with the principles set out by the Supreme Court of Canada in *Free World Trust v Électro Santé Inc.*, 2000 SCC 66 and *Whirlpool Corp. v Camco Inc.*, 2000 SCC 67.

The goal of purposive construction of a claim is to determine the fences of the monopoly claimed by the applicant.¹ This is done by objectively determining where the person skilled in the art would, as of the date of publication of the patent application and on the basis of the particular words or phrases used in the claim, have understood the applicant to have intended to place the fences around the monopoly being claimed.²

The purposive construction of a claim is carried out in light of the whole of the specification and takes into account what the person skilled in the art would understand from it to be the nature of the invention.³

Once a claim has been purposively construed, that construction is used to determine whether the claim complies with the *Patent Act* and *Patent Rules*. Where there is no disagreement as to the construction of a claim, the examiner may choose not to provide the detailed purposive construction analysis in a report.

12.02.01 Steps of purposive construction

When examining a claim, an examiner must read the claim in an informed and purposive way. Prior to construing a claim an examiner will:

1. Identify the person of ordinary skill in the art [see [12.02.02b](#)]; and
2. Identify the relevant common general knowledge (CGK) of the person of ordinary skill in the art (POSITA) at the time of publication [see [12.02.02c](#)].

The above steps provide the context in which the claim is to be read. Once the context is determined the examiner will:

3. Determine the meaning of the terms used in the claim and identify the elements of the claim that are essential [see [12.02.02d](#)].

12.02.02 Considerations for claim construction

Claim construction during examination therefore requires an examiner to interpret each claim in a structured manner whereby the examiner will:

12.02.02a Use a fair, balanced and informed approach

The specification as a whole is addressed to the person skilled in the art and, as such, provides the context in which the claim should be read and informs the meaning of the terms recited in the claim and the nature of the invention.⁴ Upon a purposive construction the terms of a claim will be given specific technical meanings in light of the common general knowledge of the person skilled in the art.⁵ Thus, in order to arrive at a fair, balanced and informed understanding of the subject-matter of a claim, it is critical that a purposive construction of the claim be performed considering the specification as a whole as read through the eyes of the person skilled in the art, against the background of the common general knowledge in the field or fields relevant to the invention at the time the application became available to the public.

During examination, the necessary foundation of knowledge for performing a purposive construction of the claims is found in submissions from the applicant and the knowledge of an appropriately experienced examiner.⁶

12.02.02b Identify the person skilled in the art

As detailed above, prior to construing the claims, the examiner must first identify the person skilled in the art.

The person skilled in the art (POSITA) is a fictitious construct that represents an average worker competent in the field or fields relevant to the invention.⁷ The person skilled in the art can represent an individual, or a team of individuals whose conjoint knowledge is relevant to the invention in suit.⁸

The person skilled in the art is considered to be competent; a logical but unimaginative worker in the field,⁹ who is neither a dull-witted incompetent nor a creative, intuitive expert.¹⁰ In a highly technical field, the person skilled in the art may be presumed to have expert-level knowledge and skills.¹¹ The skilled person need not be a manufacturer or designer, but must understand the problem to be overcome, have knowledge of means to address the problem and the likely effect of using the means.¹² Furthermore, the person skilled in the art is reasonably diligent in keeping up with advances in the field or fields of relevance to the invention,¹³ and has the advantage of being multilingual and thereby being able to comprehend prior art in any language.¹⁴ Note that the person skilled in the art may have knowledge from outside the field of the invention, although it should not be presumed that they would.¹⁵ In this context, the nature of the problem being addressed by the alleged invention may be helpful in defining the skilled person.

During examination, the person skilled in the art is relevant in many contexts. It is important to recognise that there is only a single description of the person skilled in the art for a given alleged invention. Nevertheless, the common general knowledge of the person skilled in the art will depend on the date at which an understanding of the application is required.¹⁶ Note that in some circumstances, this can require the person skilled in the art to rely on knowledge which, while generally accepted at the relevant date, was later shown to be wrong.¹⁷

Depending on the specifics of a given case, it may be necessary to explicitly identify the person skilled in the art. It should be stressed that this is not necessary where the nature of the person skilled in the art does not appear to be under debate or where it is unlikely to impact on any conclusions as to patentability.

Where the specific nature of the person skilled in the art is relevant for resolving an issue during examination, the examiner will determine who this person is by reference to the field or fields relevant to the invention and will consider comments by the applicant in the determination. The person skilled in the art may be ascertained from the language of the specification of the application.¹⁸ Attributes such as proclivity for engaging in research or experimentation may help form the profile of the skilled person.

Although the characterisation of the person skilled in the art should be done carefully,¹⁹ it should also be done with a certain degree of generalisation.²⁰ During examination, an examiner must attempt to interpret the application using the appropriate knowledge that the person skilled in the art would have possessed at the relevant date. Specific details such as the skilled person's exact educational background or length of work experience are typically unnecessary and have the potential to be misleading or overly restrictive; precise definitions of the skilled person should therefore be avoided.

12.02.02c Identify the common general knowledge

After identifying the person skilled in the art (see [12.02.02b](#)), the examiner must identify the relevant common general knowledge (CGK) of the person of ordinary skill in the art at relevant date. The relevant date for construing the claims is the publication date.

“Common general knowledge means knowledge generally known by persons skilled in the relevant art at the relevant time.”²¹ The common general knowledge in a field has been described as the knowledge that emerges as common themes from the “forest of art”, and which becomes commonly known to the ordinary person skilled in the art.²² This knowledge undergoes continuous evolution and growth.²³

The common general knowledge distinguishes the body of information that is widely

recognised from that which is simply publicly available. Individual disclosures may become common general knowledge, but only when they are generally known and regarded as a good basis for further action.²⁴ At the same time, some information that forms part of the common general knowledge may not have been written down at all.

Where the common general knowledge in a field becomes relevant for the purposes of examination, examiners may refer to information they believe to have been common general knowledge as of the *relevant date*. Unless it becomes evident through the applicant's comments that the nature of the common general knowledge is not common ground and is reasonably in dispute, an examiner need not identify documents establishing the common general knowledge.

Where it is appropriate or necessary to establish the common general knowledge in a field (for example where the examiner and applicant disagree as to the common general knowledge), this can be done by citing established reference works (such as textbooks, review articles, handbooks, etc.) or by demonstrating commonality of certain knowledge in a number of disclosures in the field. The common general knowledge at a certain date can be confirmed by subsequent publications,²⁵ or by showing that the knowledge had been accepted in the field over a period of time. Statements in the application's description that describe certain information or knowledge as commonly known may be relied upon, without verification, as establishing aspects of the common general knowledge; an applicant will be bound to such comments.²⁶

12.02.02d Determine which elements of the claim are essential

During purposive construction of a claim, the elements of the claimed invention "are identified as either essential elements (where substitution of another element or omission takes the device outside the monopoly) or non-essential elements (where substitution or omission is not necessarily fatal to an allegation of infringement)."²⁷ In carrying out this identification of essential and non-essential elements, all elements set out in a claim are presumed essential, unless it is established otherwise or is contrary to the language used in the claim.²⁸

12.02.03 Examination considerations concerning purposive construction

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.

Similarly, in some cases it will be possible to conclude that a claim does not comply with the *Patent Act* or *Patent Rules* without explicitly determining whether a given element is or is not essential. A prior art document that discloses all the elements of a claim, for example, will anticipate the claimed subject-matter regardless of whether each element is essential or not. Here again, examiners are not required to detail in reports parts of their analysis that are not in issue.

Where an examiner concludes that a specific element is non-essential, and this determination is relevant to the identification of a perceived defect, the examiner should provide reasons to support their conclusion. More specifically, the examiner should detail the language in the claim that indicates the element is non-essential.

Once the claims have been purposively construed, the essential elements can be analyzed to determine if they clearly define subject-matter that complies with the *Patent Act* and *Patent Rules*. Specific requirements are discussed in the following chapters of the MOPOP:

Requirements for the clarity and form of the claims are covered in [Chapter 16](#).

Subject matter is covered in [Chapter 17](#).

Utility is covered in [Chapter 19](#).

Novelty, obviousness and double patenting are covered in [Chapter 18](#).

12.02.04 Examples of non-essential elements under purposive construction

The following examples provide a non-exhaustive list of situations where elements may be found to be non-essential when purposively construing the subject-matter of the claim.

For all the claims listed below the element “nails” is not essential under a purposive construction:

Claim 1: A box comprising wooden slats held together by an attachment means preferably nails.

Claim 2: A box comprising wooden slats held together by glue and, optionally, nails.

Claim 3: A box comprising wooden slats held together by an attachment means (nails).

Claim 4: A box comprising wooden slats held together by an attachment means where the means does not include nails.

The following claim exemplifies a situation involving alternatives:

Claim 5: A box comprising wooden slats held together by screws or nails.

Under purposive construction this claim comprises multiple embodiments of which there is one where “screws” are an essential element and “nails” are not essential as well as another where the situation is reversed. All embodiments of the claim are assessed on the different requirements of patentability. However, in practice, one of the embodiments may be more relevant to the analysis such that a defect is identified based on a construction where a particular alternative element is chosen as essential.

12.03 Search of the prior art - March 2021

Patentability must be assessed in view of the prior art, and it is therefore necessary for the relevant prior art to be identified. The prior art, broadly speaking, includes all information, in any form, made available to the public in Canada or elsewhere before the claim date²⁹, with a limited exception for information disclosed by the applicant or those obtaining information from the applicant (see paragraphs 28.2(1)(a) and 28.3(a) of the *Patent Act*). In practice, however, the prior art relied on during examination generally comprises published patent documents, journal articles, textbooks, manuals and the like. Furthermore, as part of the first-to-file considerations, Canadian patent applications filed by a third-party before the claim date will be prior art for the assessment of anticipation, even if published on or after the claim date (see paragraph 28.2(1)(c) of the *Patent Act*). Also, Canadian patent applications filed by a third party on or after the claim date, but validly claiming priority to a document with a relevant disclosure that is filed before the claim date, will also be prior art for the assessment of anticipation (see paragraph 28.2(1)(d) of the *Patent Act*).

An application for patent in Canada may result from a [national filing](#) or from entry into the national phase of an international application filed in Canada or elsewhere under the [Patent Cooperation Treaty](#) (PCT).

The scope of the search of the prior art performed by a Canadian examiner at the national phase is determined in part by the extent to which relevant prior art has been identified in any earlier searches³⁰. Further, examiners are not required to search claimed matter that is determined to be [not patentable subject-matter](#) (see 17.01), to

lack practical [utility](#) or that is not supported by the application as filed (e.g. where [new matter](#) has been introduced contrary to subsection 38.2(2) or 38.2(3.1) of the *Patent Act*).

Where claimed matter is not required to be searched for any of the foregoing reasons, but it is evident from the specification as a whole that a claim to related subject-matter requiring a search could be made, a search should generally be performed on this related matter. By way of example, a claim to a method of medical treatment need not be searched, but if it is clear that a claim to patentable subject-matter could be made on related matter (such as a related use), this matter should be searched.

Where the claimed subject-matter has been the subject of a comprehensive international search by an International Searching Authority, a Canadian examiner will nevertheless perform at least a search of Canadian patent documents to identify documents relevant to double-patenting or to anticipation under paragraphs 28.2(1)(c) and 28.2(1)(d) of the *Patent Act*.

An examiner will typically consider available foreign search results to avoid unnecessary replication of work. Where the results of a foreign search are relied on in a report, the report should indicate which documents were identified in a foreign search.

Whenever the examiner deems it appropriate, a further search may be undertaken. This search need not be restricted to Canadian patent documents, and can be performed on any database or other search tool to which the examiner has access. Searches are generally limited by some combination of dates, keywords, and International Patent Classification (IPC) codes of relevance to the claimed matter.

In keeping with the purpose of an examiner's report, it is desirable for all relevant prior art to be identified at the time of the first report. Nevertheless, given the sheer quantity of prior art now available it must be acknowledged that in practice documents may be missed, or that at the early stages of examination the relevance of some documents may not be fully appreciated. It is also possible that, in view of amendments to the claims or arguments presented by the applicant, it becomes necessary to rely on additional prior art.

Where, for any reason, relevant prior art is identified during the course of prosecution, it is incumbent on the examiner to cite this prior art against the claimed invention.

12.04 Examiner's reports - March 2021

An examiner's report is an examiner's official means of communicating with an

applicant. A report will contain at least one requisition as well as information provided to clarify the scope or content of each requisition. A report will also indicate the time limit within which the applicant must respond to each requisition in order to avoid abandonment. [For more information on abandonment and time limits see [Chapter 9](#) of this manual.]

Under subsection 86(2) of the *Patent Rules*, where an examiner has reasonable grounds to believe that an application does not comply with the *Patent Act* and *Patent Rules*, the applicant must be informed of the application's defects and must be requisitioned to amend the application to comply or to provide arguments as to why the application does comply. Where an examiner has identified one or more defects, these will be detailed in the report and, for the purposes of paragraph 73(1)(a) of the *Patent Act*, they are considered to be a single requisition. The beginning of this requisition can generally be identified in a report by text such as "The examiner has identified the following defects in the application". The requisition ends with a paragraph such as "In view of the foregoing defects, the applicant is requisitioned, under subsection 86(2) of the *Patent Rules*, to amend the application in order to comply with the *Patent Act* and the *Patent Rules* or to provide arguments as to why the application does comply". If it appears that prosecution has reached an impasse, the examiner may issue a final action. See [chapter 26](#) for further details.

Reports may also include additional requisitions under sections 85 and 94 of the *Patent Rules*. More information on these types of requisitions is given in sections [12.04.01](#) and [12.04.02](#).

Each separate requisition made in a report must be responded to within the time period indicated in the report or the application will be abandoned in accordance with paragraph 73(1)(a) of the *Patent Act*. For each requisition on the basis of which the application was deemed to be abandoned, a specific request for reinstatement must be made, a separate reinstatement fee must be paid, and any required actions must be taken.

An examiner's report will usually include additional content that does not form part of a requisition, but which provides useful information regarding the report. This content may indicate the date of the most recent amendments and, in the case of a first report, their origin (international stage or national stage), an indication of the number of claims on file, a statement regarding the search performed, and an identification of any prior art documents discovered and a discussion of their pertinence. The report may also include general comments on the prosecution and discussions relating to points raised by the applicant in their correspondence. Where there appears to be a disagreement between the applicant and the examiner as to the construction of the claims, the report may

include the examiner's identification of the person skilled in the art, the common general knowledge and the essential elements.

Where an examiner has deferred the search and examination of the claims this will be indicated in the report along with the reasons leading to the deferral. An examiner may, for example, choose to defer the search and examination of the claims in situations where a unity of invention defect is identified; where an application intended to be a divisional does not appear to be entitled to divisional status; or in situations where the examiner has determined that the claims are not directed to patentable subject-matter.

If the examiner considers the application compliant with the *Patent Act* and the *Patent Rules*, it will be approved for allowance per section 86(1) of the *Patent Rules*. See [chapter 25](#) for further details.

12.04.01 Requisitions concerning foreign applications

Section 85 of the *Patent Rules* provides that where an examiner "has reasonable grounds to believe that an application for a patent disclosing the same invention has been filed, in or for any country other than Canada, by an inventor of that invention or a person claiming through them", the examiner may by notice requisition the applicant to provide any of the following information, a copy of any related document and/or a translation into English or French of all or part of any related document not in one of those languages:

- a. an identification of any prior art cited in respect of the foreign application;
- b. the foreign application numbers, filing dates and, if granted, the patent numbers; and
- c. particulars of, any opposition, re-examination, impeachment or similar proceedings.

Per section 85 of the *Patent Rules*, an applicant must respond to such a requisition by providing the information or document requested or by specifically stating that the information or document is not available to them.

Examiners should not requisition an identification of prior art cited in published search reports to which the examiner has ready access. Such search reports include the International Search Report, and any European Patent Office or United States Patent and Trademark Office search reports available through the respective web sites of those offices. Similarly, examiners should not requisition any information that is available to them through the web sites of those offices, including particulars of

examination, opposition, or similar proceedings.

Recognising that translating documents may place a significant financial burden on the applicant, requisitions for translations should be limited to cases where no viable alternative exists.

Where a foreign language document appears relevant to examination, an examiner should attempt to locate a version of that document (or minimally of its abstract) in an Official language with which they can work. In this regard, examiners should make use of reliable online translation engines, such as that provided by the JPO, at least at the early stages of examination.

Where an examiner is working from a machine translation or from a family member of a citable document, this should be clearly stated in the report. An applicant wishing to rebut arguments made on the basis of such a document, however, may be required to provide a translation of the document to support their arguments.

Where a translation is requisitioned, the applicant must provide a translation of the document, or a part of the document, into English or French or an indication that such a translation is not available. Where only a part of the document is necessary for examination, an examiner should indicate, wherever possible, in respect of which part or parts of the document the requisition for a translation is being made.

Under Article 42 of the Patent Cooperation Treaty (PCT), no national office having received an international preliminary examination report “may require that the applicant furnish copies, or information on the contents, of any papers connected with the examination relating to the same international application in any other elected Office”. Article 42 of the PCT applies in respect of any national phase application that has been the subject of International Preliminary Examination under Chapter II of the PCT.

The Office considers that a requisition for the identification of prior art under paragraph 85(1)(a)(i) of the *Patent Rules* or for application numbers, filing dates, and/or patent numbers under paragraph 85(1)(a)(ii) of the *Patent Rules* complies with the requirements of Article 42 of the PCT as the information being requisitioned is connected with the search of the prior art, and is not considered to be a request for copies of papers, or information on the contents of papers, “connected with examination”.

Similarly, the Office does not consider opposition, re-examination, impeachment and similar proceedings to be “connected with examination” in the sense intended by Article 42 of the PCT, and consequently requisitions under section 85 of the *Patent Rules* relating to such proceedings are also considered to be consistent with Article 42 of the

PCT.

12.04.02 Biological Deposit requisitions

Requisitions under section 94 of the *Patent Rules* pertain to the inclusion in the description of the date of deposit of biological material. An examiner may requisition the applicant to amend the description to specify the date of deposit. This subject is covered in detail in [chapter 23](#).

12.04.03 Withdrawal of an examiner's report – December 2020

An examiner's report may be withdrawn in exceptional circumstances where the facts of the case demonstrate a need to withdraw the report. Such situations can include, but are not limited to:

- i. an examiner's report is sent in error;
- ii. an examiner's report is sent to the wrong address as a result of an error attributed to CIPO (see [2.02.09b](#));
- iii. an examiner's report is so uninformative that it prevents the applicant from recognizing and seeking to counter the defects raised by the examiner;
- iv. mailing and CIPO processing errors, such as missing pages of an examiner's report or an incorrect due date in an examiner's report;
- v. an examiner's report is based on incorrect pages of the claims, description or drawing that affect the relevancy of the report in full (this does not include typographical errors in the indication of pages of the claims, description or drawing examined, or in the indication of the number of claims examined). An exception to this is when the correct pages that should have been examined were contained in a voluntary amendment received within the one month period before the date of the examiner's report, other than a voluntary amendment submitted within a predetermined timeframe in response to a formal interview (see [12.06](#)); and
- vi. in the event of delays of greater than one month between the date of the examiner's report and the date the report is received by the applicant, upon receipt of evidence satisfactory to the Commissioner (see [2.02.09d](#)).

If an applicant believes that an examiner's report should be withdrawn, a written request to withdraw the examiner's report must be made to the Patent Office (requests made by phone will not be considered). In respect of situations defined in items iii, iv, and v, the time limit to request withdrawal of a report is the earlier of four months after the date of the examiner's report (i.e. the due date to respond to the requisition) and the day the

applicant responds to the examiner's report. There is no time limit to request withdrawal of an examiner's report sent in error.

If the applicant chooses to request an examiner's report be withdrawn, the applicant should clearly denote this request in uppercase characters on the first page of the cover letter along with the date of the examiner's report and must specify the reason(s) they believe the report should be withdrawn. For example:

- **REQUEST FOR WITHDRAWAL OF EXAMINER'S REPORT**

Applicant requests withdrawal of examiner's report dated [DATE]. It appears the examiner's report is missing pages 2 and 3.

Once a request is received in the Patent Office, the reason(s) for requesting withdrawal of the report and the timeliness of the request will be evaluated and the applicant will be informed by letter whether or not the report has been withdrawn.

12.04.03a Minor errors in an examiner's report – December 2020

Where an examiner's report contains minor errors, for example, correctness and completeness of arguments in relation to noted defect(s), or typographical errors in the indication of pages, in the number of claims examined, in a defect noted, in reference to parts of the *Patent Act* or *Patent Rules*, or in prior art citations, the report will not be withdrawn. If the correction of the minor error is not immediately obvious, it is recommended that applicants raise the issue with the examiner through an applicant-initiated interview (see [12.06.01](#)) such that any correction or clarification may be sought and be fully and clearly documented in an interview record. The applicant may also wish to include discussion on the minor error in the response to the report.

12.05 Other Notices During Examination - October 2019

12.05.01 Additional Drawings

The Commissioner may see fit to require further drawings if those on file do not clearly show all parts of the invention. These may be requested by notice under section 27(5.2) of the *Patent Act*. If a good faith reply attempting to provide the requested drawings is not received within three months of the request date, the application is deemed to be abandoned.

12.05.02 Translation of Priority Documents

During the course of examination, if consideration of a priority document based partly or entirely in a language other than English or French is necessary, an examiner may, by notice, request under section 76(1) of the *Patent Rules* that the applicant provide an English or French translation of part or all of said document. If the examiner has reasonable grounds to believe that such a translation is inaccurate, a certified translation may be requested under section 76(2) of the *Patent Rules*. Both of these notices require a response within four months, failing which, the associated request for priority will be considered to have been withdrawn (see section [7.05](#) for more information).

12.05.03 Accessibility of Priority Documents – September 2020

With respect to an application for which a request for priority on an application filed other than in Canada was made before October 30th, 2019, an examiner may, by notice, require the applicant under section 196(1) of the *Patent Rules* to provide within four months:

- a. A certified copy of said priority application, and a certificate indicating the filing date, issued by the filing office; or
- b. A digital copy of said priority application to be made available in the designated digital library.

The request for priority will be considered to have been withdrawn if the request is not met, unless the applicant requests restoration of priority and provides evidence of having submitted the request to the filing office. In this case, said requested documents must be provided to the Commissioner no later than three months after the date of receipt by the applicant (see section [7.04](#) for more information on requests for priority and section [18.03](#) for more information on priority during examination).

12.06 Interviews – October 2019

In some cases interviews may take place between examiners and the appointed patent agent, common representative or single applicant. Where an agent has been appointed, an interview may only be conducted with the common representative or single applicant if the agent is present in the interview; or, has provided written permission for the common representative or single applicant to conduct an interview in the agent's absence. Such interviews will be documented in the Canadian Patent Database.

12.06.01 Applicant-initiated interviews

Subject to the conditions imposed by section 39 of the *Patent Rules*, the appointed patent agent, common representative or single applicant may request an interview with an examiner in respect of an application. Appointments must be arranged in advance so that the examiner will be available and prepared to discuss the prosecution of the application. Where an agent has been appointed, the agent must be present at the interview or have authorized it.

An interview concerning the prosecution of an application, including an application that has received a final action, may be requested at any stage of the prosecution and will be conducted by the examiner in charge of the application. During the interview the examiner may provide further explanation about the defects identified in a report or clarify certain points concerning the invention. It should be noted that interviews do not replace the normal prosecution of an application. An examiner will not provide definitive verbal opinions or agree to accept amendments to the specifications during an interview.

In the case of an interview with a new examiner in training, a senior examiner or a section head will also be in attendance. Problems that do not concern the examination process are referred to the appropriate section of the Patent Office.

The Commissioner does not meet with applicants or agents about prosecution issues related to specific applications.

12.06.02 Examiner-initiated interviews

The Patent Examination Interview Service promotes direct communication between CIPPO's patent examiners and patent agents or unrepresented inventors by allowing for the prosecution of patent applications by telephone. The Service encourages patent examiners to contact the appointed patent agent or common representative or single applicant if no agent has been appointed by phone in situations where advancing prosecution is likely, such as when there are only a few minor defects remaining in an application.

The Service offers the appointed patent agent or common representative or single applicant if no agent has been appointed an opportunity to discuss the application directly with the examiner, obtain suggestions or advice from the examiner as to how an identified defect may be overcome, and correct any identified defects through written submission of a voluntary amendment within a predetermined timeframe. Any voluntary amendments submitted as a result of a phone interview are reviewed by the examiner

expeditiously and the application is approved for allowance, if the amended application complies with the *Patent Act* and *Patent Rules*.

The predetermined timeframe above does not have any effect on the standing of the application; if a voluntary amendment is not received by the end of the predetermined timeframe, the examiner will simply issue a report based on the last received amendments.

1 [Free World Trust v Électro Santé Inc., 2000 SCC 66](#), paragraphs 14 and 15.

2 [Whirlpool Corp. v Camco Inc., 2000 SCC 67](#), paragraph 45 and [Free World Trust v Électro Santé Inc., 2000 SCC 66](#), paragraph 31.

3 [Whirlpool Corp. v Camco Inc., 2000 SCC 67](#), paragraph 52.

4 [Whirlpool Corp. v. Camco Inc., 2000 SCC 67](#) at paragraphs 49(f)(g), 52 and 53

5 [Free World Trust v. Électro Santé Inc., 2000 SCC 66](#) at paragraph 51

6 [Canada \(Attorney General\) v. Amazon.com Inc., 2011 FCA 328](#) at paragraph 73

7 [Merck & Co., Inc. v. Pharmascience Inc. 2010 FC 510](#) at paragraphs 32 and 35

8 [Bayer Aktiengesellschaft v. Apotex Inc. \[\(1995\), 60 C.P.R. \(3rd\), 58 \(On.Ct.G.D.\)\]](#) at page 79; [Johnson & Johnson Inc. v. Boston Scientific Ltd. 2008 FC 552](#) at paragraph 97; [Lundbeck Canada Inc v. Minister of Health 2009 FC 146](#) at paragraph 36; [Bauer Hockey Corp. v. Easton Sports Canada Inc. 2010 FC 361](#) at paragraph 122

9 From *Beloit Canada Ltd. v. Valmet Oy* [(1986), 8 C.P.R. (3rd), 289 (F.C.A.)] at page 294 we know them to be a paragon of deduction. See also the comments on point in [Janssen-Ortho Inc. v. Novopharm Ltd. 2006 FC 1234](#) at paragraph 113.

10 [Bayer Aktiengesellschaft v. Apotex Inc. \[\(1995\), 60 C.P.R. \(3rd\), 58 \(On.Ct.G.D.\)\]](#) at page 79; [Merck-Frosst - Schering Pharma GP v. Teva Canada Limited 2010 FC 933](#) at paragraphs 68 and 69

11 [Servier Canada Inc. v. Apotex Inc. 2008 FC 825](#) at paragraph 99; [Lundbeck Canada Inc. v. Ratiopharm Inc. 2009 FC 1102](#) at paragraph 29; [Sanofi-Aventis Canada Inc. v. Apotex 2009 FC 676](#) at paragraph 80

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- 12 *Almecon Industries Ltd. v. Nutron Manufacturing Ltd.* (1997) 72 C.P.R. 3d 397 at page 401.
- 13 [Whirlpool Corp. v. Camco Inc. 2000 SCC 67](#) at paragraph 74; [Servier Canada Inc. v. Apotex Inc. 2008 FC 825](#) at paragraph 254; [Newco Tank Corp v. Canada \(Attorney General\) 2014 FC 287](#) at paragraph 28.
- 14 [Axcan Pharma Inc. v. Pharmascience Inc., 2006 FC 527](#) at paragraph 38
- 15 [Servier Canada Inc. v. Apotex Inc. 2008 FC 825](#) at paragraph 236
- 16 [Ratiopharm Inc. v. Pfizer Limited 2009 FC 711](#), at paragraph 30, *aff'd* [2010 FCA 204](#)
- 17 [GlaxoSmithKline Inc. v. Pharmascience Inc., 2008 FC 593](#) at paragraph 35
18. [Janssen-Ortho Inc. v. Novopharm Ltd. 2006 FC 1234](#) at paragraph 90.
- 19 [Bauer Hockey Corp. v. Easton Sports Canada Inc. 2010 FC 361](#) at paragraph 121
- 20 [Merck & Co., Inc. v. Pharmascience Inc. 2010 FC 510](#) at paragraph 40; [AstraZeneca Canada Inc. v. Apotex Inc. 2010 FC 714](#) at paragraph 39
- 21 [Apotex Inc. v. Sanofi-Synthelabo Canada Inc. 2008 SCC 61](#) at paragraph 37
- 22 [Sanofi-Aventis Canada Inc. v. Apotex 2009 FC 676](#) at paragraph 304
- 23 [Whirlpool Corp. v. Camco Inc. 2000 SCC 67](#) at paragraph 74
- 24 [Eli Lilly and Company v. Apotex Inc. 2009 FC 991](#) at paragraph 97, citing *General Tire & Rubber Co. v. Firestone Tyre & Rubber Co. Ltd.*, [1972] RPC 457 at pages 482-483
- 25 [Eli Lilly and Company v. Apotex Inc. 2009 FC 991](#) at paragraph 421
- 26 [Shire Biochem Inc. v. Minister of Health 2008 FC 538](#) at paragraph 25; [Eli Lilly Canada Inc. v. Novopharm Ltd. 2007 FC 596](#) at paragraph 142; [Pfizer Canada Inc. v. Novopharm Ltd. 2005 FC 1299](#) at paragraph 78; *Whirlpool Corp. v. Camco Inc.* [(1997), 76 C.P.R. (3rd), 150 (F.C.T.D.)] at page 186
- 27 [Free World Trust v Électro Santé Inc., 2000 SCC 66](#), paragraph 55.
- 28 [Distrimedic Inc v Dispill Inc. 2013 FC 1043](#), paragraph 201.
- 29 The “claim date” of a claim in an application or patent is the filing date of the application in

Canada, unless a request for priority is made. In the latter case the claim date is the filing date of the earliest priority application that discloses the subject-matter defined by the claim.

30 Searches performed by Canadian examiners as part of CIPO's obligations as an International Searching Authority are governed by the requirements of the PCT, and are not covered by this section of the manual.

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