Chapter 18 Anticipation, Obviousness and Double-Patenting

18.01 Anticipation – MODIFIED

The requirement that an invention be novel finds its basis in the definition of *invention* in section 2 of the *Patent Act* – "any new [...] art, process, machine, manufacture or composition of matter or any new and useful improvement in any art, process, machine, manufacture or composition of matter".[1]

In order for an invention to be novel, it must be established that individual disclosures in the prior art do not anticipate the claimed invention.

Whether a given disclosure is considered to be prior art is governed by section 28.2 of the *Patent Act*. Although any public disclosure of information may be considered in principle, for practical reasons the assessment is almost exclusively performed on the basis of written disclosures.

Anticipation is assessed on a claim-by-claim basis by asking whether the prior disclosure, when understood by the person skilled in the art in light of their common general knowledge, provides both a description of the claimed invention (disclosure) and sufficient instructions to enable the invention to be practised (enablement).[2]

The comparison of the claimed invention to the prior disclosure is based on a comparison of the essential elements of the claim, properly construed, to the prior art.[3] Furthermore, an invention is considered to have been previously described where the subject-matter previously disclosed would, if performed, infringe the later claim.[4]

A prior disclosure is considered to be enabling for the purpose of anticipation if the person skilled in the art, where necessary through trial and error experimentation that is neither inventive nor an undue burden, can operate the disclosed invention successfully.[5]

18.01.01 Prior art when assessing anticipation

Section 28.2 of the *Patent Act* defines what disclosures may be considered for the purpose of assessing anticipation. In summary, this section establishes: a *grace period* of an application during which disclosures originating from the applicant are excluded as prior art; third party disclosures anywhere in the world before the application *claim date* as prior art; and the conditions respecting first-to-file when a co-pending Canadian application filed by a person other than the applicant is prior art.

Pursuant to section 163 of the *Patent Rules*, an international application (i.e. one filed under the *Patent Cooperation Treaty*) is not considered to be a Canadian application for the purposes of *first-to-file* anticipation (paragraphs 28.2(1)(c) and (d) of the *Patent Act)* unless it has entered the national phase. Subsection 155(1) of the *Patent Rules* provides that once an international application enters the national phase to become a PCT national phase application, it is considered to be an application filed in Canada.

In accordance with subsection 28.2(2) of the *Patent Act*, a Canadian application that is withdrawn before being opened to public inspection is considered, for the purposes of paragraphs 28.2(1)(c) and (d), never to have been filed. Consequently, such an application is not eligible as *first-to-file* prior art. Any Canadian application that has been opened to public inspection may be eligible as prior art under 28.2(1)(c) or (d) even where it has been withdrawn, abandoned or refused.

18.01.01a Self-anticipation

Paragraph 28.2(1)(a) of the *Patent Act* provides that

> The subject-matter defined by a claim in an application for a patent in Canada (the “pending application)” must not have been disclosed (a) before the one-year period immediately preceding the filing date or, if the claim date is before that period, before the claim date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant, in such a manner that the subject-matter became available to the public in Canada or elsewhere[.]

This provision defines self-anticipation which occurs when a public disclosure made by the applicant or by a person who obtained their knowledge directly or indirectly from the applicant is used as prior art for the assessment of anticipation, but excludes this disclosure as prior art if it was made in the *grace period*. For the purposes of self-anticipation, the Patent Office considers the applicant to include the inventor(s) (see the definition of “applicant” in section 2 of the *Patent Act*).

The grace period is one year before the filing date of the application, unless the claim date is earlier than that period, in which case the grace period is the period starting at the beginning of the claim date and ending immediately before the filing date [See 18.04].

18.01.01b Third party anticipation

Paragraph 28.2(1)(b) of the *Patent Act* provides that

> The subject-matter defined by a claim in an application for a patent in Canada (the “pending application”) must not have been disclosed
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> (b) before the claim date by a person not mentioned in paragraph (a) in such a manner that the subject-matter became available to the public in Canada or elsewhere[.]

This provision defines any public disclosure made by a third party (i.e. by a person other than the applicant or a person who obtained their knowledge directly or indirectly from the applicant) as prior art for the assessment of anticipation if it was made before the *claim date* [see 18.03].

18.01.01c First-to-file anticipation based on filing-date

Paragraph 28.2(1)(c) of the *Patent Act* provides that

> The subject-matter defined by a claim in an application for a patent in Canada (the “pending application”) must not have been disclosed
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> (c) in an application for a patent that is filed in Canada by a person other than the applicant, and has a filing date that is before the claim date[.]

This provision exists to give effect to *first-to-file* considerations, and allows a Canadian patent application that was not open to public inspection as of the subject application's claim date and which would consequently not be citable under paragraph 28.2(1)(b) of the *Patent Act* to nevertheless be considered for the purpose of anticipation. Note that the entire content of the earlier application is considered in assessing anticipation. The analysis is not limited by the matter claimed in the earlier application.

This provision defines a Canadian co-pending patent application, made by a third party, not open to public inspection as of the subject application's claim date and having a filing date earlier than the pending application claim date as prior art for the assessment of anticipation of the pending application. Paragraphs 28.2(1)(c) and (d) effectively establish Canada's first-to-file regime.

Where the applicability of a Canadian application as prior art under paragraph 28.2(1)(c) depends on the validity and extent of the priority claim of the application being examined, the examiner should obtain the priority document and verify whether the filing date of the priority date may be used as the claim date (see 18.03).

18.01.01d First-to-file anticipation based on priority date

Paragraph 28.2(1)(d) of the *Patent Act* provides that

> The subject-matter defined by a claim in an application for a patent in Canada (the "pending application") must not have been disclosed
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> (d) in an application (the "co-pending application") for a patent that is filed in Canada by a person other than the applicant and has a filing date that is on or after the claim date if
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> (i) the co-pending application is filed by
>
> (A) a person who has, or whose agent, legal representative or predecessor in title has, previously regularly filed in or for Canada an application for a patent disclosing the subject-matter defined by the claim, or
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> (B) a person who is entitled to protection under the terms of any treaty or convention relating to patents to which Canada is a party and who has, or whose agent, legal representative or predecessor in title has, previously regularly filed in or for any other country that by treaty, convention or law affords similar protection to citizens of Canada an application for a patent disclosing the subject-matter defined by the claim,
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> (ii) the filing date of the previously regularly filed application is before the claim date of the pending application,
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> (iii) the filing date of the co-pending application is within twelve months after the filing date of the previously regularly filed application, and

(iv) the applicant has, in respect of the co-pending application, made a request for priority on the basis of the previously regularly filed application.

This provision expands the definition of prior art for the assessment of anticipation of a pending application to include Canadian co-pending applications not open to public inspection as of the subject application's claim date and having a claim date earlier than the pending application claim date.

The provision requires that the claims of the co-pending Canadian application benefit from a priority date that precedes the claim date of the application being examined. The filing date, information relating to the priority request, and content of the priority document of the co-pending application should be reviewed by the examiner to ensure that it has met all requirements necessary to benefit from this earlier claim date (see 18.03). The assessment is based on the entirety of the information benefiting from the priority date, and is not further limited by the claims.

18.01.02 Assessing anticipation

The test for anticipation, as set out by the Supreme Court in *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* 2008 SCC 61, requires that a single disclosure both disclose and enable the claimed invention.[6] The approach taken by the person skilled in the art in reading and applying the prior art differs slightly when assessing the two parts of the test.

The first part of the test for anticipation asks whether a single prior teaching discloses the same invention that has been claimed in the application under consideration (or, where a claim encompasses several embodiments, of at least one operating embodiment of the claimed invention). In reading the prior disclosure to understand the matter it describes, the skilled person[7] is "taken to be trying to understand what the author of the description [in the prior patent] meant".[8] The prior disclosure is read in the same informed and purposive manner as the application itself, so as to fairly interpret its teachings,[9] as if being read by the person skilled in the art at the *claim date* of the claim under consideration.[10] The disclosure does not have to be an "exact description" of the claimed invention. The disclosure must be sufficient so that when read by a person skilled in the art willing to understand what is being said, it can be understood "without trial and error".[11] Even if the prior disclosure uses quite different terms to describe its subject-matter, "if carrying out the directions contained in the prior inventor's publication will inevitably result in something being made or done which [...] would constitute an infringement" of a claim being examined, the prior disclosure describes the same invention.[12]

If the prior teaching does disclose the claimed invention, the next part of the test must be evaluated. That is, does the prior disclosure enable the disclosed invention to be operated without inventive effort or undue experimentation? [See Chapter 14 of this manual as it relates to disclosure]. At this stage, the person skilled in the art "is assumed to be willing to make trial and error experiments to get [the invention] to work".[13] Note that enablement does not mean that the earlier invention was actually put into practice, but simply that the earlier disclosure was sufficient to enable the person skilled in the art to build, operate or use the invention. If, on a fair and balanced reading of an earlier disclosure, it is unclear whether the disclosure is enabling of the claimed invention, the examiner must set forth the reasons for considering that the disclosure is, in fact, enabling. In contrast, where an applicant asserts that inventive effort or an undue burden would be required to operate an invention in view of an earlier disclosure, this should be supported by reasoned arguments and, as appropriate, by relevant facts.

While particular expressions of the test for anticipation have been provided by various Courts, a common thread is that the prior teaching has to anticipate "for [the] purpose of practical necessity",[14] implying that the test for anticipation is based on practical considerations rather than theoretical ones.[15] The test has been described as asking whether the prior art document gives "information which for the purpose of practical utility is equal to that given by the subject" application,[16] and similarly as asking whether the prior disclosure would allow the person skilled in the art to understand "and be able practically to apply the discovery without the necessity of making further experiments and gaining further information before the invention can be made useful".[17]

In many circumstances, the concept of "reverse infringement" can be used to assess anticipation.[18] Based on the principle that "what amounts to infringement, if posterior, should, as a general rule, amount to anticipation, if anterior",[19] anticipation by reverse infringement asks "if the earlier disclosure were to be put into practice, would it infringe the later claims"?[20]

While the jurisprudence describes the approach to anticipation using various expressions relevant to the facts of the cases then under consideration, ultimately it is important to bear in mind that the actual requirement to be satisfied is simply that provided in section 28.2 of the *Patent Act*. At its simplest, the assessment of anticipation can be reduced to this: the subject-matter of the claim being examined is analysed in order to identify the elements that are essential. The prior art is analysed to determine if it discloses and enables the use of the same elements (whether or not disclosed in the same terms) in a form suitable for the same purpose as the claimed matter. If so, the prior disclosure anticipates the later claimed subject-matter.

In performing this analysis, it may be necessary to determine whether claimed elements

function in combination to produce a unitary or synergistic result. Where different elements or sets of elements in a claim operate independently of each other to produce distinct results, then the two do not form a proper combination, but rather define an aggregation. In such a case, the removal of one element would have no effect on how the remaining elements function. Where a claim is construed to define two or more collocated but distinct inventions, each invention should be individually assessed for anticipation. In such cases, a defect under section 28.2 of the *Patent Act* should not be raised unless all of the inventions are anticipated; if at least one invention is novel, the claimed subject-matter will not have been previously disclosed.

In assessing anticipation, it may also be determined that a claim encompasses many different operating embodiments. The claim will be anticipated if any one working embodiment is disclosed and enabled by the prior art.[21]

Example:

An application is directed to improved methods of treating lung cancer. The application discloses that the inventors surprisingly found that the combination of cisplatin with chelerythrine (a protein kinase C inhibitor) is unexpectedly effective in treating lung cancer. In follow-up studies, the inventors discovered that the effect was shared by other protein kinase C inhibitors including staurosporine (a broad spectrum protein kinase inhibitor that inhibits protein kinase C).

Patent application D1, filed by a third party and published before the claim date of the application under review, discloses the use of cisplatin and staurosporine in treating lung cancer. D1 also notes the unexpected effectiveness of the combination but, because of the large number of potential targets of stauroporine, D1 does not disclose the actual target responsible for the unexpected effectiveness or otherwise follows-up on the results. D1 includes information about how to formulate and administer the combination of drugs.

Claims:

1. The use of cisplatin and protein kinase C inhibitors in combination for the treatment of lung cancer.

2. The use of claim 1 wherein the protein kinase C inhibitor is chelerythrine or staurosporine.

3. The use of claim 1 wherein the protein kinase C inhibitor is not staurosporine.

Analysis

Purposive Construction

Person of ordinary skill in the art (POSITA)

The POSITA is likely made up of a team including an oncologist knowledgeable in the field of lung cancer and a pharmacologist knowledgeable in the formulation of cancer drugs.

Common general knowledge (CGK)

The CGK includes the well-known treatments for lung cancer as well as the many ways in which treatments can be combined, formulated and administered. The CGK would also include a broad knowledge of the different categories of inhibitors used in cancer treatments as well as that category to which well-known particular inhibitors might belong.

Meaning of terms

It is clear from the claims, and supported by reference to the specification read in view of the CGK of the POSITA, that the expression “protein kinase C inhibitor” encompasses all molecules that inhibit protein kinase C even if the molecules also inhibit other targets. Thus, staurosporine would be considered to be a protein kinase C inhibitor.

What elements are essential?

For claim 1 all elements are essential which, based on the construction of the meaning of “protein kinase C inhibitor” above, means that the use of staurosporine in combination with cisplatin is within the fences of the claim.

For claim 2 the expression involving “or” signals a situation involving alternatives which means that there are embodiments where not all the elements are necessarily essential. While all the embodiments need to be assessed for patentability, in the present situation it is the embodiment where chelerythrine is not essential that is most relevant for the assessment of anticipation. In particular, the essential elements of this embodiment are the use of cisplatin and staurosporine for the treatment of lung cancer.

For claim 3 the presence of a proviso (or negative limitation) indicates that the element “staurosporine” is not essential. In fact, it is the absence of staurosporine that is an essential element of the claim. Thus, the use of staurosporine in combination with cisplatin is not within the fences of the claim.

Are the claims anticipated?

D1 discloses and enables the use of the combination of cisplatin and staurosporine in the treatment of lung cancer. Thus, D1 will anticipate any claim which is purposively construed to contain an embodiment where cisplatin and staurosporine are used in combination to treat lung cancer. From the purposive construction above it is clear that claims 1 and 2 have such an embodiment and claim 3 does not include such an embodiment. Therefore, claims 1 and 2 are anticipated by D1 while claim 3 is novel over D1.

18.01.03 Anticipation by prior sale or use

Although the majority of prior art consists of written disclosures, the sale or use of an invention can also be relevant prior art if it effectively provides an enabling disclosure of the application's claimed subject-matter prior to the claim date of the pending application.[22]

To be considered to have disclosed the claimed invention, the prior sale or use must provide to the person skilled in the art information sufficient to comprehend the invention.[23] "The use of a product makes the invention part of the state of the art only so far as that use makes available the necessary information."[24] The information made available must be such that if the person skilled in the art were to write down that information, they would have drafted a clear and unambiguous description of the claimed invention.[25] Disclosure may be made if the public has the "opportunity to access the information that is the invention".[26]

As was noted in *Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd.*, in determining whether a publicly available product anticipates a claimed invention, the ability of the person skilled in the art to reverse engineer the product "in accordance with known analytical techniques" may be relevant.[27] What is required for this consideration is the ability to reverse engineer without inventive effort; it is not necessary to establish that the product was actually reverse engineered.[28]

In considering whether anticipation by prior sale or use of an invention has occurred, the *grace period* provided for in paragraph 28.2(1)(*a*) of the *Patent Act* applies in respect of any making available of the invention by the applicant or by a person who obtained the relevant knowledge directly or indirectly from the applicant (see 18.04).

18.01.04 Implicit or inherent disclosure

An enabling disclosure is considered to disclose everything that would inevitably or

necessarily occur or be done by a person practising the invention. Old and known subject-matter is not rendered novel simply by disclosing and claiming a feature which is inherently (i.e. necessarily present) or implicitly (i.e. suggested but not directly expressed) found in the prior art.[29] The concepts of inherent and implicit disclosure are related.

Inherent features of a disclosed invention include properties and characteristics of the elements of the invention, such as the ductility of a metal used in a part in a machine, the mechanism of action of a drug taken to treat a disease, or the thermoplastic properties of a polymer.

Implicit features include those things that a person skilled in the art would, in view of their common general knowledge, necessarily understand to be part of what one would do in order to operate the disclosed invention. If a chemical process calls for 'distillation at reduced pressure' without further elaboration, the use of some means for reducing the pressure to below atmospheric is implicit. If a watch band is to be assembled using parts that interact to give the band greater flexibility, the use of attachment means to hold the parts together would be understood by the person skilled in the art and could be considered implicit in the disclosure even if no specific directions to attach the parts together were given.[30]

The mere discovery of the properties of a previously disclosed invention does not make that invention newly patentable, but where the discovery leads to a new practical application of the previous invention that new practical application may be patentable.[31]

> Example:
>
> Consider that a prior art document discloses a chemical compound X and how to make it, and establishes that compound X is useful in treating disease Y. Where subsequent research uncovers the mechanism of action of the compound, a claim to the use of compound X to treat disease Y via the newly discovered mechanism is not novel. Compound X inherently treated disease Y via the mechanism, and the discovery has not led to a new use for the known compound.[32] However, if the discovery of the mechanism allows one to conclude that compound X would also be useful in treating disease Z, the use of compound X to treat disease Z may be patentable.

Where features implicit or inherent in a previously disclosed invention are being considered when assessing anticipation, it is important to recognise that such features do not create a new invention if a person using the previously disclosed invention would already have achieved the benefits arising from the presence of the implicit or inherent

features. This follows from the “well-known principle in Patent law that a man need not state the effect or the advantage of his invention, if he describes his invention so as to produce it”.[33] The earlier invention is sufficiently disclosed even if all its advantages were not taught, and the earlier inventor “is entitled to its benefit even if he does not fully appreciate or realize the advantages that flow from it or cannot give the scientific reasons for them”.[34] Performing the earlier invention would provide the benefits arising from the implicit or inherent features; under the principle of anticipation by reverse infringement [18.01.02], the earlier disclosure would be anticipatory.

Where a conclusion of anticipation requires the presence of an inherent or implicit feature, it is necessary for the examiner to clearly explain the basis for concluding that the feature is implicit or inherent to the matter of the prior disclosure. Where such a conclusion is supported by secondary references, the date of publication of these references is not important.

Example:

In the field of respiratory diseases, the use of a powdered drug C is well known.

An applicant files an application A, which describes a powder inhaler capable of aerosolizing and delivering powdered medicament to a recipient. Their specification describes and illustrates the inhaler as having means for varying airflow volume and resistance and notes that adjustments thereto may be made for delivering unspecified powdered medicaments. No indication is made as to the specific airflow properties of the inhaler but feature Z is illustrated.

Two years after the publication of application A, the applicant files application B, which describes a delivery-efficacy testing regimen for the inhaler claimed in application A. Application B does not describe any inventive medicament, but does refer to drug C. No modifications to the inhaler are disclosed in application B.

Claims of application B:

1. A dry powder inhaler for delivering a powdered drug, comprising feature Z and having a delivery efficiency of at least W wherein the inhaler has a flow resistance of X at a flow rate of Y.

2. The dry powder inhaler according to claim 1 wherein the powdered drug is C.

Analysis: Application B discloses that the dry powder inhaler described in application A was used for the applicant’s trials, and does not describe any modifications made to the inhaler. It must be concluded that whenever the dry powder inhaler of

application A is used, it will have the delivery efficiency, flow resistance and flow rate defined in the claim. These are merely inherent properties of a dry powder inhaler as described in application A. Inclusion of these properties in the claim of application B does not direct claim 1 to a different dry powder inhaler than the one disclosed in application A. Claim 1 is therefore anticipated.

Claim 2 defines the dry powder inhaler of claim 1 wherein the drug that will be delivered is the well-known drug C. Since no adaptation of the inhaler is, in view of application B, required for it to deliver drug C, the claim remains directed, simply, to the inhaler disclosed in application A and is anticipated. Defining that the inhaler is capable of delivering drug C merely specifies one of its inherent abilities.

18.01.05 Anticipation based on related teachings

Anticipation assesses whether a single prior disclosure both revealed the invention in a claim being examined and enabled a person skilled in the art to operate it.

In some limited situations, a single prior disclosure can comprise teachings in more than a single document. This may occur where a primary source of information makes explicit reference to specific teachings in a secondary source, thereby making clear to the skilled reader that the teachings of the secondary source are to be relied on in order to understand or complete the disclosure of the invention in the primary source.

In order to consider multiple sources of information to comprise a single disclosure, there must be an unambiguous relationship between the two sources. References in one source that merely mention the other are not sufficient to establish such a relationship. Rather, the first source must direct the reader to use the teachings of the second source for the purposes of understanding and operating the invention.

18.02 Obviousness – MODIFIED

The requirement that an invention be inventive was, prior to October 1, 1996, recognised judicially as inherent to the definition of *invention*[35] but is now more formally reflected in the *Patent Act*.[36] Ingenuity is tested by determining whether the claimed invention is obvious (i.e. uninventive) when considered by a person skilled in the art in light of their common general knowledge and the state of the art as a whole.[37] In contrast to the approach for assessing anticipation [see 18.01.02], the evaluation of obviousness allows for a consideration of the combined teachings of multiple prior art documents.[38]

The use of the term “obvious” in section 28.3 of the *Patent Act* has not changed the

inherent requirement that an invention be the result of ingenuity.[39] The courts have noted that “obviousness is an attack on a patent based on its lack of inventiveness”[40] and “[t]he courts have chosen to define ‘lack of inventiveness’ rather than ‘inventiveness’ and have called it ‘obviousness’ ”.[41]

Obviousness is assessed on a claim-by-claim basis by asking whether the claimed invention is obvious (or uninventive) when considered by the person skilled in the art in light of their common general knowledge and the state of the art as a whole.

To be considered obvious, the teachings present in the prior art must be sufficient so that, if combined, they would lead to the claimed invention (or to a working embodiment within the claim). Furthermore, it must be obvious (i.e. uninventive) to combine the necessary teachings so as to arrive at the claimed invention.

18.02.01 Prior art when assessing obviousness - June 2016

Section 28.3 of the *Patent Act* defines what disclosures may be considered for the purpose of assessing obviousness. Although any public disclosure of information may be considered in principle, for practical reasons the assessment is almost exclusively performed on the basis of written disclosures. In summary, this section provides for a *grace period* with respect to disclosures by the applicant before the *filing date* and allows any third party disclosure anywhere in the world made prior to the *claim date* to be considered.

18.02.01a Obviousness and prior disclosures by the applicant

Paragraph 28.3(a) of the *Patent Act* provides that

> The subject-matter defined by a claim in an application for a patent in Canada must be subject-matter that would not have been obvious on the claim date to a person skilled in the art or science to which it pertains, having regard to
>
> (a) information disclosed before the one-year period immediately preceding the filing date or, if the claim date is before that period, before the claim date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant in such a manner that the information became available to the public in Canada or elsewhere.

This provision defines public disclosures by the applicant, or by a person who obtained their knowledge directly or indirectly from the applicant, made before the *grace period* as prior art for the assessment of obviousness, but excludes these disclosures as prior art if made in the *grace period* preceding the *filing date*. For the purposes of this

paragraph of the *Patent Act*, the Patent Office considers the applicant to include the inventor(s) (see the definition of “applicant” in section 2 of the *Patent Act*).

The *grace period* is one year before the filing date of the application, unless the claim date is earlier than that period, in which case the grace period is the period starting at the beginning of the claim date and ending immediately before the filing date [See 18.04].

18.02.01b Obviousness and third party disclosures

Paragraph 28.3(b) of the *Patent Act* provides that

> The subject-matter defined by a claim in an application for a patent in Canada must be subject-matter that would not have been obvious on the claim date to a person skilled in the art or science to which it pertains, having regard to
>
> (b) information disclosed before the claim date by a person not mentioned in paragraph (a) in such a manner that the information became available to the public in Canada or elsewhere.

This provision defines any public disclosure made by a third party (i.e. by a person other than the applicant or a person who obtained their knowledge directly or indirectly from the applicant) as prior art for the assessment of obviousness if it was made before the *claim date* [see 18.03].

18.02.02 Assessing obviousness - October 2019

Obviousness is assessed from the viewpoint of the person skilled in the art, in light of their common general knowledge and the state of the art as it was on the claim date. For a claimed invention to satisfy the requirement of section 28.3 of the *Patent Act* there must be present that “characteristic or quality” (i.e. that “scintilla of invention necessary to support the patent”[42]) which serves to elevate the matter of the claims from mere workshop improvement to real invention.[43]

Although various tests have been expressed for assessing obviousness, the inquiry is not well served by attempting to rigidly apply any one test in all circumstances.[44] It is important to address the question in an informed way and the Supreme Court has endorsed a four-step analysis for this purpose, wherein the first three steps frame the inquiry and the fourth step is to ask the pertinent question.

The four steps in the analysis were set out by the Court in *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* as:[45]

(1) (a) Identify the notional "person skilled in the art";

(b) Identify the relevant common general knowledge of that person;

(2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;

(3) Identify what, if any, difference exists between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

The Supreme Court's admonition against attempting to apply any one test in all circumstances refers specifically to the question asked at step 4.

The *Sanofi* four-step analysis will typically be done intuitively and automatically by an examiner. Where there appears to be a disagreement between the examiner and applicant(s) as to whether or not a claim is obvious, the *Sanofi* four-step analysis should be set out in a report. This analysis must be set out in a pre-final or *Final Action* report.

To inform the first step of the *Sanofi* four-step analysis, guidelines for the identification of the person skilled in the art and of the common general knowledge follow. It should be kept in mind that the person skilled in the art and the common general knowledge of said person are considered in many aspects of examination and the following discussion is useful in this regard.

18.02.02a Person skilled in the art (Step 1(a))

The specification is to be read and understood from the point of view of the person skilled in the art (POSITA). More information on the POSITA can be found in section 12.02.02b.

The person skilled in the art is presumed to read prior disclosures in the same manner as the specification of the application itself. That is, with a mind willing to understand[46] and desirous of success.[47] In understanding the significance of the prior art, they may apply teachings from one source to another setting or even combine teachings.[48]

During examination, an examiner must attempt to interpret the application and the prior art using the appropriate knowledge that the person skilled in the art would have possessed at the relevant date.

18.02.02b Common general knowledge (Step 1(b))

"Common general knowledge means knowledge generally known by persons skilled in the relevant art at the relevant time."[49] The relevant time for the purposes of evaluating obviousness is the claim date.

More information on the common general knowledge is found in section 12.02.02c.

18.02.02c Identifying the inventive concept (Step 2)

The inventive concept of a claim is not necessarily the same as the essential elements gleaned following a purposive construction analysis (Purposive construction is outlined in section 12.02 of this manual). Construing the inventive concept for the purpose of the obviousness analysis is a separate exercise from claim construction, meaning that the construction of the claims is not determinative of the inventive concept.[50]

The inventive concept has been identified as not materially different from "the solution taught by the patent".[51] The identification of the inventive concept is, therefore, based on elements which would be recognised by a person skilled in the art as providing the solution to a given problem. The inventive concept may be discernible from the claims as purposively construed. However, "where it is not possible to fully grasp the nature of the inventive concept solely from those claims," it is possible to "have regard to the patent specification to determine if it provides any insight or clarification into the inventive concept of the claim(s) in issue".[52] When having regard to the patent specification, the identification of the inventive concept should be based on a reading of the specification as a whole from the perspective of the person skilled in the art, in light of their CGK. However, it is important that the inventive concept of the claim in question is that "which must be considered, not some generalised concept to be derived from the specification as a whole."[53]

Considering the focus on the claim, the inventive concept will generally include at least some of the essential elements identified during purposive construction of the claim, but it might not include all the essential elements of the claim. Furthermore, the inventive concept is not necessarily limited to the essential elements of the claim.[54]

18.02.02d Identifying the differences between the inventive concept and the state of the art (Step 3)

At step 3 of the obviousness analysis, the inventive concept of the claim in step 2 is compared to the state of the art to determine whether, or to what extent, there are any differences between the two. The state of the art refers to the information available to

the person skilled in the art in accordance with section 28.3 of the *Patent Act*, and generally will be identified by reference to specific prior art documents.

Should there be no difference between the inventive concept of the claim and the state of the art, the claim is most likely defective for being anticipated or obvious. For example, a claim may be anticipated where there is no difference between the inventive concept of a claim and only one prior art disclosure that is cited as state of the art, provided that the prior art disclosure is enabling. In cases where the prior art disclosure is not enabling, the claim may not be anticipated but may still be obvious. A claim may also be obvious where more than one state of the art document is required to arrive at the inventive concept.

Where differences exist between the inventive concept of the claim and the state of the art, it must be determined whether these differences would have been obvious to the person skilled in the art as of the claim date.

18.02.02e Do the differences constitute an inventive step? (Step 4)

Once any differences between the state of the art and the inventive concept of the claim or the claim as construed have been identified, it must be determined whether the subject-matter of the claim is obvious or is the result of inventive ingenuity. This must be done without presupposing that the specific problem addressed by the inventors was recognised in the prior art, so as to avoid adopting an improper “hindsight” perspective. Where the existence or nature of a problem was unobvious, the act of identifying the problem may inform the inventive concept.

As noted above, various tests have been articulated in the jurisprudence in order to answer this question, and the Supreme Court has cautioned that no single expression of this test is likely to apply to all circumstances. Although the test question may be framed taking into account the nature of the specific case in question, one must never lose sight that its purpose is to evaluate the statutory requirement of section 28.3 of the *Patent Act*, and care should be taken to ensure the question is not phrased in such a way that a different standard is applied.

In answering the question at step 4, the factors to be considered include:

i. the climate in the relevant field at the time the alleged invention was made, including not only knowledge and information available but also attitudes, trends, prejudices and expectations that would define the person skilled in the art;

ii. any motivation in existence at the time of the alleged invention to solve a recognised problem in the field of the invention; and

iii. the time and effort involved in the invention[55]

It should also be remembered that “the inventive ingenuity necessary to support a valid patent may be found in the underlying idea, or in the practical application of that idea, or in both. It may happen that the idea or conception is a meritorious one, but that once suggested, its application is very simple. Again, it may be that the idea is an obvious one, but that ingenuity is required to put it into practice. Or, again, the idea itself may have merit and the method of carrying it into practice also requires inventive ingenuity”.[56]

Where the problem to be solved was already recognised in the art, it may be appropriate to inquire only into whether inventive ingenuity was required to conceive of the claimed solution and put it into practice. Where, however, the problem or its underlying cause was not previously recognised or understood, there may be an invention even where the proposed solution to the newly identified problem would have been immediately apparent to the person skilled in the art. Inventive ingenuity, however, does not exist if the alleged problem never existed and was simply an artificial obstacle or “straw man” developed to imply inventiveness in the proposed “solution”.[57] Furthermore, there is nothing inventive in adding elements to a claim that are irrelevant to the invention’s successful operation.

The assessment of obviousness is approached by considering the prior art as a whole, and the teachings of several documents may be combined in order to show why the claimed subject-matter is not the result of inventive ingenuity. When combining teachings from several documents, the relationship of the documents to each other, and to the person skilled in the art, must be considered. An explanation as to why it was obvious to combine the teachings may be necessary in situations where it is not self-evidently so. This may be given, for example, by establishing why a motivation to combine the teachings in the cited documents exists, whether based on the teachings of the documents themselves, on the common general knowledge or trends in the field of the invention.

Where a document from outside the field of the invention is relied upon in the analysis, the need to explain why it would be obvious to apply the teachings to the field of the invention is greater.

Example of *Sanofi* four-step analysis*:*

An application discloses a method of cleaning lead from the interior of a steam still using a high-pressure stream of water. Suitable operating parameter ranges are disclosed, encompassing those that were actually used by the inventors to

successfully clean a still.

The use of high-pressure water to clean surfaces has many applications, and is used in many environments. A search of the prior art reveals documents D1-D3. D1 teaches a method of removing carbon deposits from the interior of a smoke stack by sweeping a high pressure stream of cleaning fluid over the encrusted surface. D2 teaches a wet abrasion process for removing calcium deposits from tiles, and includes illustrations of distributed and focussed spray patterns and of workers sweeping a sprayer at a surface from a distance. D3 teaches a pressure washer for cleaning barnacles off the hull of a vessel, and discloses interchangeable nozzles attachable to a wand where each nozzle produces a specific spray pattern. Each of the documents discloses operating parameters suitable for its specific environment.

Claim 1:

A method of removing lead residue from the interior of a steam still, wherein a stream of fluid from a nozzle is directed to a surface of the steam still at a velocity of between 300 and 1200 ft/s, with the nozzle held from 1-12 inches from the surface at an angle of between 15 and 45 degrees.

Analysis: The problem addressed in the application is cleaning deposits off a hard surface.

In order to determine whether the claimed subject-matter is inventive, the claim is assessed via the four step method [see 18.02.02].

(1)(a) Identify the notional “person skilled in the art”:

The person skilled in this art is taken to be a technician familiar with high-pressure washing and general removal, i.e., cleaning, of deposits from surfaces.

(b) Identify the relevant common general knowledge of that person:

The common general knowledge includes an understanding of typical operating parameters for pressure-washers, suitable cleaning agents and common applications for such washers.

(2) Identify the inventive concept of the claim in question:

In this case the inventive concept includes all of claim 1: a method of removing lead residue from the interior of a steam still, wherein a stream of fluid from a nozzle is directed to a surface of the steam still at a velocity of between 300 and 1200 ft/s, with the nozzle held from 1-12 inches from the surface at an angle of between 15

and 45 degrees.

(3) Identify what, if any, difference exists between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed:

The inventive concept of the claim differs from the state of the art (D1 to D3) in specifying that the surface to be cleaned is the interior of a steam still and in establishing certain specific operating parameters.

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

The person skilled in the art, presented with a steam still surface requiring cleaning would arrive at the operating parameters defined in the claim without inventive ingenuity or undue burden. The use of a pressure-washer in a steam still is directly analogous to its use in the environments disclosed in D1 to D3, and uninventive in view of those disclosures. No unexpected result arises from operating the washer within the parameters defined in the claim. The subject-matter of the claim is therefore obvious.

18.02.03 Obvious to try considerations - June 2016

Determining whether a claimed invention is obvious at step 4 of the obviousness inquiry may involve asking whether the claimed subject-matter is obvious because the route to the invention would have been *obvious to try*. This approach may be especially pertinent in “areas of endeavour where advances are often won by experimentation”[58] but there are no restrictions on its applicability to specific technologies.[59,]

When considering an *obvious to try* analysis, the following non-exhaustive list of factors is relevant:

1. Is it more or less self-evident that what is being tried ought to work? Are there a finite number of identified predictable solutions known to the person skilled in the art?

2. What is the extent, nature and amount of effort required to achieve the invention? Are routine trials carried out or is the experimentation prolonged and arduous, such that the trials would not be considered routine?

3. Is there a motive provided in the prior art to find the solution the patent addresses?[60]

When assessing obviousness during examination, these factors may be recast as questions to be considered by the examiner:

1. Would the person skilled in the art have been aware, in view of the prior art and the common general knowledge on the *claim date*, that a limited number of predictable and identifiable solutions exist to the same or a similar problem such that they would believe that one of those solutions more or less self-evidently ought to work to solve the problem being addressed?

   For the purpose of the *obvious to try* analysis, it is not necessary that a particular choice from the available solutions be immediately obvious as providing the claimed subject-matter, nor is it necessary that a particular option be best suited to providing the solution. If none of the limited number of predictable and identifiable solutions is related to the solution covered by the claimed subject-matter, the examiner may conclude that the skilled person would not have deemed the subject-matter *obvious to try*.

2. Could the person skilled in the art be expected to arrive specifically at the solution claimed, starting from the limited number of solutions conceptually identified in factor 1, without inventive step or undue burden? That is, would the solution be arrived at by routine and predictable methods, and without requiring prolonged and arduous effort?

   The more difficult it is to arrive at the claimed subject-matter from the limited number of likely solutions, the less likely it is that a conclusion of *obvious to try* is appropriate. Where the person skilled in the art would need to exercise inventive ingenuity in order to solve problems for the purpose of testing the various solutions, for example, it cannot be considered obvious for the person skilled in the art to have tried that route.

   In cases where the *obvious to try* test may be appropriate, the examiner will objectively determine if the exercise of inventive ingenuity or undue effort were necessary to arrive at the claimed solution. The examiner will take into account the nature of the person skilled in the art and the knowledge and the climate in the relevant field or fields at the *claim date*. The subjective experience of the inventors will not be considered relevant unless it can be established that it reflects what would have been expected of the hypothetical person skilled in the art.

3. Does the person skilled in the art, in view of the prior art, have a motive to find the solution the problem addressed by the application?

> The existence of motivation, in the broadest sense, to solve problems in the field of the invention through scientific inquiry will generally not be sufficient to sustain a conclusion that the claimed invention is *obvious to try*. It will usually be necessary to show that there was a more specific motivation to work along similar lines as those pursued by the inventor. The person skilled in the art must have been motivated to conduct experiments in the area of the invention, aimed at solving the same or a similar problem to that addressed by the inventor by identifying a solution such as that defined in the claim under consideration.

The attitudes, prejudices and expectations of the person skilled in the art and their awareness of the trends in their field are relevant factors to consider in assessing subject-matter as *obvious to try*, and are assessed in light of the state of the prior art.

It should be remembered that *obvious to try* considerations are used to determine whether the subject-matter of a claim is the result of inventive ingenuity and, by consequence, is unobvious. Factors 1 to 3 might be thought of as asking whether it was obvious to search for a solution to the problem addressed by the inventors (the motivation factor) and whether the route to the claimed subject-matter was also obvious. If there was no invention in either conceiving of the solution or reducing it to a practical form, the claimed subject-matter is not the result of an inventive step and is therefore obvious.

Where the questions in factors 1 and 3 can be answered in the affirmative, and the conclusion when considering factor 2 is that the subject-matter of the claim would be arrived at by routine trials that were not prolonged and arduous, it can be concluded that the subject-matter of the claim is obvious since it would have been *obvious to try* to identify the claimed matter from among a finite number of likely solutions one of which more or less self-evidently ought to work.

Little guidance exists as to which areas of endeavour are those in which advances are often won by experimentation, although it has been commented that in such areas "there may be numerous interrelated variables with which to experiment".[61] Where there are a finite number of identified, predictable solutions known to the person skilled in the art and a motivation provided in the prior art to find the solution the application addresses, these factors can be indicative that one is in an area of endeavour where advances are often won by experimentation. The "threshold" question of whether *obvious to try* is applicable is considered to be inherently addressed when the factors of the test itself are considered.

18.02.04 Aggregations – June 2016

As stated in section 18.01.02, elements that cooperate to produce a unitary result must be considered in combination when novelty is being assessed. It is not necessary for any of the individual elements of a claim to be new provided the elements are combined to produce a unitary result that is different from the sum of the results of the elements.[62] Such combinations are patentable whereas "a mere aggregation of elements is not".[63] The subject-matter of a claim is considered to be a mere aggregation if each of the elements performs its own individual function and if any one element is removed the remaining elements would continue to perform their own individual function.[64]

When an invention is merely a juxtaposition of parts or known devices, and each part or device merely functions as would be expected if it were used on its own, the assembly is not a true combination but is a mere aggregation. An aggregation of old parts cannot form the basis of a patentable invention.

An aggregation should be identified as a defect under section 28.3 of the *Patent Act* as being obvious. Separate prior art documents may be cited to show that each individual part is known in the prior art.

18.02.05 Obviousness and utility – June 2016

In many cases, the ingenuity of an invention is related to its utility. This is particularly the case where some unexpected result is achieved through the subject-matter of the claim. This can arise, for example, where a known product or process is modified in some way that makes it novel and leads to the unexpected result. The unexpected result could be, for example, that the product or process becomes useful for some new purpose or provides some additional advantage when used for its intended purpose. Alternatively, the unexpected result could be that despite simplifying the known product or process (for example, by omitting parts or steps) the utility of the original product or process is retained.

Where the invention lies in discovering that a known thing has properties that make it useful for some new purpose, that mere discovery does not confer patentability on the known thing. The new use may be patented, however, if it is novel and unobvious.

Minor variations in existing inventions, such as the changing of size, shape, proportion or quality,[65] where the result is merely the doing of "the same thing in the same way, by substantially the same means, with better results, is not such an invention as will sustain a patent".[66] The substitution of a superior material for an inferior material, where the advantages of the substitution were expected, has similarly been found to be

obvious.[67]

Even where the use is different, there must be something unexpected or inventive in play to support a patent. “A patent for the mere new use of a known contrivance, without any additional ingenuity in overcoming fresh difficulties is bad and cannot be supported. If the new use involves no ingenuity, but is in manner and purpose analogous to the old use, although not quite the same, there is no invention”.[68]

Where a combination of parts is being considered, “[a]ll the elements being old, and the functions to be performed being identical, [it can] be patentable only if it performed the old function in some better or cheaper way than did the earlier machines - there must be a new mode of operation resulting from the combination [...]; it is not invention to combine old devices in a new machine or manufacture without producing some new mode of operation...”.[69] Absent a new unitary result arising from their combination, an assemblage of known parts is merely an uninventive aggregation [see 18.02.04].

The assessment of utility and obviousness may also be somewhat interdependent where the utility of the invention must be based on a sound prediction, particularly where the information necessary to permit a person skilled in the art to soundly predict that a known thing would be useful for some given purpose forms part of the *state of the art*. Although in certain situations it may be that an invention either lacks sound prediction or is obvious, it must be remembered that the assessment of sound prediction and the assessment of obviousness are distinct tests.[70] The former is based on the applicant’s own description and drawings, scientifically accepted laws or principles and the common general knowledge of the skilled person, while the latter is based on the state of the art.

18.02.06 Obviousness of anticipated claims - June 2016

Where the subject-matter of a claim is considered to be anticipated by a prior art disclosure, it will often also be considered to be obvious. The existence of an anticipatory disclosure will typically lead to the conclusion at step 3 of the *Sanofi* obviousness analysis that there is no difference between the inventive concept of the claim and the state of the art [see 18.02.02].

Where the applicant’s amendments or arguments in response to the examiner’s requisition overcome the lack of novelty defect, the claim may nevertheless remain defective for obviousness.

In the interests of keeping examination efficient, examiners having identified that a claim is defective in view of the prior art need not provide separate analyses for anticipation

and obviousness defects where a single analysis is applicable to both assessments. It remains permissible for both defects to be identified in a later report, particularly where the applicant's amendments or arguments have assisted in more clearly identifying any points of disagreement in respect of the applicability of the cited prior art.

When responding to an examiner's report identifying a lack of novelty, an applicant may be well served to provide comments explaining why the claimed subject-matter should be considered unobvious even if obviousness was not explicitly identified as a defect in the examiner's report. While no single test is appropriate in all cases where obviousness is a consideration, the *Sanofi* four-step analysis outlined in 18.02.02 will generally be used by the examiner. An applicant should consider this approach when formulating an argument.

Where an examiner considers that an impasse is developing in respect of the applicability of the prior art, and that the application is approaching rejection in a *Final Action*, separate analyses for anticipation and obviousness should be provided. This must be done at least one report before the *Final Action*. More information on the requirements for issuing a *Final Action* may be found in section 26.04 of this manual.

18.03 Claim date – October 2019

In accordance with subsection 28.1(1) of the *Patent Act*, the claim date is the filing date unless there is a compliant request for priority to a previously filed application (see Chapter 7), where that application (priority document) was filed within 12 months of the pending application by an eligible person in Canada or by an eligible person in an eligible country, and where the claimed subject-matter of the pending application is disclosed in the priority document. Under subsection 28.1(2) of the *Patent Act*, where those criteria are satisfied, the claim date is the filing date of the priority document.

For situations where the priority document is the subject of a compliant request for restoration of the right of priority (see Chapter 7), the aforementioned claim date requirement that the application be filed within 12 months of the priority document is satisfied, as the filing date of the pending application is deemed, for that requirement, to be within 12 months of the priority document under subsection 28.4(6) of the *Patent Act*. As such, successful restoration of priority requests may, if those applications satisfy the requirements set forth in subsection 28.1(1) of the *Patent Act*, result in applications having a claim date that is more than 12 months before the filing date. In principle, each claim in an application may have a different *claim date* from all other claims, although in practice it is typical for an application to claim priority from one or two priority documents.

Where a public disclosure would be relevant prior art for the assessment of anticipation or obviousness if a claim's *claim date* is the application's *filing date*, but not relevant if the claim's *claim date* is a specific priority date, it will be necessary for the examiner to obtain the relevant priority document and determine whether the application is entitled to the earlier claim date.

The examiner will verify:

1. whether a compliant request for priority had been submitted (see Chapter 7);
2. the filing date of the priority document to determine whether it has been filed, or deemed filed, within 12 months of the application relying on the priority claim; and
3. the content of the priority document to determine whether the subject-matter of each claim present in the application relying on the priority claim was disclosed in the priority document.

Where the request for priority is compliant, and the filing date of the priority document is within (or deemed within) 12 months of the pending application, the priority is valid only to the extent that the priority document discloses the same subject-matter as is claimed in the application. Where the scope of the teachings in the priority document and the application are different, the claim in the application may not benefit from the earlier *claim date*. Where, for example, the priority document teaches a specific embodiment and the application claims generalised subject-matter covering the specific embodiment, a claim to the generalised subject-matter may not benefit from the priority date if further support for the generalised subject-matter is not found in the priority document, whereas a claim limited in scope to the specific embodiment disclosed in the priority document would.

18.03.01 Claim date based on multiple previously filed applications - October 2019

An application which claims priority from two or more prior applications may have multiple claim dates. Where an applicant has requested priority from two or more previously regularly filed applications, subsection 28.4(4) of the *Patent Act* provides that

> (4) If two or more applications have been previously regularly filed as described in paragraph 28.1(1)(a), subparagraph 28.2(1)(d)(i) or paragraph 78.3(1)(a) or (2)(a), either in or for the same country or in or for different countries,

(a) paragraph 28.1(1)(b), subparagraph 28.2(1)(d)(iii) or paragraph 78.3(1)(b) or (2)(b), as the case may be, shall be applied using the earliest filing date of the previously regularly filed applications; and

(b) subsection 28.1(2), subparagraph 28.2(1)(d)(ii) or paragraph 78.3(1)(d) or (2)(d), as the case may be, shall be applied using the earliest filing date of the previously regularly filed applications on the basis of which a request for priority is made.

This has the effect of according the earliest possible claim date for subject-matter claimed in the pending application based on the content of the earliest corresponding priority document.

18.03.01a Same subject-matter in multiple previously filed applications

Any application filed more than one year before the filing date of a Canadian application may not form the basis of priority for the Canadian application. For greater certainty, applications which have been filed more than one year before filing, but satisfy the requirements of subsection 28.4(6) of the *Patent Act* have a filing date that is "deemed to be within 12 months". See section 7.06 for further information.

Where a first application has been filed more than twelve months before the filing date of a Canadian application and a second application having the same subject-matter is filed within the 12-month period before the filing date of the Canadian application, priority cannot be based on the second application, except for subject-matter exclusive to the second application. In practice an examiner would not be expected to search for such documents but may come across them during a typical prior art search.

An exception to this bar is found in subsection 28.4(5) of the *Patent Act* which provides relief where the first application, filed more than one year before the Canadian filing date, has never been open to public inspection and will never publish.

If the first application has never been open to public inspection and is considered withdrawn, abandoned or refused by the granting authority, an inventor may be entitled to full priority rights based upon the subsequently filed second application or, where no previously filed applications remain, the claim date of the pending application will be the date the application is filed in Canada.

18.03.02 U.S. continuation and continuation-in-part applications

Under some conditions, priority may be based on continuation or continuation-in-part applications before the United States Patent and Trademark Office. A United States continuation application is an application which has the same specification of an earlier

application but contains claims directed to either different subject-matter, i.e., a different invention than claimed in the earlier application or claims a different embodiment of the earlier claimed invention. No new matter is disclosed or claimed. A continuation-in-part application discloses and claims additional subject-matter over the earlier application.

If a Canadian application is filed within one year of a continuation-in-part application, this continuation-in-part application may serve as a priority document for any new matter not disclosed in the original U.S. application from which the continuation-in-part application extends.

Where a Canadian application is filed more than twelve months after the filing date of the original U.S. application, but within twelve months after the continuation-in-part, the applicant is not entitled to priority on subject-matter common to the two U.S. applications, except in circumstances as described below. If both the original and the continuation-in-part applications are filed within the 12-month period preceding the filing of the Canadian application, priority may be based on both the original application and on the new matter in the continuation-in-part.

Where priority is necessary to support a claim date in the prosecution of a Canadian application claiming priority from a U.S. continuation-in-part application only, it is necessary to identify the matter derived from the original U.S. application to determine the priority rights of the applicant. Because a U.S. continuation-in-part application does not identify the new matter added to the original U.S. application, the applicant must submit certified copies of both the original and continuation-in-part applications whenever required to do so by the Office.

Example:

An application is filed on March 1, 2009. In the Petition, the applicant requests priority from a US continuation application filed in the United States on March 2, 2008. The US continuation application is a continuation of a prior US application (the “original US application”) filed before the USPTO on February 1, 2008. In the Petition, the applicant provides the application number, country code and filing date of the US continuation application and requests priority from this application.

Analysis:

The Canadian application will not be granted the priority date of the continuation application as the subject matter of the Canadian application was disclosed on February 1, 2008 in the original US application, which is more than twelve months before the date the application was filed in Canada. Note: If the second US application was a continuation-in-part application, the Canadian application would

receive the priority from the filing date of the continuation-in-part only for the subject-matter disclosed uniquely therein (see also section 7.05).

18.04 Grace period – MODIFIED

The *Patent Act* provides for a *grace period* before the *filing date*, during which information that became publicly available due to a disclosure by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant, is not considered during the assessment of whether the claimed invention is novel and inventive. The *grace period* is one year before the filing date of the application, unless the claim date is earlier than that period, in which case the grace period is the period starting at the beginning of the claim date and ending immediately before the filing date.

The claim date may be earlier than 12 months prior to the filing date of an application in circumstances where right to priority is successfully restored (see 7.06 and 18.03) or in situations involving prescribed or designated days (see 2.03.03a).

As defined in section 2 of the *Patent Act,* the term *applicant* "includes an inventor and the legal representatives of an applicant or inventor". The term *legal representative* itself "includes heirs, executors, administrators of the estate, liquidators of the succession, guardians, curators, tutors, transferees and all other persons claiming through applicants for patents and patentees of inventions or through holders of certificates of supplementary protection".

In considering whether the *grace period* applies to a given disclosure of information, the prior disclosure is only protected by the *grace period* if the person making the disclosure was, or must be deemed to have been, *the applicant or a person who obtained knowledge, directly or indirectly, from the applicant* at the time the earlier disclosure was made (i.e. at the date of making available to the public, such as the date of publication or of laying open for public inspection).[71]

The *grace period* covers any prior disclosure, whether an oral disclosure such as a presentation at a conference or a written disclosure such as an article in a trade journal. Since the majority of disclosures of information relevant to patent examination are publicly available documents, the applicability of the *grace period* is typically assessed by considering whether the application being examined and the prior publication share authors (e.g. whether the inventors were the authors of a prior publication) or, where the prior disclosure is a patent document, had the same applicant. It must be remembered that, in respect of domestic patent documents, the *grace period* applies when considering anticipation or obviousness, but not when assessing double-patenting.

In cases where the applicability of the *grace period* is in dispute, the applicant may provide such evidence as they consider appropriate to support a relationship between the author of the prior disclosure and the applicant.

18.05 Establishing the publication date of prior art – January 2016

In order for a prior disclosure to be considered prior art, the date at which it became available to the public must generally be known. Where the exact date on which a disclosure was made to the public is not known, the disclosure cannot be cited unless a reliable basis exists for concluding that the information was available to the public before the relevant date (i.e. claim date).

For patent documents (issued patents and applications), this information is usually known. In other cases, it may be less clear. It will usually be possible to determine the publication date of articles published by reputable journals, magazines and similar publications. In many cases, the actual date of publication will be indicated (either of the article in particular or of the issue of the publication in which it is found). In certain cases, only the month and year of publication will be identified. In such cases, it cannot be presumed that the document became available to the public before the last day of the month. Where only a year of publication is available, it cannot be presumed that the publication date was earlier than December 31 of that year.

There may be methods for establishing earlier actual publication dates, including (in the case of documents available on the internet) establishing dates of first publication via third party archiving services.

18.05.01 Verifying the content of priority documents – October 2019

Part of the claim date analysis requires the examiner to determine whether the claimed subject-matter was disclosed in the priority document. For applications where the request for priority was made on or after October 30, 2019, the content of the priority document can be verified using the copy submitted or made available under subsection 74(1) of the *Patent Rules*. In the event that examination commences before a copy of a priority document is submitted or made available, examination should proceed assuming that the claim date is the filing date until the copy is submitted or made available.

18.05.01a Requesting translations of priority documents – October 2019

For an examiner to verify the content of a priority document filed in a language other than English or French, a translation into English or French may be necessary. Such a request can be done via a notice under subsection 76(1) of the *Patent Rules*. Recognising that translating documents may place a significant financial burden on the applicant, requests for translations should be limited to cases where no viable alternative exists. 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.

Where a foreign language priority document appears relevant to examination, an examiner should attempt to locate a version of that document 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 Japanese Patent Office (JPO), at least at the early stages of examination.

Where an examiner is working from a machine translation of a priority 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.

If the examiner has reasonable grounds to believe that the submitted translation is not accurate then a further notice under subsection 76(2) of the *Patent Rules* can be sent. In response the applicant must submit either a statement by the translator that to the best of their knowledge the translation is accurate or a new translation into English or French along with a statement by the translator that to the best of their knowledge the new translation is accurate. In the event that a statement by the translator that to the best of their knowledge the translation is accurate is provided with the translation submitted in response to the notice under subsection 76(1) of the *Patent Rules*, the examiner should not send out a notice under 76(2) of the *Patent Rules*.

18.05.01b Transitional consideration – October 2019

For applications where the request for priority was made before October 30, 2019, in order to verify the content of a priority document not filed in Canada the examiner should first attempt to acquire the document from a reliable source, e.g. WIPO's PATENTSCOPE database or the International Bureau. Where the priority document is not retrievable by the examiner or where the content of a non-certified copy of the priority document has been relied upon and some question exists as to its accuracy, the applicant may be requested in accordance with subsection 196(1) of the *Patent Rules* to

provide a certified copy of the priority document or to make a copy of the priority document available in a digital library.

18.06 Double-patenting – September 2017

Double-patenting refers to the judicially recognised proscription against an applicant being granted more than one patent for a single invention.[72] The principles governing the doctrine of double-patenting have evolved in the jurisprudence, which now recognises two branches: "same invention" and "obviousness" double-patenting.[73]

Underlying this doctrine is the recognition by the Courts that "a second patent [can] not be justified unless the claims [exhibit] "novelty or ingenuity" over the first patent".[74] In essence, once a patent is granted for an invention, "further invention" is required to support another patent.[75]

The assessment of double-patenting, in practical terms, can be understood as a specialised evaluation of anticipation and obviousness wherein the "prior art" consists solely of one other patent by the same applicant (the "existing patent"). The assessment differs from the statutory assessment of anticipation and obviousness in two important ways:

i. the "prior art" under consideration is not citable under paragraph 28.2(1)(a) or 28.3(a) of the *Patent Act*; and

ii. only the claims of the "prior art" patent by the same applicant are considered in the assessment.

The assessment involves a comparison of the claims rather than the disclosure, as the claims define the monopoly. However, claim comparison is not done on a literal construction of the claims; claims are to be given a purposive construction based on a reading of the specification through the eyes of the skilled person, taking into account their common general knowledge. If the claims of the existing patent, when understood by the person skilled in the art in light of the common general knowledge on the *claim date* and the teachings of the specification as a whole, anticipate or render obvious the claims of the application being examined, the claims are not patentably distinct from each other. Granting both sets of claims would therefore result in double-patenting. Where it can be concluded that the claims in an application are "not patentably distinct" from the claims in the existing patent, the test under either the "same invention" or "obviousness" branch of the doctrine of double-patenting would have been met.

As mentioned above, double-patenting only arises when considering patents belonging

to the same inventor or applicant as the application being examined.

The meaning of “same applicant” for the purpose of double-patenting is based on the definition of *applicant* from section 2 of the *Patent Act*, and therefore includes *an inventor and the legal representatives of an applicant or inventor*. The term *legal representative* itself *includes heirs, executors, administrators of the estate, liquidators of the succession, guardians, curators, tutors, transferees and all other persons claiming through applicants for patents and patentees of inventions or through holders of certificates of supplementary protection*.

In many cases the named inventor(s) and the applicant may be the same, but this is not a requirement. Applicants may have many individuals working on different aspects of related projects and may consequently list different inventors on an application. Regardless of the persons listed as inventors, double-patenting restrictions apply to an applicant as though the same inventors were listed.

The Office takes the position that the doctrine of double-patenting applies if the application being examined belonged to the “same applicant” at any time.

18.06.01 Overlap – September 2017

Overlap is a term of convenience describing the situation in which an operating embodiment in a claim of an application being examined is identical to an operating embodiment in a claim in an existing patent. The embodiment in the existing patent, being the same as that in the application being examined, therefore acts as a bar against the latter; granting that embodiment in two patents would result in double-patenting.

An operating embodiment can be either the entirety of the claimed subject-matter, or one of several alternatives within a claim. In the latter case, it is possible that the overlap between the claims involves only a small fraction of the scope of the claim in one or both documents. Nevertheless, having the embodiment in question be granted in two patents would result in double-patenting.

Overlap may occur in situations where the claims in the application and the existing patent otherwise appear to be directed to distinct inventions. Where overlap is identified between claims in an application and an existing patent, the claim being examined is not patentably distinct from the claim in the existing patent insofar as the overlapping subject-matter is concerned. The claim being examined is consequently defective due to double-patenting. Removing the overlap, such as by deleting the duplicated subject-matter from the application would remove the double-patenting defect.

Example:

An applicant files two applications consecutively (or concurrently as the case may be). One application claiming feature A issues to patent before the other application. The remaining application claims feature B. Each document has a dependent claim that defines A+B. Granting the application would result in double-patenting for the embodiment A+B, but if the dependent claim directed to that embodiment is removed from the application, and presuming B is not obvious in view of A, the double-patenting defect would be removed.

18.06.02 Existing patent – September 2017

Double-patenting is often described as barring a second patent in view of an 'earlier patent', and the "sin of double patenting"[76] is often described in terms of the problem of evergreening[77] a monopoly by extending the rights in time through the filing of subsequent applications differing only in uninventive details.

It has been noted, however, that a further patent can provide additional rights to the patentee beyond an extension of the term of the monopoly, and that the overriding principle is the need for a further patent to exhibit novelty and ingenuity in order to be justified.[78] The Office takes the position that having more than one patent to a single invention is not permitted by the doctrine of double-patenting, whether or not the further patent extends the term of the monopoly right granted in the existing patent. The Office takes the position that an "earlier patent" is simply a patent that has already issued and which claims an invention that is not patentably distinct from that in the claims of the application being examined.

This position considers a further patent to be an inappropriate extension of rights both in the sense that the rights in the existing patent would not be exclusive to the existing patent (as provided by section 42 of the *Patent Act*) and that those rights would not be limited to the term of the existing patent (as provided by section 44 of the *Patent Act*).

It is not necessary for the existing patent to have issued from an application having an earlier filing or claim date than the application being examined. There are many reasons for which a later filed application could be issued to patent before an earlier filed application, including many factors controlled by the applicant (the request for examination date, a request for advanced examination, the time taken to respond to reports, etc.).

The Office takes the position that an extension of rights can occur whether or not the rights conferred by an existing patent are still available to the patentee. The expiry of

the existing patent does not alter that the issuance of the existing patent bars the grant of a further patent defining an invention not patentably distinct from that in the existing patent. In such cases, the grant of a further patent would restore rights that had expired or been surrendered, thus extending the patent rights.

18.06.03 Co-pending applications – September 2017

Where two applications belonging to the same applicant define inventions that are not patentably distinct from one another, the examiner will inform the applicant that a potential double-patenting issue exists. Preferably, this is done in reports on both applications (where a report is warranted; see below), in order to ensure the applicant is fully aware of the potential problem. This potential defect is not identified in a requisition under section 86 of the *Patent Rules*, since it is not an actual defect until one of the applications issues to patent. Rather, the applicant is advised of the potential defect. Where an application is otherwise in condition for allowance, it will not be held back solely because of a potential double-patenting issue (i.e., a theoretical future defect does not delay allowance of an application). This applies to applications that are in a condition for allowance when first examined; applicants should consequently exercise care when filing applications with closely-related claims, to ensure that all the claims to a given invention are included in a single application. Once a first application issues, the subsequent application(s) will contain an identifiable defect.

Double-patenting is identified between an application and an issued patent regardless of whether the potential defect was identified between the applications while co-pending. This is so whether the double-patenting existed at the time the existing patent's application was allowed, or was subsequently introduced to the application being examined by way of amendment. It is up to the applicant to ensure that all the claims to a given invention are included in a single application. Where a patent issues, but claims to certain aspects of the defined invention were omitted during the application stage (whether accidentally or by design), double-patenting will prevent the granting of those claims in a subsequent patent unless they represent "further invention" over the claims in the existing patent.

18.06.04 Division at the direction of the Office – October 2019

The Supreme Court has noted that if "patents are granted on divisional applications directed by the Patent Office, none of them should be deemed invalid, or open to attack, by reason only of the grant of the original patent".[79]

Where an examiner has identified a lack of unity of invention in a report on an

application, and the applicant files a divisional application in response to that report, the claims in the divisional application are exempt from examination for double-patenting if they are identical to claims identified by the examiner in the parent application as lacking unity and they differ from those retained in the parent application.

Chapter 21 of this manual details the procedures for identifying a lack of unity among the claims of an application. Subsequent to any divisional applications that result from an examiner's identification of multiple inventions in a parent application, a double-patenting defect will not be identified where the claims in the divisional application correspond to claims identified in the report as belonging to a different invention than that defined in the claims retained in the parent. This is typically the case where the applicant has adhered to the claim groupings identified by the examiner.

Where, however, the claims in the divisional do not correspond to the groupings identified in the report on the parent application, whether at filing or as the result of subsequent amendment, they will be examined for double-patenting. This is typically the case where the applicant either determines that groupings different from those identified by the examiner are appropriate, or where subsequent to division the applicant amends the claims (in either the parent or the divisional application) so as to change the claimed invention (see e.g. sections 3.04 and 21.07.05, 21.09, 21.10 for further information on divisional applications).

18.07 Selections – June 2016

A *selection*, as the term is used in patent law, rests on the idea that if a disclosure has provided a general description of an invention (e.g. a genus), it may be that certain things falling within the scope of the general teachings can nevertheless be considered to be different inventions (e.g. a species of the genus). These further inventions must be based on the disclosure of substantial advantages not disclosed by the inventors of the broad invention.

The three conditions that must be satisfied for a patentable selection are that:

i. the *selection* be based on some substantial advantage;

ii. the whole of the *selection* must possess the advantage; and

iii. the advantage must be in respect of a quality of a special character peculiar to the whole *selection*.[80]

It is important to note that the advantage (which can include avoiding a substantial disadvantage) must be in comparison to the overall group from which the selection has

been made, and be made on the basis of sufficient representative testing and not simply be a comparison to a few isolated members of the overall group.[81]

It should be remembered that in assessing whether an alleged selection is patentable, the patentability of a claim must be assessed against the usual requirements (novelty, utility, ingenuity, sufficiency of disclosure, etc.)[82]

A newly discovered, substantial advantage is necessary to provide the utility and inventive step to the *selection* for patentability to be acknowledged.[83] Although there is no special or higher disclosure burden for a selection in comparison with any other type of invention, the advantage must be properly disclosed for there to be an invention[84] and, if unclear, the new utility arising from the advantage must also be disclosed. If there is no way to assess the purported "advantage", there is no way for the person skilled in the art to appreciate that an invention has been "correctly and fully" described. An inventor "has in truth disclosed no invention whatever if he merely says that the selected group possesses the advantages. Apart altogether from the question of what is called sufficiency, he must disclose an invention; he fails to do this in the case of a selection for special characteristics, if he does not adequately define them."[85]

A purported selection whose utility has not been established, by demonstration or sound prediction [see Chapter 19 of this manual], is necessarily not an invention. Establishing that there is, in fact, an advantage requires that some point of reference be disclosed. Mere statements that a certain embodiment of an identified group is "preferred" or possesses an otherwise unspecified advantage, benefit or improved property are not sufficient to adequately disclose the substantial advantage necessary to establish inventive selection.[86]

The ingenuity of the alleged *selection* involves a consideration of whether "a particular member or group within [the earlier disclosed] class [has] the same or different properties, and, if different, how different?"[87] Its novelty rests on the fact that the selected aspects of the prior disclosure had not previously been made: per Maughan J. in *I.G. Farbenindustrie*, "[i]t must be remembered, of course, that the selected compounds have not been made before, or the patent would fail for want of novelty".[88]

If an operating embodiment within the *selection* claim has already been made, the advantages of the invention have already been made available and the claimed invention is anticipated. If something within the *selection* claim was merely listed in the prior document, however, without disclosing the advantage upon which the *selection* is based, the requirement for prior disclosure is not met and there is no anticipation.

Where a purported *selection* is not anticipated, it may nevertheless be found to be

obvious. The assessment of the obviousness of a *selection* may in some cases be directly assessed by a consideration of whether the alleged advantage is truly unexpected, but may also arise (particularly in the chemical arts) in the context of an *obvious to try* analysis[89] [see 18.02.03].

Example:

An application discloses that it is known to raise sunken ships by pumping a plurality of buoyant bodies through a tube into the ship, and that in the past this had been done by pumping hollow spheres into the ship. The application discloses the use, in particular, of tetrahedral bodies, whose greater packing density increases the effectiveness of the method.

A search of the prior art reveals the use of buoyant bodies to raise sunken ships, but does not indicate the particulars of the shape of said bodies. One piece of prior art appears to illustrate spherical bodies for this purpose.

Claim 1:

A method for raising a sunken ship, the method comprising the steps of: 1) establishing a conduit between a surface pump and the sunken ship,

2) pumping a plurality of generally tetrahedral-shaped buoyant bodies into the ship via the conduit.

Analysis: The prior art teaches the use of buoyant bodies in general, but it appears that only spherical shapes were specifically used. The application teaches that tetrahedral bodies have a substantially higher packing factor than spherical bodies and achieve better packing efficiencies than those of rectilinear or curvilinear bodies. The result of using tetrahedral bodies enables greater packing into a sunken ship and thus higher maximum buoyancy as well as substantially greater retention of the buoyant bodies in the ship (i.e., loss prevention). Given the disclosure of an advantage specific to the use of tetrahedral bodies, it appears their use could be approached as a potential selection from among the generic means “buoyant bodies”. Since no prior disclosure of the use of tetrahedra exists, novelty can be acknowledged. The obviousness of claim 1 would have to be evaluated to determine whether the selection of tetrahedra in particular from “buoyant bodies” in general leads to an unexpected benefit such that an inventive step could be acknowledged.

18.08 Provisos – October 2019

Where an applicant is aware of relevant prior art at the time of filing, or becomes aware

of relevant prior art during prosecution, they may choose to amend their claim in order to exclude certain embodiments disclosed in the prior art.

One method for excluding known subject-matter is by a *proviso*; a statement that provides that the claim does not include some specified matter. The term *proviso* is used herein to refer to any such exclusionary limitation, regardless of the precise language used to express it (e.g. an attachment means, provided said attachment means is not a rubber-based adhesive; a straight chain alkyl group other than an ethyl or propyl group; a non-field effect transistor).

A *proviso* based on a prior art disclosure may be introduced to an application in order to establish novelty. To comply with section 38.2 of the *Patent Act* the *proviso* should not introduce new matter (e.g. by broadening the claim outside what was reasonably inferable from the original specification).

A *proviso* may be used to establish novelty, or inventive step over the prior art. When introduced as an amendment, a *proviso* that excludes a feature that was not necessarily present in the original claim should be very carefully considered, since the newly-identified feature is presumably not required for the proper operation of the claimed subject-matter.

In general, a *proviso* will therefore render a claim patentable where the broad claim would have been considered novel and inventive if it were not for an isolated earlier disclosure of something within the claim. A broad product claim might, for example, be anticipated by a specific product suitable for the same purpose as that taught by the applicant, but which was disclosed in the earlier document for a different use. Excluding the specific product might render the remaining subject-matter of the claim novel. Depending on the relationship between the two uses, the *proviso* might be sufficient to also render the amended claim unobvious.

Where a claim is amended to include a number of *provisos* to establish novelty and inventiveness, a greater level of scrutiny is necessary to ensure that the remaining subject-matter is still a single invention, and that the nature of the invention described in the original application has not been obscured or changed (e.g. by defining the invention solely in terms of what it is not, rather than what it is).

Example:

An application describes the therapeutic effectiveness of a class of compounds which have, in common, structural element A. Prior art application D1 discloses compound X as a useful drug in the therapy of disease Y, X comprises structural element A. Subsequent to the publication of D1, the applicant found that A is an

element essential to the effective treatment of disease Y in the class of compounds.

Claims:

1. A compound having <structural element A> for use in treating disease Y.
2. A compound having <structural element A> for use in treating disease Y, provided said compound is not compound X.

Analysis: Claim 1 is anticipated by D1 because compound X has established utility as an effective treatment for Y and comprises structural element A.

Claim 2 is not anticipated by D1 as the proviso removes the applicability of D1 by tying the effective treatment to previously unknown importance of element A in said treatment.

Having been deemed novel in view of the proviso, the inventive concept of claim 2 would require additional analysis to determine inventiveness in view of the common general knowledge at the claim date.

Information regarding unity and provisos can be found in subsection 21.08.07 of this manual.

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1 *Shire Biochem Inc. v. Minister of Health 2008 FC 538* at paragraph 61 ; *Apotex Inc. v. Wellcome Foundation Ltd.*, [2002] 4 S.C.R. 153, 2002 SCC 77 at paragraph 37

2 *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* 2008 SCC 61 at paragraphs 24-27 and 33-37

3 *Eli Lilly and Company v. Apotex Inc.* 2009 FC 991 at paragraph 397*;* *Shire Biochem Inc. v. Minister of Health 2008 FC 538* at paragraph 75.

4 *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* 2008 SCC 61 at paragraph 25

5 *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* 2008 SCC 61 at paragraphs 33-37

6 *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* 2008 SCC 61 at paragraphs 24-46; Lundbeck Canada Inc. v. Ratiopharm Inc. 2009 FC 1102 at paragraph 69; *Abbott Laboratories v. Minister of Health* 2008 FC 1359 at paragraph 59 (aff'd 2009 FCA 94).

7 *Bristol-Myers Squibb Canada Co. v. Apotex Inc.* 2009 FC 137 at paragraph 35

8 *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* 2008 SCC 61 at paragraph 25, citing *Synthon B.V. v. SmithKline Beecham plc* 2005 UKHL 59 at paragraph 32

9 *Schmuel Hershkovitz v. Tyco Safety Products Canada Ltd.* 2009 FC 256 at paragraph 100; *Shire Biochem Inc. v. Minister of Health 2008 FC 538* at paragraph 65

10 *Abbott Laboratories v. Minister of Health* 2008 FC 1359 at paragraphs 59 and 60; *Johnson & Johnson Inc. v. Boston Scientific Ltd.* 2008 FC 552 at paragraph 309; this principle is also inherent in wording of subsection 28.2(*1*) of the *Patent Act*.

11 *Abbott Laboratories v. Minister of Health* 2008 FC 1359 at paragraph 75 (aff'd 2009 FCA 94)

12 *Steel Co. of Canada Ltd. v. Sivaco Wire and Nail Co.* [(1973), 11 C.P.R. (2nd), 153 (F.C.T.D.)] at page 190, citing *General Tire & Rubber Co. v. Firestone Tyre & Rubber Co. Ltd.* [1972] R.P.C. 464 at page 486; Abbott Laboratories v. Canada (Minister of Health) 2006 FCA 187 at paragraph 24, citing *Smithkline Beecham PLC's (Paroxetine Methanesulfonate) Patent*, [2005] UKHL 59 at paragraph 22, itself citing *Merrell Dow Pharmaceuticals Inc v N.H. Norton & Co. Ltd.* [1996] R.P.C. 76 at page 90

13 *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* 2008 SCC 61 at paragraph 27

14 *Free World Trust v. Électro Santé Inc.* 2000 SCC 66 at paragraph 26 citing *Consolboard Inc. c. MacMillan Bloedel (Saskatchewan) Ltd.* [1981] 1 RCS 504 [(1981), 56 CPR (2nd), 145 (CSC)] per Dickson J. at p. 534

15 See, e.g., *Schmuel Hershkovitz v. Tyco Safety Products Canada Ltd.* 2009 FC 256 at paragraph 105

16 *Reeves Bros. v. Toronto Quilting* [(1978), 43 C.P.R. (2nd), 145 (F.C.T.D.)] at page 157, apparently relying on a proposition stated at least as early as *Hill v. Evans* (1869), 4 DeG. F. & J. 988, 45 E.R. 1195 at page 301. The continued relevance of the factors enumerated in *Reeves Bros.* was discussed in *Johnson & Johnson Inc. v. Boston Scientific Ltd.* 2008 FC 552 at paragraph 295.

17 *Lovell Manufacturing Co. v. Beatty Bros. Ltd.* [(1962), 41 C.P.R. (1st), 18 (Ex. Ct.)] at page 45, citing *Hill v. Evans* (1869), 4 DeG. F. & J. 988, 45 E.R. 1195 at page 300

18 Abbott Laboratories v. Canada (Minister of Health) 2006 FCA 187 at paragraphs 24 and

25; *Eli Lilly and Company v. Apotex Inc.* 2009 FC 991 at paragraph 397; *AstraZeneca Canada Inc. v. Apotex Inc.* 2010 FC 714 at paragraph 124

19 *Lightning Fastener Co. v. Colonial Fastener Co*. [1933] S.C.R. 377 (affirming [1932] Ex. C.R. 101) at page 381.

20 *Shire Biochem Inc. v. Minister of Health 2008 FC 538* at paragraph 63

21 Baker Petrolite Corp v Canwell Enviro Industries Ltd 2002 FCA 158 at para. 42

22 Baker Petrolite Corp v Canwell Enviro Industries Ltd 2002 FCA 158 at paragraphs 35 and 42

23 *Bauer Hockey Corp. v. Easton Sports Canada Inc.* 2010 FC 361 at paragraphs 216-220

24 Baker Petrolite Corp v Canwell Enviro Industries Ltd 2002 FCA 158 at para 42 citing *Merrell Dow Pharmaceuticals Inc. v. H.N. Norton & Co. Ltd.* (1995), [1996] R.P.C. 76 (H.L.) at p. 86

25 *Bauer Hockey Corp. v. Easton Sports Canada Inc.* 2010 FC 361 citing *Lux Traffic Controls Limited v. Pike Signals Limited*, [1993] R.P.C. 107 (Pat. Ct.) at p.132

26. *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd* 2012 FCA 333 at paragraphs 68 and 74

27 Baker Petrolite Corp v Canwell Enviro Industries Ltd 2002 FCA 158 at paragraph 42

28 Baker Petrolite Corp v Canwell Enviro Industries Ltd 2002 FCA 158 at paragraph 42; *Gibney v. Ford Motor Co. of Canada* [(1967), 35 Fox Pat. C. 143] at paragraph 61

29 *Abbott Laboratories v. Canada (Minister of Health)* 2006 FCA 187 at paragraphs 23 to 25; *Calgon Carbon Corporation v. North Bay (City)* 2006 FC 1373 at paragraphs 114 to 136

30. See Metalliflex Limited v. Rodi & Wienenberger Aktiengesellschaft, [1961] S.C.R. 117

31 *Abbott Laboratories v. Minister of Health* 2008 FC 1359 at paragraphs 69-73; *Lundbeck Canada Inc. v. Ratiopharm Inc.* 2009 FC 1102 at paragraphs 20, 118 and 136;

32 *Astrazeneca AB v. Apotex Inc.* 2007 FC 688 at paragraphs 50-53

33 *The King v. American Optical Co.* [(1950), 13 C.P.R. (1st), 87 (Ex. Ct.)] at pages 109-110,

citing *Clay v. Allcock & Co.* (1906), 23 R.P.C. 745 at page 750

34 Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd. [(1981), 56 C.P.R. (2nd), 145 (S.C.C.)] at page 161, citing *The King v. American Optical Co.* [(1950), 13 C.P.R. (1st), 87 (Ex. Ct.)] at pages 109-110

35 Commissioner of Patents v. Farbewerke Hoechst Aktiengesellschaft Vormals Meister Lucius & Bruning [1964] S.C.R. 49, [(1963), 41 C.P.R. (1st), 9 (S.C.C.)] at page 17

36 The requirement codified in section 28.3 of the *Patent Act* that an invention not be obvious in view of certain prior art implies a requirement for ingenuity - see *Janssen-Ortho Inc. v. Novopharm Ltd.* 2006 FC 1234 at paragraphs 109-110; Canamould Extrusions Ltd. v. Driangle Inc. 2003 FCT 244 at paragraph 61 (rev'd on other grounds); *Baker Petrolite Corp. v. Canwell Enviro Industries Ltd.* 2001 FCT 889 at paragraphs 94-96 (rev'd on other grounds); *Harvard College v. Canada (Commissioner of Patents)* [(2000), 7 C.P.R. (4th), 1 (F.C.A.)] at paragraph 105 (rev'd on other grounds); *Diversified Products v. Tye-Sil* [(1991), 35 C.P.R. (3rd), 350 (F.C.A.)] at page 366.

37 *Janssen-Ortho Inc. v. Novopharm Ltd.* 2006 FC 1234 at paragraphs 99, aff'd 2007 FCA 217. Baker Petrolite Corp v Canwell Enviro Industries Ltd 2002 FCA 158.

38 *Hospira Healthcare Corporation v Kennedy Trust for Rheumatology Research* 2020 FCA 30 at paragraph 86; *Biogen Canada Inc. v Taro Pharmaceuticals Inc* 2020 FC 621 at paragraph 154; *Eli Lilly Canada Inc. v Mylan Pharmaceuticals ULC* 2020 FC 816 at paragraph 173.

39 The requirement codified in section 28.3 of the *Patent Act* that an invention not be obvious in view of certain prior art implies a requirement for ingenuity - see *Janssen-Ortho Inc. v. Novopharm Ltd.* 2006 FC 1234 at paragraphs 109-110; *Canamould Extrusions Ltd. v. Driangle Inc.* 2003 FCT 244 at paragraph 61 (rev'd on other grounds); Baker Petrolite Corp v Canwell Enviro Industries Ltd 2002 FCA 158 at paragraphs 94-96 (rev'd on other grounds); *Harvard College v. Canada (Commissioner of Patents)* [(2000), 7 C.P.R. (4th), 1 (F.C.A.)] at paragraph 105 (rev'd on other grounds); *Diversified Products v. Tye-Sil* [(1991), 35 C.P.R. (3rd), 350 (F.C.A.)] at page 366; *Apotex Inc. v Shire LLC*, 2021 FCA 52 at paragraphs 65 and 77.

40 *Beloit Canada Ltd. v. Valmet Oy* [(1986), 8 C.P.R. (3rd), 289 (F.C.A.)] at page 293

41 *Diversified Products v. Tye-Sil* [(1991), 35 C.P.R. (3rd), 350 (F.C.A.)] at page 366

42 *Xerox of Canada Ltd. v. IBM Canada Ltd.* [(1977), 33 C.P.R. (2nd), 24 (F.C.T.D.)] at page 52, citing *Samuel Parkes & Co. Ltd. v. Cocker Bros. Ltd.* [(1929), 46 R.P.C. 241] at page 248.

43 *The King v. Uhlemann Optical Co.* [(1951), 15 C.P.R. (1st), 99 (S.C.C.)] at pages 104-105; Wandscheer v. Sicard Ltd [1948] S.C.R. 1 [(1947), 8 C.P.R. (1st), 35 (S.C.C.)] at page 48; both cases citing *Samuel Parkes & Co. Ltd. v. Cocker Bros. Ltd.* [(1929), 46 R.P.C. 241] at page 248.

44 *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* 2008 SCC 61 at paragraphs 61-64; *Janssen-Ortho Inc. v. Novopharm Limited* 2007 FCA 217 at paragraph 25.

45 *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* 2008 SCC 61 at paragraph 67. The approach is based on that taken in *Windsurfing International Inc. v. Tabur Marine (Great Britain) Ltd.* [1985] R.P.C. 59 (C.A.) and refined in *Pozzoli SPA v. BDMO SA* [2007] EWCA Civ 588 and may be termed the Windsurfing/Pozzoli approach.

46 *Free World Trust v. Électro Santé Inc.* 2000 SCC 66 at paragraph 44, quoting H.G. Fox from his *Canadian Law and Practice Relating to Letters Patent for Inventions* [(1969), 4th Ed.] at page 184; *Whirlpool Corp. v. Camco Inc.* 2000 SCC 67 at paragraph 49, citing *Lister v. Norton Brothers and Co.* [(1886), 3 R.P.C. 199 (Ch.D.)] at page 203

47 *Free World Trust v. Électro Santé Inc.* 2000 SCC 66 at paragraph 44

48 *Servier Canada Inc. v. Apotex Inc.* 2008 FC 825 at paragraph 254

49 *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* 2008 SCC 61 at paragraph 37

50 *Allergan Inc v Canada (Health) and Cobalt Pharmaceuticals, 2014 FC 566* at paragraph 25; *Allergan Inc v Canada (Health) and Apotex Inc, 2014 FC 567* at paragraph 25; *Apotex Inc. v Shire LLC*, 2021 FCA 52 at paragraphs 68, 74 and 75

51 *Apotex Inc. v Shire LLC*, 2021 FCA 52 at paragraph 76

52 *Apotex Inc. v Shire LLC*, 2021 FCA 52 at paragraph 67

53 *Apotex Inc. v Shire LLC*, 2021 FCA 52 at paragraph 69 quoting *Unilever PLC. v. Chefaro Proprietaries Ltd.*, [1994] R.P.C. 567 (Eng. C.A.) at 580

54 *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* 2008 SCC 61 at paragraph 77; *Apotex Inc. v Shire LLC*, 2021 FCA 52 at paragraph 74

55 *Janssen-Ortho Inc. v. Novopharm Ltd.* 2006 FC 1234 at paragraph 113, aff'd 2007 FCA 217 at paragraph 25; these factors are considered to remain relevant in view of the guidance of the Supreme Court in *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* 2008 SCC 61.

56 *Canadian Gypsum Co. v. Gypsum, Lime & Alabastine, Canada Ltd.* [1931] Ex. C.R. 180 at paragraph 12

57 *Sanofi-Aventis Canada Inc. v. Ratiopharm Inc.* 2010 FC 230 at paragraphs 83-87; Commissioner's Decision 1304 at paragraph 43

58 *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* 2008 SCC 61 at paragraph 68

59 *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd*., 2011 FC 1323 at paragraphs 193 to 197 where the *obvious-to-try* test was applied to downhole drilling equipment. Comments on the appropriateness of the test were made on appeal (see 2012 FCA 333) at paragraphs 91 to 108, especially paragraph 95.

60 *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* 2008 SCC 61 at paragraph 59-69, especially at 59, 64, 68 and 69; *Sanofi-Aventis v. Apotex Inc.,* 2013 FCA 186 at paragraphs 74-80

61 *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* 2008 SCC 61 at paragraph 68

62. *The King v. American Optical Co.* [(1950), 13 C.P.R. (1st), 87 (Ex. Ct.)] at page 98

63 *Schmuel Hershkovitz v. Tyco Safety Products Canada Ltd.* 2009 FC 256 at paragraph 148 referring to R.H. Barrigar, *Canadian Patent Act Annotated*, 2nd ed. (Aurora: Canada Law Book, 2008) at PA-28.11-12; *Domtar Ltd. v. McMillan Bloedel Packaging Ltd*. (1977), 33 C.P.R. (2d) 182 at 189-91 (F.C.T.D.), affirmed (1978), 41 C.P.R. (2d) 182 (F.C.A.).

64. *Crila Plastic Industries Ltd. v. Ninety-eight Plastic Trim Ltd.* 18 C.P.R. (3d) 1 at pages 1 and 7 to 9, affirming 10 C.P.R. (3d) 226, referring to *Domtar Ltd. v. McMillan Bloedel Packaging Ltd*. (1977), 33 C.P.R. (2d) 182 at 189-91 (F.C.T.D.), affirmed (1978), 41 C.P.R. (2d) 182 (F.C.A.).

65 *Visirecord of Canada Ltd. v. Malton* [1958] Ex. C.R. 116 at paragraph 59, citing *Lightning Fastener Company Limited v. Colonial Fastener Company, Limited* [1932] Ex. C.R. 101 at page 106

66 *Visirecord of Canada Ltd. v. Malton* [1958] Ex. C.R. 116 at paragraph 60, citing *Lowe-Martin Company Ltd. v. Office Specialty Manufacturing Company Ltd.* [1930] Ex. C.R. 181 at page 187

67 *Johnson Controls, Inc. v. Varta Batteries Ltd.* [(1984), 80 C.P.R. (2nd), 1 (F.C.A.)] at pages

12-13

68 *Visirecord of Canada Ltd. v. Malton* [1958] Ex. C.R. 116 at paragraph 61, citing *The Railroad Supply Co. v. The Elyria Iron and Steel Co.* [1917] Patent Office Gaz. (U.S.) vol. 239, at page 658

69 *Visirecord of Canada Ltd. v. Malton* [1958] Ex. C.R. 116 at paragraph 62, citing *Helson v. Dominion Dustless Sweepers Co. Limited* (1923), 23 O.W.N. 597 at page 598

70 *Genpharm Inc. v. Procter & Gamble Pharmaceuticals Canada, Inc.* 2004 FCA 393 at paragraph 47

71 *Uview Ultraviolet Systems Inc. v. Brasscorp Ltd.* 2009 FC 58 at paragraph 224.

72 Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd. [(1981), 56 C.P.R. (2nd), 145 (S.C.C.)] at page 168

73 *Whirlpool Corp. v. Camco Inc.* 2000 SCC 67 at paragraph 63-67

74 *Abbott Laboratories v. The Minister of Health* 2009 FC 648 at paragraph 187, referring to Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd. [(1981), 56 C.P.R. (2nd), 145 (S.C.C.)] at page 169, itself referring to Commissioner of Patents v. Farbewerke Hoechst Aktiengesellschaft Vormals Meister Lucius & Bruning [1964] S.C.R. 49, [(1963), 41 C.P.R. (1st), 9 (S.C.C.)] at page 13

75 Commissioner of Patents v. Farbewerke Hoechst Aktiengesellschaft Vormals Meister Lucius & Bruning [1964] S.C.R. 49, [(1963), 41 C.P.R. (1st), 9 (S.C.C.)] at page 13.

76 *GlaxoSmithKline Inc. v. Apotex Inc.* 2003 FCT 687 at paragraphs 89-91

77 *GlaxoSmithKline Inc. v. Apotex Inc.* 2003 FCT 687 at paragraph 37.

78 *GlaxoSmithKline Inc. v. Apotex Inc.* 2003 FCT 687 at paragraphs 87-91; *Bayer Inc. v. Canada (Minister of National Health and Welfare*) 154 F.T.R [(1998), 82 C.P.R. (3rd), 359 (F.C.T.D.), aff'd (2000), 6 C.P.R. (4th), 285 (F.C.A.] at paragraph 33. See also Apotex Inc. v. Merck & Co. 2006 FCA 323 at paragraph 49.

79 Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd. [(1981), 56 C.P.R. (2nd), 145 (S.C.C.)] at page 169

80 *I.G. Farbenindustrie A.G.'s Patents* [(1930), 47 R.P.C. 289] at pages 322-323; these criteria appear to have been endorsed in Canada at least as early as 1947 in *Minerals*

Separation North American Corp. v. Noranda Mines, Ltd. [(1947), 12 C.P.R. (1st), 102 (Ex.Ct.)] at pages 163-164) and were endorsed by the Supreme Court in *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* 2008 SCC 61 at paragraph 10.

81 *GlaxoSmithKline Inc. v. Pharmascience Inc.* 2008 FC 593 at paragraph 70 and at paragraph 51 with reference to *Dreyfus and Others Application* [(1945), 62 R.P.C. 125 (H.L.)] at page 133; *I.G. Farbenindustrie A.G.'s Patents* [(1930), 47 R.P.C. 289] at page 327

82 Eli Lilly Canada Inc. v. Novopharm Limited 2010 FCA 197 at paragraphs 27, 30; *Ratiopharm Inc. v. Pfizer Limited* 2009 FC 711 at paragraph 175, aff'd 2010 FCA 204 at paragraph 33

83 *Pfizer Canada Inc. v. Canada* 2006 FCA 214 at paragraph 4

84 Pfizer Canada Inc. v. Ranbaxy Laboratories Limited 2008 FCA 108 at paragraph 59; Eli Lilly Canada Inc. v. Apotex Inc. 2007 FC 455 at paragraph 89

85 *I.G. Farbenindustrie A.G.'s Patents* [(1930), 47 R.P.C. 289] at page 323

86 see, e.g., *Eli Lilly Canada Inc. v. Novopharm Limited* 2009 FC 235 at paragraph 100; *Eli Lilly Canada Inc. v. Novopharm Ltd.* 2007 FC 596 at paragraph 162; *Ratiopharm Inc. v. Pfizer Limited* 2009 FC 711 at paragraph 179;

87 *Ratiopharm Inc. v. Pfizer Limited* 2009 FC 711 at paragraph 175, aff'd 2010 FCA 204 at paragraphs 27-28

88 *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* 2008 SCC 61 at paragraph 9; *I.G. Farbenindustrie A.G.'s Patents* [(1930), 47 R.P.C. 289] at page 321

89 *Pfizer Limited v. Ratiopharm Inc.* 2010 FCA 204 at paragraphs 27-28