

Reply to the Attention of    Mr. Keith Bird  
Direct Line                    416.307.4205  
Email Address                keith.bird@mcmillan.ca  
Date                              August 4, 2017

## DELIVERED

Canadian Intellectual Property Office  
Patent Branch  
50 Rue Victoria  
Gatineau, Q.C. K1A 0C9  
Attention: Josée Pharand

Dear Madam:

### Re:    MOPOP Chapter 12 Consultation

You have conducted consultation seeking comments on chapter 12 of MOPOP. McMillan is a leading business law firm with practice in intellectual property including patents. This response constitutes the comments of McMillan LLP on chapter 12.

For consistency with the Supreme Court of Canada's decision in AstraZeneca Canada Inc. v. Apotex Inc. ("AstraZeneca") (2017 SCC 36), we propose that the following statement be removed:

“However, where the specification sets out an explicit promise, utility will be measured against that promise”

Additionally, we propose that section 12.04 be amended to instruct patent examiners to undertake the analysis outlined in paragraph [54] of AstraZeneca. Specifically we propose the addition of the following, based on the court's decision:

“First, the examiner must identify the subject-matter of the invention as claimed in the patent. Second, the examiner must ask whether that subject-matter is useful – is it capable of a practical purpose (i.e. an actual result)?”

Section 12.04.02 should be removed. The SCC, in AstraZeneca supra has made it clear that “the application of the Promise Doctrine is not the correct approach to determine whether a patent has sufficient utility” (para [2] of AstraZeneca supra). In addition, the SCC has indicated that “the Promise Doctrine undermines a key part of the scheme of the Act; it is not good law” (para [51] of AstraZeneca supra). Accordingly, the contents of section 12.04.02 are now obsolete.

Yours truly,



Keith Bird  
KB/sa