

****I submit these comments in my personal capacity and not on behalf of a client or my firm.****

Preamble

Canada already has a very good *Patent Act*. However, it seems that the provisions in the statute are not universally understood or consistently and properly applied (*e.g.*, by CIPO, by the courts, etc.). There is little point in amending a statute (for harmonization reasons or otherwise) that is widely misunderstood, misinterpreted, and misapplied.

To the extent that any "harmonization" of Canada's patent laws and regulations is considered desirable, greater conformity with US law and practice should be the goal, particularly since the Canadian *Patent Act* is modeled on the US patent law. Unfortunately, "harmonization" in a Canadian context almost always seems to be equated with "conforming to European practice". This does not make sense for a number of reasons: the Canadian Act is modeled on the US Act (not the EPC). Canada is a peripheral-claim (not central-claim) jurisdiction, the Canadian patent system is more balanced than the EPC system, etc.

Objectives of the global patent system

- i. Comment: The primary objectives of the patent system are to spur innovation and encourage sharing of information by providing property rights to innovators who invest time and energy in scientific advancements. Any other goals (*e.g.*, coherence, balance) are secondary.
- ii. Comment: Legal certainty, in the sense of a European-type civil code, is not reflective of Canadian law, which allows for flexibility (see, *e.g.*, the law of purposive construction).
- iii. Comment: Why does this section mention "inventive step" and "industrial applicability"? These are European concepts that are not reflected in the Canadian *Patent Act*. Canada is a peripheral-claim, not central-claim, jurisdiction (and thereby provides better notice to the public of the scope of protection). There is absolutely no requirement in the Act for an inventive step. Moreover, the Canadian *Patent Act* requires a claimed invention to have a utility, not an industrial application. The Canadian system is superior to the European system, and there is no valid reason to morph the Canadian statute into a strict European-type code.
- iv. b. Comment: The goal of consistency across jurisdictions may be an important next step after achieving consistency at CIPO. However, to date, examination at CIPO is not consistent with the *Patent Act* or from examiner to examiner. Shouldn't we try to achieve consistency within our own Patent Office first?
- iv. c. Comment: A patent system that is properly designed will necessarily promote both innovation and competition.

Principles and commentary

1. Non-prejudicial disclosures / grace period

- i., ii. Comment: The grace period should not be qualified. Anyway, how would CIPO even confirm that the "circumstances" are met in each and every filing?

iii., iv. Comment: The listed factors do not seem particularly important or compelling.

Circumstances in which applicants should have the opportunity to patent a disclosed invention

Comment: The patent grant permits inventors to obtain protection for that which they have invented in good faith. Deprivation of substantive property rights on the basis of arbitrary administrative requirements may be unconstitutional.

Other characteristics of a potential grace period

- Encouraging transparency

Comment: An additional document should not be required. Section 53 of the *Patent Act* (patent void for material misstatement) already provides appropriate safeguards.

- The duration of the grace period should be harmonised, and calculated from the priority date.

Comment: Is there evidence to suggest that the 12-month NAFTA grace period is somehow inadequate? If not, why is this the focus of time and energy?

Rights of third parties

Comment: Is there evidence to suggest that the Act's existing recognition of prior-user rights and the current grace period are somehow inadequate? If not, why are these the focus of time and energy?

2. Publication of applications

i., iii. Comment: Is there evidence to suggest that the 18-month publication date under the PCT is somehow inadequate? If not, why are these issues being raised?

ii. Comment: Isn't a patent applicant's disclosure to others normally dependent upon his date of first filing, not the date of publication?

vi. Comment: Is CIPO proposing to be the arbiter of public order, morality, or national security?

4. Prior user rights

Comment: This issue is outside the scope of CIPO's expertise.

5. Prior art

Comment: The Canadian *Patent Act* already carefully identifies prior art for novelty/obviousness purposes.