



**February 19, 2022**

**By Email:**

Virginie Ethier  
Director General, Patent Branch  
Canadian Intellectual Property Office  
Innovation, Science and Economic Development Canada  
Email: ic.cipo-consultations-opic.ic@canada.ca

**Re: Submission Regarding “Consultation on changes to MOPOP resulting from "Patentable Subject-Matter under the Patent Act"” opened December 20, 2021**

Dear Colleagues:

This letter is in response to the Consultation opened December 20, 2021 entitled ““Consultation on changes to MOPOP resulting from "Patentable Subject-Matter under the Patent Act””. We appreciate CIPO having invited FICPI Canada to provide a submission in this Consultation.

FICPI (the Federation Internationale des Conseils en Propriété Intellectuelle), comprises more than 5000 intellectual property attorneys in private practice in 86 countries. FICPI Canada is a self-governing national association of FICPI and represents the interests of Canadian patent and trademark professionals. Our membership includes senior professionals at most major Canadian intellectual property firms. Our clients span all types and sizes of businesses, including multi-national corporations, small and medium size enterprises, and individuals.

FICPI Canada wishes to express great concern with the proposed changes to MOPOP, and in particular with the proposed amendments to Chapters 17 and 22. In short, FICPI Canada firmly believes that the proposed amendments misinterpret the principles elucidated by the Federal Court in *Choueifaty v. Canada (Attorney General)*, 2020 FC 837 (hereinafter “Choueifaty”) upon which the amendments are presumably meant to be based.

More particularly, the Choueifaty decision made abundantly clear that the only claim interpretation permissible under Canadian patent law is purposive construction, and that only upon a proper purposive construction of the claims can an examiner or a court assess issues of patentability, including subject matter eligibility, novelty and

obviousness. The Choueifaty decision made clear that any resort to principles other than purposive construction are improper and must be avoided, which is consistent with *Amazon FCA*, *Free World Trust (SCC)* and *Whirlpool*.

Unfortunately, it appears to FICPI Canada that the proposed amendments to MOPOP rehash the same key issue as the prior revision; namely, that “[i]t is evident on a reading of the MOPOP that the Commissioner, notwithstanding stating that the patent claims are to be construed in a purposive manner, does not intend or direct patent examiners to follow the teachings of *Free World Trust and Whirlpool*.” (see Choueifaty at paragraph [29]).

At paragraph [32] of the Choueifaty decision, the Court confirms that:

In *Canada (Attorney General) v Amazon.com Inc*, the Federal Court of Appeal observed that, during examination, Supreme Court jurisprudence “requires the Commissioner’s identification of the actual invention to be grounded in a purposive construction of the patent claims”.

The Amazon case, and Choueifaty after it, clarify that any resort to an “actual invention” analysis must be “grounded in a purposive construction”. It is clear in these decisions that the claims purposively construed are the actual invention; there is no separate analysis of actual invention beyond the purposive construction. To permit such a separate analysis renders the purposive construction as wholly irrelevant to patentability, which is contradictory to the jurisprudence.

The amendments to MOPOP directly contradict this principle.

The proposed amendments to Section 17.02, for example, state that:

An element of a claimed invention that is identified as essential for establishing the fences of the monopoly under purposive construction is not necessarily part of the actual invention.

and

An element may thus be an essential element of the claim because the applicant intended it to be essential even though it has no material effect on the working of the invention. Such an element would not form part of the actual invention because the fact that it has no material effect on the working of the invention means it does not cooperate with other elements of the claimed invention

Not only are the above assertions unsupported by the jurisprudence in Canada, it is illogical that any particular claim element could be considered essential to an invention but not part of that same invention. If the claim element does not form part of the invention, then it is not essential to the invention.

Such assertions in the proposed MOPOP contradict the guidance from Choueifaty, Amazon, Whirlpool and Free World Trust. Again, any resort to such an “actual invention” analysis renders the purposive construction completely irrelevant (which cannot have been the intention of the Court in Choueifaty) and is also overly subjective and unpredictable (both of which were warned against in Amazon).

In short, FICPI Canada asserts that the “actual invention” is necessarily the invention as determined by the claims purposively construed, and that the Commissioner’s analysis of “actual invention” separate from the purposive construction is incorrect as a matter of law.

Additionally, the proposed revisions continue to reference the problem-solution approach which the Court in Choueifaty expressly held to be incorrect under Canadian law (see Choueifaty at paragraph [37]-[40]). For example:

Section 17.02: “An actual invention may generally consist of either a single element that provides a solution to a problem or of a combination of elements that cooperate together to provide a solution to a problem (see chapter 22 on computer-implemented inventions for further clarification relating to inventions involving computers).”

Section 17.02.01: “Claimed subject-matter involving, or relating to, a field outside the manual or productive arts may still be patentable subject matter if the actual invention itself provides a solution to a problem in the manual or productive arts (e.g. it is new functional tool or represents an application of the applied or industrial sciences).”

Section 17.02.02f: “For the printed matter and the substrate to be considered to cooperate together to form an actual invention, they must together solve a problem related to the use of the printed matter in general, and not be based solely on the intellectual, artistic or aesthetic content of the printed matter itself.”

Similarly, Section 22.02.02 is entitled “Adapting a computer to solve a problem”.

Whether or not such an analysis carried out on a particular claim results in a proper finding, these references to the problem-solution approach may lead to confusion as to whether such reasoning is available to examiners in subject matter analyses. The Court has made clear that it is not.

It is respectfully submitted that Chapters 17 and 22 be revised to state:

“Claim construction:

Section 27(4) of the Patent Act states that the specification must end with a claim or claims defining distinctly and in explicit terms the subject-matter of the invention for which an exclusive privilege or property is claimed. Amazon FCA provides that it is the subject matter defined by the claim that is the subject of the question of whether or not the application is directed to patentable subject matter, meets the requirements for Novelty,

Utility, Non-obviousness and whether or not the claimed subject matter is statutorily prohibited within the meaning of Section 27(8) of the Patent Act.

Whirlpool provides that the claims shall have the same interpretation for all purposes and Free World Trust provided specific considerations for interpreting the claims in the context of infringement and therefore provides clear directions for interpreting the claims for assessment of whether or not the claimed subject matter complies with Section 2 of the Patent Act or is statutorily prohibited under Section 27(8) of the Patent Act. In particular, Free World Trust provides that:

- (a) The *Patent Act* promotes adherence to the language of the claims.
- (b) Adherence to the language of the claims in turn promotes both fairness and predictability.
- (c) The claim language must, however, be read in an informed and purposive way.
- (d) The language of the claims thus construed defines the monopoly. There is no recourse to such vague notions as the “spirit of the invention” to expand it further.
- (e) The claims language will, on a purposive construction, show that some elements of the claimed invention are essential while others are non-essential. The identification of elements as essential or non-essential is made:
  - (i) on the basis of the common knowledge of the worker skilled in the art to which the patent relates;

- (ii) as of the date the patent is published;
  
- (iii) having regard to whether or not it was obvious to the skilled reader at the time the patent was published that a variant of a particular element would *not* make a difference to the way in which the invention works; or
  
- (iv) according to the intent of the inventor, expressed or inferred from the claims, that a particular element is essential irrespective of its practical effect;
  
- (v) without, however, resort to extrinsic evidence of the inventor's intention.

Element (e) above specifically refers to purposive construction and Free World Trust explains, in connection with this aspect:

The words chosen by the inventor will be read in the sense the inventor is presumed to have intended, and **in a way that is sympathetic to accomplishment of the inventor's purpose expressed or implicit in the text of the claims**. However, if the inventor has misspoken or otherwise created an unnecessary or troublesome limitation in the claims, it is a self-inflicted wound. The public is entitled to rely on the words used provided the words used are interpreted fairly and knowledgeably.

Element (e) above also explains with explicit detail how to identify the essential elements of a claim, in particular:

- (iii) having regard to whether or not it was obvious to the skilled reader at the time the patent was published that a variant of a particular element would *not* make a difference to the way in which the invention works; or

- (iv) according to the intent of the inventor, expressed or inferred from the claims, that a particular element is essential irrespective of its practical effect;

As such, if omission of the computer would not make a difference to the way the invention works, the computer might not be an essential element of the claim, unless the intent of the inventor expressed or inferred from the claims suggests that a particular element is essential, irrespective of its practical effect.”

By stating the principles of claim construction in this way, applicants and examiners are essentially referred to the relevant jurisprudence and can consult that jurisprudence for further explanation on how to employ the principles established by the courts. In this way, the office practice would be much more closely aligned with the jurisprudence and would allow the examiner’s focus to remain on the principles to be derived from the jurisprudence rather than catch phrases, tag words and generalizations that can take on a life of their own, and divert attention away from the governing principle, as cautioned by the court in *Amazon FCA*.

Once again, FICPI Canada appreciates being invited by CIPO to comment on the proposed amendments to MOPOP and urges that these amendments be reconsidered in light of the comments above and amended accordingly to be more reflective of the jurisprudence in the area before they are adopted.

Yours truly,

**FICPI Canada**

per Coleen Morrison  
President  
FICPI Canada