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By Email: Barney.deSchneider@ic.gc.ca

Barney de Schneider
Assistant Commissioner of Patents
Canadian Intellectual Property Office
Patent Branch
50 Victoria Street
Gatineau, Québec
K1A 0C9

Dear Mr. de Schneider:

Re: Proposed Practice Notice on Obviousness

FICPI Canada wishes to thank the Canadian Intellectual Property Office for the opportunity to comment on the Practice Notice on Obviousness proposed May 14, 2009.

As you know, FICPI (the Federation Internationale des Conseils en Propriété Industrielle), comprises more than 3500 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 trade mark 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.

The purpose of this submission is to provide constructive comments for improvements to the draft Practice Notice. We share the view that examiners should be provided with guidance when assessing obviousness. Guidance documents generally provide greater objectivity and consistency in the examination of patent applications. We also share the view that the Supreme Court decision in the matter of *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* [2008] SCC 61 provides added guidance on the proper conduct of an obviousness enquiry.

The following points are raised in this submission:

1. The requirement for conformity with Section 28.3 of the "new Act";
2. The need for greater clarity when referring to "inventive concept";
3. The need for greater clarity when referring to "obvious to try";
4. The need to state the importance of the history of the invention in an obviousness determination;
5. The need to state that the Canadian requirement for minimal degree of invention has not changed;
6. The need for examiners to state a proper documentary basis before referring to common general knowledge;
7. The need for examiners to specifically point out passages in the prior art and state in detail why the claim is obvious.

1. The requirement for conformity with Section 28.3 of the "new Act"

The *Sanofi* decision was an "old Act" decision, decided under the provisions of the *Patent Act* as it read immediately prior to October 1, 1989. (*Sanofi*, para. [15].) Insofar as the *Sanofi* decision may have general application beyond the specific facts involving the old Act patent that was before the court in *Sanofi*, the Supreme Court was careful to expressly caution that any such general application of the principles of anticipation and obviousness discussed therein must be "*subject to limitations in the Patent Act.*" (*Sanofi*, para. [29].)

The Supreme Court expressly acknowledged that under the pre-1989 laws governing the *Sanofi* decision, there was no statutory provision governing obviousness. (*Sanofi*, para. [51]). In contrast, under the *Patent Act* that came into force on October 1, 1989, there is indeed a statutory provision governing obviousness, in section 28.3 of the Act, which states that "*The subject-matter defined by a claim ... must ... not have been obvious on the claim date ...*"

Section 28.3 does in fact impose a number of statutory limitations. Therefore, as expressly contemplated by the Supreme Court in *Sanofi* (at para. [29]), the principles for obviousness expressed in that decision must be adapted to conform to the limitations imposed by section 28.3 in any "new Act" cases. As a first example, under the "old Act", the critical date for assessing obviousness was the *date of invention* (*Sanofi*, para. [52]). In contrast, s.28.3 expressly requires that the claimed subject-matter "*must not have been obvious on the claim date*". As a second example, s.28.3 defines the prior art that is citable for obviousness, including a *one-year* grace period in s.28.3(a) which differs from the *two-year* grace period found in s.28(2) of the old Act. Finally, as a third example, to the extent that an "inventive concept" approach to obviousness may have been acceptable under the old Act, such an approach is not permitted by the opening

words of s.28.3 of the new Act, which states that it is "The *subject-matter defined by a claim*" which must not have been obvious.

Thus, Parliament did not impose any requirement for an "inventive concept" or for anything other than "the subject-matter defined by a claim" to be non-obvious. Going forward, the guidance provided by the *Sanofi* decision must not be allowed to trump the provisions of the new Act and in particular Section 28.3 specifically dealing with obviousness and absent from the old Act.

From CIPO's perspective, section 40 of the *Patent Act* must also be borne in mind. Section 40 of the *Patent Act* provides as follows: "Whenever the Commissioner is satisfied that an applicant is not *by law* entitled to be granted a patent, he shall refuse the application and, by registered letter addressed to the applicant or his registered agent, notify the applicant of the refusal and of the ground or reason therefor." [emphasis added]. The Supreme Court of Canada has repeatedly held that as a result of section 40, and in particular, the words "*by law*", the Commissioner has no discretion independent of the *Patent Act* to refuse an application. (See e.g. *Monsanto Co. v. Commissioner of Patents* (1979), 42 C.P.R. (2d) 161 at 178 (S.C.C.); *Vanity Fair Silk Mills v. Commissioner of Patents*, [1938] 4 D.L.R. 657, [1939] S.C.R. 245 at p. 246.)

2. The need for greater clarity when referring to "inventive concept"

FICPI is of the view that the "inventive concept" approach must be compliant with s.28.3 of the "new Act". To do this, whenever the proposed Practice Notice refers to "inventive concept", this should be strictly defined as the "inventive concept" particularly expressed in a given claim after construing the claimed features. More specifically, we suggest that the directive to examiners expressed at the top of page 3 of the Practice Notice should be amended to state that the inventive concept is that of the particular claimed features of a given claim under consideration rather than a generalised inventive concept of a given claim. The communication between examiners and applicants will be simplified by referring to particular claimed features and combinations thereof rather than generalised "inventive concepts" where disagreements could frequently arise.

In the *Sanofi* decision, the Supreme Court referred to the *Pozzoli* case para. [19]:

"in some cases the parties cannot agree on what the concept is. If one is not careful such a disagreement can develop into a satellite debate. In the end what matters is/are the differences between what is claimed and the prior art. It is those differences which form the "step" to be considered at stage (4). So if a disagreement about the inventive concept of a claim starts getting too involved, *the sensible way to proceed is to forget it and simply work on the features of the claim.*" [emphasis ours]

Practitioners often ponder for hours to find concise language that captures the "inventive concept" and use it in the claims and applicants are often involved in at least approving the language capturing the inventive concept. Therefore, to avoid improper or diverging interpretations of inventive concepts, specific claim language should be used to pinpoint the inventive concept. The examiner should not be encouraged to re-cast the claims by defining what he/she believes the inventive concept to be but rather must be confined to the language used in the claims for consistency with Section 28.3 of the Patent Act and to avoid satellite debate. Indeed, the possibility of satellite debates does little more than aggravate the parties and unnecessarily increases the cost of obtaining a patent in Canada and the burden on the applicant and the Office.

Another aspect of the proposed Practice Notice relates to the paragraph appearing at p. 4 which reads:

"Where it can be reasonably concluded that the person skilled in the art would have been motivated to solve a recognized problem, the criterion set out in item (A) of the Sanofi-Synthelabo "obvious to try" considerations is satisfied."

This cannot be true since it refers to the problem, whereas item (A) refers to "solution". In addition the problem referred to in the statement cannot be just any problem – it must be *the* problem addressed by the applicant's claims. If the problem is too broadly defined the statement encourages the applicant's solution to the problem to be dismissed without proper consideration. Disagreements between examiners and applicants as to the scope of the problem can lead to the satellite debates referred to earlier. Clearly again the use of the terms problem and solution raise some ambiguity and strict adherence to the claim language is necessary to avoid the effects of overbroad interpretations of the problem addressed by the invention. FICPI recommends avoiding the use of problem and solution language as part of the obviousness inquiry.

It is also noteworthy that in the United Kingdom, from which the restated *Windsurfing* questions articulated in *Sanofi* originated, the House of Lords has since abolished the "inventive concept" approach to obviousness. In this regard, several months after *Sanofi* was argued before the Supreme Court of Canada, the House of Lords handed down its decision in *Conor Medsystems Inc. v. Angiotech Pharmaceuticals Inc.*, [2008] UKHL 49. *Conor* involved an attempt to revoke Angiotech's patent. The parties disagreed as to the "inventive concept". The trial judge favoured Conor's view of the "inventive concept" and concluded that Angiotech's patent was obvious on that basis. The House of Lords emphatically disagreed with this approach to obviousness, stating at paras 17-19: "It is the claimed invention which has to involve an inventive step. The invention means *prima facie* that specified in the claim ... In my opinion, however, *the invention is the product specified in a claim and the patentee is entitled to have the question of obviousness determined by reference to his claim*

and not to some vague paraphrase based upon the extent of his disclosure in the description." (As the *Conor* decision of the House of Lords was not handed down until several months after *Sanofi* was argued before the Supreme Court, only the Court of Appeal decision in *Conor* was considered by the Supreme Court of Canada; the subsequent House of Lords decision is cited only to confirm that the reversal by the House of Lords did not affect the passage from the Court of Appeal's decision which had been cited with approval in *Sanofi*, and which is unrelated to the "inventive concept" question.) FICPI submits that it would be awkward if CIPO were to adopt a UK approach in its broken and unworkable form rather than in the corrected form recently adopted by the House of Lords. We therefore suggest to move away from the "inventive concept" language in favour of simply instructing examiners to construe the claims as per the claimed features.

Another aspect related to "inventive concept" is the use of the terms "problem" and "solution". This appears to improperly import into Canadian practice a European method of assessing obviousness. There is no Canadian law that supports this. The problem-solution approach is used in Europe and has the drawback of attracting hindsight analysis, which the Office appears to wish to avoid. Patent specifications are prepared long after an invention is made and before such applications are prepared, searches of prior art are often conducted to assist the applicant's agent in preparing claims. Any description of the prior art in the specification is provided with the knowledge of the invention and often some prior art and does not reflect the inventor's state of mind when the invention was made. Therefore resort to the specification to determine the inventive concept inherently incorporates a hindsight approach, because the specification itself is prepared with knowledge of the invention and at least some prior art, whereas at the time the invention was made the concept of the invention and its relation to the prior art are known to the inventor and this is a critical factor in determining whether an invention is obvious. The subjective experience of the inventor is very relevant and is likely more relevant than an examiner's time-pressured opinion obtained in light of prior art found by the examiner after reading the specification which presents the invention in light of the prior art known at the time the specification was prepared. Thus, FICPI is of the view that the "problem-solution" approach is not in line with Canadian law and should be avoided because it attracts hindsight and a generalisation of the disclosure rather than properly focusing on claimed features.

3. The need for greater clarity when referring to "obvious to try"

On page 4 of the proposed Practice Notice, CIPO asserts that "a specific motivation must exist to identify a solution to a specific problem, from among a limited number of possible solutions one of which ought reasonably to work".

The reference to "a limited number of possible solutions one of which ought reasonably to work" is not consistent with *Sanofi*, particularly not as subsequently

applied by the Federal Court of Appeal in the VIAGRA case, *Apotex v. Pfizer*, 2009 FCA 9, in two respects.

First, it is not enough for "one of" the possible solutions to be obvious to try; it must be the solution recited in the claim under review. Second, "ought reasonably to work" is not enough: it is clear that an invention cannot be found "obvious to try" unless it is "very plain" and "self-evident" that it will in fact work. In this regard, as held in the VIAGRA case, "obvious to try" under *Sanofi* is not the same as "worth a try" in the UK. The F.C.A. held that, "The test recognized is 'obvious to try' where the word 'obvious' means 'very plain.' According to this test, an invention is not made obvious [merely] because the prior art would have alerted the person skilled in the art to the possibility that something might be worth trying. The invention must be more or less self-evident."

The F.C.A. also held that no degree of motivation can satisfy the separate requirement that it must be "self-evident that what is being tried ought to work", stating, "the degree of motivation cannot transform a possible solution into an obvious one."

FICPI recommends that the Practice Notice should emphasize these aspects of "obvious to try", to avoid any misunderstanding by examiners and applicants of the nature of the enquiry.

The proposed Practice Notice at the top of page 4 refers to *Novopharm Limited v. Janssen-Ortho Inc.* [2007 FCA 217] as remaining relevant in view of *Sanofi*. The first part of the obviousness inquiry set forth in *Novopharm* (climate, trends etc. in the relevant field) would appear to provide further specificity to the first two steps of the test set forth in *Sanofi*.

The second part of the *Novopharm* inquiry relates to determining whether there was any motivation to incorporate the differences determined, by applying the fourth step of the *Sanofi* test. It is here that the still relevant *Beloit* test may provide some assistance in appreciating that at least a scintilla of inventiveness should be sufficient to support a finding of non-obviousness. The proposed Practice Notice, at the bottom of page 3 acknowledges that *Beloit Canada Ltd. v. Valmet Oy* (1986), 8 C.P.R. (3rd) (FCA) remains relevant, but not compulsory. FICPI recommends that the Office clarify that it considers the guidance affirmed in *Beloit* to remain relevant.

In addition, as the court stated in *Sanofi*, it will be at the fourth step of the approach to obviousness that the issue of "obvious to try" will arise. Thus the "obvious to try inquiry" seems to be an alternative to the *Novopharm* enquiry and the *Beloit* test and all three of these enquiries should or could be made at step four of the *Windsurfing/Pozzoli* test. In *Sanofi*, the court considered when the "obvious to try" test is appropriate and suggested that it might be appropriate in areas of endeavour where advances are often won by experimentation. FICPI is

of the view that the alternative nature of the three enquiries at the fourth step of the *Windsurfing/Pozzoli* test should be stated more clearly in the Practice Notice and the suggestion that the "obvious to try" test be applied to areas of endeavour where advances are often won by experimentation should be stated more clearly.

4. The need to state the importance of the history of the invention in an obviousness determination

Sanofi, para. [70] points out the importance of the history of the invention in an obviousness determination. FICPI submits that this should be incorporated into the Practice Notice. The last full paragraph of page 4 of the proposed Practice Notice seems to imply that the experience of the inventors will not be determinative during examination for lack of a practical mechanism existing for an examiner to ascertain the work done by the inventors. FICPI suggests that a practical mechanism would be a sworn declaration from the inventor(s) or others knowledgeable in the field of the invention, setting out the history of the invention, the factual demonstration of "undue burden", the climate in the relevant field, etc. This would be of assistance to examiners and would appear to be permissible under Canadian law. FICPI urges the Office to incorporate such a possibility within the Practice Notice.

5. The need to state that the Canadian requirement for minimal degree of invention has not changed

FICPI is of the view that it should be emphasized in the Practice Notice that under step 4, the test articulated by the Supreme Court of Canada is whether the differences between the claimed invention and the state of the art "require *any degree of invention*". The *Sanofi* decision does not in any way detract from previous, equally binding decisions of the Supreme Court of Canada to the effect that only "*a scintilla of invention*" is required to support a patent: see e.g. *The King v. Uhlemann Optical Co.* (1951), 15 C.P.R. 99 at 104-106 (S.C.C.); *DeFrees and Betts Machine Co. v. Dominion Auto Accessories Ltd.* (1963), 44 C.P.R. 74 at 109 (Ex. Ct.), affd. (1965), 47 C.P.R. 12 at 14 (S.C.C.).

6. The need for examiners to state a proper documentary basis before referring to common general knowledge

FICPI recommends that examiners be requested to state and document a proper evidentiary basis before referring to common general knowledge. Indeed, examiners may be tempted to "fill-in" gaps in the prior art by resorting to vague notions of common general knowledge. It is submitted that Canadian law provides that assessing common general knowledge is a factual enquiry which must be substantiated with facts.

The four step test for obviousness in *Sanofi* involves finding differences between the inventive concept and the prior art and then assessing whether these

differences are obvious. FICPI suggests that the proposed Practice Notice be amended to require the examiner to identify art supporting an allegation of common general knowledge. If an aspect is truly common general knowledge, it should impose little burden on an examiner to find a piece of art supporting this notion. This should avoid baseless allegations of common general knowledge.

7. The need for examiners to specifically point out passages in the prior art and state in detail why the claim is obvious

FICPI recommends that the proposed Practice Notice be amended to require the examiner to carefully articulate the differences between the inventive concept and the prior art and state in detail why the examiner believes the differences are obvious. For example, the examiner should indicate the specific pages, lines and reference number in Figures, upon which he/she relies as equivalent element/structure to an element/structure recited in a claim and should carefully articulate the motivations that he/she alleges would have led a person skilled in the art to incorporate the differences into the prior art to arrive at the claimed invention. This should avoid vague comparisons between the prior art and the claimed invention and allow a more meaningful examination to occur earlier in the examination process.

Miscellaneous

On page 3 of the draft Practice Notice, we note the use of the term "state of the art". We recognize that this is a European term, but in our view it would be better referred to as: "prior art".

Regarding impact on cases under prosecution, FICPI Canada recommends that the Practice Notice should also state that examiners having found claims obvious under prior practice could withdraw an earlier objection in light of the new guidance which allows a wider scope of inquiry.

FICPI Canada wishes to thank the Canadian Intellectual Property Office for the opportunity to present these comments.

Respectfully submitted,

per 

Robert Storey - President, FICPI Canada
Alain Leclerc - Vice President, FICPI Canada
and John Knox - Secretary, FICPI Canada

cc Chris Evans, CIPO (by Facsimile at 819-994-1989)