

Raju Khubchandani  
Phone: (613) 820-2549  
Email: [rajukhub@yahoo.ca](mailto:rajukhub@yahoo.ca)

11 June 2009

Sent by e-mail

Dear Chris Evans:

**Re: Proposed Practice Notice on Obviousness**

I thank Barney De Schneider – Assistant Commissioner of Patents at CIPO and his staff for sending me an email on 14 May 2009, requesting my participation in a consultation on the proposed changes to the assessment of obviousness in Canada.

My feedbacks on three issues, viz. identifying person skilled in the art, undue burden and hindsight are given below.

**1) HELP FOR IDENTIFYING PERSON SKILLED IN THE ART**

On page 1 of the document under consultation, it states,

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

On page 2, it states that

“(1)(a) Where necessary, examiners will identify the person skilled in the art by reference to the field or fields relevant to the invention,…”

On page 4, it states that

“no practical mechanism exists for an examiner to fully ascertain ...whether the inventor should be treated as the relevant person skilled in the art.”

**Comment:** At times, it may not be easy/quick to identify the notional person skilled in the art. To help the examiners identify a person skilled in the art, would it be beneficial to request applicants to submit information about the inventor(s) academic qualifications and current resume(s)? This voluntary information may be submitted at the time of initial application. The examiner does understand that the invention under consideration may be outside the field in which the inventor obtained academic qualifications; nevertheless, this kind of voluntary information

from the applicants may help the examiners in identifying a person skilled in the art.

To protect the privacy of the inventor, the resume of the inventor need not be open for public inspection.

The practical advantages of soliciting this information could be for example, to help the Patent Office assign a Patent Examiner who is familiar with the subject matter and speed up the mandatory task of classifying the application according to the International Patent Classification System.

## **2) UNDUE BURDEN IN ARRIVING AT THE SOLUTION**

On page 2, it states that

“is the experimentation prolonged and arduous...”

and

“(if) the 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...”

**Comment:** I understand one of the reasons for the trials to be prolonged and arduous is the justification of awarding the patent and all its associated benefits, in return for the time and money spent in conducting R & D to invent. I am of the opinion that the trials need not be prolonged and arduous, since it is one of the hallmarks of some inventive geniuses not to work long and hard. This may not be true for all genius people but is true for some. The inventive genius should be rewarded with the patent for the fact that he/she is disseminating knowledge to the public through the patent application, (if all else in the patent application is satisfied).

On the flip side, if the invention required prolonged and arduous experimentation, it could be the basis for granting the patent, to reward the inventor's investment in R & D, but lack of the same should not become the basis for denial of a patent.

Even if the matter of the claim would be arrived at by routine trials that were not prolonged and arduous, if it leads to someone skilled in the art to ask, “Wow!, why did I not think of that? It is so simple”, then it should not be the basis for denial of the patent. In order to discourage frivolous patent applications, let me clarify that “why did I not think of that” in the aforementioned sentence, that refers to the “solution of the problem”, and not “applying for a patent”.

In fact, in the last para on page 4, the document does imply that evaluating the “undue burden” aspect of the test is not straightforward.

One benefit of this policy would be encouraging the public to patent some of their Trade secrets, if they are simple but do not require undue burden. Since patents fuel progress, as a society, we must encourage people to patent their Trade secrets. It may be a loss to society in general, if the Trade secret is carried to the grave by the inventor. However, the benefit of adopting the aforementioned policy may not be immediately evident, unless all the member countries of WIPO accept to disregard the “undue burden” test, since we live in an era of a global economy.

### 3) HINDSIGHT

On page 3, it states that

This is important to avoid adopting an improper “hindsight” perspective; where the existence or nature of a problem was unobvious, identifying the problem can contribute to the necessary inventive step.

**Comment:** I agree that the examiner must avoid adopting an improper “hindsight” perspective, hence have underlined the aforementioned statement for emphasis.

Sincerely,

Raju Khubchandani  
Email: [rajukhub@yahoo.ca](mailto:rajukhub@yahoo.ca)