

Joint Liaison Committee
Meeting #118
Wednesday, October 28, 2009

Attendees:	IPIC	Patent Office
	R. Caldwell	B. de Schneider
	L.P. Gravelle	R.. Jaecques
	K. Lachaine	L. Giardina
	M. Eisen	D. Campbell
	A. Brett	C. Evans
	H. Probert	M. Gillen
	A. Zahl	S. Périard
	D. Schwartz	S. Carrier
	S. White	S. Tupper
	C. Gervais	
	D. Nauman	
	A. Ionescu	
	E. Saffman	
	V. Donnelly	
	M. Paton	
	K. Ledwell	
	Y. Bismilla	
	I. Clark	
	J. Raakman	

Via Conference Call*	CIPO Observers
K. Sechley	D. Begin
A. Malloy	J. Orser
S. Rancourt	M. Oberol
M. Kingston	
M.A. Arnaldo	

1. MINUTES OF THE PREVIOUS MEETING

The minutes of the meeting of June 17, 2009, were approved without amendment.

2. BUSINESS ARISING

4o New Practice Concerning Title of Invention

A. Zahl expressed concerns about CIPO's recent change in practice regarding the title of the invention wherein, unless advised otherwise, the patent issues with the title that appears on the first page of the description when that title disagrees with the title identified in the initial request. It would be beneficial to the applicant to be warned of the discrepancy in title before the applicant's only remaining option is to pay the Amendment After Allowance fee to rectify the situation.

S. Périard responded that a front end review is now in effect to note any discrepancy between the title in TechSource and the title appearing on the first page of the description. Moreover, examiners may also note the discrepancy and alert the applicant in an official action. S. Périard also proposed that title discrepancies could be identified prior to the notice of allowance together with the 3 month requisition letter calling for new pages.

It was decided by all members to maintain the current practices without further review and discussion on this topic.

4e Rejections Relating to Sound Predictions and Utility

This item was previously covered in the minutes of the meetings of June 4, 2008 and June 17, 2009.

D. Campbell informed the committee that it was decided not to conduct another wide consultation on this issue and instead referred the committee to a handout provided entitled "Claim Support and Promised Utility" (see attached) which outlines the Office's practice.

Any comments on the handout or subsequent analysis can be forwarded to C. Evans at chris.evans@ic.gc.ca.

4f General Authorization

Based on concerns raised previously by D. Schwartz, the Office agreed to review the concept of conditional reinstatement requests and its implications in terms of responsibility to the Office.

C. Evans advised the committee that the Office is in the process of developing a Practice Notice on this issue to be available for consultation for December. The Practice Notice will clarify the

type of language that can be utilized to effect a general authorization. Specific examples of suitable language will also be provided in the Notice. Comments in response to the Notice will be welcomed.

3. ON-GOING ITEMS

3a Corporate Feedback Mechanism Report

A report summarising feedback received during the period June 1, 2009, to August 31, 2009, was included in the JLC members' information packages.

B. de Schneider reminded the committee that the Corporate Feedback Mechanism is an effective tool to efficiently and expeditiously resolve client service issues. The Office is committed to addressing feedback in a timely manner as well as noting service satisfaction trends in order to improve service delivery generally. When queried, members of the profession present indicated satisfaction with the Corporate Feedback Mechanism and the responses received.

B. de Schneider summarized the feedback received and noted that the bulk of complaints continue to relate to the application process.

3b Service Standards

"Dashboard Highlights" for August, 2009, and *Additional Patent Statistics* for August, 2009, were included in the JLC members' information packages.

B. de Schneider advised the members of the committee that examination production is progressing well and remains on target. Turn around times in Operations are also meeting service standards. This is a significant improvement from last year, where we had difficulty, particularly with PCT National entry.

B. de Schneider queried the profession as to whether the statistics provided were useful, focussed and addressed all areas of interest to their clients. A. Zahl responded that feedback on this issue could be provided only after conferring with the file clerks at his firm. A. Brett added that the tracking of turn-around-times and errors in scanning would be beneficial and that efforts should be made to significantly reduce the current times. K. Ledwell opined that consistency in the turn-around-times is more important than the actual turn-around-times and that he would be interested in a more realistic presentation of examination statistics where the mean time to issue and the mean time to reach examination are monitored. It was also mentioned that the turn-around-time for granting would be useful.

B. de Schneider closed this agenda item by stating that the Office wants the statistics to be useful and clear and by requesting that the profession provide an indication of what they would like to see measured and monitored.

4. NEW BUSINESS

4a Regulations Update

C. Evans, in S. Vasudev's absence, provided a brief update on the three regulations packages.

Package #1 has been vetted through two consultation processes and the comments received therefrom have been posted on CIPO's web-site. Package #1 is currently going through the approval chain. Significant IT implementation challenges have come to light which will delay the coming into force of the regulations covered by the package.

Package #2 has been vetted through one consultation process and the comments therefrom are also available on CIPO's web-site. IT challenges appear to be an issue with this package as well. Further opportunity to comment will be available when this package appears in Gazette 1.

Package #3 has been vetted through a single consultation process and the comments received therefrom are currently being evaluated. Opportunities to comment on package #3 will be provided when these changes appear in Gazette 1.

H. Probert indicated that package #1 was originally slated to come into force by November, 2009, and enquired as to the likely length of the delay and whether package #2 would also be delayed as a result.

B. de Schneider responded that it appears that package #1 would be delayed for one year and that package #2 would likely also be delayed as a result.

4b MOPOP Update

C. Evans provided an update on the progress of revision to the Manual of Patent Office Practice (MOPOP).

There will be a public consultation on Chapter 9 (Descriptions) this Fall. Following through from work on Chapters 12 and 13, it is expected that a public consultation on Chapter 16 (Computer Implemented Inventions) will be conducted in Spring, 2010. A consultation is planned for the Summer of 2010 for revised Chapter 14 (Unity of Invention). A working group is convening in the Spring of 2010 to begin work on Chapters 11 (Claims) and 15 (Novelty and Obviousness)

with public consultations to follow. With respect to Chapters 12 (Subject Matter and Utility) and 13 (Examination of Applications), comments received from the consultative process are now available on CIPO's web-site. A briefing on these latter chapters is currently being developed for the Commissioner of Patents.

A. Brett questioned whether examiners are already utilizing the draft chapters when examining. It appears that some examiners are taking into account the Commissioner's Amazon decision. Should this be happening in view of the fact that the Amazon decision has been appealed and could potentially be reversed? Until the decision has been reviewed by a court of law, Office practice should remain constant.

B. de Schneider responded that it would not be reasonable to delay the prosecution of applications until every controversial issue has been vetted by the Courts. It is incumbent upon the Office to operate in accordance with authoritative decisions as they unfold.

4c Section 8 Update

C. Evans, in S. Vasudev's absence, provided a Section 8 update.

Currently, there are sixty four Section 8 requests pending before the Office. The vast majority of these were filed in 2009. Some of the older requests have been delayed awaiting judicial decisions.

H. Probert questioned the Office's refund policy regarding Section 8 requests. Ms. Probert filed eight identical Section 8 requests; four of which were implemented and four of which were refused. In view of this contradiction, is she entitled to a refund for the refused requests?

C. Evans requested that Ms. Probert contact F. Dionne for clarification on this issue.

4d Patent Prosecution Highway (PPH) Update

B. de Schneider provided to the committee an update on the Patent Prosecution Highway (PPH).

The PPH pilot with the United States continues to be successful and the Office has received approximately 700 PPH requests thus far. Correspondingly, only approximately 12 PPH requests have been received by the United States Patent Office. Canada has recently formalized PPH agreements with Denmark, Japan and South Korea. Feedback from the profession has been positive.

H. Probert considers the PPH arrangement to be 100% positive; both quick and well done. D. Schwartz questioned whether true harmonization was possible between PPH countries when the national laws are so different. V. Donnelly expressed satisfaction with the PPH process but

indicated that subsequent actions appeared to be delayed relative to the first action and wondered whether a tracking process would be beneficial. D. Campbell responded that examiners have clear instructions to process PPH applications on a priority basis and that the TechSource system prioritizes PPH tasks. The targeted turn-around-times for PPH applications is sixty days from receipt of the PPH task. L.P. Gravelle added that a client became disenchanted with the PPH process when the Office issued a seven page examiner's action on a PPH application.

4e Vancouver Group Office (VGO)

D. Campbell referred to a handout provided to the committee entitled "Vancouver Group" (see attached) which outlines the principles of cooperation between the Canadian, Australian and United Kingdom Intellectual Property Offices in a work sharing arrangement. The intent of the arrangement is to share information (such as search and examination results) and to reduce the duplication of work - - leading to improved efficiencies for the three offices.

The Vancouver Group Mutual Exploitation (VGO-ME) initiative aims to be transparent, promote consistency and to result in an accelerated examination of patent applications where prior work in one of the three offices is utilized to timely advantage.

The World Intellectual Property Organization (WIPO) has agreed to provide the IT infrastructure to enable the exchange of examination results for the VGO. Examiners would have access to the information stored in the library to be utilized to effect the mandate of the VGO-ME.

Currently, one examiner at CIPO is participating in a VGO pilot to determine the business requirements for the infrastructure.

4f Electronic Filing System

J. Raakman expressed concerns about CIPO's electronic filing system and its failure to provide a confirmation of receipt. Moreover, the delay between the receipt of the application and confirmation of the filing date and serial number is too long by today's IT standards.

B. de Schneider admitted that CIPO's electronic filing system is rudimentary and stated that there are long term plans to improve the system. However, a stop-gap solution may be for the Office to provide an e-mail within 24 hours of receipt confirming the number of pages contained in the application. Would such an arrangement be an efficient use of Office resources? The profession opined that instant verification would be ideal, but that 24 hour notice is better than no notice at all.

B. de Schneider emphasized that this e-mail notification procedure would apply to the electronic filing of applications only and not to other forms of correspondence.

4g Scanning Delays

A. Brett raised concerns about scanning delays at CIPO causing his firm problems with respect to the filing of Declarations of Entitlement and Amendments after Allowance. Notices of abandonment have been issued and withdrawn by the Office due to the delay to scan filed Declarations of Entitlement and there has also been concern over whether amendments after allowance would be scanned prior to the application of final fees.

S. Rancourt complained that the Office has issued Notices of Allowance failing to take into account amendments filed up to 2 months prior.

A. Zahl complained that CIPO has issued requisitions for Declarations of Entitlement on applications where the Declaration was filed months previously but not processed due to scanning delays. This has created extra work and raised uncertainty for his firm.

A. Ionescu has also received erroneous Notices of Abandonment on applications that should have been in good status due to scanning delays and questioned whether CIPO could communicate internally to prevent this from happening.

S. Périard responded that scanning delays have been variable since the Spring. In May, the turn-around-time in scanning was 6 weeks, in July, scanning was delayed to 7 weeks, only to return to 6 weeks by the end of Summer. Today, the turn-around-time is back at 7 weeks. To combat these fluctuations in scanning delivery, it is planned to hire and train 4 additional people by the end of the year. In the meantime, all abandonments will be verified before the notices are mailed. It is a priority of the Office to restore the scanning turn-around-time to 6 weeks and to eliminate the scanning back-log.

S. Rancourt stated that a 6 week scanning turn-around-time for responses to Office Actions is satisfactory, but is inadequate for Amendments after Allowance. S. Périard responded that there is currently no priority given to amendments but that is the ultimate goal of the Office to reduce the scanning TAT to 4 weeks. However, S. Périard stated that the process will be reviewed to determine if it is possible to alert examiners to amendments in the pipeline and will report back on this at the next meeting.

4h Document Handling

A. Brett complained that a request for a certified copy of a PCT application was denied by CIPO on the basis that the file had been destroyed in spite of the fact that a Receiving Office has an obligation to provide such certified copies.

S. Périard responded that files are destroyed after 10 years but that S. Vasudev, upon his return, would confer with WIPO and re-evaluate the procedure.

J. Raakman complained that CIPO has required replacement pages for pages containing serial numbers handwritten by CIPO staff and for pages that were erroneously scanned.

CIPO staff have been reminded not to hand write on the pages.

S. Périard responded that when filing correspondence or applications by facsimile, if the English facsimile number is busy, try the French facsimile number and vice versa. Occasionally, the transmission of jumbo applications may jam the machines. On October 1st, a new server and five additional lines were added.

A. Ionescu questioned whether the Office would provide a certified copy of an application to the applicant subsequent to its withdrawal prior to the laid open date.

S. Périard responded that the Office's reproduction unit would provide a certified copy of an application in this situation to either the applicant or the agent.

4i Web-site - Canadian Patent Database

A. Ionescu questioned whether, in addition to the presently available links to separate sections of an application, it would be possible to provide links to an entire application in the .pdf and .tiff formats.

B. de Schneider responded that this issue was raised in a previous meeting, the Office is aware of the need and that it remains lower on the list of IT priorities.

A. Ionescu expressed dismay that, while CIPO does not, Delphion does provide this service for Canadian applications at a nominal cost.

Other members of the profession then informed the committee that both espacenet and the German Patent Database provide entire Canadian applications in the .pdf and .tiff format at no additional cost.

4j Rule 84

M. Eisen has received Office actions including objections under Section 84 of the Patent Rules asserting a lack of clarity, a lack of conciseness and a statement that the sheer number of claims makes it difficult to determine the overall scope, together with a lack of unity objection. What does the Office consider "overall scope" to mean - particularly in view of a unity objection?

C. Evans responded that this objection is a relatively new practice in the Office but is utilized, e.g., where the sheer number of independent claims render the nature of the invention unclear when the independent claims are considered one relative to another. Normally, this objection is

raised only when there are a large number of similar independent claims.

M. Eisen added that this objection is difficult to respond to and not clear in its meaning.

C. Evans responded that the PERM paragraphs used by examiners as well as the training materials will be reviewed and adjusted to clarify when these objections should be raised.

4k Lack of Unity Objections

S. Rancourt questioned whether examiners should be required to clearly elaborate which claims fall into which groups when alleging a lack of unity of invention; particularly in view of the fact that a patent is not invalid on the basis of claiming more than one invention (Section 36 of the Patent Act).

L. Giardina responded that this issue has been raised in a previous meeting but that examiners should clearly identify claim groupings taking into account all the claims when possible. However, when there is significant overlap between the groupings, it can be difficult to definitively identify all groups. The Office considers this issue to be a shared responsibility and that when there are many combinations of claim groupings, it is possible that only the broad lines will be presented.

S. Rancourt opined that there is a risk to the applicant when the applicant must decide the claim groupings and that the examiner should be deciding this issue.

L. Giardina reiterated that examiners should present a full breakdown of claim groupings when feasible and that a reminder will be issued.

4l Rejections of a Claim Relating to Both Novelty and Obviousness

A. Ionescu raised concerns over examiner objections based on novelty that additionally assert that because the claims lack novelty it automatically follows that the same claims also lack an inventive step. In the view of Mr. Ionescu, examiners should be appraising obviousness before considering novelty, that obviousness must be based on more than one prior art citation and that a patent that lacks inventiveness cannot be novel but that one that lacks novelty may still be inventive (Beloit, 1980).

C. Evans responded that the Office operates on the presumption that a claim that lacks novelty also lacks an inventive step. This issue may be discussed in the future but it is the position of the Office that this is the correct approach to objections based on novelty and obviousness. The profession will have an opportunity to submit comments on this issue during the public consultation for Chapter 15 of the Manual of Patent Office Practice (MOPOP). The issues of

novelty and obviousness should be considered in view of the prior art, and not from the subjective perspective of the inventor. An inventor may have independently arrived at their claimed invention after much inventive effort but that does not necessarily mean that the subject matter, legally, is new or involves an inventive step in view of the prior art.

D. Campbell added that both novelty and inventiveness must be addressed together in order to avoid any potential possibility for two separate and consecutive final actions.

4m Reliance on IPRPs

S. Rancourt expressed concern over examiners referring to the IPRP for objections related to novelty and/or obviousness. The paragraphs used by examiners refer to “the claims” and fail to explicitly identify which claims are objectionable even when only some of the claims in the IPRP are at issue. This causes the applicant confusion.

C. Evans responded that it is true that the paragraphs refer to “the claims” but that it is readily apparent later in the paragraph that phrase “the claims” refers to the claims specifically objected to in the IPRP. The paragraphs are worded in this manner to avoid transcription errors and are considered by the Office to be clear.

4n Consideration of Foreign Search Results

D. Schwartz would appreciate examiners’ first Office actions including an indication of the prior art that has been considered; such as whether the art cited in USPAIR or EPonline has been evaluated. Such a practice would alleviate or eliminate the need for voluntary submissions outlining all of the prior art known to the applicant.

A. Ionescu also believes that it would be of value for examiners to at least clearly identify which foreign search reports have been taken into account in the examination thus reducing the burden on the applicant to report all known prior art.

D. Campbell responded that the Office appreciates the benefits of identifying in the first action what search results the examiner has used in the search. Similarly, the VGO also desires to be transparent with respect to what work has been performed by which office. Accordingly, it is planned to develop PERM paragraphs for examiners’ use that will accomplish this.

D. Schwartz questioned whether it is possible to no longer request the provision of US and EP search results in the confirmation letters issued by the Office in response to a request for examination.

D. Campbell responded that the language of these letters will be re-evaluated upon F. Dionne’s return to the Office.

A. Ionescu questioned whether a check box -type approach could be utilized in examiners' actions to identify which foreign search reports have been taken into account.

C. Evans responded that a draft check box-like PERM is in development wherein specific countries or offices could be identified but is still subject to approval.

5. OTHER BUSINESS

None

6. ITEMS PREVIOUSLY ADDRESSED

None

7. SPECIFIC ENQUIRIES

-- Unity of Invention in the guise of an Objection over Section 84 of the Patent Rules.

– Requirement for Translation.

8. NEXT MEETING

The next meeting is scheduled to take place February 24, 2010 [at 9:30 a.m. in Room D, 24th floor, Place du Portage, Phase I, 50 rue Victoria, Gatineau QC K1A 0C9].

The meeting adjourned at 12:50 pm.

S. M. Tupper