Practice Subsequent to the
***Amazon.com* Decision**

PN2011-04

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To all examiners:

Subsequent to the decision of the Federal Court in *Amazon.com Inc. v. Commissioner of Patents* 2010 FC 1011, the Office has revisited certain practices. The following practice guidelines are in effect immediately and until further notice, in place of any contrary guidance in the MOPOP.

Note that the following guidelines discuss general approaches to examination. The guidance is not limited to determining whether a claim defines an *art*, *process*, *machine*, *manufacture* or *composition of matter* (*i.e.* a "statutory" invention) except where this is explicitly stated.

Practice Guidelines

In examining an application, two things must be identified in the assessment of patentability: 1) what the applicant is claiming as its monopoly, and 2) what the inventors actually invented.

If either the *claimed monopoly* or the *actual invention* is not patentable, the application is defective and is not to be allowed.

<u>The claimed monopoly</u>

The *claimed monopoly* is the subject-matter for which the applicant is seeking protection; that which the applicant has fenced in by the language of their claim (*i.e.* the subject-matter of the claim). In order to be patented, the subject-matter of the claim must be an *art*, *process*, *machine*, *manufacture* or *composition of matter*, must be unambiguously defined, and must be novel, inventive, useful and sufficiently disclosed.

Where any defect in a claim can be identified without going beyond the language of the claim itself, it may be identified without an explicit consideration of the *actual invention*. A claim that fences in only excluded matter (such as a claim to a method of medical treatment, an electronic signal or a computer program), or matter that in its totality is old

or obvious[1], lacks utility or is not fully supported by the description is not patentable. These defects can be identified without needing to analyse the claim to determine the *actual invention*.

Wherever conclusions can be based directly on the language of the claim, this should be done in order to keep examination as streamlined, simple and straightforward as possible.

The actual invention

The term *actual invention* is used to refer to what the application, when read in an informed and purposive manner by the person skilled in the art in light of the relevant common general knowledge, discloses as being the invention covered by a given claim.

The Office takes the position that the *actual invention* is equivalent to the *inventive concept* of a claim, when the *inventive concept* is identified according to the guidance set forth in the appendix to this document.

A claim is not patentable unless its subject-matter relates directly to an *inventive concept* that is statutory (*i.e.* is an *art*, *process*, *machine*, *manufacture* or *composition of matter*), useful, new, unobvious, and fully supported by the description.

Practical considerations respecting the inventive concept

As set out in the Appendix, the *inventive concept* is determined on a claim-by-claim basis by first identifying those elements that are required in order to provide the solution disclosed by the inventors to the problem being confronted. From among these elements, some or all will relate directly to the allegedly inventive advance disclosed by the inventors while other simply provide context for understanding the environment of the invention. The *inventive concept* statement should emphasize the former.

For example, consider an applicant who has invented a new control circuit to produce steadier temperatures in an oven. The *inventive concept* of a claim to an oven including that control circuit would focus on the elements of the circuit rather than mundane elements of the oven. Things like the door to the oven, its heating chamber, and the cooking racks could be explicitly defined in the claim (or not), but merely provide context (in the sense that they are required in order to have an operating oven, but are not part of the advance disclosed by the inventors). The *inventive concept* might be stated as “an oven including a control circuit comprising [the elements

[1] Where it is clear that the subject-matter of a claim is obvious on a consideration of all the defined elements, the same conclusion would in principle be arrived at using the claim’s *inventive concept*. It is not in all circumstances necessary to identify the *inventive concept* of a claim in order to conclude that the claim is defective for obviousness.

of the control circuit]" rather than "an oven comprising a heating chamber, a door, a cooking rack, and a circuit comprising [the elements of the control circuit]", thus keeping the focus on the essence of the invention and promoting an uncluttered analysis.

A. Missing or superfluous elements

Where it appears, upon a fair reading of the description, that an element that ought to form part of the *inventive concept* has not been defined in the claim, the claim may be defective for overbreadth (*i.e.* lack of support) and/or for lack of utility.

Where a claim includes elements superfluous to the solution to a given problem, these may simply be immaterial limitations on the scope of the claim. In many cases, the inclusion of superfluous elements to the claim merely narrows the scope of the *claimed monopoly* without affecting patentability.[2] The mere presence of superfluous limitations is not a defect as such (although the inclusion of such elements could render a claim defective, for example if their presence results in ambiguity).

B. Inventive concept not a solution to a technical problem

Should the elements in the claim only provide a solution to a non-technical problem, neither the *claimed monopoly* nor the claim's *inventive concept* relate to the manual and productive arts. Such a claim is not directed to a statutory *art*, *process*, *machine*, *manufacture* or *composition of matter*. Furthermore, such a claim lacks practical utility.

The term "technical" is here taken to mean "involving or concerned with applied and industrial sciences", and more generally as referring to "technology" in the sense of "the application of scientific knowledge for practical purposes, especially in industry", "machinery and equipment developed from scientific knowledge", and "the branch of knowledge dealing with engineering or applied sciences".

C. Multiple inventive concepts in a single claim

Where a claim includes solutions to more than one problem it includes more than one *inventive concept*. Each set of elements that provides a solution to a problem should be considered independently of the others.

Such a situation might arise where existing inventions have been aggregated together in the claim (*i.e.* such that the resulting claim is not patentable), or where more than one patentable invention has been collocated in a single claim (*i.e.* such that the resulting claim is patentable, but narrower than necessary).

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[2] A superfluous element is, necessarily, not required for the invention to operate in order to produce its useful result, and consequently will not be part of the claim's *inventive concept* [see Appendix].

A claim is not defective for including more than one *inventive concept*, but to be patentable at least one of its *inventive concepts* must relate to subject-matter that would be patentable if claimed on its own.

D. Both statutory and non-statutory inventive concepts in a claim

A claim may include a set of elements that provides a solution to a technical problem and another set of elements that provides a solution to a non-technical problem.

If the elements that provide the solution to the technical problem would be patentable on their own, the claim is not objectionable because of the mere presence of the elements providing the solution to the non-technical problem. These are simply immaterial limitations the applicant has included in their claim.

If, however, the elements providing the solution to the technical problem are not patentable (*e.g.* due to being anticipated or obvious), the claim is not patentable. The *inventive concept* relevant to the elements that provide a solution to a non-technical problem does not relate to a statutory *art*, *process*, *machine*, *manufacture* or *composition of matter*. The claim is not patentable, since neither *inventive concept* would have been patentable if claimed on its own.

The presence of both statutory and non-statutory *inventive concepts* occurs more frequently in certain arts. Computer-related inventions, where conventional hardware has been claimed in terms of a method it has been programmed to perform, typically require careful consideration. A computer does not become patentable simply because it has been programmed to do something new. In order for the program to be part of the same *inventive concept* as the hardware, it must cause the computer to become a new solution to a technical problem.

<u>Examining for statutory subject-matter</u>

In order to qualify as statutory subject-matter under section 2 of the *Patent Act*, a claim must have an *inventive concept* that satisfies the requirement of being an *art*, *process*, *machine*, *manufacture*, and *composition of matter*. An examiner should therefore always attempt to identify elements in a claim that provide a solution to a technical problem, and determine whether the claim is patentable by virtue of those elements.

E. Guidance respecting the five categories of invention

The definitions of *art*, *process*, *machine*, *manufacture*, and *composition of matter* in section 12.02 of the MOPOP may be relied on in this determination. In so doing, however, the definition of *art* in section 12.02.01 must be read omitting the reference to “field of technology” in the first paragraph and bearing in mind the caution expressed at paragraph 53 of the *Amazon.com* decision to the effect that

> *[t]he language in [*Lawson v. Commissioner of Patents *(1970), 62 C.P.R. 101] must not be interpreted to restrict the patentability of practical applications which might, in light of today's technology, consist of a slightly less conventional "change in character" or effect that* (sic.) *through a machine such as a computer*.

This caution is reflected in the guidance in 16.02.01, which notes that the electronic processes within a computer are considered to satisfy the requirement for a physical change if they are relevant to the claim's *inventive concept*. Finally, as regards a *use* claim, the closing paragraph in 12.02.01 should be read replacing the words "contribution to the art" by the words *inventive concept*.

F. Reporting a claim with a non-statutory inventive concept

If an examiner has identified both statutory and non-statutory *inventive concepts* within a claim, the facts of the case will determine whether and to what extent the non-statutory *inventive concept* must be explicitly addressed in a report.

If the subject-matter associated with the statutory *inventive concept* is patentable (*i.e.* is novel, unobvious, useful and properly supported), it may not be necessary to discuss the subject-matter associated with the non-statutory *inventive concept* at all. The mere presence of this latter subject-matter is not a defect as such, although its presence could render the claim defective for other reasons (such as if it introduces ambiguity).

If, on the other hand, the subject-matter associated with the statutory *inventive concept* is not patentable (*e.g.* for anticipation or obviousness), it may be appropriate for the examiner to also discuss the subject-matter associated with the non-statutory *inventive concept*. Where the non-statutory *inventive concept* appears to be central to what the inventors consider to be their invention, explaining that it does not render the claim patentable will usually be appropriate. Note that if the non-statutory *inventive concept* was also the *inventive concept* of another claim in the application, it is unnecessary to do more than to refer to the conclusions provided in the analysis of the other claim.

APPENDIX

Approach for Identifying the Inventive Concept

An invention is a practical solution to a problem, and must be defined in a claim in a form that, when operated, interacts with the physical world to give effect to the solution. The *inventive concept* of a claimed invention refers to those aspects of the solution that define, in practical terms, the new skill or knowledge disclosed by the inventors and which capture the essence of the invention.

The identification of the *inventive concept* is performed by considering the matter of a claim in light of the teachings of the description, as read by the person skilled in the art with the benefit of the relevant common general knowledge. Its identification is thus performed in the same informed and purposive way as the construction of the claim.

In some cases, the *inventive concept* can be defined in terms of some or all of the elements of the claim as construed, while in others it must be defined in different terms. Where, for example, the invention is based on the realisation that combining certain parts provides a new unitary result, the *inventive concept* will reflect all the parts that contribute to the result.[3] In a case where the invention is an improvement to an earlier invention, it may be possible to express the *inventive concept* in terms of, for example, the inclusion in an old device of a specific part that enables the improvement. In other cases, such as a claim to a chemical composition, the *inventive concept* may need to refer to aspects of the invention not defined in the claim at all (such as the pharmaceutical properties of the composition of matter).[4]

In identifying the problem that the inventors set out to address, and the solution proposed through the invention, guidance should be found in the description, in accordance with paragraph 80(1)(*d*) of the *Patent Rules* which provides that the description shall:

> *describe the invention in terms that allow the understanding of the technical problem, even if not expressly stated as such, and its solution*.

Identifying the problem to be solved and its solution can be understood in the context of "achieving the objects of the invention" and "fulfilling the purpose of the invention".

As is clear from the four-step approach to obviousness, the *inventive concept* is identified before the state of the art is considered. The term *inventive concept* therefore

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[3] *Bridgeview Manufacturing Inc. v. 931409 Alberta Ltd.* 2010 FCA 188 at paragraphs 51-52

[4] *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.* 2008 SCC 61 at paragraph 77

refers to what, on a fair and balanced consideration of the application as a whole, appears to be the invention described and covered by the claim under consideration.[5]

It may be practical to determine the *inventive concept* after having first identified those features in the claim that are required in order for the invention to operate so as to provide its useful result. Without limiting the factors that may be considered, the identification of the *inventive concept* will generally include a consideration of:

i) what has been defined in the claim;
ii) what was disclosed by the inventors in their specification and drawings, particularly in respect of the features required for the successful operation of the invention;
iii) what, in light of the disclosure and the common general knowledge, appears to be the advance in the art; and
iv) which features in particular are responsible for the result arising from that advance in the field of the invention.

The solving of a problem must be achieved in practice by some element or combination of elements defined in the claim. Elements are not relevant to the *inventive concept* unless they materially affect the way in which the invention operates so as to provide the solution. Where certain features do not cooperate to produce a unitary result (*e.g.* are not part of a combination; see section 9.04.03 of the MOPOP), they are not part of the same *inventive concept*. The subject-matter of a claim may be defined in such a way as to cover more than one *inventive concept*, and in such cases each *inventive concept* should be considered independently when assessing patentability.

The identification of the *inventive concept* is performed on a claim-by-claim basis, recognising that the specific *inventive concept* of each claim can (and should) be a refinement of the single general *inventive concept* that must link the claims for compliance with section 36 of the *Patent Rules*. The relevant *inventive concept* is that of the claim under examination, and not a generalised *inventive concept* derived from the specification as a whole.

The *inventive concept* of a given claim should reflect the subject-matter of the claim, and should accord to the extent practical with the preamble of the claim. A claim in one category of *invention* (i.e. art, process, machine, manufacture or composition of matter) will generally have a different *inventive concept* than a claim in another category (albeit that they may be closely related). Where an application contains more than one claim in a given category of *invention*, each claim may have a distinct *inventive concept* or

[5] It must be noted that identifying the problem being addressed and its solution is done in the context provided by the description, and not by reference to the closest prior art. This exercise is not to be confused with the "problem and solution" approach to obviousness used by the European Patent Office, which frames the problem in view of the closest prior art.

certain claims (which differ from each other only in non-inventive details) may share a single *inventive concept*. Where a claim covers more than one *inventive concept*, it may be that not all of these *inventive concepts* are in the same category of *invention*. This situation is most likely where a claim defines its subject-matter using features that belong to different categories of *invention* (such as a product defined in terms of the method for using it).

Where the *inventive concept* of a claim is relied upon for conclusions in an examiner's report, the examiner's statement of the *inventive concept* must be made clear to the applicant. An explanation should be provided where appropriate, with a level of detail appropriate to the facts of the case, to support the examiner's statement of the *inventive concept*. Any comments submitted by an applicant in response should be carefully considered, and the *inventive concept* statement adjusted accordingly as warranted. Where an applicant does not explicitly disagree with an *inventive concept* statement in a report, examination will proceed on the presumption that the statement is correct. Where the applicant and the examiner cannot agree on an *inventive concept* statement for a given claim, the examiner may nevertheless proceed with the analysis on the basis of the *inventive concept* statement they consider correct. Debates over the *inventive concept* should not be permitted to derail or inappropriately protract examination.