

Chapter 13

Examination of Applications

- 13.01 Scope of this chapter
- 13.02 Request for examination
- 13.03 Request for advanced examination (special order)
- 13.04 Rule 29 requisitions
- 13.05 Examination
 - 13.05.01 Identifying the invention
 - 13.05.01a Identifying the problem and its solution
 - 13.05.01b Examining the invention as claimed
 - 13.05.02 Form and substance examination
 - 13.05.03 Patentability and contribution
 - 13.05.03a Identifying statutory and non-statutory features
 - 13.05.03b Examination and the contribution analysis
 - 13.05.03c Examples
 - 13.05.04 Search of the prior art
- 13.06 Examiner's report
 - 13.06.01 Withdrawal of an examiner's report
- 13.07 Amendment of the application
- 13.08 Final action
- 13.09 Refusal to grant a patent
- 13.10 Allowance and notice of allowance
- 13.11 Withdrawal from allowance
- 13.12 Grant and issue of a patent

Chapter 13

Examination of Applications

13.01 Scope of this chapter

The present chapter provides an overview of the examination of applications. The chapter discusses examination in terms of both the analysis of applications by a patent examiner and the procedural steps specifically related to examination that may apply to an application.

The chapter does not cover purely operational procedures such as the payment of maintenance fees.

The chapter introduces topics in roughly the order they would usually be encountered in the prosecution of an application, from the step of requesting examination through to completion of prosecution before an examiner.

The purpose of examination is to ensure that the specification, abstract and any drawings of an application comply with the formal and substantive requirements of the *Patent Act* and *Patent Rules*. Many of these requirements are discussed in detail in other chapters of this manual, and the present chapter will focus on certain aspects of examination not covered elsewhere.

13.02 Request for examination

Under the current *Patent Act*, applications are not examined automatically. Rather, Canada operates on a system of deferred examination, wherein an application is only examined upon request.

In accordance with subsection 35(1) of the *Patent Act*, a request for examination may be made by any person, as long as it is in the prescribed manner and accompanied by the necessary fee (set out in item 3 of Schedule II). The Commissioner of Patents may also, under subsection 35(2) of the *Patent Act*, require an applicant to request examination of their application.

If a request for examination is made by a third party, the Office will inform the applicant of this fact.

Section 95 of the *Patent Rules* sets out the information that must be included with a request for examination, this being:

- (a) *the name and address of the person making the request;*
- (b) *if the person making the request is not the applicant, the name of the applicant;*
- (c) *information, such as the application number, sufficient to identify the application.*

Section 96 of the *Patent Rules* establishes that the request for examination must be made before the expiry of the five-year period after the filing date of the application or, in the case of a divisional application, the later of this five-year period and the six-month period after the date on which the divisional application is actually filed.

If a request for examination is not made within the prescribed period or within the time specified in a notice sent under subsection 35(2) of the *Patent Act*, the application will be considered abandoned in accordance with paragraph 73(1)(d) or 73(1)(e) of the *Patent Act*, respectively [see also section 20.02.07 of this manual].

13.03 Request to advance examination (special order)

Applications, including divisional applications, are generally examined sequentially according to the date on which their request for examination was made.¹

Under subsection 28(1) of the *Patent Rules*, the Commissioner of Patents may advance an application for examination out of its routine order on the request of any person who pays the fee set out in item 4 of Schedule II, where the Commissioner determines that failure to advance the application is likely to prejudice that person's rights. Applications that are subject to advanced examination are commonly referred to as "special order" applications.

In accordance with subsection 28(2) of the *Patent Rules*, such a request can be made only if the application in question is open to public inspection under section 10 of the *Patent Act* and a request for examination has been made pursuant to subsection 35(1) of the *Patent Act*.

Although a third party may request that an application be examined, only the applicant may request that their application be laid open before the prescribed time. A third party may, therefore, only request advanced examination on a laid-open application. Where advanced examination is accorded at the request of a third party, the Office will inform the applicant of this by letter.

A request to advance examination will not be considered if the application in respect of which the request was made is incomplete [see Chapter 5 for completion requirements].

Once an application is given special order status, this status will generally apply for the

duration of prosecution. The person who requested special order status can request that advanced examination cease, in which case the application will be examined in its regular order. The fee for requesting advanced examination is not refundable under section 4 of the *Patent Rules*.

13.04 Rule 29 requisitions

Section 29 of the *Patent Rules* provides that where an examiner has reasonable grounds to believe that an application for a patent describing the same invention has been filed, in or for any country, on behalf of the applicant or of any other person claiming under an inventor named in the application being examined, the examiner may requisition from the applicant any of the following information and a copy of any related document:

- (a) an identification of any prior art cited in respect of the applications;
- (b) the application numbers, filing dates and, if granted, the patent numbers;
- (c) particulars of conflict, opposition, re-examination or similar proceedings; and
- (d) translations into English or French of all or part of a relevant document not in one of those languages.

An applicant must respond to such a requisition by providing the information requested or by specifically stating that the information is not available to them, and why this is. This latter statement, required under subsection 29(3) of the *Patent Rules*, must be provided even where the reason certain information is unavailable is that it does not exist. The position of the Office is that a translation is generally available to the applicant if the document to be translated is available to them.

When a request for examination is made, an Office letter is sent to the applicant to confirm the request for examination and to ask the applicant to consider voluntarily submitting the information referred to in section 29 of the *Patent Rules* as it becomes available to them. Voluntary submission of this information reduces the likelihood that an examiner will need to make a formal requisition to obtain it. Applicants should generally not submit information which is readily available to the examiner (see below). The object of the voluntary submission of prior art is to expedite prosecution by bringing the attention of the examiner to documents that might otherwise not be immediately identified at the outset of examination. Where a document is identified to the Office, the applicant should generally not submit a copy of the document unless they have reason to believe that copies of that document will not be readily available to the examiner.

Examiners should not requisition an identification of prior art cited in published search reports to which the examiner has ready access. Such search reports include the International Search Report, and any European Patent Office or United States Patent

and Trademark Office search reports available through the respective web sites of those Offices. Similarly, examiners should not requisition any information that is available to them through the web sites of those Offices, including particulars of examination, opposition, or similar proceedings.

Recognising that translating documents may place a significant financial burden on the applicant, requisitions for translations should be limited to cases where no viable alternative exists.

Where a foreign language document appears relevant to examination, an examiner should attempt to locate a version of that document (or minimally of its abstract) in an Official language with which they can work. In this regard, examiners should make use of reliable online translation engines, such as that provided by the JPO, at least at the early stages of examination.

Where an examiner is working from a machine translation or from a family member of a citable document, this should be clearly stated in the report. An applicant wishing to rebut arguments made on the basis of such a document, however, may be required to provide a translation of the document to support their arguments.

Where a translation is requisitioned, the applicant must provide, in accordance with paragraph 29(1)(d) of the *Patent Rules*, a translation of the document, or a part of the document, into English or French. Where only a part of the document is necessary for examination, an examiner should indicate, wherever possible, in respect of which part or parts of the document the requisition for a translation is being made.

Under Article 42 of the Patent Cooperation Treaty (PCT), no national office having received an international preliminary examination report (IPER) “may require that the applicant furnish copies, or information on the contents, of any papers connected with the examination relating to the same international application in any other elected Office”. The Office considers Article 42 of the PCT to apply in respect of any application that has been the subject of International Preliminary Examination under Chapter II of the PCT.

The Office considers a requisition for the identification of prior art under paragraph 29(1)(a) of the *Patent Rules* or for application numbers, filing dates, and/or patent numbers under paragraph 29(1)(b) of the *Patent Rules* to comply with the requirements of Article 42 of the PCT. The information being requisitioned is connected with the search of the prior art, and is not considered to be a request for copies of papers, or information on the contents of papers, connected with examination. The Office also does not consider that conflict, opposition, re-examination and similar proceedings are “connected with examination” in the sense intended by Article 42 of the PCT, and consequently takes the position that requisitions under section 29 of the *Patent Rules*

are consistent with Article 42 of the PCT.

13.05 Examination

Examiners and applicants interact primarily through written correspondence, which may take the form of voluntary amendments made by the applicant before or during examination, and of any examiners' reports and applicants' responses thereto which may arise in respect of an application.

These reports are, except in the case of a Final Action [see 13.08], issued under authority of subsection 30(2) of the *Patent Rules* which provides that:

Where an examiner [...] has reasonable grounds to believe that an application does not comply with the Act or these Rules, the examiner shall inform the applicant of the application's defects and shall requisition the applicant to amend the application in order to comply or to provide arguments as to why the application does comply...

The content of a report is dealt with in section 13.06, and the remainder of this section addresses the analysis of an application performed by an examiner.

The purpose of examination is, at each stage, to perform a thorough analysis of the application to ensure it complies with the requirements of the *Patent Act* and *Patent Rules*. Particular guidance regarding specific requirements for obtaining a patent are set out in other chapters of this manual.

After having performed this analysis, the examiner must decide whether the application is allowable or a report must be issued. Where a report is to be issued, it should be as comprehensive as possible, to enable the applicant to make informed decisions regarding the continued prosecution of their application and, if possible, to place the application in a condition for allowance [see 13.10].

Note that an application may be examined prior to being laid open to public inspection under section 10 of the *Patent Act*, but the examiner will not approve the application for allowance until it has been laid open.

13.05.01 Identifying the invention

As noted in section 12.01 of this manual, an invention is a solution to a practical problem. In the words of the Supreme Court in *Apotex v. Wellcome*: the granting of patents is "a method by which inventive solutions to practical problems are coaxed into the public domain".²

13.05.01a Identifying the problem and its solution

The Office considers “a solution to a practical problem” to imply “a technological solution to a practical problem” or, equivalently, “a technological solution to a problem in a field of technology”.

As noted in 12.02.01, the Office considers the term “field of technology” to refer to what the Courts have called the “useful arts” and the “manual and productive arts”, but using language more reflective of modern industry. The term “technology” itself means “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”.³

To understand what the inventors view as the problem and its solution, an examiner is guided by the application itself, since the applicant is required to set out in the description the technical field of the invention [paragraph 80(1)(b) of the *Patent Rules*], and the nature of the technical problem being addressed and the solution to that problem [paragraph 80(1)(d) of the *Patent Rules*].⁴ Note that the terms “problem” and “solution” need not appear in the description. An applicant will often describe their invention in terms of its “objects”, i.e. its purpose or goal.

The initial assessment of the problem and its solution is made without comparing the matter of the claim to the prior art. Identifying the solution being proposed by the applicant provides important context for examining the claims. Whether the solution being proposed in the application is patentable depends on it being statutory subject-matter that is novel, unobvious and useful.

A patentable invention may be an alternative solution to a known problem (such as an improvement over, simplification of, or selection from another invention) or a solution to an unresolved problem (which problem could be previously known or newly identified).

It is also possible for an application to disclose solutions to more than one problem. A preferred embodiment of an invention, for example, may solve not only the problem broadly addressed, but simultaneously address a further problem. Where an application discloses and claims more than one solution to a problem, or solutions to different problems, it is necessary to consider the requirements of unity of invention [see chapter 14 of this manual].

13.05.01b Examining the invention as claimed

Examination is guided by the claims, since the exclusive rights conferred by a patent apply only to subject-matter encompassed by the claims as understood by the person skilled in the art. The person skilled in the art will read the specification with “a mind

willing to understand, not a mind desirous of misunderstanding”.⁵ As noted by the Supreme Court, “[a] ‘mind willing to understand’ necessarily pays close attention to the purpose and intent of the author”.⁶

In interpreting the matter of the claims during examination, the purpose for which the invention was invented must be kept in mind. Each claim must define a solution to a practical problem and must be supported by the description. The solution defined in a given claim is that set of elements that are, together, necessary to provide a solution to a problem addressed by the inventors.⁷ These are the “essential elements” of the invention. Identifying which disclosed solution the claim is directed to permits its essential elements to be identified. Since each claim may define a solution to a different problem than that solved by the subject-matter of other claims, each claim may have different essential elements than the other claims.

It is important to remember that the analysis to identify the essential elements is performed in view of the common general knowledge of the person skilled in the art but before the matter of the claim is compared to the teachings of the prior art.

During examination, the nature of the problem addressed and solution to that problem may be discussed in correspondence between the examiner and the applicant. A change in an examiner’s understanding of the problem addressed by the matter of a claim may change their interpretation of which elements in that claim are essential for defining the solution to that problem.

A patentable invention must be a novel, inventive technological solution to a problem in a field of technology, and each claim in an application must be examined to determine whether it defines such subject-matter.

13.05.02 Form and substance examination

During examination, the subject-matter of each claim is considered from the perspective of both form and substance. By “form” is meant what the language of a claim, on its face, appears to be defining as the invention. By “substance” is meant the solution to a particular problem to which, in view of the specification as a whole, the applicant appears to be directing the claim.

Examination, as noted in 13.05.01*b*, is guided by the claims. Under “form and substance” examination, defects arising from either the form or the substance of a claimed invention may be identified in an examiner’s report.

Defects related to the form of a claim are those that may be identified purely from an analysis of the language of the claim itself. Form-based objections can be made, for example, to certain defects arising from a claim’s language, or where a claim is

explicitly directed to non-statutory subject-matter.

Defects related to the substance of a claimed invention are those that may only be identified when the text of the claim is assessed in view of the description and/or the prior art and common general knowledge of the person skilled in the art. Substance-based objections can be made, for example, in respect of issues of proper support (written description or enablement), utility, novelty or obviousness of the claimed matter, or where the invention, in substance, is non-statutory.

Defects related to the form of a claim are identified regardless of the substance of the claim, while defects related to the substance of the invention may be raised, as circumstances dictate, regardless of the form of the claim [see, e.g., 13.05.03b].

Examination of the claims is performed on a claim-by-claim basis, but where a claim includes more than one complete, operable form of the invention each such embodiment must be considered independently. Where even a single embodiment in a claim is objectionable (e.g. for a lack of novelty, obviousness, lack of utility or for being non-statutory) an objection is made to the claim as a whole.

13.05.03 Patentability and contribution

To be patentable, an invention must fall within the definition of “invention” set out in section 2 of the *Patent Act*. That is, an invention must be statutory subject-matter and, further, must “fulfil the statutory requirements of novelty, ingenuity and utility”.⁸ The novelty, ingenuity, and utility of the invention must be common to a single set of elements that are, in combination, statutory subject-matter.

The novelty and ingenuity of an invention arise from a disclosure to the public of something they did not previously have, and which would not have been obvious in view of the information they had as of the claim date. This new and unobvious matter constitutes what the applicant has added to human knowledge, and is referred to as their “contribution”.⁹

In order to determine what has been contributed, the subject-matter of a claim is generally compared to the relevant prior art and common general knowledge. An acknowledgement by the applicant of the state of the prior art, in respect of what is anticipated or obvious, is binding on the applicant.¹⁰ Such statements therefore establish limits on the potential contribution. Similarly, a lack of detail in the description regarding some matter within a claim can be taken as an indication that the applicant considers that matter, or how to arrive at or operate that matter, to be known to the person skilled in the art.¹¹

The utility of an “invention” arises from its being a technological solution to a practical

problem.¹² As noted in 13.05.01*b*, the solution in a given claim is defined by that set of elements that are, together, necessary to provide a solution to a problem addressed by the inventors. These are the “essential elements” of the claimed invention, and it is these elements that must provide novelty and ingenuity to the matter of the claim.

These essential elements, as a set, also must be statutory subject-matter. That is, they must be, when considered in combination, a statutory art, process, machine, manufacture or composition of matter. A set of “essential elements” in a form that can interact with the physical world to provide a technological solution to a practical problem is called a “practical form” (or “practicable form”) of an invention [see section 12.03 of this manual]. A “practical form” will, by necessity, include at least one physical element. An allowable claim must define a contributed, statutory “practical form” of an invention.

Since the patentability of a claim depends on statutory subject-matter having been contributed, it is not necessary during examination to determine whether or not a claimed non-statutory element has been contributed if that element does not form part of a statutory combination [see 13.05.03*a* and 13.05.03*b*]. Whether contributed or not, that element will not of itself lead to a patentable invention.¹³

When determining what within a claim has been contributed (i.e. is novel and unobvious), a set of elements that works together to achieve a specific result should be assessed by considering the set as a whole. This is to ensure that useful combinations are not inappropriately assessed by considering the novelty or ingenuity of their parts in isolation. Where mutually independent results are achieved by the operation of certain elements of a claim, however, the sets of elements responsible for each independent result should be considered separately. This is to avoid aggregations being improperly treated as if they were combinations.

For example, consider a claim to a high-powered car having good road adhesion, where the car is defined as comprising a certain engine and particular tires. The engine is responsible for an independent result (the high power), and should be compared to the prior art as a discrete combination (the engine itself being a set of elements that, together, are necessary to provide a specific result). The tires, being responsible for a different independent result (the road adhesion), should also be considered separately to determine if they are a contribution.

A set of elements is contributed when it is both novel and inventive. The inventive step associated with a novel set of elements can arise either from conceiving of that set of elements as being a solution to a particular problem, or from the activities necessary to reduce the idea of the set of elements to a practical form, or both.¹⁴

Where the invention resides in using something to solve a problem it wasn't known to solve (a new use for the thing), the application of the thing to the new purpose can be a

contribution. Thus, even where a known article is used in new circumstances to achieve an unobvious result, there has been a contribution. The known thing cannot itself be claimed, but the new use can be. For further guidance on “use” claims, see section 12.06.06 of this manual.

13.05.03a Identifying statutory and non-statutory features

A claim will define its subject-matter in terms of one or more features, each of which limits the scope of the claim in some way. In order to determine whether the matter of a claim includes a statutory contribution, and hence a potentially patentable invention, it is necessary to identify which features (or elements; the two terms are interchangeable) within a claim are statutory subject-matter and which are non-statutory subject-matter.

A “non-statutory feature” is one that would be objected to as non-statutory if defined on its own in a claim, while a “statutory feature” (or “statutory element”) means a material object (a machine, manufactured article or composition of matter) or a physical step in an art or process, other than one that is a “non-statutory feature” [see Chapter 12 of this manual for a discussion of statutory and non-statutory subject-matter].

The term “discrete element” is used to describe a feature or set of features whose role in achieving the objects of the invention can be considered independently of other features. Where a claim includes more than one feature, one feature may serve to limit the technological scope of another by further defining the characteristics or properties responsible for the practical utility of the feature being limited. In such cases, it is only the “so-limited feature” that is a discrete element of the claim. “A metal bar comprising a carbon-steel alloy”, for example, is a single discrete element wherein the feature “carbon-steel alloy” limits the technological scope of the feature “metal bar”. An element in a claim is not discrete, for the purposes of the invention defined by that claim, if it provides necessary definition to the technological nature of another element in that claim.

Where one feature does not provide a technological limitation to another, the two features should each be treated as a discrete element of the claim. “A DVD having a piece of music stored thereon”, for example, contains two elements: the DVD, and the piece of music. The music does not limit the technological character of the DVD.

When analysing a claim to determine the nature of the contribution, the analysis is based on a consideration of the discrete elements. The “essential elements” of a practical form of a technological solution are that set of discrete elements that are necessary to define that solution.

Where a feature A limits the nature of a feature B, the resulting discrete element is of the type defined by feature B. Thus, the discrete element “a metal bar comprising a

carbon-steel alloy” is a type of metal bar, not a type of carbon steel.

Where a non-statutory feature provides a technological limitation to a statutory feature, the resultant discrete element is statutory. Through the limitation, the technological properties or characteristics of the statutory element are further defined. Conversely, where a statutory feature provides a limitation to a non-statutory feature, the resultant discrete element is non-statutory.

A common “non-statutory feature” that appears often in claims is a formula or equation. A formula or equation is a “non-statutory feature” given that, in view of subsection 27(8) of the *Patent Act*, it would be non-statutory if claimed on its own [see section 12.05.01 of this manual]. In a claim, a formula may serve to limit the technological properties or characteristics of another feature. For example, in a method for synthesizing a chemical product, the act of adding one reagent could be performed according to an equation that governs how much of that reagent is added as a function of time. Presuming that the addition profile leads to a particular practical result, the step of adding the reagent is given a particular technological character by the equation. In this example, the “equation-limited step” is therefore a discrete, statutory element of the claimed method.

An example of a non-statutory feature limited by a statutory feature is a method of surgery performed using a particular surgical tool. Where the tool modifies the technological character of the surgical step, the discrete element of the claim is a “tool-modified surgical step”, and is non-statutory [see section 12.05.02 of this manual]. This is so regardless of whether a valid claim could be made to the surgical tool itself; in the context of the method, the surgical tool is not a discrete element of the claim but rather is a modifier of a step in the method. The same analysis would apply, for example, to a claim to a mouse modified by a prosthetic. The “prosthetic-modified mouse” is a discrete, non-statutory element. Even where the prosthetic itself could be claimed as an invention, in the claim to the modified mouse it is not a discrete element of the claim, but rather a modifier of the mouse. The “modified mouse” would be rejected as non-statutory [see section 12.05.03 of this manual].

Where a claim includes a formula or equation as one of its features, it will generally be necessary to determine whether or not the formula or equation limits the technological scope of another feature in the claim. In the case of a chemical equation or formula, however, the conclusion is always that the chemical formula limits the characteristics or properties responsible for the utility of the composition of matter. Where a composition of matter defined by an equation or formula is a discrete element of a claim, it is statutory.

Note that, in identifying the statutory and non-statutory features, a discrete element can be defined by more than two features. For example, the “metal bar comprising a

carbon-steel alloy” could be further defined in terms of the carbon-steel alloy having a formula X. The discrete element would then be the “metal bar comprising a carbon-steel alloy having the composition defined by formula X”.

In considering whether one feature in a claim is modifying the technological properties of another, the purpose and nature of the claimed invention provide important context. In a method or process, for example, the essential elements are method steps. In a composition of matter, the essential elements are ingredients of the composition, and in a machine or article of manufacture the essential elements are components or parts.

The examples in of 13.05.03c illustrate the application of the foregoing analysis to specific cases.

13.05.03b Examination and the contribution analysis

In examining a claim, once the discrete elements of the claim have been identified, three cases can be encountered:

- i) the claim includes only statutory discrete elements;
- ii) the claim includes only non-statutory discrete elements or is otherwise excluded by its form; and
- iii) the claim includes both statutory and non-statutory discrete elements.

Case i)

Where a claim includes only statutory discrete elements, the “contribution” analysis is, simply, the traditional analysis for novelty and obviousness [see Chapter 15 of this manual for further information on assessing novelty and obviousness]. It necessarily follows that any contribution that might exist would be statutory. If no contribution exists the claim is objectionable, e.g. under either section 28.2 or 28.3 of the *Patent Act*. If a contribution exists, and the claimed matter is useful, the claim defines a patentable invention.¹⁵

Case ii)

Where a claim includes only non-statutory discrete elements or is otherwise directed to non-statutory subject-matter by its form, the claim is objectionable under section 2 of the *Patent Act* [see Chapter 12 of this manual for a discussion of statutory and non-statutory subject-matter]. It is not necessary for the novelty or obviousness of the claimed matter to be evaluated; regardless of what within such a claim might have been contributed, the claim does not define a statutory “invention”.

Case iii)

Where a claim includes both statutory and non-statutory discrete elements, the contribution analysis is focussed on determining whether or not the claim includes a statutory contribution.

As discussed in 13.05.03, for a claim to include a contribution it must define a novel and unobvious set of elements. For the claim to be patentable, the contributed subject-matter also must be useful and statutory. That is, the contributed element or combination of elements must provide a technological solution to a problem in a field of technology, and not be excluded subject-matter. As stated in 13.05.03, the contribution in a patentable claim must include a statutory “practical form”.

If there is no statutory contribution, there is no statutory “invention” within the meaning of section 2 of the *Patent Act*. Where this is the case, the examiner’s report should include a separate section that sets out the analysis whereby the statutory elements were determined not to be part of the contribution. Since this analysis will consider the novelty and obviousness of any statutory elements in the claim, it should be provided separately from any objection under section 2 of the *Patent Act* that arises from its conclusions, in order to avoid any confusion as to the basis of the objection.

A discrete non-statutory feature cannot itself result in a statutory invention. It is therefore not necessary to assess whether any discrete non-statutory features have actually been contributed. Where a claim includes a discrete non-statutory feature and it is concluded that no statutory contribution exists, the claim is objected to as defining matter that is not a statutory “invention” within the meaning of section 2 of the *Patent Act*. Such an objection is maintained as long as the discrete non-statutory feature remains in the claim, and regardless of whether or not it is actually a contribution.¹⁶

It should be clear from the objection that the defect is not that all the elements defined in the claim are non-statutory, but rather that, having determined that no statutory element is part of the contribution, any possible “invention” in the claim (being that of the non-statutory features) is non-statutory. As noted by the Federal Court of Appeal, the language of a claim is not to effect the “transforming into patentable subject-matter [of] what would, otherwise, be clearly not patentable”.¹⁷

13.05.03c Examples

The following examples apply the guidance set out in 13.05.03a and 13.05.03b to various claims, to illustrate the application of this guidance in specific cases.

Examples:

1. An application discloses compositions for stimulating hair growth. Prior art document D1 discloses certain medicinal compositions and discloses and exemplifies compositions which fall within the scope of claim 1.

Claim:

1. A composition comprising a compound defined by the chemical formula (I) and an acceptable carrier therefor.

Analysis: At the outset, the claim could appear to include three features - the compound, the chemical formula (I) and the carrier. The formula, on its own, would be a non-statutory feature and it is therefore necessary to understand its effect in the claim. The chemical formula (I) serves to define the technological nature of the composition of matter it modifies, and the compound defined in terms of chemical formula (I) is a statutory element of the claim. It is worth noting that this is always the appropriate conclusion when a chemical formula is used to limit a composition of matter to yield a discrete element of a claim. The claim also includes a second statutory element, this being the carrier. The claim therefore includes two discrete statutory elements and, for the purposes of examination, falls into case i). In view of D1, the claim does not make any contribution. It teaches only an old solution - the known composition. The claim is objectionable under section 28.2 of the *Patent Act*.

Summary: Case i); the claim includes two discrete statutory elements. No contribution in view of the prior art. The claim is objected to for lack of novelty.

2. An application discloses a method for manufacturing tires, and discloses an equation to calculate how much vulcanizing agent should be added as a function of time in order to improve the cure of the rubber. The prior art does not disclose or make obvious to vulcanize tires in the manner proposed, and the description supports the promised advantages of the modified process.

Claim:

1. In a process for vulcanizing tires, the improvement wherein the addition of a sulfur-based vulcanizing agent is made according to equation (1).

Analysis: Equation (1) could not be claimed on its own, and is therefore a non-statutory feature. In the claim, however, it serves to limit the nature of a physical step in the process (the step of adding vulcanizing agent), such that the step is made suitable for solving the practical problem set out in the application (i.e. the technological character of the step is modified by the equation). The physical step of addition practised according to the limits established by equation (1) is a single discrete element of the claim. The claim therefore includes only a single discrete, statutory element and, for

the purposes of examination, falls into case i). The claim contributes a statutory element, and the modified process is a practical form - it can be used to achieve the promised utility. The claim therefore defines a patentable invention.

Summary: Case i); the claim includes a single discrete statutory element (a modified statutory method step). The claim is allowable.

3. An application discloses that a particular woodworking tool makes it easy to inscribe complicated patterns on work pieces. The tool combines features previously known in two separate woodworking tools disclosed in documents D1 and D2. It provides only the aggregate advantage of the two known tools.

Claims:

1. A woodworking tool comprising a hooked blade having an offset point, said blade being attached via a locking ball joint to an ergonomic handle.
2. A dining table inscribed with a pattern produced by scribing using the woodworking tool of claim 1.

Analysis: Claim 1 defines a woodworking tool having three discrete statutory elements - the blade, the locking ball joint, and the handle. These operate together as a set to provide the promised utility of the invention. The claim includes only statutory elements and, for the purposes of examination, falls into case i). In view of D1 and D2, the examiner concludes that there is no ingenuity in the tool, and the claim is objected to under section 28.3 of the *Patent Act*.

Claim 2 contains two features, these being the table and the pattern inscribed by the tool. The table is a statutory element, and the pattern is a non-statutory feature having a purely aesthetic significance. The pattern does not change the practical utility of the table, i.e. its technological character. Note that the woodworking tool is not an actual feature of the claim, since it does not limit the nature of the inscribed pattern. In the present case, the feature "a pattern" has the same scope as "a pattern produced by scribing using the woodworking tool of claim 1". The claim therefore includes both a statutory (the table) and a non-statutory (the pattern) discrete element and, for the purposes of examination, falls into case iii). Tables unquestionably forming part of the common general knowledge, the table itself has not been contributed. The claim consequently does not include a statutory contribution, but does include a discrete non-statutory feature - the pattern. The examiner sets out this analysis in their report. An objection is made to the claim under section 2 of the *Patent Act* for not defining a statutory "invention".

Summary: Claim 1 belongs to case i); it contains three discrete statutory elements. There is no contribution in view of the prior art. The claim is objected to for obviousness. Claim 2 belongs to case iii); it contains a discrete statutory element (the

table) and a discrete non-statutory element (the pattern). The table is not a contribution, therefore the claim is objected to, in view of the pattern, for not defining a statutory "invention".

4. An application discloses a genetically-modified mouse that is predisposed to certain cancers of the liver. The mouse is modified by the introduction of recombinant DNA into its genome, thereby causing the predisposition to cancer. The application also teaches how the mouse can be used to screen for drug candidates to treat those cancers, using a known screening technique disclosed in several documents.

Claims:

1. A recombinant vector comprising a DNA molecule defined by SEQ ID NO: 1.
2. A transgenic mouse having a genome comprising the recombinant vector of claim 1.
3. A method for screening drug candidates for anticancer activity in the liver, said method comprising the steps of: (a) providing a mouse according to claim 2 that exhibits liver tumours; (b) injecting said mouse with a dose of a drug candidate; (c) monitoring the size of liver tumours over the course of 1 week; (d) identifying drug candidates that reduce the size of said liver tumours by at least 5% by volume.

Analysis: Claim 1 defines a composition of matter (the vector) defined in terms of DNA that is itself defined in terms of the sequence provided by SEQ ID NO: 1. As noted in 13.05.03a, a composition of matter limited by a chemical equation or formula is a statutory element. The DNA is therefore limited in a technological manner by the limitation on its sequence listing, and the recombinant vector as a composition of matter is limited in a technological way by inclusion therein of the DNA. The claim includes a single discrete, statutory element (the vector modified by the DNA defined by the sequence) and, for the purposes of examination, falls into case i). Presuming the promised utility has been established, the patentability of the vector depends on it being a contribution (i.e. that the vector is novel and unobvious).

Claim 2 on its face is directed to a mouse. The claim therefore belongs to case ii), since the claim, by its form, is directed to a higher life form. The claim will consequently be objected to under section 2 of the *Patent Act*. Although it is not necessary to perform a more complete analysis of the claim, such an analysis would arrive at the same conclusion. The claim could initially be interpreted as defining three features - a mouse, a genome and the vector of claim 1. The vector provides a technological limitation to the genome, and these two features can initially be considered to together form a single element - the modified genome. The modified genome, in turn, provides a technological limitation to the mouse, and the claim therefore defines only a single discrete feature, being the "genome-modified mouse". As noted at the outset, mouse

is, by its form, non-statutory, and the claim consequently falls into case ii) and is objected to under section 2 of the *Patent Act*. Whether or not the mouse is a contribution (i.e. is novel and unobvious) is not material to the examination of claim 2.

Claim 3 defines a method that requires several steps that together provide a technological solution. The method is best considered not as a series of individual steps, but as a combination. Ignoring the mouse for the moment, the method itself involves physical manipulations that satisfy the basic requirement set out in section 12.02.01 of this manual. That is, it is a method that includes “an act or series of acts performed by a physical agent on a physical object and producing in that object some change of either character or condition”. The method, considered as a series of generic steps unmodified by the mouse, is a statutory set of elements. The claim also includes a non-statutory feature, since it depends on the presence of the mouse of claim 2. The mouse has the effect of changing the technological character of the method, since it causes the method to screen specifically for drug candidates for treating cancers of the liver. The mouse, therefore, is not a discrete element of the method claim, but rather modifies the statutory method to give it a distinct technological character. A statutory method step modified in a technological manner by a non-statutory feature remains a statutory method step [see 13.05.03a]. The statutory nature of the method as a whole therefore remains unchanged, and the claim, for the purposes of examination, falls into case i). Note that the proper conclusion is reached by bearing in mind that the claimed invention is a method with a specific purpose. The elements necessary for the method to provide its promised utility are its steps. The mouse, as a feature of the claim, serves to limit the technological scope of certain essential method steps such that a specific practical result can be achieved. It is the “mouse-modified steps”, and not the mouse itself, that are the discrete elements of claim 3. If the purpose of the method is ignored, the conclusion reached could be that the mouse is a discrete element of the claim, and that only the mouse, rather than the method as a whole, is the contribution. This could lead to the incorrect conclusion that the claimed invention is non-statutory.

Summary: Claim 1 belongs to case i); it defines a single discrete statutory element. The claim would be examined for novelty and obviousness (i.e. for a contribution) and for utility. Claim 2 belongs to case ii); it defines a single discrete non-statutory element. The claim is objected to under section 2 of the *Patent Act*. Claim 3 belongs to case i); it defines a single statutory set of elements (the method). The claim would be examined for novelty and obviousness, and for utility.

5. An application discloses a set of match-making criteria to be used in matching members of a dating service. The computer is a general purpose machine, and the technological approach to querying storage locations, transferring data, and performing logic functions are known. The algorithm used in match-making is the result of extensive empirical studies of interpersonal behaviour and is asserted as leading to matches with greater compatibility.

Claim:

1. A computer adapted to identify interpersonal compatibility by comparing variables associated with a first party and variables associated with an nth party according to the weighting scale defined by the following criteria [X, Y, Z] and to display the n best matches, wherein the computer obtains a variable (1a) regarding the first party from a first storage location, and variable (na) regarding the nth party from an nth storage location, ...

Analysis: Claim 1 includes two features, these being the computer and the algorithm that has adapted it to implement the match-making. The algorithm itself is a non-statutory feature. The algorithm (implemented as software) for identifying interpersonal compatibility does not modify or limit the computer in a way that provides a technological solution to a practical problem. It is therefore concluded that the two features of the claim are discrete. The computer itself is a statutory discrete element, and the algorithm is a non-statutory discrete element. The claim belongs to case iii). The computer itself is a known general purpose machine, and does not form part of the contribution. The claim therefore does not include a statutory contribution, but does include a discrete non-statutory feature - the algorithm. It is not necessary for the examiner to determine whether the non-statutory feature is novel or inventive. In objecting to the claim, the examiner would provide their contribution analysis, setting out how they determined that the computer is not part of the contribution (i.e. is not novel and inventive). An objection to the claim would be made, setting forth that, in view of the contribution analysis, it does not define a statutory "invention" within the meaning of section 2 of the *Patent Act*.

Summary: Case iii); the claim includes a discrete statutory element (the computer) and a discrete non-statutory element (the algorithm). The computer not being a contribution, the claim is objected to in view of the algorithm for not defining a statutory "invention".

6. An application discloses a particular coating for seeds, that prevents early germination and frost damage. The application is sufficient to support the utility of the coating and the coated seeds. The coated seeds are novel and not obvious in view of the prior art.

Claims:

1. A coating composition for coating seeds, comprising [several components].
2. A seed coated with a coating as defined in claim 1.
3. An agricultural product comprising a seed coated with a coating composition as defined in claim 1.
4. A process for producing a coated seed, comprising the steps of: i) providing a supply of seeds; ii) providing a supply of a coating material as defined in claim 1; iii) coating the seeds with the coating material.

Analysis: Claim 1, presuming the components to be chemical products, includes only a set of discrete statutory elements. The claim falls in case i). Since the utility of the seeds is supported by the application, the utility of the composition is a given. The patentability of the composition consequently depends only on its novelty and ingenuity.

Claim 2 is directed to a higher life form (a seed) and is excluded by its form. The claim therefore belongs to case ii), and is objected to as such. Although unnecessary to do so, this conclusion can be confirmed by initially considering the claim to include a non-statutory feature (the seed) and a statutory element (the coating composition). Recognising that the coating modifies the technological properties of the seed, it is correctly concluded that the claim includes a single non-statutory discrete element - the coated seed.

In the case of claim 3, merely calling the seed an “agricultural product” does not alter that the claim is directed to a coated seed *per se*. The same analysis as provided for claim 2 applies to claim 3.

Claim 4 can be analysed in a manner similar to the method of example 4. The steps of the method (providing a substrate, providing a coating material, coating the substrate with the material) are best considered not as a series of individual steps, but as a combination. Ignoring the seed for the moment, the method itself involves physical manipulations that satisfy the basic requirement set out in section 12.02.01 of this manual. That is, it is a method that includes “an act or series of acts performed by a physical agent on a physical object and producing in that object some change of either character or condition”. The method, considered as a series of generic steps unmodified by the seed, is a statutory set of elements. The claim also includes the seed, which is itself a non-statutory feature. In the claim, however, it serves to limit the technological scope of the method, such that the nature of the product being manufactured is controlled. A statutory method whose technological scope is modified by a non-statutory feature remains a statutory method [see 13.05.03a]. The claim, for the purposes of examination, falls into case i). Given that the coated seeds are novel and unobvious, it follows that the process to produce the seeds has been contributed and that this claim includes a patentable invention. Note that absent claim 4, it would not be necessary to assess the novelty or obviousness of the seeds. In assessing whether the method has been contributed, however, the search would uncover whether the coated seeds are known or obvious. Note also that the fact that the process produces a non-statutory product does not cause the process itself to be non-statutory [see section 12.02.02 of this manual].

Summary: Claim 1 belongs to case i); it includes only statutory discrete elements. Patentability depends on novelty and ingenuity (utility having been established in the present example). Claims 2 and 3 belong to case ii); they include only a non-statutory discrete element, and are objected to for under section 2 of the *Patent Act*. Claim 4

belongs to case i); it includes only statutory discrete elements, since the non-statutory feature is merely a limit on the technological scope of the statutory method. The method is found to be patentable.

7. An application discloses a method for diagnosing disease X in a human, wherein the method involves screening blood or liver tissue for a particular antibody Z whose presence indicates that the patient has disease X. The correlation between antibody Z and the disease was not previously known, and nothing in the prior art suggests that it had ever been screened for before.

Claims:

1. A method of diagnosing a patient for disease X, comprising the steps of:
 - (a) removing a sample of blood from the patient;
 - (b) screening the sample for the presence of antibody Z;
 - (c) determining whether the patient has disease X on the basis of the presence or not of antibody Z.
2. A method of diagnosing a patient for disease X, comprising the steps of:
 - (a) removing a sample of liver tissue from the patient;
 - (b) screening the sample for the presence of antibody Z;
 - (c) determining whether the patient has disease X on the basis of the presence or not of antibody Z.

Analysis: Claim 1 includes steps (a) and (b) that are physical steps, and step (c) that is a mental step of data analysis. Each step of the method is a discrete element, and the set of elements as a whole does not treat a medical condition. The claim is not, on its face, directed to a method of medical treatment, and is not excluded by its form. Steps (a) and (b) are statutory steps [drawing blood is not considered a surgical intervention; see section 17.02.03 of this manual], whereas step (c) is a mental process (drawing a conclusion by analysing data) and is itself non-statutory. The claim therefore belongs to case iii). Patentability of this claim therefore depends on whether or not it includes a statutory contribution. The technological scope of step (b) is modified by antibody Z. Given that this species had never been screened for before, step (b) has been contributed and provides a technological solution to the practical problem of identifying the presence of the antibody in the blood. The claim, presuming utility, is therefore allowable.

Claim 2 also includes three steps, but in its case step (a) is an excluded surgical manipulation (excising tissue from a patient's liver). The set of elements as a whole is therefore an excluded method of surgery, and belongs to case ii) [see section 17.02.03 of this manual].

Summary: Claim 1 includes both statutory discrete elements and non-statutory discrete elements, and belongs to case iii). Since one of the statutory discrete elements is

contributed, the claim (presuming utility) is allowable. Claim 2 also includes both statutory and non-statutory discrete elements. Its discrete elements, as a set, define an excluded method of surgery, and the claim therefore belongs to case ii) and is objected to for being directed to non-statutory subject-matter.

8. In *Schlumberger Canada Ltd. v. Commissioner of Patents*¹⁸ the Federal Court of Appeal was asked to pronounce on the patentability of a process in which calculations were made, by way of a computer, according to certain new formulae. The Patent Appeal Board considered a set of claims with two independent claims, and the Commissioner of Patents accepted the recommendation that these claims be refused. The application taught that the calculations performed (the “machine combining” of data) are best carried out on a programmed general purpose computer. In upholding the Commissioner’s decision, the Federal Court of Appeal commented that “it is obvious, I think, that there is nothing new in using computers to make calculations of the kind that are prescribed by the specifications. It is precisely in order to make that kind of calculation that computers were invented. What is new here is the discovery of the various calculations to be made and of the mathematical formulae to be used in making those calculations. This is not, in my view, an invention within the meaning of s. 2.”

Claims:

1. A machine operated method of processing well logging data, comprising:
 - (a) deriving a plurality of measurements [...];
 - (b) machine combining at least some of said derived measurements [...] to compute at least one input parameter [...];[steps (c) and (d) are equivalent to step (b), but calculate different quantities.]
46. Apparatus for processing well logging data [...] comprising:
 - (a) means for deriving a plurality of measurements [...]
 - (b) a data processing unit; and
 - (c) means adapted to control said data processing unit [according to the method of claim 1].

Analysis: The following analysis sets out how the above claims could be approached using the guidance set out in this chapter, and is provided to highlight the similarity of this approach to the analysis performed by the Court.

Claim 1 defines a method for obtaining and machine processing data. Step (a) of the claim appears to be statutory (the acts of obtaining data are presumed to be physical). The “machine combining data” steps involve, when understood in view of the description, a general purpose computer performing calculations. The data being combined does not limit the technological properties of the computer as it performs the

acts of “machine combining”, and steps (b) through (d) therefore include both statutory features (the technological act of machine combining) and non-statutory features (the acts of combining data to calculate parameters). The claim therefore falls into case iii). In view of the state of the art, it was concluded that neither the collecting of data [i.e. the acts of step (a)] nor the manner by which the computer performed the “machine combining” were new. Consequently, the claim was found not to include a statutory contribution. The calculations to be performed, of themselves, are non-statutory; they are not a patentable invention. The claim would be objected to for not defining a statutory “invention” within the meaning of section 2 of the *Patent Act*.

Claim 46 defines an apparatus, and appears to have been construed during its actual prosecution as defining a programmed general purpose computer. Feature (a), and its relationship to the claimed apparatus, was not directly discussed when considering the claimed apparatus in the actual prosecution, and for consistency it will not be considered in this analysis. As a starting point, the claim is therefore taken to define a computer programmed to perform certain calculations. Feature (b) (the data processing unit) is a statutory element. Feature (c) is understood in the present context to be a computer program that will cause the computer to carry out the calculations (the “machine combining”) set out by the method of claim 1. The calculations manipulate data to extract more meaningful information from the data. Neither the calculations nor the formulae embodying them are, of themselves, statutory. They do not control the computer so as to provide a technological solution to a practical problem. Since, in the present case, feature (c) does not limit the technological properties of the data processing unit (b), features (b) and (c) are both discrete. The claim falls into case iii). It is admitted in the application’s description that the data processing unit (b) is a known device (a general purpose computer), and therefore it does not form part of the contribution. As noted above, the act of combining data according to an algorithm or equation is not of itself statutory. The claim consequently does not include a statutory contribution, and is objected to for not defining a statutory “invention” within the meaning of section 2 of the *Patent Act*.

Summary: Claims 1 and 46 both include both statutory and non-statutory discrete features and belong to case iii). Upon analysis, the statutory features are determined not to be contributed, and the claims, in view of the discrete algorithm feature, are consequently objected to for not defining a statutory “invention”.

9. In *Lawson v. Commissioner of Patents*¹⁹ the court considered a claim to parcels of land subdivided according to a particular plan. The inventor proposed to subdivide land such that the individual parcels of land had legal boundaries defined by the shape of a champagne glass. During the case, all parties agreed that a claim to the land *per se* was untenable. The court consequently proceeded “[o]n the assumption that what is being applied for is a patent for a method”. The court, therefore, determined to consider the substance of the

invention rather than the language of the claim. In assessing whether or not there was a patentable method, the court noted that the subdivided land itself was unchanged in its character (i.e. not “new”). This led to the conclusion that any novelty was resident in the plan for subdividing, which plan is not of itself statutory matter.

Claim:

1. In the art of municipal development the improvement which consists in a subdivided parcel of building land [...] (the claim then defining the shape of the legal boundary)

5. A subdivided parcel of building land as defined in claim 1 [...]

Analysis: This case is an example of the Courts rendering judgement on the substance of the alleged invention rather than on the basis of the form of the claims under consideration.

Claims 1 and 5 both define a parcel of building land defined in terms of its legal boundaries. The claims could be considered to include two features - land, which for the present analysis is presumed to be statutory as either a composition of matter or a manufacture, and the legal boundary, which is a feature having solely intellectual significance and is of itself non-statutory [see section 12.06.01 of this manual]. The legal boundary does not provide any technological limitation to the land itself, and the claims consequently include both statutory and non-statutory discrete elements and fall into case iii). Since a parcel of land is clearly not a contribution (this could be argued to be common general knowledge and would not require any prior art to be cited to support the point), the claims would be objected to for not defining a statutory “invention” within the meaning of section 2 of the *Patent Act*.

If a claim had been drafted as a claim to a method for subdividing land, this method would be non-statutory on its face, regardless of whether or not it would make use of any patentable technology. Following 12.04.02, the method would have significance only in respect of human law, and would not be a method in a field of technology. Such a claim would belong to case ii).

Summary: Claims 1 and 5 both include statutory discrete element (the parcel of land) and a non-statutory discrete element (the legal boundary), and fall into case iii). The land itself not forming part of the contribution, the claims are objected to in view of the legal boundary feature, on the grounds that they do not define a statutory “invention”.

13.05.04 Search of the prior art

Patentability must be assessed in view of the prior art, and it is therefore necessary for

the relevant prior art to be identified. The prior art, broadly speaking, includes everything known, in Canada or elsewhere, at the claim date.²⁰ In practice, however, the prior art relied on generally comprises only published patent documents, journal articles, textbooks, manuals and the like.

An application for patent in Canada may result from a national filing or from entry into the national phase of an international application filed in Canada or elsewhere under the Patent Cooperation Treaty (PCT).

The scope of the search of the prior art performed by a Canadian examiner at the national phase is determined in part by the extent to which relevant prior art has been identified in any earlier searches.²¹ Further, examiners are not required to search claimed matter that is determined to be non-statutory, to lack practical utility or that is not supported by the application as filed (e.g. where new matter has been introduced contrary to subsection 38.2(2) of the *Patent Act*).

Where claimed matter is not required to be searched for any of the foregoing reasons, but it is evident from the specification as a whole that a claim to related subject-matter requiring a search could be made, a search should generally be performed on this related matter. By way of example, a claim to a method of medical treatment need not be searched, but if it is clear that a “use” claim could be made on related matter, the “use” should be searched.

Where the claimed subject-matter has been the subject of a comprehensive international search by an International Searching Authority, as regards that subject-matter a Canadian examiner will nevertheless perform at least a search of Canadian patent documents covering the five-year period prior to the application’s filing date. The principal purpose of such a search is to identify Canadian patent documents relevant to double-patenting or, by virtue of their claim date, to anticipation under the first-to-file system (that is, under paragraphs 28.2(1)(c) and 28.2(1)(d) of the *Patent Act*).

It is usual for a Canadian examiner to consider all available foreign search results to avoid unnecessary replication of work. Where the results of a foreign search are relied on in a report, the report should indicate which documents were identified in a foreign search.

Where, for whatever reason, the examiner deems a further search would be appropriate, a comprehensive search is undertaken. This search need not be restricted to Canadian patent documents, but can be performed on any database to which the examiner has access. Of principal relevance are the databases of the EPO, USPTO and the Japanese and Korean patent offices. Examiners also have access to certain commercial databases.

Searches are generally limited by some combination of dates, keywords, and International Patent Classification (IPC) codes of relevance to the claimed matter. Examiners are not, as a general rule, required to indicate any details of their search strategy in their reports.

In keeping with the purpose of an examiner's report, it is desirable for all relevant prior art to be identified at the time of the first report. Nevertheless, particularly given the sheer quantity of prior art now available and practical limitations on the time an examiner can spend on an application, it must be acknowledged that in practice documents may be missed, or that at the early stages of examination the relevance of some documents may not be fully appreciated. It is also possible that, in view of amendments to the claims or arguments presented by the applicant, it becomes necessary to rely on additional prior art.

Where, for any reason, relevant prior art is identified during the course of prosecution, it is incumbent on the examiner to cite this prior art against the claimed invention.

13.06 Examiner's reports

An examiner's report is the official means of communication between an examiner and an applicant. It may contain one or more requisitions as well as information provided to clarify the scope or content of the requisition(s). The report will begin with a conspicuous (usually entirely in majuscule letters) opening paragraph informing the applicant of how many requisitions it contains (identified by bullets) and under which authority each requisition is made. It will also indicate the time limit to respond [see Chapter 20 of this manual for a complete discussion on time limits].

Each requisition made in a report must be responded to within the time period indicated in the report or the application will be abandoned in accordance with paragraph 73(1)(a) of the *Patent Act*. For each requisition on the basis of which the application was deemed to be abandoned, a specific request for reinstatement must be made, a separate reinstatement fee must be paid, and the necessary action taken to comply with the original requisition.

Under subsection 30(2) of the *Patent Rules*, where an examiner has reasonable grounds to believe that an application does not comply with the *Patent Act* and *Patent Rules*, the applicant must be informed of the application's defects and must be requisitioned to amend their application to comply or to provide arguments as to why the application does comply. The identification of all the defects the examiner was able to identify forms, for the purposes of paragraph 73(1)(a) of the *Patent Act*, a single requisition.

The beginning of this requisition can generally be identified in a report by text such as

“the examiner has identified the following defects in the application:”. The requisition ends with a paragraph such as “in view of the foregoing defects, the applicant is requisitioned, under subsection 30(2) of the *Patent Rules*, to amend the application in order to comply with the *Patent Act* and the *Patent Rules* or to provide arguments as to why the application does comply”.

If the report includes additional requisitions, these will usually come after the 30(2) requisition. Other requisitions that may be present in an examiner’s report are requisitions under section 29 of the *Patent Rules* (pertaining to the identification of prior art), requisitions under section 89 of the *Patent Rules* (pertaining to the provision of certified copies of priority documents), and requisitions under section 104.1 of the *Patent Rules* (pertaining to inclusion in the description of the date of deposit of biological material).

An examiner’s report will usually include additional content that does not form part of a requisition, but which provides useful information regarding the report. This content, which may be called the preamble, will occur after the opening paragraph of the report and before the first requisition. Typically, the preamble of the report will indicate the date of the most recent amendments and, in the case of a first report, their origin (international stage or national stage), an indication of the number of claims on file, a statement regarding the search performed, and an identification of documents discovered and a discussion of their contents (if any).

Particularly where there is a question regarding unity of invention, the preamble will indicate to what extent the application has been searched and examined. If, in response to a unity of invention objection, an applicant appears to have limited the claims to one invention only (e.g. by selecting one of the identified groups, or by amending the claims in such a way that only a single invention is defined), this will be indicated in a subsequent report (if any).

The preamble may also include general comments on the prosecution and discussions relating to points raised by the applicant in their correspondence.

13.06.01 Withdrawal of an examiner’s report

An examiner’s report may be withdrawn where it is determined that the content of the requisition is inapplicable or unnecessary.

Such may be the case, for example, where an examiner’s report and an applicant’s amendment cross in the mail, and the report is by consequence no longer accurate.

Where an examiner’s report is to be withdrawn, the examiner will inform Examination Support, who will cancel the report, remove the due date and inform the applicant in

writing that the report is withdrawn. The examiner may also inform the applicant by telephone, as a courtesy and to prevent confusion and unnecessary work.

13.07 Amendment of the application

Section 38.2 of the *Patent Act* provides that the specification and drawings of an application may be amended before a patent is issued.

Any such amendment may not introduce any matter not reasonably to be inferred from the specification or drawings as originally filed (“new matter”), except in so far as it is admitted in the specification that the matter is prior art with respect to the application.

Amendments made subsequent to the sending of a notice of allowance and especially subsequent to the payment of a final fee are subject to certain limitations as discussed in 13.10 and 13.11.

Amendments must be submitted in the form of replacement pages, as the Patent Office will not amend the content of individual pages.

In accordance with section 34 of the *Patent Rules*, any amendment must be accompanied by a statement explaining the nature and purpose of the amendment.

An amended application is subject to further examination.

Amendments to an application are discussed fully in chapter 19 of this manual.

13.08 Final Action

In the course of examination, it will sometimes be that an impasse occurs between an applicant and an examiner as regards certain perceived defects of the application.

Where this is the case, the examiner may, in accordance with subsection 30(4) of the *Patent Rules*, write a “Final Action” on the application in which they set out all the outstanding defects and in which they reject the application under subsection 30(3) of the *Patent Rules*.

Final action practice is covered in chapter 21 of this manual.

13.09 Refusal to grant a patent

Section 40 of the *Patent Act* stipulates that whenever the Commissioner is satisfied that an applicant is not by law entitled to be granted a patent, the application shall be refused.

A registered letter addressed to the applicant or to the agent of record is sent, notifying the recipient of the refusal and of the reason therefor.

Typically, refusal of an application occurs subsequent to the sending of a final action and on the recommendation of the Patent Appeal Board. The refusal will usually include the heading “Decision of the Commissioner of Patents” and will include a complete explanation of the grounds for refusal.

Commissioner’s Decisions, whatever the decision (full or partial refusal of the application or overturning of the examiner), are numbered sequentially and, except in the case of a decision to refuse an application filed prior to October 1, 1989 where the applicant did not give permission for the Office to publish the decision, are publicly available via the Office’s web site at <http://patents.ic.gc.ca/cipo/comdec/en/search.html>.

In accordance with section 41 of the *Patent Act*, a refusal of the Commissioner may be appealed to the Federal Court within six months after the date of mailing of the decision.

13.10 Allowance and notice of allowance

Subsections 30(1) and 30(5) of the *Patent Rules* provide that where an examiner has reasonable grounds to believe that an application complies with the *Patent Act* and *Patent Rules*, the Commissioner shall notify the applicant that the application has been found allowable.²²

The process within the Office is that an examiner approves an application for allowance. Patent Operations then checks the application to ensure certain formal requirements are met, and subsequently issues a notice of allowance requisitioning payment of the applicable final fee set out in item 6 of Schedule II within six months.

The application is “allowed” on the date at which the notice of allowance is sent.

Once an application is allowed, prosecution before the examiner has technically ceased. Amendments after allowance are, in accordance with subsection 32(2) of the *Patent Rules*, not permitted if they would require a further search by the examiner or if they would make the application not comply with the *Patent Act* and *Patent Rules*. Further, in accordance with subsection 32(1) of the *Patent Rules* an amendment after allowance may only be made upon payment of the fee set out in item 5 of Schedule II unless the amendment is to correct a clerical error that is obvious on the face of the application.

Failure to pay the final fee will result in abandonment in accordance with paragraph 73(1)(f) of the *Patent Act*. An application that has been reinstated after being

abandoned for failure to pay the final fee may be amended, and is subject to further searching and examination before a new notice of allowance is sent.

Note that where an application is abandoned for failure to pay the final fee, paragraph 30(10)(a) of the *Patent Rules* provides that upon reinstatement the previous notice of allowance is deemed never to have been sent. In accordance with paragraph 30(10)(b) of the *Patent Rules*, a further notice of allowance will not require payment of the final fee unless the final fee submitted to effect reinstatement has been refunded or was not, in view of amendments changing the number of pages in the allowed application, sufficient.

13.11 Withdrawal from allowance

Subsection 30(7) of the *Patent Rules* provides that if, after a notice of allowance is sent but before a patent is issued, the Commissioner has reasonable grounds to believe that the application does not comply with the *Patent Act* or *Patent Rules*, the Commissioner shall notify the applicant of that fact, withdraw the notice of allowance, refund the final fee (if it has been paid), and return the application to the examiner for further examination.

The notice of allowance is deemed never to have been sent, nor (if applicable) the final fee to have been paid, and the provisions of sections 32 and 33 of the *Patent Rules* do not apply.

An application may be withdrawn from allowance, for example, in view of applicable prior art identified in a protest or in a filing of prior art under section 34.1 of the *Patent Act*.

13.12 Issuance of a patent

Upon payment of the final fee referred to in 13.10, the Office will process the application to grant, and will generally issue the patent on a Tuesday approximately nine weeks after payment of the final fee. The patent will issue in the name(s) of the inventor(s), or to the legal representative(s) on the basis of appropriate documentation such as assignments received no later than the day on which the final fee is paid.

In accordance with subsection 33(1) of the *Patent Rules*, where the final fee has been paid on an allowed application and has not been refunded, no amendment may be made to the application except where the final fee was paid to reinstate an application previously abandoned in accordance with paragraph 73(1)(f) of the *Patent Act* for failure to pay that final fee, and prior to a new notice of allowance being sent.

Under paragraph 4(10)(b) of the *Patent Rules*, a final fee may be refunded if the

request for refund is received before the technical preparations for issue are begun.²³

Where a patent issues from an application filed prior to October 1, 1989, it will receive a patent number in the 1,000,000 series. For applications having an application number in the 2,000,000 series, the issued patent will bear the same number as the application.

Endnotes for chapter 13

1. Applications are assigned to an examiner working in the field to which the claimed invention belongs, and are examined sequentially, within the applications assigned to a given examiner, according to the request for examination date.
2. *Apotex Inc. v. Wellcome Foundation Ltd.* [2002] SCC 77 [(2002), 21 C.P.R. (4th), 499 (S.C.C.)] at paragraph 37.
3. “Technology noun”, *The Oxford Dictionary of English (revised edition)*, Oxford University Press 2005.
4. This guidance is only required of applications filed on or after October 1, 1996.
5. *Whirlpool Corp. v. Camco Inc.* [(2000), 9 C.P.R. (4th), 129 (S.C.C.)] at paragraph 49; citing *Lister v. Norton Brothers and Co.* [(1886), 3 R.P.C. 199, (Ch.D.)] at page 203. The actual quote from *Lister* is that a patent “must be read by a mind willing to understand, not by a mind desirous of misunderstanding”.
6. *Whirlpool* (supra at 5) at paragraph 49
7. The term “set of elements” must be understood to include a set of one. The use of the term “together” is relevant only for a set of two or more elements.
8. *Biolysse Pharma Corporation v. Bristol-Myers Squibb Company* [2005] SCC 26 at paragraph 1
9. The approach set out in 13.05.03 is conceptually similar to the *Aerotel/Macrossan (Aerotel Ltd. v. Telco Holdings Ltd. & in the Matter of: Patent Application GB 0314464.0 of Macrossan* [2006] EWCA Civ 1371) “contribution approach” made use of in the UK, and the use of the term “contribution” will inevitably draw comparisons. The present approach, however, is distinct and cannot be directly related to the UK practice. The analysis, and the conclusions reached, in some ways also resemble the approach in the *Hitachi* decision [(2004) T258/03] followed by the EPO. It is important for the reader not to import into the present explanation any presumption that the practice being described is intended to mirror either *Aerotel* or *Hitachi*. Important distinctions exist, and the present approach is based solely on an assessment of Canadian jurisprudence.
10. *Shire Biochem Inc. v. Apotex Inc.* [2008] FC 538 at paragraph 25; *Eli Lilly Canada Inc. v. Novopharm Ltd.* [2007] FC 596 at paragraph 142; *Pfizer Canada Inc. v. Novopharm Ltd.* [2005] FC 1299 at paragraph 78; *Whirlpool Corp. v. Camco Inc.* [(1997), 76 C.P.R. (3rd), 150 (F.C.T.D.)] at page 186

11. Whether the applicant is correct to consider the matter to be known to the person skilled in the art is addressed when considering sufficiency of disclosure.
12. To be “useful” in the sense required by the *Patent Act*, the various requirements set out in Chapter 12 of this manual must all be met.
13. The differences between the present approach and the *Aerotel/Macrossan* and *Hitachi* approaches (see supra at 9) can be summarised as follows: in *Aerotel* one determines what has been contributed and asks whether it is statutory (i.e. whether it is an “invention” within the meaning of the UK equivalent to section 2 of the *Patent Act*); in *Hitachi* one asks whether the technical matter of the claim is unobvious, and presumes the non-technical matter to be obvious (i.e. one asks whether the statutory matter of the claim is unobvious under the EPC equivalent to section 28.3 of the *Patent Act*); in the present approach, one asks whether the claim includes statutory subject-matter that has been contributed. These approaches are all, fundamentally, concerned with determining whether the matter of the claim that is novel, unobvious and useful is also statutory. Although the perspective from which the analysis is performed differs, the end result should be consistent.
14. *Canadian Gypsum Co. Ltd. v. Gypsum, Lime & Alabastine, Canada, Ltd.* [1931] Ex.C.R. 180; *Shell Oil v. Commissioner of Patents* [(1982), 67 C.P.R. (2nd), 1 (S.C.C.)] at pages 10-11
15. Any defects of form or content must, of course, be addressed before the claim will be allowed.
16. Examiners need not examine non-statutory matter for novelty and obviousness. Consequently, where it has been determined that a claim does not include contributed statutory subject-matter, but does include a discrete non-statutory feature, the discrete non-statutory feature is viewed as the “invention” being asserted and is objected to under section 2 of the *Patent Act*. Such an objection is made even if it is clear from the application itself, the prior art, or statements made by the applicant that the discrete non-statutory feature in a claim has not been contributed.
17. *Schlumberger Canada Ltd. v. Commissioner of Patents* [(1981), 56 C.P.R. (2nd), 204 (F.C.A.)] at page 206
18. *Schlumberger* (supra at 17)
19. *Lawson v. Commissioner of Patents* [(1970), 62 C.P.R. (1st), 101 (Ex.Ct.)]
20. “claim date” meaning the earlier of the filing date or valid priority date.

21. Searches performed by Canadian examiners as part of CIPO's obligations as an International Searching Authority are governed by the requirements of the PCT, and are not covered by this section of the manual.
22. Subsection 30(1) applies where a final action was not issued, and 30(5) where the application is found allowable subsequent to a response to a final action.
23. This refers to a final fee paid by the authorized correspondent on an application that has been allowed.