

## **Chapter 15**

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## Chapter 15

### Requirements for patentability

#### 15.01 Introduction

The subject matter protected by a patent is defined by the claims. This chapter deals with the various requirements imposed by law and jurisprudence on claims before they can be said to be directed to novel and unobvious subject matter in accordance with sections 28.2 and 28.3 of the *Patent Act*.

##### 15.01.01 Novelty and anticipation

To be considered novel the whole of subject matter defined by a claim shall not form part of the state of the art. With respect to each claim in an application for patent in Canada the state of the art may be defined generally as everything disclosed in such a manner that it became available to the public in Canada or elsewhere before the **CLAIM DATE**. The **CLAIM DATE** of a claim in a Canadian patent application is the filing date of the application in Canada, unless, priority is claimed on an earlier filed application in Canada or elsewhere. In the latter case, the claim date is the filing date of the earliest application which supports the subject matter of the claim (Sections 2 and 28.1 of the *Patent Act*).

If the subject matter defined by a claim in an application is disclosed completely in a single prior art reference, it is considered to be anticipated by the reference (meaning lacking in novelty). In this situation the examiner will inform the applicant of the defect and requisition the applicant to amend the application to comply with the *Patent Act* and Rules or to provide arguments as to why the application does comply. The defect in this case is that the claim lacks novelty in view of the prior art (i.e. is anticipated by the reference). Although novelty is assessed on the basis of a single item of prior art, it is permitted to read into prior art things that can be considered to be implicit therein, but references may not be combined to find a lack of novelty. Combining references to show lack of novelty has been referred to as an improper "mosaic" of references (Pope v. Spanish River 46 RPC 1929).

### **15.01.02 Obviousness**

A claim will be objected to under section 28.3 of the *Patent Act* if it is considered to be obvious to one of skill in the art or science, on the claim date. The test for obviousness is essentially whether or not an unimaginative skilled technician would, in the light of the state of the art and common general knowledge at the claim date, be led directly and without difficulty to the invention covered by the claim i.e. subject matter defined by the claim.

While some references do not show every detail of an invention claimed in an application, the differences between the two may be so slight that the invention claimed is obvious in view of the reference. Where the differences could have been made using the ordinary skill of one versed in the art, the claims are rejected for obviousness in view of the state of the prior art revealed in the reference or references.

Care must be exercised in assessing whether the differences between the claimed invention and the disclosure of the prior art, even if minor, produce unexpected results, in which event the element of unobviousness could be present.

It may be necessary to cite two or more references, or one reference and evidence of common knowledge to show all the features of an applicant's invention. Several references may be cited to show that the state of the art is such that the applicant failed to make any inventive improvement when the rejection is for obviousness rather than for anticipation. The references cannot be from such diverse arts that one skilled in the art of the invention claimed would not normally be expected to be aware of it. There may be invention in applying known principles of one art to another art if the different arts are sufficiently remote from each other, even though one skilled in the art would be expected to look beyond the immediate environment of the invention

It has been held by the courts to be obvious to do any of the following:

- (a) To merely substitute superior for inferior materials, in the manufacture of one or more or all of the parts of a machine or manufacture.
- (b) To merely change the size or dimensions of an object.

- (c) To omit one or more of the parts of a machine or manufacture with a corresponding omission of function, unless that omission causes a new mode of operation of the parts retained.
- (d) To change a process, machine, manufacture or composition of matter, by substituting an equivalent for any of its parts, unless the new part not only performs the function of the part for which it was substituted, but also performs another function, by another mode of operation, or develops new uses and properties of the article formed.
- (e) To merely use an old process, machine or manufacture for a new but analogous purpose.
- (f) To change the form or proportions of a machine or manufacture, unless a new mode of operation or function results.
- (g) To produce an article which differs from an older article only in excellence of workmanship.
- (h) To duplicate one or more of the parts of a machine or manufacture unless the duplication causes a new mode of operation, or produces a new unitary result.
- (i) To combine old devices into a new machine or manufacture, without producing any new mode of operation.

## **15.02 Internal priority**

A Canadian application may be used as a basis for priority for claims in subsequently filed applications within Canada (subparagraph 28.1(1)(a)(i) and subsection 28.1(2) of the *Patent Act*). In order to establish a priority claim, the filing date of the subject application must be within twelve months of the filing date of the preceding Canadian application (subsection 28.1(1)(b) of the *Patent Act*), and the request for priority must be made within a four month period after the filing of the subject application (paragraph 88(1)(b) of the *Patent Rules*). Where the subject matter of a claim is disclosed in more than one preceding Canadian or foreign application a priority claim may only be made if

the subject application is filed within 12 months of the earliest filed application (paragraph 28.4(4)(a) of the *Patent Act*).

### **15.03 Claim Date**

The claim date of a claim in an application or patent is the filing date of the application in Canada, unless there is a priority claimed. In the latter case the claim date is the filing date of the earliest priority application which supports the subject matter of the claim.

In order to have a valid priority claim date the following conditions must be satisfied:

- a) the previously filed Canadian or foreign application must disclose the subject matter defined in the claim of the subject application (subparagraph 28.1(1)(a)(i) and (ii) of the *Patent Act* and chapter 7 of this Manual);
- b) the subject matter of the claim must be reasonably inferred from supported by the specification or drawings as they were originally filed in the preceding Canadian or foreign application (section 38.2(2) and (3) of the *Patent Act*);
- c) the filing date of the subject application must be within twelve months of the filing date of the preceding Canadian or foreign application (section 28.1(b) of the *Patent Act*);
- d) a request for priority must be made within a four month period after filing the subject application (section 28.4 of the *Patent Act*, paragraph 88(1)(b) of the *Patent Rules*), the applicant must provide the Commissioner with the date and country of filing of each previously regularly filed application on which the request for priority is based before the expiry the four-month period after the filing date of the subject application. The applicant must also provide the Commissioner with the application number of any such application before the expiry of the later of the four-month period after the filing date of the subject application and the twelve-month period after the

filing date of the previously filed application; and

- e) upon requisition by the examiner, the applicant must provide a certified copy of any foreign application that forms a basis for the priority request (section 89 of the *Patent Rules*).

A situation may arise where an application may contain claims having different claim dates. This may occur when an applicant requests priority from two or more preceding applications, or when only part of the application has priority from a preceding application (section 28.4(4) of the *Patent Act*). A claim that defines subject matter in the alternative may be derived from several priority documents. In such a circumstance each alternative in the claim will be considered as a separate claim and will possess its own claim date (section 27(5) of the *Patent Act*).

#### **15.04 Grace period**

The public disclosure of claimed subject matter by the applicant, or by a person who obtained knowledge of this subject matter directly or indirectly from the applicant, will not be used to object to claims for lack of novelty or obviousness unless such disclosure was made more than one year (grace period) before the Canadian filing date (section 28.2(1)(a) of the *Patent Act*). For applications filed on or after October 1, 1996, any publication arising from an applicant's corresponding application in a foreign jurisdiction will not constitute a bar if the Canadian application is filed within 12 months of the publication (subsection 28.2(1)(a) of the *Patent Act*). For applications filed prior to October 1, 1996, any patent arising from an applicant's corresponding application in a foreign jurisdiction constitutes a bar unless (1) the Canadian application was filed before the foreign patent issued or (2) the foreign patent issued within 12 months after the filing of the first corresponding application by that inventor (subsection 27(2) of the *Patent Act* as it read prior to October 1, 1996).

#### **15.05 Citation of art**

Art cited in examiners' reports falls into two categories, that applied against the

application as a basis for objection or amendment, and that cited as of interest only. Art that is applied is usually placed near the start of the examiner's report under the heading "References Applied". An examiner may also place on record related art of interest that shows the state of the art.

#### **15.05.01      References applied**

References may be applied because they disclose the invention claimed in the application (section 28.2 of the *Patent Act*), or because they show that the claims define something that is obvious and therefore unpatentable (section 28.3 of the *Patent Act*).

#### **15.05.02      References of interest**

All references placed on record that are not relied upon as grounds for objection, or to requisition amendments, are cited to show the state of the art. They may be useful in identifying subject matter disclosed but not claimed by an applicant and which cannot be claimed through subsequent amendment of the application. On some occasions, the abstract of a document which appears pertinent will be cited as a reference of interest when the full document is not available to the examiner.

#### **15.05.03      Identification of art cited**

When a reference is first cited against an application, it is identified sufficiently so that the applicant will be able to locate it. For a publication, the author, title, publisher, date of publication and page number are normally given. In the case of a patent, the number, country, date on which it became available to the public and name of inventor or patentee (if known) are given. Sometimes, as in the case of United States patents, the patent classification at the time of issue is also listed. If specific pages of the disclosure or certain views in the drawings are relied upon, they are identified.

#### **15.05.04      Incorrect citation of references**

When the Patent Office discovers that a reference has been incorrectly cited in an examiner's action which has already been sent to the applicant, a letter of correction is sent to him. Such a letter does not extend the time set for replying to an outstanding

action, but if the applicant finds that as a result of the original error he is left with insufficient time to deal with the citation properly he may so indicate in his response. Under these circumstances, the objection made in view of the citation will be repeated in a subsequent action, thus giving the applicant a further opportunity to consider it.

## **15.06 Manner of citing references**

Any patent, opened patent application, printed publication or public knowledge anywhere, disclosing the subject matter of the claim, and which disclosure was available to the public prior to the claim date of the subject application filed in Canada, constitutes a bar to the grant of a patent on that application, unless such disclosures originate from the applicant and comes within the grace period (section 28.2(1)(a) of the *Patent Act*). Therefore, public disclosures of the invention by the applicant or by a person who obtained knowledge of the invention, directly or indirectly from the applicant and which disclosures occurred more than one year before the Canadian filing date (grace period) of the application are also a bar. These disclosures are considered eligible citations both for lack of novelty and obviousness. The applicant is given the opportunity to overcome the citation by amendment to clear the reference or by presenting convincing arguments showing that the invention claimed differs patentably from that described in the cited reference.

For example, under section 28.2 of the *Patent Act* claims are objected to if the subject matter was:

- (i) disclosed by the applicant, or by a person who gained knowledge of the invention from the applicant, so as to be available to the public more than one year prior to the Canadian filing date (section 28.2(1)(a) of the *Patent Act*), or
- (ii) disclosed by another person so as to be available to the public before the claim date.

However, a foreign application of the same inventor disclosing the same invention as the corresponding Canadian application, and which was published, laid open, or granted prior to the Canadian filing date, is a bar to the grant of the Canadian Patent,



unless the Canadian application was filed within twelve months of such foreign publication or granting (grace period).

### **15.06.01 Citations of copending Canadian applications**

A laid open copending application by a different applicant describing the same invention and having at least one claim with an earlier claim date than a subject application will be cited as a document that negates the novelty of the claims of the subject application (paragraph 28.2(1)(d)). However, a copending application cannot be cited against a subject application on the grounds of obviousness, unless the subject matter of the copending application was made available to the public prior to the claim date of the subject application. In this section, the subject application is the application under examination.

In the event that two or more copending applications describe the same invention the following situations may arise:

(A) No examination request on any application:

No consideration will be given to the copending applications until examination has been requested for at least one of the applications.

(B) Subject application is the earlier filed application:

(i) where the subject application has a Canadian filing date that predates the claim date of any other copending applications, no consideration will be given to the other copending applications and examination of the subject application will proceed as though they did not exist;

(ii) where any copending application has at least one claim date earlier than the Canadian filing date of the subject application then the relevant claim dates of the subject application and copending application need to be verified (section 89 of the *Patent Rules*);

(C) Subject application is the later filed application:

where the subject application has a Canadian filing date that is preceded by the claim date of any other copending application describing the same invention, then;

- (i) where the copending application having the earlier claim date has been laid open to the public in Canada or in any other country before the claim date of the subject application, then the copending application or its foreign counterpart having the earlier claim date is cited against the subject application as a publication;
- (ii) where the copending application having the earlier claim date was not available to the public in Canada or in any other country before the filing date of the subject application, the copending application is cited under paragraph 28.2(1)(c) or (d) of the *Patent Act* after the copending application is laid open. Verification of the claim dates of the copending and the subject application is necessary. The copending application cannot be cited against the subject application as a reference for obviousness since the disclosure of the subject matter was not available to the public at the claim date of subject application (subsection 28.3(b) of the *Patent Act*).

(D) Overlap between copending applications of the same applicant:

Where an examination request is received for an application and there is an application by the same applicant describing and claiming the same invention having an earlier claim date then:

- (i) Where the application having the earlier claim date has been made available to the public in Canada or in any other country more than one year (grace period) before the application under examination was filed in Canada, then the application having the earlier claim date would be applied against the subject application in the same manner as any other citable published material;
- (ii) Where the application having the earlier claim date has not been made available to the public for more than one year before the application under

Examination was filed in Canada, the application having the earlier claim date would be cited requisitioning the applicant to remove the overlapping claimed subject matter. The citation for overlapping subject matter is applied irrespective of whether or not internal priority has been established on the previously filed application. Since the term of protection initiates from the filing date and not the claim date, the applicant must choose in which application to prosecute the overlapping subject matter in order to prevent extension of the exclusive right (sections 44 and 45 of the *Patent Act*). This precludes using the applicants' earlier filed application against his/her own later filed application(s) ("self collision").

#### **15.06.02 Copending PCT applications**

Applications filed under the provisions of the Patent Cooperation Treaty are a special case in regard to their copendency with other Canadian applications. Section 63 of the *Patent Rules* particularly indicates that such applications will be deemed to be applications filed in Canada at the time they become national phase applications.

For the purpose of a citation under section 28.2(1)(c) and (d) of the *Patent Act* in the prosecution of another application, a PCT application will benefit from its filing date or priority date only after it has entered the national phase. This could be 20 months after the filing date of the international application but may be delayed up to 42 months in certain circumstances. Should an examiner wish to cite a PCT application the status with respect to national entry in Canada must first be verified. If such application has not entered the national phase, it may be cited only as a publication using the international publication date.

**15.07 Jurisprudence**

The following decisions of the courts are of importance in considering the subject matter of this chapter:

Obviousness/Anticipation

Fada Radio v CGE	SCR	520	1927
Christiani v Rice	Ex CR	111	1929
	SCR	443	1930
	RPC	511	1931
Mico Products v Acetol	Ex CR	64	1930
Crosley Radio v CGE	SCR	551	1936
K v Uhleman Optical	Ex CR	142	1950
	1 SCR	143	1952
Comm of Pat v Ciba	SCR	378	1959
Lovell v Beatty	41 CPR	18	1962
Defrees v Dominion Auto	Ex CR	331	1963
Lamb Sets v Carlton	Ex CR	377	1964
Comm of Pat v Farbweke	SCR	49	1964
Gibney v Ford	2 Ex CR	279	1972
Xerox v IBM	33 CPR (2d)	24	1977
Marzon v Eli Lilly	37 CPR (2d)	37	1978
Globe Union v Varta	57 CPR (2d)	132	1978
Reeves Bros v Toronto	43 CPR (2d)	145	1978
Farbwerke v Halocarbon	2 SCR	929	1979
	74 CPR (2d)	95	1983
Beecham v Procter & Gamble	61 CPR (2d)	1	1982
Cutter v Baxter Travenol	68 CPR (3d)	179	1983
	74 CPR (2d)	95	1983
Johnston Controls v Varta	80 CPR (2d)	1	1984
Windsurfing v Bic Sports	8 CPR (3d)	241	1985
Beloit v Valmet	8 CPR (3d)	289	1986
Sandvick v Windsor	8 CPR (3d)	433	1986
Tye-Sil v Diversified	16 CPR (3d)	207	1987
	35 CPR (3d)	350	1991

Reading & Bates v Baker	18 CPR (3d)	181	1987
	35 CPR (3d)	350	1991
Apotex v Hoffman-La Roche	15 CPR (3d)	217	1987
	24 CPR (3d)	289	1989
Brushtech v Liberty	23 CPR (3d)	370	1988
Gorse v Upwardor	25 CPR (3d)	166	1989
	40 CPR (3d)	479	1992
AT&T Tech v Mitel	26 CPR (3d)	238	1989
Control Data v Senstar	23 CPR (3d)	449	1989
Lubrizol v Imperial Oil	33 CPR (3d)	1	1990
	45 CPR (3d)	449	1992
Procter & Gamble v Kimberly	40 CPR (3d)	1	1991
Martinray v Fabricants	14 CPR (3d)	1	1991
Rothmans, Benson & Hedges	35 CPR (3d)	417	1991
Procter Gamble v Kimberly	40 CPR (3d)	1	1991
Re: Hering's Application	53 CPR (3d)	390	1992
	47 CPR (3d)	188	1993
Atlas v CIL	41 CPR (3d)	348	1992
Allied v Du Pont	52 CPR (3d)	351	1993
	50 CPR (3d)	1	1993
CFM v Wolf Steel	50 CPR (3d)	215	1993
	64 CPR (3d)	75	1995
Hi-Quail v Rea's Welding	55 CPR (3d)	224	1994
Anderson v Machinerics	58 CPR (3d)	449	1994
Almecon v Nutron	65 CPR (3d)	417	1996

"What would infringe later, anticipates earlier"

Lightning Fastener v Colonial	Ex CR	89	1932
	SCR	363	1933
	51 RPC	349	1934
EMI v Lisen	56 RPC	23	1939
Atlas Copco v CIL	41 CPR (3d)	348	1992
CFM v Wolf Steel	50 CPR (3d)	215	1993
	64 CPR (3d)	75	1995

subject matter reasonable inferred

Re Application No. 139,256	51 CPR (2d)	95	1977
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overlapping subject matter/double patenting

Short Milling v George Weston	Ex CR	69	1941
Rohm & Haas v Comm of Patents	30 CPR	113	1959
Lovell v Beatty	41 CPR	18	1962
Boehringer v Bell-Craig	39 CPR	201	1962
Comm of Pat v Farbweke	41 CPR	9	1963
	SCR	49	1964
Xerox v IBM	33 CPR (2d)	24	1977
Consolboard v MacMillan	56 CPR (2d)	145	1981
	1 SCR	504	1981
Beecham v Procter & Gamble	61 CPR (2d)	1	1982
Re: Hedstrom	31 CPR (3d)	324	1989

types of prior art (printed documents, experimental use etc.)

Gibney v Ford	2 Ex CR	279	1972
Leithiser v Pengo Hydra-Pull	12 CPR (2d)	117	1973
	2 FC	954	1974
Xerox v IBM	33 CPR (2d)	24	1977
Koehering v Owens-Illinois	40 CPR (2d)	72	1978
	52 CPR (2d)	1	1980
Beecham v Procter & Gamble	61 CPR (2d)	1	1982
Johnston Controls v Varta	80 CPR (2d)	1	1984
J M Voith v Beloit	27 CPR (3d)	289	1989
Beloit v Valmet	36 CPR (3d)	322	1991
Hi-Quail v Rea's Welding	55 CPR (3d)	224	1994