

January 20, 2010

By Email: Barney.deSchneider@ic.gc.ca

Barney de Schneider
Assistant Commissioner of Patents
Canadian Intellectual Property Office
Patent Branch
50 Victoria Street
Gatineau, Québec
K1A 0C9

Dear Mr. de Schneider:

Re: Proposed Amendments to MOPOP Chapter 9

FICPI Canada wishes to thank the Canadian Intellectual Property Office for the opportunity to comment on the proposed revisions to Chapter 9 of the Manuel of Patent Office Practice which were released for public review on November 16, 2009.

As you know, FICPI (the Federation Internationale des Conseils en Propriété Industrielle), comprises more than 3500 intellectual property attorneys in private practice in over 80 countries. FICPI Canada is a self-governing national association of FICPI and represents the interests of Canadian patent and trade mark professionals. Our membership includes senior professionals at most major Canadian intellectual property firms. Our clients span all types and sizes of businesses, including multi-national corporations, small and medium size enterprises, and individuals.

We recognize that updating Chapter 9 of MOPOP represents an enormous effort and we commend the Patent Office for addressing this important project. It is crucial that MOPOP be kept up to date, and that it provide clear guidance to the examination staff in the Patent Office.

FICPI Canada's submissions are set out in the attached documents, which include a marked-up copy of the proposed draft of Chapter 9 containing recommended changes and notes.

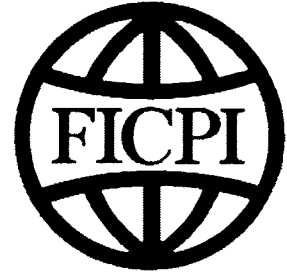
FICPI Canada wishes to thank the Canadian Intellectual Property Office for the opportunity to provide comments. If CIPO has any comments about our submissions, or if you consider it would be helpful to have a meeting with representatives from FICPI Canada, please do not hesitate to contact the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Storey', with a long horizontal flourish extending to the right.

Robert B. Storey
President - FICPI Canada

cc Chris Evans, CIPO (by email at chris.evans@ic.gc.ca)



FICPI Canada Submission to CIPO

Re: Proposed Amendments to MOPOP Chapter 9

January 20, 2010

Submission

This submission is provided in response to a call for comments on a draft amended Chapter 9 of the Manual of Patent Office Practice (“MOPOP”) entitled “Descriptions”.

FICPI Canada shares the view that examiners should be provided with guidance when examining patent applications. Guidance documents generally provide greater objectivity and consistency in the examination of patent applications.

FICPI Canada supports CIPO's ongoing work in amending MOPOP and acknowledges the contribution of the individuals involved in this work.

Recommendations

Recommendation 1

FICPI Canada is of the view that some portions of the draft extend into areas already covered and best dealt by other chapters of the MOPOP. Such extension into overlapping chapters is not necessary for the purposes of Chapter 9. It is consequently recommended to delete portions of draft Chapter 9 and instead provide cross-reference to other MOPOP Chapters. Hyperlinks could be a convenient way for cross-referencing an online document.

Cross-reference is preferable since:

- it avoids inconsistencies within MOPOP on a given subject;
- it avoids having to rewrite more than one chapter of MOPOP when the law changes on a given subject;
- it avoids blending concepts which could lead to poorer understanding of description requirements;
- 9.01 of draft Chapter 9, entitled “Scope of this chapter”, deals with section 27(3) of the *Patent Act* as well as the various requirements as to the form and content of a description under the *Patent Rules*. The scope should not extend to other concepts best dealt in other MOPOP chapters.

The approach of cross-referencing to other MOPOP chapters is consistent with the approach adopted by the Federal Court of Appeal in Pfizer vs. Ranbaxy case 2008 FCA 108:

[59] Only two questions are relevant for the purpose of subsection 27(3) of the Act. What is the invention? How does it work?: see Consolboard, supra, at 520

In the case, the Court of Appeal had to address, inter alia, allegations of "weak data" in the disclosure. The Court was clear that "weak data" was not an issue of sufficiency under 27(3) of the Act:

[51] These allegations, although placed under a heading entitled sufficiency in the NOA, have, in my respectful view, nothing to do with the disclosure requirement under subsection 27(3) of the Act. Rather, they are relevant to an analysis of the utility, novelty and/or obviousness of a patent.

This is clear from the first paragraph of the NOA cited above, according to which the disclosure does not support there being any novel or inventive aspect as claimed. What Ranbaxy is really challenging in its NOA under the heading of "sufficiency" is the fact that Pfizer obtained a selection patent without having provided reliable data showing that the narrow class of compounds selected was better than the compounds covered by the genus patent.

In view of the above, the cross-referencing approach for Chapter 9 allows focusing on written description requirements for achieving sufficiency of description as per the Act and Rules while directing the reader to other chapters for subject matter eligibility, utility, novelty and/or obviousness.

Query whether Chapter 9 would be even more clearly presented if split in (i) formal requirements and (ii) substantive requirements, with respective reference to relevant sections of the Act and Rules.

Recommendation 2

It is understood and acknowledged that patent description requirements will vary according to individual fact scenarios. For example, description requirements will vary depending on the field of technology or the basic knowledge of those skilled in the particular art of the invention. Furthermore, description requirements will vary depending on the nature of the inventive contribution. Differences exist between inventions based on selection of species from a broader genus, inventions based on synergistic combinations of known elements, inventions involving sound prediction of utility, inventions directed to software implementations, methods, systems or new uses. Thus the description requirements are intimately linked to patentability requirements. FICPI Canada recommends that this be acknowledged in Chapter 9 and that Examiners are specifically instructed to refer to other chapters of the MOPOP for patentability requirements that may impact on description requirements.

* * *

FICPI Canada's recommendations are embodied in the attached marked-up version of draft Chapter 9. As part of the same document, notes and suggestions are also provided for improved reference to case law and concepts.

Respectfully submitted,



FICPI Canada

Per Robert Storey, Alain Leclerc, Stephen Perry and John Knox.

Chapter 9 - Descriptions

DRAFT

This document is a draft of a revised chapter of the MOPOP. The Commissioner of Patents has authorized that this draft be released for public review until December 30, 2009, subsequent to which the chapter, in its present or an amended form, may be adopted by the Office as expressing official practice.

Pending formal approval of this chapter by the Commissioner of Patents, readers should bear in mind that to the extent that the content of this document may differ from content found in the current (i.e. official) version of this chapter, or elsewhere in the MOPOP, this document does not reflect the official practice of the Office

During the review period, the public is invited to submit any comments pertaining to the content of the draft. Comments may be submitted electronically or in writing, using the coordinates available at the MOPOP Updates web site.

Chapter 9

Descriptions

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- 9.02 General requirements of disclosure
 - 9.02.01 Proper disclosure
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Chapter 9 Descriptions

9.01 Scope of this chapter

The description, together with the claims, form the specification of an application.¹ Although the claims play a prominent role in the patent system, in that they define the scope of the exclusive privilege conferred by a patent, a proper description is fundamental to a valid patent. As was noted by the Supreme Court, “[d]isclosure is the *quid pro quo* for valuable proprietary rights to exclusivity which are entirely the statutory creature of the *Patent Act*.”²

The present chapter discusses the various requirements for proper disclosure under section 27(3) of the *Patent Act* as well as the various requirements as to the form and content of a description under the *Patent Rules*.

9.02 General requirements of disclosure

The description must provide a clear and complete disclosure of the invention such that the person skilled in the art:

- (1) can unambiguously identify what has been invented; and
- (2) is enabled to practice this invention.³ [Footnote 3 should avoid reference to Apotex v. Sanofi which does not address sufficiency of disclosure, see para [26]]

In *Consolboard Inc. v. Macmillan Bloedel (Saskatchewan) Ltd.*, Dickson J. further noted that “the inventor must, in return for the grant of a patent, give to the public an adequate description of the invention with sufficiently complete and accurate details as will enable a workman, skilled in the art to which the invention relates, to construct or use that invention when the period of the monopoly has expired”.⁴ The description must be able to answer the questions “What is your invention?: How does it work?”⁵ [Footnote 5 should also refer to Pioneer Hi-Bred, SCC and Ranbaxy, FCA] such that “when the period of the monopoly has expired the public will be able, having only the specification, to make the same successful use of the invention as the inventor could at the time of his application”.⁶

It is beyond doubt that the “public” referred to in the foregoing quote takes the form of the person skilled in the art.

9.02.01 Proper disclosure

The statutory requirements of proper disclosure are set out in subsection 27(3) of the *Patent Act*, which requires that:

The specification of an invention must

(a) correctly and fully describe the invention and its operation or use as contemplated by the inventor;

(b) set out clearly the various steps in a process, or the method of constructing, making, compounding or using a machine, manufacture or composition of matter, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it pertains, or with which it is most closely connected, to make, construct, compound or use it;

(c) in the case of a machine, explain the principle of the machine and the best mode in which the inventor has contemplated the application of that principle; and

(d) in the case of a process, explain the necessary sequence, if any, of the various steps, so as to distinguish the invention from other inventions.

Thorson P. summarized the foregoing requirements in *Minerals Separation North American Corp. v. Noranda Mines, Ltd.*,⁷ and later described the “onus of disclosure” as “a heavy and exacting one”.⁸

[Note: the last quotes are peculiar to the facts of that the Radio Corp v. Raytheon case where the applicant had substituted the claims of a competitor's corresponding US patent while clearly not having the required support in its own disclosure. The quoted phrases of Thorson P. have not been adopted in other jurisprudence as a pronouncement as to the general law for description adequacy. FICPI urges that MOPOP should refer only to the more definitive quote from Thorson P. provided below.]

The description must be correct; this means that it must be both clear and accurate. It must be free from avoidable obscurity or ambiguity and must be as simple and distinct as the difficulty of description permits. It must not contain erroneous or misleading statements calculated to deceive or mislead the persons to whom the specification is addressed and render it difficult for them without trial and experiment to comprehend in what manner the invention is to be performed. It must not, for example, direct the use of alternative methods of putting it into effect if only one is practicable, even if persons skilled in the art would be likely to choose the practicable method. The description of the invention must also be full; this means that its ambit must be defined, for nothing that has not been described may be validly claimed. The description must also give all information that is necessary for successful operation or use of the invention, without leaving

such result to the chance of successful experiment, and if warnings are required in order to avert failure such warnings must be given. Moreover, the inventor must act *uberrima fide* and give all information known to him that will enable the invention to be carried out to its best effect as contemplated by him.⁹

[Note: the Consolboard decision cited above appears to have tempered the above statements. Query if more emphasis should be given to Consolboard rather than Minerals Separation.]

The foregoing touches on both aspects of a sufficient disclosure: that it set out in clear and precise terms what the invention is (i.e. a correct and full description), and that it provide sufficient instructions to the person skilled in the art so that this person is enabled to reproduce and successfully operate the invention.

9.02.02 Addressee is the person skilled in the art

The specification of an invention is directed to a person skilled in the art or science to which it pertains, or with which it is most closely connected.¹⁰ Whether or not a description is sufficient depends on the interpretation it would be given by the person skilled in the art, who must interpret it with a mind willing to understand¹¹ and desirous of success.¹²

The person skilled in the art is competent, and represents an average, logical but unimaginative worker in the field.¹³ This person is neither a dull-witted incompetent nor a creative, intuitive expert,¹⁴ albeit that in a highly technical field the person skilled in the art may be presumed to have expert-level knowledge and skills.¹⁵ Furthermore, the person skilled in the art is reasonably diligent in keeping up with advances in the field or fields of technology of relevance to the invention,¹⁶ and has the advantage of being multilingual and thereby being able to comprehend prior art in any language.¹⁷

In addition, the person skilled in the art need not be an actual individual; they are a fictitious construct and can represent a team of individuals whose conjoint knowledge is relevant to the invention in suit.¹⁸

In order to properly assess whether a correct and full description of the invention has been provided, it is necessary to determine the particular nature of the person skilled in the art to which the application is directed.

In accordance with paragraph 80(1)(b) and 80(1)(d) of the *Patent Rules*, the description must indicate the technical field of the invention and must allow an understanding of the technical problem being addressed and the solution to that problem through the invention.¹⁹ The person skilled in the art will be competent in the field or fields of technology of relevance to the invention.

A complexity arising from the nature of the person skilled in the art is that, as a general rule, neither the inventors nor the examiner may be directly equated to this person. Examiners and inventors, for example, are not free of creativity and intuition. They may have knowledge that surpasses that expected of the person skilled in the art in a given field, but again may not be as skilled in other fields of the invention as this person. During examination, an examiner must attempt to interpret the application and the prior art using the appropriate knowledge that the person skilled in the art would have possessed at the relevant date. This may be particularly challenging where knowledge in the field at the date of examination has significantly developed since the relevant date, and particularly where certain views held at the relevant date have subsequently been found to be incorrect.²⁰ [Suggestion: add mention that response to Office Action including sworn or unsworn declarations or affidavits referring to available documentation, such as textbooks or scientific literature can be considered by examiners to establish the skillset of the person skilled in the art.]

9.02.03 Description supplemented by common knowledge

A description sufficient to allow the person skilled in the art to practice the invention with the same success as the inventor is said to be enabling. Since the person skilled in the art is the addressee of the description, it is not necessary for common knowledge to be comprehensively disclosed nor to teach to the person skilled in the art things that would be plainly obvious to them.²¹

The date at which the person skilled in the art brings their knowledge to bear on the application is the date on which the application came into their possession; that is to say, the publication date.²² [Footnote 22 should refer to AlliedSignal Inc. v Dupont Canada Inc (1995), 61 C.P.R (4th), FCA rather than Free World Trust]

Since the common general knowledge may develop between the filing date and the publication date, this theoretically means that a specification that was not enabling as filed could nevertheless, on the basis of more extensive common general knowledge, be enabling by the publication date. However, the invention must still be fully described as of the filing date, and the utility of the invention must have been established no later than at this date [see 9.04].

9.02.04 Misleading or erroneous statements

The person skilled in the art will read a description with a mind willing to understand and desirous of success. They will use their common general knowledge to supplement the description in order to successfully operate the invention, and will overlook obvious errors or omissions that can be readily corrected.²³