

## PATENT CLAIM CONSTRUCTION DECISION MAY BOOST PATENT ELIGIBILITY IN CANADA

by Matthew D. Powell

Those applying for Canadian patents will be pleased to learn of a recent [decision](#) by the Federal Court of Canada invalidating the patent office's controversial *problem-solution* approach to patent claim construction. The Court suggested that, because the *problem-solution* approach fails to respond to the issue of an inventor's intention in choosing words for a patent claim, it is not in keeping with the principles of purposive claim construction taught by the Supreme Court of Canada.

As claim construction is the formal process of scrutinizing patent claims to understand precisely what the inventor would like to stop others from copying, *how* claim construction is conducted can have a significant impact on whether an invention is deemed to comply with the *Patent Act* and can thus be patented.

The *problem-solution* approach to claim construction justifies a process of distilling an inventor's words out of his claim with the goal of, in some sense, freeing an essential idea. According to the approach, it is this essential idea – and not the inventor's claim – that is tested by examiners against the statutory requirements of patentability. However, the manner in which such distillation is done directly affects whether the essential idea arising from it fails the test for patentability.

The Federal Court's decision will hopefully have a positive impact on patentability particularly of computing inventions and medical diagnostic tests in Canada. The *problem-solution* approach has in these fields lent less weight to inventors' words than the Supreme Court's principles of purposive claim construction would require. This has resulted in numerous documented refusals of patent applications for failing to qualify as a member of a statutory category of invention. Should the patent office now develop a claim construction approach that more closely aligns with the Supreme Court's direction on purposive construction, there should be less justification for these kinds of refusals.

### BACKGROUND

It is central to Canadian patent law that claim construction – the process of interpreting what the inventor has claimed he or she should be able to stop others from copying – is to be done before considering whether the patent is valid or has been infringed.

In the *Whirlpool* and *Free World Trust* pair of decisions handed down in 2000, the Supreme Court of Canada articulated a justification for, and an approach to, *purposively* construing the claims of a patent. Purposive claim construction seeks to achieve a balance between the interests of the inventor and of the public. For example, to uphold the public-notice function of the claims, purposive claim construction requires adherence to the claim language itself. This means that an unnecessary or troublesome limitation written into the claims – one that, for example, serves in hindsight to limit the scope of the claims – is to be regarded as a self-inflicted wound. On the other hand, to protect the inventor from excessive literalism, the claim language is also to be read with a sense of the inventor's purpose or intent. The claim language is also to be read with a sense as to whether the person of ordinary

skill in the art would appreciate that certain claimed elements could be substituted without affecting the working of the invention.

The patent office publishes the Manual of Patent Office Procedure (MOPOP) as a guide for patent examiners. As currently written, the MOPOP explains the importance to examination of establishing a purposive claim construction in accordance with *Whirlpool* and *Free World Trust*, but it instructs examiners to embark on a *problem-solution* approach to claim construction. This approach requires examiners to read the patent application to identify a problem and a matching solution so that such a *problem-solution* pairing can establish the context in which the patent claims can be understood. In practice, however, it is all too easy to settle upon a *problem-solution* pairing without regard to the claim language itself. If this is done, the *problem-solution* pairing tends to function more as a language filter that, when finally turned onto the claims, justifies the filtering-out of claimed words and phrases as not essential to the solution.

The patent office developed the *problem-solution* approach to claims construction in response to the Federal Court of Appeal having discredited their prior approach in [Amazon.com, Inc. v. Attorney General of Canada et al. \(2011\)](#). However, patent applicants and other commentators have since pointed out that, in practice, the *problem-solution* approach suffers from the same lack of adherence to *Free World Trust* and *Whirlpool* as did its predecessor. For example, like its predecessor, it tends to work against the Supreme Court's requirement established in *Free World Trust* that "[T]he words chosen by the inventor will be read in the sense the inventor is presumed to have intended, and in a way that is sympathetic to the accomplishment of the inventor's purpose expressed or implicit in the text of the claims."

### THE COURT'S DECISION

Issued on August 21, 2020, the Federal Court decision, written by Zinn J., set aside a [2019 Commissioner's Decision](#) that had affirmed the patent examiner's refusal of [Canadian Patent Application No. 2,635,393](#) to inventor Yves Choueifaty. In the 2019 Commissioner's Decision, the Commissioner of Patents had concurred with the recommendations of the Patent Appeal Board to refuse the application for claiming subject matter falling outside the definition of invention set out in Section 2 of the *Patent Act*. The refused claims had been construed using the *problem-solution* approach.

In its ruling, the Court observed that the patent office had not been following the teachings of the Supreme Court of Canada on purposive claim construction, as set out in *Free World Trust* and *Whirlpool*. In particular, the Court stated that the MOPOP "...notwithstanding stating that the patent claims are to be construed in a purposive manner, does not intend or direct patent examiners to follow the teachings of *Free World Trust* and *Whirlpool*." The Court then went on: "...I find that the Commissioner erred in determining the essential elements of the claimed invention by using the *problem-solution* approach, rather than the approach *Whirlpool* directs be used."

The Court did not actually rule on whether the claims fall within the definition of invention. Instead, the Federal Court remanded the application to the Commissioner of Patents to "*do a fresh assessment*."

The Attorney General of Canada has the right to appeal the Federal Court's decision, and may well do this given the impact the Federal

Court's decision could have. For example, this author has estimated that, since the start of 2019 alone, the Commissioner of Patents has concurred with the Patent Appeal Board's recommendation to issue refusals of appeals in over 40 patent applications based on patent eligibility of claims construed using the *problem-solution* approach.

#### OPPORTUNITIES FOR APPLICANTS

The Federal Court's decision should be useful to applicants arguing in favor of the patent eligibility of claimed inventions in situations in which claim construction has played a significant role in examiners' rejections or Preliminary Reviews issued by the Patent Appeal Board.

Additionally, applicants whose patent applications have more recently been the subject of negative Commissioner's Decisions may wish, as did Choueifaty, to appeal simply on the basis that the patent office had deployed the *problem-solution* approach in justifying the refusals. Because the Federal Court itself is now characterizing the *problem-solution* approach as discredited, the Court may be more inclined to allow such appeals and remand applications back to the Commissioner for their own "fresh" assessments. This would certainly avail applicants of the chance to have patentability re-assessed for little additional cost and with the hope of a better result.

Section 41 of the *Patent Act* provides patent applicants with a six (6) month window within which to appeal a Commissioner's decision to the Federal Court. The author estimates that, as of the time of this writing, over 20 patent applications refused since March 2020 based on the patent eligibility of claims construed using the *problem-solution* approach are still within their respective appeal windows. It will be interesting to observe whether any of the applicants in these cases make the attempt.

#### USEFUL LINKS

- [Canadian Patent Application No. 2,635,393 "METHOD AND SYSTEMS FOR PROVIDING AN ANTI-BENCHMARK PORTFOLIO"](#)
- [Commissioner Decision No. 1478, Refusing Canadian Patent Application No. 2,635,393](#)
- [Federal Court's August 21, 2020 Ruling Setting Aside Commissioner's Decision No. 1478](#)
- [Federal Court of Appeal's 2011 decision in Amazon.com, Inc. v. Commissioner of Patents](#)

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