

**IN THE SUPREME COURT OF CANADA**  
**(ON APPEAL FROM THE FEDERAL COURT OF APPEAL)**

BETWEEN:

ASTRAZENECA CANADA INC.  
ASTRAZENECA AKTIEBOLAG and  
ASTRAZENECA UK LIMITED

Appellants

- and -

APOTEX INC. and  
APOTEX PHARMACHEM INC.

Respondents

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**MOTION RECORD OF**  
**INTELLECTUAL PROPERTY OWNERS ASSOCIATION**  
**(Motion by Intellectual Property Owners Association for Leave to Intervene**  
**pursuant to Rules 47 and 55 of the *Rules of the Supreme Court of Canada*)**

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## TABLE OF CONTENTS

Tab	Document	Page
1	Notice of Motion	1
2	Affidavit of Mark W. Lauroesch	5
3	Memorandum of Argument	14
	PART I – FACTS	14
	Overview	14
	IPO	15
	IPO's history of intervention	16
	PART II – QUESTION IN ISSUE	17
	PART III – ARGUMENT	17
	The test for leave to intervene	17
	IPO has an interest in this appeal	18
	IPO will make useful and different submissions	18
	IPO's proposed submissions	19
	PART IV – SUBMISSIONS CONCERNING COSTS	23
	PART V – ORDER SOUGHT	23
	PART VI – TABLE OF AUTHORITIES	25
	PART VII – STATUTORY PROVISIONS	26
A	<i>Patent Act, R.S.C., 1985, c. P-4, ss. 2, 27, 27(1), 28.2(1), 28.3</i>	27

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ASTRAZENECA CANADA INC.  
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Respondents

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**NOTICE OF MOTION TO A JUDGE**  
**(Motion by Intellectual Property Owners Association for Leave to Intervene pursuant to Rules 47 and 55 of the *Rules of the Supreme Court of Canada*)**

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TAKE NOTICE that Intellectual Property Owners Association ("IPO") hereby applies to a judge of the Court under Rules 47 and 55 of the *Rules of the Supreme Court of Canada* for an order:

- (a) granting IPO leave to intervene in this appeal;
- (b) permitting IPO to file a factum not exceeding 10 pages;
- (c) permitting IPO to present oral argument at the hearing of the appeal; and
- (d) any further or other order that the Court may deem appropriate.

AND FURTHER TAKE NOTICE that the motion shall be made on the following grounds:

1. IPO is an international trade association representing companies and individuals in all industries and fields of technology that own, or are interested in, intellectual property rights. Its members hold patents for inventions in a diverse range of technological fields, including but not

limited to computer technology, biotechnology, household products, and oil and gas. IPO's membership includes approximately 200 companies and over 12,000 individuals who are involved in the association either through their companies or as an individual inventor, author, executive, law firm, or lawyer. IPO is a global voice for intellectual property rights across all industries. Among its many initiatives, IPO advocates for the effective use of patent rights to maximize innovation to the benefit of Canadians and the international community as a whole.

2. ***IPO has an interest in this appeal.*** Many of IPO's members maintain patent portfolios in Canada to protect their research and development investments. IPO therefore has an interest in this appeal. In particular, IPO, on behalf of its members, has a direct stake in ensuring that the Canadian requirement for utility (including the promise doctrine) is applied with clarity and predictability, in a manner that both respects the underlying patent bargain, and is consistent with patent systems in the rest of the world.

3. ***IPO has a long history of intervention.*** IPO is one of the largest filers of amicus briefs in the United States on significant intellectual property issues. In the past six years alone, IPO has filed amicus briefs in 28 cases brought before the Supreme Court of the United States.


4. ***IPO can make useful and different submissions.*** If granted leave to intervene, IPO will bring a unique cross-border, cross-industry perspective to this appeal that is distinct from that of the parties. Given IPO's long and consistent involvement with advocacy for improved patent rights and the universal harmonization of patent regimes, its intervention will ensure that argument regarding the issues in this appeal will be presented from the broader perspective of owners of intellectual property rights across many countries and all industries.

5. Moreover, IPO will make useful and different submissions. Unlike the appellants, who focus primarily on the existence of the promise doctrine as applied by the Federal Courts, IPO will argue that the Court should apply a framework for assessing utility, based on the *Patent Act*, that will enhance fairness and predictability. In particular, IPO will propose a two-step test for assessing utility that focuses on the claimed invention rather than the "promise of the patent."

6. An overview of IPO's proposed submissions appears at paragraphs 22 to 41 of IPO's memorandum of argument. IPO will cooperate with the parties to avoid repetition of argument and material.

Dated at Toronto, Ontario this 2nd day of August, 2016.

SIGNED BY

  
as agent for

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NOTICE TO THE RESPONDENTS TO THE MOTION: A respondent to the motion may serve and file a response to this motion within 10 days after service of the motion. If no response is filed within that time, the motion will be submitted for consideration to a judge.

File Number: 36654

**IN THE SUPREME COURT OF CANADA**  
**(ON APPEAL FROM THE FEDERAL COURT OF APPEAL)**

BETWEEN:

ASTRAZENECA CANADA INC.  
ASTRAZENECA AKTIEBOLAG and  
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Appellants

- and -

APOTEX INC. and  
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**AFFIDAVIT OF MARK W. LAUROESCH**  
**(Motion by Intellectual Property Owners Association for Leave to Intervene**  
**pursuant to Rules 47 and 55 of the *Rules of the Supreme Court of Canada*)**

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I, Mark W. Lauroesch, of the City of Washington, in the District of Columbia, in the United States of America, SWEAR THAT:

1. I am the Executive Director of the Intellectual Property Owners Association ("IPO"), and a member of the New York, Massachusetts, District of Columbia, and U.S. Patent & Trademark Office Bars. I have been the Executive Director of IPO since 2015, and served on IPO's Board of Directors from 2011 to 2013. I therefore have personal knowledge of the matters described below.

**IPO is an international voice for intellectual property rights across all industries**

2. Founded in 1972, IPO is an international trade association representing companies and individuals in all industries and fields of technology that own, or are interested in, intellectual property rights. IPO's membership includes about 200 companies and over 12,000 individuals who are involved in the association either through their companies or as an individual inventor, author, executive, law firm, or lawyer. IPO membership spans 43 countries.



3. IPO represents patent right holders in a broad spectrum of industries, including computer technology, biotechnology, telecommunications, household products, and oil and gas. Its Board of Directors is similarly comprised of representatives from a wide variety of companies including 3M Innovative Properties Co., Intel Corp., Ford Global Technologies LLC, Dow Chemical Co., Monsanto Co., Procter & Gamble Co., Hewlett Packard Enterprise Company, Pitney Bowes Inc., Shell International B.V., General Electric Co., Exxon Mobil Corp., DuPont, Apple Inc., AT&T, Boston Scientific Corp., IBM Corp., and Caterpillar Inc.

4. As owners of intellectual property, the members of IPO believe that intellectual property rights promote the innovation, creativity, and investment necessary to address major global challenges and improve lives around the world. IPO therefore strives to maximize innovation across all industries by fostering high quality intellectual property rights and effective, standardized intellectual property systems to obtain and enforce them, on behalf of all its members. To achieve its mission, IPO is committed to:

- (a) supporting member interests relating to legislative and international issues;
- (b) analyzing current intellectual property issues and issuing statements to governments, administrative agencies, courts, IPO members, and the public on proposed or adopted developments in intellectual property law;
- (c) providing information and educational services for IPO members and the public regarding intellectual property legislation, rules, and applicable treaties;
- (d) holding regular meetings and conferences to build knowledge and relationships within the intellectual property community; and
- (e) disseminating information to the general public on the importance of intellectual property rights.

5. IPO advocates for effective and affordable intellectual property ownership rights and global patent law harmonization. It works towards improving the efficacy of intellectual property law, including through the following initiatives:

- (a) promoting legislation and policy initiatives to reform patent, trade secret, copyright, and trademark laws, including representing the interests of its members before legislative and regulatory bodies and other governmental agencies;

- (b) filing amicus briefs with various international courts and tribunals on significant issues of intellectual property law;
  - (c) commenting on regulations and guidelines regarding intellectual property law implementation to assist members and administrative agencies in improving patent quality and the efficiency of patent prosecution;
  - (d) advocating for adequate funding for the U.S. Patent and Trademark Office;
  - (e) pursuing patent litigation reform to improve the value of patent regimes for private parties and the public as a whole; and
  - (f) combatting counterfeiting and piracy internationally.
6. IPO also strives to advance intellectual property literacy among its members and the general public, including through the following publications: the *IPO Daily News*, a concise daily summary of intellectual property cases, legislation, and events worldwide, and the *IPO Law Journal*, a forum for articles and reports for IPO members.

**IPO's past intervention as *amicus curiae***

7. On behalf of its members, IPO regularly files amicus briefs before courts in the United States, as well as other international courts, in cases involving intellectual property rights and policy. Indeed, in the United States, it is one of the largest filers of amicus briefs on significant intellectual property issues. IPO's Amicus Brief Committee and Board of Directors carefully select cases that are appropriate for IPO amicus briefs.

8. In the past six years alone, IPO has filed amicus briefs in 28 cases brought before the Supreme Court of the United States. Many of these cases related to issues of patent validity, including the following:

- (a) *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 890 (2016) (No. 15-446);
- (b) *Teva Pharm, USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831 (2015) (No. 13-854);
- (c) *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014) (No. 13-298);
- (d) *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014) (No. 13-369);

- (e) *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107 (2013) (No. 12-398);
- (f) *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012) (No. 10-1150); and
- (g) *Microsoft Corp. v. i4i Ltd. P'ship*, 564 U.S. 91 (2011) (No. 10-290).

**The interest of IPO in this appeal**

9. IPO's corporate membership is comprised of companies with valuable patent portfolios protecting their investments in research and development. Many of IPO's members operate internationally and maintain international patent portfolios, including in Canada. As a result, these companies have significant investments in Canadian intellectual property. These rights are subject to Canadian law, including the utility requirements imposed by the "promise of the patent."

10. The legal issues to be decided on this appeal will therefore affect IPO members in a variety of different ways. The outcome of this appeal will directly impact the validity of those patents currently before Canadian courts and the Canadian Intellectual Property Office. It will also affect the value of many more patents that might be subject to validity challenges in the future on the basis of the "promise of the patent." In addition, because patent laws and jurisprudence provide a framework for patentees to assess the risks involved in developing new inventions, the consequences of this appeal will dictate how IPO members approach their investments in research and development, their patent portfolios, and their intellectual property strategies in Canada.

11. IPO has a significant interest in ensuring that patent laws are implemented in a manner that promotes innovation and provides certainty to all stakeholders. Given IPO's international membership base, it also is a strong advocate for equivalent and effective intellectual property rights worldwide. Among other things, IPO is concerned with the ability of IPO members to file patent applications that will become valid patents in Canada using an international application under the Patent Cooperation Treaty ("PCT"), because the "promise doctrine" does not exist in other jurisdictions.

12. IPO also has an interest in ensuring that patent laws worldwide respect the underlying patent bargain between patentees and the public, which provides inventors with a limited monopoly in exchange for providing the public with useful inventions. While the public rightfully has an interest in invalidating patents for inventions that are not useful, both patentees and the public have an interest in a patent system that encourages innovation.

**IPO's position will be useful and different**

13. As an international association made up of individuals and companies who own significant patent portfolios worldwide, IPO brings a cross-border, cross-industry perspective that is distinct from the parties to this appeal.

14. Given IPO's long and consistent involvement with advocacy for the improved efficacy of patent rights and the universal harmonization of patent regimes, its intervention will ensure that views regarding the issues in this appeal will be presented from the broader perspective of owners of intellectual property rights across many countries and all industries.

15. IPO's diverse membership has significant experience with the development and enforcement of patent rights before administrative bodies and the courts around the world. As such, it will be able to assist the Court in understanding how the promise doctrine affects the innovative process that benefits not just the Canadian public, but also the international community. IPO is uniquely positioned to provide the Court with a perspective on the promise doctrine that is both international and encompasses all industries with an interest in Canadian patent law.

**Outline of IPO's proposed submissions**

16. If granted leave to intervene by this Court, I anticipate that IPO will make submissions along the following lines.

17. *The problems with the promise doctrine as applied by the Federal Courts.* The *Patent Act* simply requires that an *invention* be "useful." However, over the last decade or so, the promise doctrine has caused courts to focus on *the language in the patent disclosure* in assessing utility – not the underlying *invention*. The doctrine has been applied inconsistently, with courts construing modest promises in some cases, and dramatically expansive promises in others. This

trend has had a significant effect on the interests of patent holders and the validity of patents across a broad spectrum of industries, including pharmaceutical and mechanical patents. It has resulted in numerous patents for very useful inventions being invalidated for lack of utility.

18. IPO therefore supports the appellants' argument that the promise doctrine in its current form ought to be abolished. However, if it is granted leave to intervene in this appeal, IPO will posit that if the Court is inclined to maintain the promise doctrine as an integral aspect of the utility requirement, then it must be applied within a principled framework with clear guidelines so as to (1) provide patentees with certainty and predictability; and (2) respect the underlying patent bargain between the patentee and the public.

19. ***IPO's proposal: an invention-based framework for utility.*** "Utility" is a statutory prerequisite for an "invention," which, in turn, is a statutory prerequisite for a valid patent. Thus, the question of whether the invention meets the utility requirement must be answered by focusing on just that – the invention (as claimed in the patent). If granted leave to intervene by this Court, IPO will explain that "utility" should be assessed on the basis of the *Patent Act*, with the focus being "what is the utility required to support the claimed invention?"

20. Under this approach, the key question is "in light of what existed previously, what must the claimed art, process, machine, manufacture, or composition of matter (or improvement thereof) *actually do* to render it inventive?" This proposed framework places appropriate emphasis on the statutory requirement that an "invention" be "useful," rather than on the judge-made question of "what is the promise of this patent?" In addition, conducting the utility analysis with a view to whether the requisite level of utility has been met for there to be an invention protects against "promise inflation" (i.e., when courts rely on language in the specification to imply a "promised utility" to the claimed invention that far exceeds the utility required to support its inventiveness).

21. If IPO is granted leave to intervene in this appeal, based on this framework, it will propose the following two-step approach to determine the promised utility of an invention.

22. *Step one: what is the claimed invention?*

- (a) It is a well-known feature of the *Patent Act* that there can be different claims for different features or aspects of the invention. When assessing whether the claimed “invention” is “useful,” courts must therefore start the analysis by asking “what is it we are assessing?” That can only be answered by reference to the claim at issue.
- (b) This approach has the benefit of consistency with the *Patent Act*: for the requirements of novelty and non-obviousness, the *Act* mandates that what is assessed is “the subject-matter defined by a claim.” In determining whether the utility requirement (the third key criteria for a patent) is met, that same invention must be assessed. In other words, the “invention” that must be useful is the same “invention” that must be new and non-obvious.

23. *Step two: what must the claimed invention actually do to render it inventive?*

- (a) Once the claimed invention has been identified, the next question is “what utility is required to render this invention inventive?” This analysis must be done by recognizing that it is sufficient to satisfy the utility requirement if the patent provides the public with a “new article, a better article, a cheaper article, or affords the public a useful choice.”
- (b) This approach is also faithful to the utility requirement under the *Patent Act*, which requires usefulness to **form part of the invention**. The corollary of this principle is that if a particular use is not required to support the invention, then it cannot form part of the utility requirement. Put another way, the disclosure should not be read to impose promises beyond what is required to form the inventive concept. That would artificially inflate the utility requirement beyond what the statute contemplates.
- (c) This framework results in certain practical consequences in assessing utility:
  - (i) The role the disclosure plays in construing promise must mirror the role it plays in construing the claim (i.e., the disclosure should only be consulted when the promised utility “is not readily discernable from the claims

themselves”). The same rule should apply to promise. Where the promised utility is set out in the claim, that should be the promise.

- (ii) Statements in the disclosure should only form “promises” where they are required to support the invention, i.e., where they are an integral part of what makes the invention inventive in light of the prior art. This will encourage robust disclosure, rather than making patentees afraid to reveal anything about their invention, lest it be read as a “promise.”
- (iii) The way this would work in practice is that the court would assess whether an alleged “promise” in the disclosure is crucial to the inventive concept (i.e., necessary to render the invention new and non-obvious), or whether it is simply information offered by the patentee about its invention. Only the former would form part of the utility required to support the invention (i.e., the “promise”).

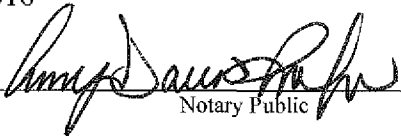
24. *The focus on invention obviates the disclosure requirement of the utility test.* The Federal Courts have also imparted a unique (and controversial) disclosure requirement in cases where the utility of the invention is based on a prediction (as opposed to demonstration). If it is granted leave to intervene in this appeal, IPO will argue that focusing on the invention means that there can be no disclosure requirement associated with utility.

25. This too is consistent with the *Patent Act*. The *Act* sets out detailed disclosure requirements for all patents. But there is no basis in the *Act* for any disclosure requirement specifically associated with utility; there is certainly no statutory basis for an extra disclosure requirement in sound prediction cases.


26. Moreover, there is no policy basis for a unique “sound prediction disclosure requirement.” The rationale for setting out criteria for a valid patent based on a prediction is to ensure that patents are not granted for “speculative” inventions. However, speculation goes to how much an inventor knows – not how much they disclose.

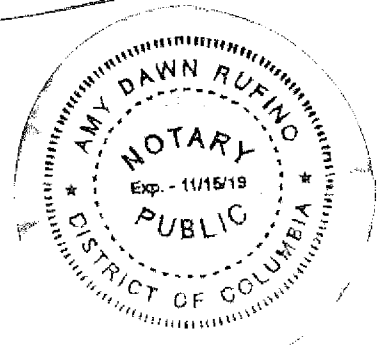
27. If permitted to intervene, IPO would cooperate with the parties to avoid repetition of argument and material.

SWORN BEFORE ME at the City of  
Washington, in the District of Columbia,  
United States of America, on July 28,  
2016

  
Notary Public

AMY DAWN RUFINO  
District of Columbia Notary Public  
My Commission Expires November 15, 2019

  
Mark W. Lauroesch





## PART I – FACTS

### Overview

1. This appeal requires this Court to consider the way in which the Federal Courts have been applying the *Patent Act* requirement of utility over the last decade. During this time, the Federal Courts have determined whether a patented invention is “useful” by looking at the words of the patent and asking whether it implies “promises” against which utility should be evaluated. Because it sets the threshold for the utility analysis, the “promise doctrine” plays a key role in ultimately determining patent validity. However, the way it has been applied by the Courts below has led to the invalidation of many patents for very useful inventions.

2. Intellectual Property Owners Association (IPO) is an international trade association representing companies and individuals who own intellectual property or are interested in promoting fair and effective intellectual property rights. Its members hold patents for inventions in a diverse range of technological fields, including but not limited to computer technology, biotechnology, household products, and oil and gas. As part of fulfilling its mission of advocating for effective patent rights worldwide, IPO has a long history of intervention in the United States and other international courts.

3. IPO has an interest in this appeal. As owners of patent portfolios spanning many countries, its members have an interest in ensuring that patent laws in all jurisdictions are applied in a manner that promotes investment and innovation. Moreover, many IPO members specifically hold patents in Canada that are subject to Canadian requirements for validity. As a result, the way in which the “promise of the patent” has been evaluated by the Courts below is a pressing issue for IPO members, as it has resulted in the invalidity of numerous patents for inventions that are in fact useful (typically at the hands of a competitor who wishes to sell such inventions).

4. IPO is well placed to provide this Court with useful submissions that are different from those of the parties. In contrast to the parties, who are pharmaceutical companies, IPO represents patent holders across a wide variety of industries. Moreover, IPO’s international viewpoint can be especially valuable in this case. Domestic patent rights are part of a worldwide patent system which have implications for innovation that go beyond the borders of any one country. IPO

therefore seeks leave to intervene to assist this Court by presenting the issues in this appeal from the broader perspective of owners of intellectual property rights across many countries and all industries with an interest in Canadian patent law.

5. If it is granted leave to intervene in this appeal, IPO will propose a new way to think about whether an invention meets the utility requirement – one that stems from, and is faithful to, the statutory requirement that an invention be “useful.”

## **IPO**

6. IPO is an international trade association representing companies and individuals in all industries and fields of technology that own, or are interested in, intellectual property rights. Its membership includes about 200 companies and over 12,000 individuals who are involved in the association either through their companies or as an individual inventor, author, executive, law firm, or lawyer.<sup>1</sup>

7. IPO represents patent right holders in a broad spectrum of industries, including computer technology, biotechnology, telecommunications, household products, and oil and gas. Its Board of Directors is similarly comprised of representatives from a wide variety of companies including 3M Innovative Properties Co., Intel Corp., Ford Global Technologies LLC, Dow Chemical Co., Monsanto Co., Procter & Gamble Co., Hewlett Packard Enterprise Company, Pitney Bowes Inc., Shell International B.V., General Electric Co., Exxon Mobil Corp., DuPont, Apple Inc., AT&T, Boston Scientific Corp., IBM Corp. and Caterpillar Inc.<sup>2</sup>

8. As owners of intellectual property, the members of IPO believe that intellectual property rights promote the innovation, creativity, and investment necessary to address major global challenges and improve lives around the world. IPO, on behalf of its members, therefore strives to maximize innovation across all industries by fostering high quality intellectual property rights and effective, standardized intellectual property systems to obtain and enforce them.<sup>3</sup>

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<sup>1</sup> Affidavit of Mark W. Lauroesch at ¶ 2, Motion Record, Tab 2 [Lauroesch Affidavit]

<sup>2</sup> Lauroesch Affidavit at ¶ 3, Motion Record, Tab 2

<sup>3</sup> Lauroesch Affidavit at ¶ 4, Motion Record, Tab 2

9. Because of its expertise, IPO frequently comments and is consulted on issues involving intellectual property, and patent rights in particular.<sup>4</sup> IPO is also involved in disseminating information about intellectual property rights to its members, government agencies, and the public as a whole.<sup>5</sup> IPO strives to improve the quality of intellectual property rights and works towards patent law harmonization, including through the following initiatives: promoting legislation and policy initiatives to reform patent laws, including representing the interests of its members before legislative and regulatory bodies and other governmental agencies; intervening in court proceedings addressing significant patent law issues in a number of countries; promoting adequate funding for the administrative bodies in charge of issuing patent, copyright, and trademark rights; pursuing patent litigation reform to improve the value of patent regimes for private parties and the public as a whole; and providing commentary on intellectual property cases, legislation and events worldwide.<sup>6</sup>

10. Given its international reach and expertise in patent rights across various industries and jurisdictions, IPO is uniquely positioned to assist the Court in understanding how the Federal Courts' application of the utility requirement affects innovation on an international level and in all industries.

#### **IPO's history of intervention**

11. IPO regularly files amicus briefs before courts in the United States, as well as other international courts, on behalf of its members in cases involving intellectual property rights and policy. In particular, it is one of the largest filers of amicus briefs on significant IP issues in the United States. IPO's Amicus Brief Committee and Board of Directors carefully selects cases that are appropriate for IPO intervention.<sup>7</sup>

12. In the past six years alone, IPO has filed amicus briefs in 28 cases brought before the Supreme Court of the United States. Many of these cases related to issues of patent validity and had far-reaching implications for patent rights globally, including the following:<sup>8</sup>

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<sup>4</sup> Lauroesch Affidavit at ¶ 4, Motion Record, Tab 2

<sup>5</sup> Lauroesch Affidavit at ¶ 3-6, Motion Record, Tab 2

<sup>6</sup> Lauroesch Affidavit at ¶ 5-6, Motion Record, Tab 2

<sup>7</sup> Lauroesch Affidavit at ¶ 6, Motion Record, Tab 2

<sup>8</sup> Lauroesch Affidavit at ¶ 7, Motion Record, Tab 2

- (a) *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 890 (2016) (No. 15-446) (on *inter partes* review);
- (b) *Teva Pharm, USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831 (2015) (No. 13-854) (on claim construction);
- (c) *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014) (No. 13-298) (on whether computer algorithms can be patentable subject matter);
- (d) *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014) (No. 13-369) (on indefiniteness);
- (e) *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107 (2013) (No. 12-398) (on the patentability of DNA sequences);
- (f) *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012) (No. 10-1150) (on whether certain medical procedures are patentable subject matter); and
- (g) *Microsoft Corp. v. i4i Ltd. P'ship*, 564 U.S. 91 (2011) (No. 10-290) (on re-examination procedure).

## PART II – QUESTION IN ISSUE

13. The issue in this motion is whether IPO should be granted leave to intervene in this appeal.

## PART III – ARGUMENT

### The test for leave to intervene

14. The Rules of this Court authorize the Court to grant leave to intervene to any person interested in an appeal. Leave to intervene will be granted if the prospective intervener shows (1) that it has an interest in the appeal and (2) that it will make submissions that will be useful and different from those of the parties.<sup>9</sup>

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<sup>9</sup> *Rules of the Supreme Court of Canada*, SOR/2002-156, Rule 55; *R v. Finta*, [1993] 1 S.C.R. 1138 at 1142 [*Finta*]; *Reference re Workers' Compensation Act, 1983 (Nfld.)*, [1989] 2 S.C.R. 335 at 339 [*Reference re Workers' Compensation*]

### **IPO has an interest in this appeal**

15. The standard for “interest” is interpreted broadly. This Court has held that “any interest is sufficient” to support an application to intervene in an appeal, subject to this Court’s discretion.<sup>10</sup> Intervener status has been granted to internationally-based associations of patent owners by this Court in the past for cases dealing with patent validity issues, including an appeal specifically addressing whether utility should be measured according to the “promise” of the patent.<sup>11</sup>

16. IPO has an interest in this appeal. Many of IPO’s members maintain patent portfolios in Canada to protect their research and development investments. The outcome of this appeal will therefore directly impact those patents that are subject to pending prosecutions or litigation. It will also affect the value of many more patents that may be subject to validity challenges in the future on the basis of the promise doctrine. More generally, this appeal will dictate how IPO members approach their patent portfolios and intellectual property investment strategies in Canada.

17. IPO also has an interest in ensuring that patent systems worldwide respect the bargain between patentees and the public that lies at the core of every patent. It therefore has an interest in ensuring that the test for utility and more specifically, the promise doctrine, does not undermine that bargain. In particular, IPO, on behalf of its members, has a direct stake in ensuring that the Canadian requirement for utility is applied with clarity and predictability, in a manner that both respects the underlying patent bargain, and is consistent with patent systems in the rest of the world.

### **IPO will make useful and different submissions**

18. The criterion of useful and different submissions “is easily satisfied by an applicant who has a history of involvement in the issue giving the applicant an expertise which can shed fresh light or provide new information on the matter.”<sup>12</sup> This Court has also noted that an intervener

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<sup>10</sup> *Norcan Limited v. Lebrock*, [1969] S.C.R. 665 at 666

<sup>11</sup> See *Apotex Inc., et al., v. Sanofi-Aventis, et al.*, Court File No. 35562

<sup>12</sup> *Reference re Workers’ Compensation* at 340

should be allowed to intervene when it can “present argument from a different perspective with respect to some of the issues” on appeal.<sup>13</sup>

19. As set out above, IPO has an extensive history in intervening on legal issues addressing intellectual property rights. It is uniquely positioned to provide this Court with a perspective that is both cross-industry and international. It is also well placed to assist this Court in understanding how its decision in this appeal will affect the development of new and useful inventions that will benefit Canadians and the international community as a whole.

20. IPO’s perspective on this appeal is different from that of the parties. The appellants’ argument focuses primarily on the *existence* of the promise doctrine as applied by the Federal Courts. It argues that because neither the *Patent Act* nor this Court’s jurisprudence provide a principled basis for the promise doctrine, the lower courts erred in finding the patent at issue to be invalid because the promise was not met.<sup>14</sup> In contrast, if granted leave to intervene, IPO will argue that if this Court chooses to uphold the promise doctrine, it should set out a statute-based framework for assessing utility that will enhance fairness and predictability, preventing it from becoming a wild card in every patent case. An outline of IPO’s proposed submissions is set out below.

### **IPO’s proposed submissions**

21. As this Court explained in *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.*, patent law is “wholly statutory” – an inventor “gets his patent according to the terms of the *Patent Act*, no more and no less.”<sup>15</sup> If permitted to intervene, IPO will propose a framework for assessing promised utility that is faithful to the structure and wording of the *Patent Act*.

22. ***The utility requirement under the Patent Act.*** The *Act* requires that patents may only be granted for an “invention.”<sup>16</sup> However, before something can qualify as an “invention,” the *Act* requires it to be “useful.”<sup>17</sup> While other jurisdictions have held that utility is a very low bar, and essentially only requires that the invention be capable of industrial application, Canada’s Federal

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<sup>13</sup> *Norberg v. Wynrib*, [1992] 2 S.C.R. 224 at 225

<sup>14</sup> Appellants’ Factum at ¶ 2

<sup>15</sup> *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.*, 2008 SCC 61 at ¶ 12

<sup>16</sup> *Patent Act*, R.S.C., 1985, c. P-4, s. 27(1), Motion Record, Tab 3A

<sup>17</sup> *Patent Act*, s. 2, Motion Record, Tab 3A

Courts have gone in the opposite direction, measuring utility by reference to essentially anything the patent says (or, in some cases, implies) about what the invention is capable of.

23. ***The problems with the promise doctrine as applied by the Federal Courts.*** In assessing whether the utility requirement is met, instead of looking at the invention, the Federal Courts have focused on the language in the patent disclosure, relying on words and phrases to impart various “promises” that must be met for validity. The result has been an inconsistent and unpredictable body of case law that focuses exclusively on the patent’s disclosure. This has distracted the Federal Courts. Instead of focusing on whether the claimed subject-matter is inventive, they focus on whether the patentee used the wrong words in the patent disclosure, and invalidating patents that have done so.

24. As a result, the utility requirement has become largely disconnected from a holistic view of patentability under the *Act*. This trend has had a significant effect on the interests of patent holders and the validity of patents across a broad spectrum of industries. It has led to numerous patents for undoubtedly useful inventions being invalidated for lack of utility.

25. If it is granted leave to intervene in this appeal, IPO will urge this Court to take a different approach to utility, which neither uses the language of “promise” nor focuses exclusively on the words of the patent. IPO appreciates that utility will not always simply require a “mere scintilla” of usefulness, that the required utility can be different for different inventions, and it often will need to be determined by the Court. However, it will argue that the utility requirement must be applied within a principled framework with clear guidelines that (1) provide patentees with certainty and predictability; and (2) respect the underlying patent bargain between the patentee and the public.

26. ***IPO’s Proposal: an invention-based framework for utility.*** If granted leave to intervene in this appeal, IPO will argue that “utility” should be assessed on the basis of the *Act*, with the focus being “what is the utility required to support the claimed invention?” The underlying rationale to this approach is that “utility” is a prerequisite for an “invention.” Thus, the question of whether the invention meets the utility requirement must be answered by focusing on the invention (as claimed in the patent).

27. This proposed framework emphasizes the statutory requirement that an “invention” be “useful.”<sup>18</sup> On this approach, the key question is “in light of what existed previously, what must the claimed art, process, machine, manufacture or composition of matter (or improvement thereof) actually do to render it inventive?” If IPO is granted leave to intervene in this appeal, it will propose the following two-step approach to determine the promised utility.

***Step one: what is the claimed invention?***

28. It is a well-known feature of the *Patent Act* that a single patent can contain numerous claims, claiming the invention in different aspects (e.g., a method and an apparatus), or at different levels of specificity (e.g., a genus and a species). As a result, the question of validity must be assessed on a claim-by-claim basis. When assessing whether the claimed “invention” is “useful,” courts must therefore start the analysis by asking “what is it we are assessing?” That can only be answered by reference to the claim(s) at issue.

29. This approach has the benefit of consistency with the *Patent Act*. In assessing novelty and non-obviousness, the *Act* specifically requires the Court to consider “the subject-matter defined by a claim.”<sup>19</sup> That same invention as claimed must be assessed for its utility.

***Step two: what must the claimed invention actually do to render it inventive?***

30. Because utility is required to make something an “invention,” once the claimed invention has been identified, the next question is “what must this new art, process, machine or composition of matter do to make it inventive?” This analysis must be conducted recognizing that it is sufficient to satisfy the utility requirement if the patent provides the public with a “new article, a better article, a cheaper article or affords the public a useful choice.”<sup>20</sup>

31. This approach is consistent with the utility requirement under the *Patent Act*, which recognizes that the utility requirement is directed to the function that **makes the claimed subject-matter into an actual invention**. The corollary of this requirement is that if a particular

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<sup>18</sup> *Patent Act*, s. 2, Motion Record, Tab 3A

<sup>19</sup> *Patent Act*, s. 28.2(1) and s. 28.3, Motion Record, Tab 3A

<sup>20</sup> *Consolboard Inc. v. MacMillan Bloedel (Sask.) Ltd.* [1981] 1 S.C.R. 504 at 525



use is not required to make something into an invention, then it should not matter for the purposes of validity, even if the patent discusses it as a potential use of the invention.

***Practical consequences of IPO's framework: rules for construing promised utility***

32. IPO's proposed framework results in certain practical consequences in assessing utility. IPO will submit that, in particular, applying the following two principles for construing promised utility will enhance consistency and predictability of Canada's patent system, to the benefit of all stakeholders in the system, including both patent owners and the public.

33. First, the disclosure should only be consulted when utility required to support the claimed invention "is not readily discernable from the claims themselves."<sup>21</sup> Where the utility is set out in the claim, no further inquiry is required. This parallels the rule used in construing the inventive concept (for the purposes of obviousness).

34. Second, even when the disclosure must be consulted (because the utility is not set out in the claim itself), then statements in the disclosure should only be part of the required utility when they are genuinely required to support the invention. This will protect against "inflation" in the utility analysis, and prevent the Courts below from relying on language in the specification to find a required utility that far exceeds what is required to support inventiveness.

***The focus on invention obviates the disclosure requirement of the utility test***

35. In assessing whether the utility requirement is met, the Federal Courts have also imposed a unique (and controversial) disclosure requirement in cases where the utility of the invention is based on a prediction (as opposed to demonstration). In those cases, the Federal Courts have required that the factual basis for the prediction, and sometimes also the sound line of reasoning for the prediction, be disclosed in the patent itself.

36. Although this additional disclosure requirement purports to be based on this Court's decision in *Apotex Inc. v. Wellcome Foundation Ltd.*, in that case this Court simply stated that there must be "proper disclosure."<sup>22</sup> It did not set out the specific content of that disclosure

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<sup>21</sup> *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.*, 2008 SCC 61 at ¶ 77

<sup>22</sup> *Apotex Inc. v. Wellcome Foundation Ltd.*, 2002 SCC 77 at ¶ 70

requirement. This Court in *Teva v. Pfizer* suggested that this additional disclosure requirement was unnecessary, but lower Courts have ignored this as *obiter*.<sup>23</sup>

37. This extra disclosure requirement is also inconsistent with the *Patent Act*. The *Act* sets out detailed disclosure requirements for all patents.<sup>24</sup> But there is no basis in the *Act* for any disclosure requirement specifically associated with utility – even when utility is based on a prediction.

38. The Federal Courts additional disclosure requirement in cases where the utility is based on prediction is also lacking in any policy basis. The sound prediction requirement exists to prevent patents from being granted for “speculative” inventions. However, this has nothing to do with the requirement of disclosure.

39. Thus, if it is granted leave to intervene in this appeal, IPO will argue that focusing on the invention means that there can be no disclosure requirement associated with utility (above and beyond the ordinary disclosure requirements set out in section 27 of the *Patent Act*). Space permitting, it will also discuss how this requirement is inconsistent with international instruments that are intended to facilitate the worldwide patent system.

40. If IPO is granted leave to intervene, in making its submissions, it will cooperate with the parties to avoid repetition of argument and materials.

#### **PART IV – SUBMISSIONS CONCERNING COSTS**

41. IPO will not seek costs and asks that no costs be awarded against it.

#### **PART V – ORDER SOUGHT**

42. IPO requests that an order be granted giving IPO leave to intervene in this appeal, to submit a factum not exceeding 10 pages in length, and to present oral submissions at the hearing of the appeal.

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<sup>23</sup> *Teva Canada Ltd. v. Pfizer Canada Inc.*, 2012 SCC 60 at ¶ 40

<sup>24</sup> *Patent Act*, s. 27, Motion Record, Tab 3A

August 2, 2016

ALL OF WHICH IS RESPECTFULLY SUBMITTED

  
as agent for

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Andrew E. Bernstein

  
as agent for

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Yael S. Bienenstock

Counsel for the Proposed Intervener,  
Intellectual Property Owners Association

## PART VI – TABLE OF AUTHORITIES

Authority	Reference in Argument
<i>Apotex Inc. v. Sanofi-Synthelabo Canada Inc.</i> , 2008 SCC 61 <a href="http://scc-csc.lexum.com/scc-csc/scc-csc/en/item/2575/index.do">http://scc-csc.lexum.com/scc-csc/scc-csc/en/item/2575/index.do</a>	21, 33
<i>Apotex Inc. v. Wellcome Foundation Ltd.</i> , 2002 SCC 77 <a href="http://scc-csc.lexum.com/scc-csc/scc-csc/en/item/2020/index.do">http://scc-csc.lexum.com/scc-csc/scc-csc/en/item/2020/index.do</a>	36
<i>Apotex Inc., et al., v. Sanofi-Aventis, et al.</i> , Court File No. 35562 <a href="http://www.scc-csc.ca/case-dossier/info/dock-regi-eng.aspx?cas=35562">http://www.scc-csc.ca/case-dossier/info/dock-regi-eng.aspx?cas=35562</a>	15
<i>Consolboard Inc. v. MacMillan Bloedel (Sask.) Ltd.</i> [1981] 1 S.C.R. 504 <a href="http://scc-csc.lexum.com/scc-csc/scc-csc/en/item/2426/index.do">http://scc-csc.lexum.com/scc-csc/scc-csc/en/item/2426/index.do</a>	30
<i>Norberg v. Wynrib</i> , [1992] 2 S.C.R. 224 <a href="http://scc-csc.lexum.com/scc-csc/scc-csc/en/item/892/index.do">http://scc-csc.lexum.com/scc-csc/scc-csc/en/item/892/index.do</a>	18
<i>Norcan Limited v. Lebrock</i> , [1969] S.C.R. 665 <a href="http://scc-csc.lexum.com/scc-csc/scc-csc/en/item/5025/index.do">http://scc-csc.lexum.com/scc-csc/scc-csc/en/item/5025/index.do</a>	15
<i>R v. Finta</i> , [1993] 1 S.C.R. 1138 <a href="http://scc-csc.lexum.com/scc-csc/scc-csc/en/item/990/index.do">http://scc-csc.lexum.com/scc-csc/scc-csc/en/item/990/index.do</a>	14
<i>Reference re Workers' Compensation Act, 1983 (Nfld.)</i> , [1989] 2 S.C.R. 335 2 <a href="http://scc-csc.lexum.com/scc-csc/scc-csc/en/item/502/index.do">http://scc-csc.lexum.com/scc-csc/scc-csc/en/item/502/index.do</a>	14, 18
<i>Teva Canada Ltd. v. Pfizer Canada Inc.</i> , 2012 SCC 60 <a href="http://scc-csc.lexum.com/scc-csc/scc-csc/en/item/12679/index.do">http://scc-csc.lexum.com/scc-csc/scc-csc/en/item/12679/index.do</a>	36

**PART VII – STATUTORY PROVISIONS**

<b>Tab</b>	<b>Authority</b>
3A	<i>Patent Act</i> , R.S.C., 1985, c. P-4, ss. 2, 27, 27(1), 28.2(1), 28.3



CANADA

CONSOLIDATION

CODIFICATION

## Patent Act

## Loi sur les brevets

R.S.C., 1985, c. P-4

L.R.C. (1985), ch. P-4

Current to June 21, 2016

À jour au 21 juin 2016

Last amended on June 17, 2015

Dernière modification le 17 juin 2015



R.S.C., 1985, c. P-4

L.R.C., 1985, ch. P-4

## An Act respecting patents of invention

## Loi concernant les brevets d'invention

### Short Title

### Titre abrégé

#### Short title

**1** This Act may be cited as the *Patent Act*.

R.S., c. P-4, s. 1.

#### Titre abrégé

**1** *Loi sur les brevets*.

S.R., ch. P-4, art. 1.

### Interpretation

### Définitions

#### Definitions

**2** In this Act, except as otherwise provided,

**applicant** includes an inventor and the legal representatives of an applicant or inventor; (*demandeur*)

**claim date** means the date of a claim in an application for a patent in Canada, as determined in accordance with section 28.1;

**Commissioner** means the Commissioner of Patents; (*commissaire*)

**country** includes a Member of the World Trade Organization, as defined in subsection 2(1) of the *World Trade Organization Agreement Implementation Act*; (*pays*)

**filing date** means, in relation to an application for a patent in Canada, the date on which the application is filed, as determined in accordance with section 28; (*date de dépôt*)

**invention** means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter; (*invention*)

**legal representatives** includes heirs, executors, administrators, guardians, curators, tutors, assigns and all other persons claiming through or under applicants for patents and patentees of inventions; (*représentants légaux*)

#### Définitions

**2** Sauf disposition contraire, les définitions qui suivent s'appliquent à la présente loi.

**brevet** Lettres patentes couvrant une invention. (*patent*)

**breveté** ou **titulaire d'un brevet** Le titulaire ayant pour le moment droit à l'avantage d'un brevet. (*patenté*)

**commissaire** Le commissaire aux brevets. (*Commissioner*)

**date de dépôt** La date du dépôt d'une demande de brevet, déterminée conformément à l'article 28. (*filing date*)

**date de priorité** [Abrogée, 1993, ch. 15, art. 26]

**demande de priorité** La demande visée à l'article 28.4. (*request for priority*)

**demandeur** Sont assimilés à un demandeur un inventeur et les représentants légaux d'un demandeur ou d'un inventeur. (*applicant*)

**exploitation sur une échelle commerciale** [Abrogée, 1993, ch. 44, art. 189]

**invention** Toute réalisation, tout procédé, toute machine, fabrication ou composition de matières, ainsi que tout perfectionnement de l'un d'eux, présentant le caractère de la nouveauté et de l'utilité. (*invention*)

**Minister** means the Minister of Industry or such other member of the Queen's Privy Council for Canada as is designated by the Governor in Council as the Minister for the purposes of this Act; (*ministre*)

**patent** means letters patent for an invention; (*brevet*)

**patentee** means the person for the time being entitled to the benefit of a patent; (*breveté* ou *titulaire d'un brevet*)

**predecessor in title** includes any person through whom an applicant for a patent in Canada claims the right to the patent; (*prédécesseur en droit*)

**prescribed** means prescribed by rules or regulations of the Governor in Council and, in the case of a fee, includes a fee determined in the manner prescribed; (*réglementaire*)

**prescribed fee** [Repealed, R.S., 1985, c. 33 (3rd Supp.), s. 1]

**priority date** [Repealed, 1993, c. 15, s. 26]

**regulation** and **rule** include rule, regulation and form; (*règlement* et *règle*)

**request for priority** means a request under section 28.4. (*demande de priorité*)

**work on a commercial scale** [Repealed, 1993, c. 44, s. 189]

R.S., 1985, c. P-4, s. 2; R.S., 1985, c. 33 (3rd Supp.), s. 1; 1992, c. 1, s. 145(F); 1993, c. 2, s. 2, c. 15, s. 26, c. 44, s. 189; 1994, c. 47, s. 141; 1995, c. 1, s. 62.

## Her Majesty

### Binding on Her Majesty

**2.1** This Act is binding on Her Majesty in right of Canada or a province.

1993, c. 44, s. 190.

## Patent Office and Officers

### Patent Office

**3** There shall be attached to the Department of Industry, or to such other department of the Government of Canada as may be determined by the Governor in Council, an office called the Patent Office.

R.S., 1985, c. P-4, s. 3; 1992, c. 1, s. 145(F); 1995, c. 1, s. 63.

**ministre** Le ministre de l'Industrie ou tel autre membre du Conseil privé de la Reine pour le Canada chargé par le gouverneur en conseil de l'application de la présente loi. (*Minister*)

**pays** Notamment un membre de l'Organisation mondiale du commerce au sens du paragraphe 2(1) de la *Loi de mise en œuvre de l'Accord sur l'Organisation mondiale du commerce*. (*country*)

**prédécesseur en droit** Est assimilée à un prédécesseur en droit toute personne par l'intermédiaire de laquelle le demandeur de brevet réclame le droit à celui-ci. (*predecessor in title*)

**règlement** et **règle** S'entendent notamment d'une formule. (*regulation* and *rule*)

**réglementaire** Prescrit par règle ou règlement du gouverneur en conseil; dans le cas où le terme qualifie une taxe, s'entend en outre d'une taxe dont le montant est déterminé selon les modalités réglementaires. (*prescribed*)

**représentants légaux** Sont assimilés aux représentants légaux les héritiers, exécuteurs testamentaires, administrateurs, gardiens, curateurs, tuteurs, ayants droit, ainsi que toutes autres personnes réclamant par l'intermédiaire ou à la faveur de demandeurs et de titulaires de brevets. (*legal representatives*)

**taxe réglementaire** [Abrogée, L.R. (1985), ch. 33 (3<sup>e</sup> suppl.), art. 1]

L.R. (1985), ch. P-4, art. 2; L.R. (1985), ch. 33 (3<sup>e</sup> suppl.), art. 1; 1992, ch. 1, art. 145(F); 1993, ch. 2, art. 2, ch. 15, art. 26, ch. 44, art. 189; 1994, ch. 47, art. 141; 1995, ch. 1, art. 62.

## Sa Majesté

### Obligation de Sa Majesté

**2.1** La présente loi lie Sa Majesté du chef du Canada ou d'une province.

1993, ch. 44, art. 190.

## Bureau des brevets et fonctionnaires

### Bureau des brevets

**3** Est attaché au ministère de l'Industrie, ou à tout autre ministère fédéral que le gouverneur en conseil peut désigner, un bureau appelé le Bureau des brevets.

L.R. (1985), ch. P-4, art. 3; 1992, ch. 1, art. 145(F); 1995, ch. 1, art. 63.



### Publication of list of patents

**26.1 (1)** The Commissioner shall, at least once in each year, publish a list of all patents issued in the year.

### Publication and printing of documents

**(2)** The Commissioner may publish any document open to the inspection of the public under section 10 and may print or cause to be printed, for distribution or sale, any such document.

R.S., 1986, c. 33 (3rd Suppl.), s. 7.

## Application for Patents

### Commissioner may grant patents

**27 (1)** The Commissioner shall grant a patent for an invention to the inventor or the inventor's legal representative if an application for the patent in Canada is filed in accordance with this Act and all other requirements for the issuance of a patent under this Act are met.

### Application requirements

**(2)** The prescribed application fee must be paid and the application must be filed in accordance with the regulations by the inventor or the inventor's legal representative and the application must contain a petition and a specification of the invention.

### Specification

**(3)** 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.

### Liste des brevets

**26.1 (1)** Le commissaire fait publier, au moins une fois l'an, la liste des brevets accordés et délivrés dans l'année.

### Publication

**(2)** Le commissaire peut faire publier pour vente ou distribution tout document accessible pour consultation sous le régime de l'article 10.

L.R. (1986), ch. 33 (3<sup>e</sup> suppl.), art. 7.

## Demandes de brevets

### Délivrance de brevet

**27 (1)** Le commissaire accorde un brevet d'invention à l'inventeur ou à son représentant légal si la demande de brevet est déposée conformément à la présente loi et si les autres conditions de celle-ci sont remplies.

### Dépôt de la demande

**(2)** L'inventeur ou son représentant légal doit déposer, en la forme réglementaire, une demande accompagnée d'une pétition et du mémoire descriptif de l'invention et payer les taxes réglementaires.

### Mémoire descriptif

**(3)** Le mémoire descriptif doit :

- a)** décrire d'une façon exacte et complète l'invention et son application ou exploitation, telles que les a conçues son inventeur;
- b)** exposer clairement les diverses phases d'un procédé, ou le mode de construction, de confection, de composition ou d'utilisation d'une machine, d'un objet manufacturé ou d'un composé de matières, dans des termes complets, clairs, concis et exacts qui permettent à toute personne versée dans l'art ou la science dont relève l'invention, ou dans l'art ou la science qui s'en rapproche le plus, de confectionner, construire, composer ou utiliser l'invention;
- c)** s'il s'agit d'une machine, en expliquer clairement le principe et la meilleure manière dont son inventeur en a conçu l'application;
- d)** s'il s'agit d'un procédé, expliquer la suite nécessaire, le cas échéant, des diverses phases du procédé, de façon à distinguer l'invention en cause d'autres inventions.

### Claims

(4) The specification must end with a claim or claims defining distinctly and in explicit terms the subject-matter of the invention for which an exclusive privilege or property is claimed.

### Alternative definition of subject-matter

(5) For greater certainty, where a claim defines the subject-matter of an invention in the alternative, each alternative is a separate claim for the purposes of sections 2, 28.1 to 28.3 and 78.3.

### When application to be completed

(6) Where an application does not completely meet the requirements of subsection (2) on its filing date, the Commissioner shall, by notice to the applicant, require the application to be completed on or before the date specified in the notice.

### Specified period

(7) The specified date must be at least three months after the date of the notice and at least twelve months after the filing date of the application.

### What may not be patented

(8) No patent shall be granted for any mere scientific principle or abstract theorem.

R.S., 1985, c. P-4, s. 27; R.S., 1985, c. 33 (3rd Supp.), s. 8; 1993, c. 15, s. 31, c. 44, s. 192.

### Maintenance fees

**27.1 (1)** An applicant for a patent shall, to maintain the application in effect, pay to the Commissioner such fees, in respect of such periods, as may be prescribed.

**(2) and (3)** [Repealed, 1993, c. 15, s. 32]

R.S., 1985, c. 33 (3rd Supp.), s. 9; 1993, c. 15, s. 32.

### Filing date

**28 (1)** The filing date of an application for a patent in Canada is the date on which the Commissioner receives the documents, information and fees prescribed for the purposes of this section or, if they are received on different dates, the last date.

### Deemed date of receipt of fees

(2) The Commissioner may, for the purposes of this section, deem prescribed fees to have been received on a date earlier than the date of their receipt if the Commissioner considers it just to do so.

R.S., 1985, c. P-4, s. 28; R.S., 1985, c. 33 (3rd Supp.), s. 10; 1993, c. 15, s. 33.

### Revendications

(4) Le mémoire descriptif se termine par une ou plusieurs revendications définissant distinctement et en des termes explicites l'objet de l'invention dont le demandeur revendique la propriété ou le privilège exclusif.

### Variantes

(5) Il est entendu que, pour l'application des articles 2, 28.1 à 28.3 et 78.3, si une revendication définit, par variantes, l'objet de l'invention, chacune d'elles constitue une revendication distincte.

### Demande incomplète

(6) Si, à la date de dépôt, la demande ne remplit pas les conditions prévues au paragraphe (2), le commissaire doit, par avis, requérir le demandeur de la compléter au plus tard à la date qui y est mentionnée.

### Délai

(7) Ce délai est d'au moins trois mois à compter de l'avis et d'au moins douze mois à compter de la date de dépôt de la demande.

### Ce qui n'est pas brevetable

(8) Il ne peut être octroyé de brevet pour de simples principes scientifiques ou conceptions théoriques.

L.R. (1986), ch. P-4, art. 27; L.R. (1986), ch. 33 (3<sup>e</sup> suppl.), art. 8; 1993, ch. 15, art. 31, ch. 44, art. 192.

### Taxes périodiques

**27.1 (1)** Le demandeur est tenu de payer au commissaire, afin de maintenir sa demande en état, les taxes réglementaires pour chaque période réglementaire.

**(2) et (3)** [Abrogés, 1993, ch. 15, art. 32]

L.R. (1986), ch. 33 (3<sup>e</sup> suppl.), art. 9; 1993, ch. 15, art. 32.

### Date de dépôt

**28 (1)** La date de dépôt d'une demande de brevet est la date à laquelle le commissaire reçoit les documents, renseignements et taxes réglementaires prévus pour l'application du présent article. S'ils sont reçus à des dates différentes, il s'agit de la dernière d'entre elles.

### Taxes réglementaires

(2) Pour l'application du paragraphe (1), le commissaire peut, s'il estime que cela est équitable, fixer une date de réception des taxes antérieure à celle à laquelle elles ont été reçues.

L.R. (1986), ch. P-4, art. 28; L.R. (1986), ch. 33 (3<sup>e</sup> suppl.), art. 10; 1993, ch. 15, art. 33.

### Claim date

**28.1 (1)** The date of a claim in an application for a patent in Canada (the “pending application”) is the filing date of the application, unless

(a) the pending application is filed by

(i) a person who has, or whose agent, legal representative or predecessor in title has, previously regularly filed in or for Canada an application for a patent disclosing the subject-matter defined by the claim, or

(ii) a person who is entitled to protection under the terms of any treaty or convention relating to patents to which Canada is a party and who has, or whose agent, legal representative or predecessor in title has, previously regularly filed in or for any other country that by treaty, convention or law affords similar protection to citizens of Canada an application for a patent disclosing the subject-matter defined by the claim;

(b) the filing date of the pending application is within twelve months after the filing date of the previously regularly filed application; and

(c) the applicant has made a request for priority on the basis of the previously regularly filed application.

### Claims based on previously regularly filed applications

**(2)** In the circumstances described in paragraphs (1)(a) to (c), the claim date is the filing date of the previously regularly filed application.

1993, c. 16, s. 33.

### Subject-matter of claim must not be previously disclosed

**28.2 (1)** The subject-matter defined by a claim in an application for a patent in Canada (the “pending application”) must not have been disclosed

(a) more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant, in such a manner that the subject-matter became available to the public in Canada or elsewhere;

(b) before the claim date by a person not mentioned in paragraph (a) in such a manner that the subject-matter became available to the public in Canada or elsewhere;

### Date de la revendication

**28.1 (1)** La date de la revendication d’une demande de brevet est la date de dépôt de celle-ci, sauf si :

a) la demande est déposée, selon le cas :

(i) par une personne qui a antérieurement déposé de façon régulière, au Canada ou pour le Canada, ou dont l’agent, le représentant légal ou le prédécesseur en droit l’a fait, une demande de brevet divulguant l’objet que définit la revendication,

(ii) par une personne qui a antérieurement déposé de façon régulière, dans un autre pays ou pour un autre pays, ou dont l’agent, le représentant légal ou le prédécesseur en droit l’a fait, une demande de brevet divulguant l’objet que définit la revendication, dans le cas où ce pays protège les droits de cette personne par traité ou convention, relatif aux brevets, auquel le Canada est partie, et accorde par traité, convention ou loi une protection similaire aux citoyens du Canada;

b) elle est déposée dans les douze mois de la date de dépôt de la demande déposée antérieurement;

c) le demandeur a présenté, à l’égard de sa demande, une demande de priorité fondée sur la demande déposée antérieurement.

### Date de dépôt de la demande antérieure

**(2)** Dans le cas où les alinéas (1)a) à c) s’appliquent, la date de la revendication est la date de dépôt de la demande antérieurement déposée de façon régulière.

1993, ch. 16, art. 33.

### Objet non divulgué

**28.2 (1)** L’objet que définit la revendication d’une demande de brevet ne doit pas :

a) plus d’un an avant la date de dépôt de celle-ci, avoir fait, de la part du demandeur ou d’un tiers ayant obtenu de lui l’information à cet égard de façon directe ou autrement, l’objet d’une communication qui l’a rendu accessible au public au Canada ou ailleurs;

b) avant la date de la revendication, avoir fait, de la part d’une autre personne, l’objet d’une communication qui l’a rendu accessible au public au Canada ou ailleurs;

c) avoir été divulgué dans une demande de brevet qui a été déposée au Canada par une personne autre que le demandeur et dont la date de dépôt est antérieure à

(c) in an application for a patent that is filed in Canada by a person other than the applicant, and has a filing date that is before the claim date; or

(d) in an application (the “co-pending application”) for a patent that is filed in Canada by a person other than the applicant and has a filing date that is on or after the claim date if

(i) the co-pending application is filed by

(A) a person who has, or whose agent, legal representative or predecessor in title has, previously regularly filed in or for Canada an application for a patent disclosing the subject-matter defined by the claim, or

(B) a person who is entitled to protection under the terms of any treaty or convention relating to patents to which Canada is a party and who has, or whose agent, legal representative or predecessor in title has, previously regularly filed in or for any other country that by treaty, convention or law affords similar protection to citizens of Canada an application for a patent disclosing the subject-matter defined by the claim,

(ii) the filing date of the previously regularly filed application is before the claim date of the pending application,

(iii) the filing date of the co-pending application is within twelve months after the filing date of the previously regularly filed application, and

(iv) the applicant has, in respect of the co-pending application, made a request for priority on the basis of the previously regularly filed application.

#### Withdrawal of application

(2) An application mentioned in paragraph (1)(c) or a co-pending application mentioned in paragraph (1)(d) that is withdrawn before it is open to public inspection shall, for the purposes of this section, be considered never to have been filed.

1993, c. 15, s. 33.

#### Invention must not be obvious

**28.3** The subject-matter defined by a claim in an application for a patent in Canada must be subject-matter that would not have been obvious on the claim date to a person skilled in the art or science to which it pertains, having regard to

(a) information disclosed more than one year before the filing date by the applicant, or by a person who

la date de la revendication de la demande visée à l’alinéa (1)a);

d) avoir été divulgué dans une demande de brevet qui a été déposée au Canada par une personne autre que le demandeur et dont la date de dépôt correspond ou est postérieure à la date de la revendication de la demande visée à l’alinéa (1)a) si :

(i) cette personne, son agent, son représentant légal ou son prédécesseur en droit, selon le cas :

(A) a antérieurement déposé de façon régulière, au Canada ou pour le Canada, une demande de brevet divulguant l’objet que définit la revendication de la demande visée à l’alinéa (1)a),

(B) a antérieurement déposé de façon régulière, dans un autre pays ou pour un autre pays, une demande de brevet divulguant l’objet que définit la revendication de la demande visée à l’alinéa (1)a), dans le cas où ce pays protège les droits de cette personne par traité ou convention, relatif aux brevets, auquel le Canada est partie, et accorde par traité, convention ou loi une protection similaire aux citoyens du Canada,

(ii) la date de dépôt de la demande déposée antérieurement est antérieure à la date de la revendication de la demande visée à l’alinéa a),

(iii) à la date de dépôt de la demande, il s’est écoulé, depuis la date de dépôt de la demande déposée antérieurement, au plus douze mois,

(iv) cette personne a présenté, à l’égard de sa demande, une demande de priorité fondée sur la demande déposée antérieurement.

#### Retrait de la demande

(2) Si la demande de brevet visée à l’alinéa (1)c) ou celle visée à l’alinéa (1)d) a été retirée avant d’être devenue accessible au public, elle est réputée, pour l’application des paragraphes (1) ou (2), n’avoir jamais été déposée.

1993, ch. 15, art. 33.

#### Objet non évident

**28.3** L’objet que définit la revendication d’une demande de brevet ne doit pas, à la date de la revendication, être évident pour une personne versée dans l’art ou la science dont relève l’objet, eu égard à toute communication :

a) qui a été faite, plus d’un an avant la date de dépôt de la demande, par le demandeur ou un tiers ayant obtenu de lui l’information à cet égard de façon directe

obtained knowledge, directly or indirectly, from the applicant in such a manner that the information became available to the public in Canada or elsewhere; and

(b) information disclosed before the claim date by a person not mentioned in paragraph (a) in such a manner that the information became available to the public in Canada or elsewhere.

1993, c. 15, s. 33.

#### **Request for priority**

**28.4 (1)** For the purposes of sections 28.1, 28.2 and 78.3, an applicant for a patent in Canada may request priority in respect of the application on the basis of one or more previously regularly filed applications.

#### **Requirements governing request**

(2) The request for priority must be made in accordance with the regulations and the applicant must inform the Commissioner of the filing date, country or office of filing and number of each previously regularly filed application on which the request is based.

#### **Withdrawal of request**

(3) An applicant may, in accordance with the regulations, withdraw a request for priority, either entirely or with respect to one or more previously regularly filed applications.

#### **Multiple previously regularly filed applications**

(4) Where two or more applications have been previously regularly filed as described in paragraph 28.1(1)(a), subparagraph 28.2(1)(d)(i) or paragraph 78.3(1)(a) or (2)(a), either in the same country or in different countries,

(a) paragraph 28.1(1)(b), subparagraph 28.2(1)(d)(iii) or paragraph 78.3(1)(b) or (2)(b), as the case may be, shall be applied using the earliest filing date of the previously regularly filed applications; and

(b) subsection 28.1(2), subparagraph 28.2(1)(d)(ii) or paragraph 78.3(1)(d) or (2)(d), as the case may be, shall be applied using the earliest filing date of the previously regularly filed applications on the basis of which a request for priority is made.

#### **Withdrawal, etc., of previously regularly filed applications**

(5) A previously regularly filed application mentioned in section 28.1 or 28.2 or subsection 78.3(1) or (2) shall, for

ou autrement, de manière telle qu'elle est devenue accessible au public au Canada ou ailleurs;

b) qui a été faite par toute autre personne avant la date de la revendication de manière telle qu'elle est devenue accessible au public au Canada ou ailleurs.

1993, ch. 15, art. 33.

#### **Demande de priorité**

**28.4 (1)** Pour l'application des articles 28.1, 28.2 et 78.3, le demandeur de brevet peut présenter une demande de priorité fondée sur une ou plusieurs demandes de brevet antérieurement déposées de façon régulière.

#### **Conditions**

(2) Le demandeur la présente selon les modalités réglementaires; il doit aussi informer le commissaire du nom du pays ou du bureau où a été déposée toute demande de brevet sur laquelle la demande de priorité est fondée, ainsi que de la date de dépôt et du numéro de cette demande de brevet.

#### **Retrait de la demande**

(3) Il peut, selon les modalités réglementaires, la retirer à l'égard de la demande déposée antérieurement; dans les cas où la demande de priorité est fondée sur plusieurs demandes, il peut la retirer à l'égard de toutes celles-ci ou d'une ou de plusieurs d'entre elles.

#### **Plusieurs demandes**

(4) Dans le cas où plusieurs demandes de brevet ont été déposées antérieurement dans le même pays ou non :

a) la date de dépôt de la première demande est retenue pour l'application de l'alinéa 28.1(1)b), du sous-alinéa 28.2(1)d)(iii) et des alinéas 78.3(1)b) et (2)b), selon le cas;

b) la date de dépôt de la première des demandes sur lesquelles la demande de priorité est fondée est retenue pour l'application du paragraphe 28.1(2), du sous-alinéa 28.2(1)d)(ii) et des alinéas 78.3(1)d) et (2)d), selon le cas.

#### **Retrait de demandes déposées antérieurement**

(5) Pour l'application des articles 28.1 et 28.2 et des paragraphes 78.3(1) et (2), une demande de brevet déposée