



# Recent CIPO Examination Practice Guidelines

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# Two New Guidelines

1. PN2013-02 Examination Practice Respecting Purposive Construction
2. PN2013-03 Examination Practice Respecting Computer-Implemented Inventions

# The Good News

1. CIPO has recognized that claims are to be construed using a “purposive construction”;
2. No more claim construction based on “contribution over the prior art”
3. No more requirement for a technological solution to a technical problem

# The Concern

1. CIPO has a distorted view of purposive construction;
  - a) Purposive construction involves considering whether a claim element is essential or non-essential;
  - b) The Patent Office Approach for determining essentiality is not consistent with the Supreme Court's approach

# Supreme Court Approach (Free World Trust)

- a) The Patent Act promotes adherence to the language of the claims.
- b) Adherence to the language of the claims in turn promotes both fairness and predictability.
- c) The claim language must, however, be read in an informed and purposive way.
- d) The language of the claims thus construed defines the monopoly. There is no recourse to such vague notions as the “spirit of the invention” to expand it further.

# Supreme Court Approach (Free World Trust)

- e) The claim language will, on a purposive construction, show that some elements of the claimed invention are essential while others are non-essential. The identification of elements as essential or non-essential is made:
  - i. on the basis of the common knowledge of the worker skilled in the art to which the patent relates;
  - ii. as of the date the patent is published;

# Supreme Court Approach (Free World Trust)

- iii. having regard to whether or not it was obvious to the skilled reader at the time the patent was published that a variant of a particular element would not make a difference to the way in which the invention works; or
- iv. according to the intent of the inventor, expressed or inferred from the claims, that a particular element is essential irrespective of its practical effect;
- v. without, however, resort to extrinsic evidence of the inventor's intention.

# Supreme Court Approach (Free World Trust)

- f) There is no infringement if an essential element is different or omitted. There may still be infringement, however, if non-essential elements are substituted or omitted.

# CA Supreme Court Approach (Improver v. Remington)

1. Does the variant have a material effect?
2. Would the fact that the variant has no material effect have been obvious at the date of publication
3. Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended strict compliance with the primary meaning was an essential requisite of the invention

# CA Supreme Court Approach (Improver v. Remington)

- The word or expression in the claim is to be considered essential unless the context of the claim language otherwise dictates

# Patent Office Approach

Examiners must interpret each claim:

1. Using a fair, balanced and informed approach
2. Having identified the problem and solution\*
3. In the context of the application as a whole
4. To determine which elements of the claim solve the identified problem\*
  - i. Missing elements
  - ii. Superfluous elements
5. By focusing on one solution to a problem\*

# Patent Office Approach

- Where a computer is found to be an essential element -  
STATUTORY
  - A good indicator is that the claim is directed to a technical solution to a technical problem
- Examiner will consider
  - background of invention
  - objects of the invention
  - any specific problems, needs, limitations or disadvantages known in the art or discovered by the inventors, etc. identifying the problem faced by the inventors

# Patent Office Approach

Possible key considerations by the office:

- Computer problem vs. non-computer problem

# Patent Office Approach

## Computer Problem:

- Description details a specific problem with the operation of a computer
- Solution to problem involves controlling a chip, system component or technical architecture element such as through firmware
- Description emphasizes challenges or deficiencies in prior computers
- There is a significant level of detail in description the algorithm or logic peripheral of the computer

# Patent Office Approach

## Not a Computer Problem:

- There is an explicit statement in the description suggesting a problem other than a computer problem
- There is an absence of any explicit indication in the application that any practical problem related to the operation of a computer was overcome
- There is a relative absence of technical details, despite an indication in the description that the solution should be implemented on a computer

# Patent Office Approach

Not a computer problem:

- Examiners must carefully consider whether a computer is essential to the solution or if its use is simply a convenience or afterthought

## Example 1

- Solution is calculations according to a specific equation
- Computer expedites mechanical manipulations without having a material effect on the operation of the equation itself
  - therefore computer is not an essential element

# Patent Office Approach

## Example 2

- Description emphasizes a solution described in conceptual terms
- Examiner must consider:
  - Does the claim define a specific solution or simply the idea or concept of solving the problem
- A lack of detail regarding implementation may point to a claim being merely the idea to use a computer to carry out certain operations where, in view of the specification as a whole, the claimed elements do not appear to define a specific manner of operating the solution.

# Thank You

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