

## Examination Practice Respecting Purposive Construction

PN2013-02

March 8, 2013

To all examiners:

In *Canada (Attorney General) v Amazon.com Inc.*, 2011 FCA 328 [*Amazon FCA*], the Court observed that, during examination, Supreme Court jurisprudence “requires the Commissioner’s identification of the actual invention to be grounded in a purposive construction of the patent claims”.<sup>1</sup>

As outlined by the Supreme Court in *Free World Trust* and *Whirlpool*, purposive construction is performed by the court to objectively determine what the person skilled in the art would, as of the date of publication of the patent application and on the basis of the particular words or phrases used in the claim, have understood the applicant to have intended to be the scope of protection sought for the disclosed invention.<sup>2</sup>

### Context for examination

*Free World Trust* and *Whirlpool* continue to guide the courts, with the benefit of expert testimony and cross-examination, to construe the claim in accordance with the principles of purposive construction outlined therein.<sup>3</sup> As noted in *Genencor*, however, *Whirlpool* was an impeachment proceeding that was not directed “to patent examiners in the course of examinations to determine whether applications for patents should be granted.”<sup>4</sup>

The statement of the court in *Genencor* can be understood by recognizing that the language of patent claims construed by judges is fixed, is the result of a negotiation with the Patent Office, was “accepted by the Commissioner of Patents as a correct statement of a monopoly that can properly be derived from the invention disclosed in the specification”,<sup>5</sup> and benefits from the presumption of validity accorded by subsection

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<sup>1</sup> *Canada (Attorney General) v Amazon.com Inc.*, 2011 FCA 328 [*Amazon FCA*] at paragraph 43

<sup>2</sup> *Free World Trust v. Électro Santé Inc.*, 2000 SCC 66 at paragraph 50; and *Whirlpool Corp. v. Camco Inc.*, 2000 SCC 67 at paragraph 48

<sup>3</sup> For an enumeration of the principles, see *Free World Trust* at paragraph 31.

<sup>4</sup> *Genencor International Inc. v. Canada (Commissioner of Patents)*, 2008 FC 608 [*Genencor*] at paragraphs 62 and 70

<sup>5</sup> *Whirlpool* at paragraph 49

43(2) of the *Patent Act*. In contrast, during examination of an application the language of the claim may change from that initially proposed by the applicant for a number of reasons.

The Office considers that the application of the principles of purposive construction discussed in *Free World Trust* and *Whirlpool* to the examination of a patent application must take into account the role of the patent examiner and the purpose and context of examination.<sup>6</sup>

## **Practice Guidelines**

The Office takes the position that claim construction during examination requires an examiner to interpret each claim:

### **1) Using a fair, balanced and informed approach**

The specification as a whole is addressed to the person skilled in the art and, as such, provides the context in which the claim should be read and informs the meaning of the terms recited in the claim and the nature of the invention.<sup>7</sup> As noted in *Free World Trust*, upon a purposive construction the terms of a claim will be given specific technical meanings in light of the common general knowledge of the person skilled in the art (paragraph 51). Thus, in order to arrive at a fair, balanced and informed understanding of the subject-matter of a claim, it is critical that a purposive construction of the claim be performed considering the specification as a whole as read through the eyes of the person skilled in the art, against the background of the common general knowledge in the field or fields relevant to the invention at the time the application became available to the public [see also the MOPOP at [9.02.02](#) and [9.02.03](#)].

In *Amazon FCA* it was recognized that, during examination, the necessary foundation of knowledge for performing a purposive construction of the claims is found in submissions from the applicant and the knowledge of an appropriately experienced examiner (paragraph 73).

### **2) Having identified the problem and solution**

The purpose of the *Patent Act* is to provide exclusive rights to an inventor for a new and useful invention in exchange for a disclosure that allows the public to use or operate the invention as contemplated by the inventor. Thus, recognizing that a patentable

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<sup>6</sup> *Genencor* at paragraphs 62 and 70 and *Amazon FCA* at paragraph 73

<sup>7</sup> *Whirlpool* at paragraphs 49(f)(g), 52 and 53

invention is an inventive solution to a practical problem,<sup>8</sup> it follows that an invention must be disclosed (and ultimately claimed) so as to provide the person skilled in the art with an operable solution.

Guidance in identifying the problem the inventors set out to address and its proposed solution should be found in the description, in accordance with paragraph 80(1)(d) of the *Patent Rules*,<sup>9</sup> and not by reference to the closest prior art. This identification occurs when construing the promise of the invention (*i.e.* its utility).

Thus, identification of the problem and the solution provided by the invention informs the purposive construction of the claims.<sup>10</sup>

### 3) In the context of the application as a whole

While claim construction during examination must remain anchored in the language of the claims, it was reiterated in *Amazon FCA* that it “cannot be determined solely on the basis of a literal reading” of the claims (paragraph 43). A properly informed purposive construction must consider the application as a whole.

Not only must one not lose sight of the fact that the claims must be interpreted in light of the description, but as the FCA noted a claim-based analysis “does not mean that the Commissioner cannot ask or determine what the inventor has actually invented, or what the inventor claims to have invented. On the contrary, these are relevant and necessary questions in a number of contexts, including novelty, obviousness, and patentable subject matter”.<sup>11</sup> The examiner must be “alive to the possibility that a patent claim may be expressed in language that is deliberately or inadvertently deceptive”, thus recognizing that, “for example, what appears on its face to be a claim for an “art” or a “process” may, on a proper construction, be a claim for a mathematical formula and therefore not patentable subject matter”.<sup>12</sup>

This is consistent with the recognition in *Free World Trust* of the need to avoid “the

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<sup>8</sup> *Apotex Inc. v. Wellcome Foundation Ltd.*, 2002 SCC 77 at paragraph 37; the Supreme Court in *Teva Canada Ltd. v. Pfizer Canada Inc.*, 2012 SCC 60 at paragraph 32 reiterates this point, and speaks of the importance of the patent bargain in advancing science and technology

<sup>9</sup> *Paragraph 80(1)(d) of the Rules* provides that the description must describe the invention so as to allow the understanding of the technical problem and its solution.

<sup>10</sup> *AstraZeneca Canada Inc. v. Apotex Inc.*, 2010 FC 714 at paragraph 33; *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd.*, 2011 FC 1323 at paragraph 61; *Jay-Lor International Inc. v. Penta Farm Systems Ltd.*, 2007 FC 358 at paragraph 55; *Sanofi-Aventis Canada Inc. v. Apotex*, 2009 FC 676 at paragraph 128; *Merck & Co. Inc. v. Apotex Inc.*, 2010 FC 1265 at paragraph 86

<sup>11</sup> *Amazon FCA* at paragraph 42

<sup>12</sup> *Amazon FCA* at paragraph 44

pitfalls of language” so as to ensure the inventor receives “protection for that which he has actually in good faith invented”.<sup>13</sup>

Subsequent to a purposive claim construction, performed in light of the description, the common general knowledge in the relevant art and the examiner’s technical expertise, an examiner can determine whether the subject matter defined by a claim complies with the requirements of the *Patent Act*, and thus is a new, useful and inventive (i) *art*, (ii) *improvement to an art*, (iii) *process*, (iv) *improvement to a process*, (v) *machine*, (vi) *improvement to a machine*, (vii) *manufacture*, (viii) *improvement to a manufacture*, (ix) *composition of matter*, or (x) *improvement to a composition of matter*.<sup>14</sup>

#### **4) To determine which elements of the claim solve the identified problem**

One aspect of purposive construction is the identification of the essential elements of the claim. The identification of the essential elements of a claim cannot be performed without having first properly identified the proposed solution to the disclosed problem. As previously discussed, this identification considers the whole of the application from the perspective of the person skilled in the art having the benefit of common general knowledge in the relevant fields. Without having first considered the problem and solution, the identification of essential elements would be circular - it would begin and end with the language of the claim, contrary to *Free World Trust* which recognizes that elements can be found to be non-essential if “at the date of publication of the patent, the skilled addressee would have appreciated that a particular element could be substituted without affecting the working of the invention”.<sup>15</sup>

Ultimately, some element or combination of elements defined in the claim must provide the “inventive solution” referred to by the Supreme Court (see footnote 8 herein). One must, however, approach each claim with an understanding that not every element that has a material effect on the operation of a given embodiment is necessarily essential for the operation of the invention. Some elements of a claim merely define the context or the environment of a specific working embodiment, but do not actually change the nature of the solution to the problem.<sup>16</sup>

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<sup>13</sup> *Free World Trust* at paragraph 58, citing *Western Electric Co. v Baldwin International Radio of Canada*, 1934 S.C.R. 570 at page 574

<sup>14</sup> *Amazon FCA* highlights the distinction between an improvement (“the only inventive aspect of the claimed invention”) and a “novel combination” at paragraph 63. Further, see paragraph 38 of *Amazon FCA* and paragraph 44 of *Teva* to the same effect.

<sup>15</sup> *Free World Trust* at paragraph 55; here, “substitution” must be understood to include either substitution or omission of the element.

<sup>16</sup> *Amazon FCA* at paragraphs 59 to 63; following the reasoning of the court, the existence of a practical embodiment does not automatically imply that the elements of the embodiment are essential elements of the invention.

Note that while the identification of the essential elements is performed “in light of the knowledge of the art at the date of the publication of the patent specification”,<sup>17</sup> this does not mean that one can simply conclude that the essential elements of the invention are those that distinguish the claimed subject matter from the prior art.<sup>18</sup>

Having identified the problem and solution, and defined the essential elements in the claims, an examiner may conclude that the claim either omits an essential element or includes non-essential elements.

### **i) Missing elements**

Where it appears, having considered a claim in light of a fair reading of the description, that an element essential to the operation of the solution has not been defined in the claim, the claim may be defective for overbreadth (*i.e.* lack of support) and/or for lack of utility.

### **ii) Superfluous elements**

In certain cases, an examiner may consider elements included in a claim of an application to be superfluous (non-essential) to the solution to a given problem. The mere presence of a superfluous limitation is not a defect as such, although the inclusion of such an element could render a claim defective (for example if its presence results in ambiguity).

It must be recognized that while the Office considers superfluous elements to be non-essential and not relevant to the determination of a claim’s patentability during examination, if an applicant maintains such an element in the claim through to grant a court might later construe it to be essential when applying the “self-inflicted wound” factors of purposive construction as identified in *Free World Trust* and *Whirlpool*.<sup>19</sup>

## **5) By focusing on one solution to a problem**

An invention is an element or a combination of elements<sup>20</sup> that provides a solution to a problem. Where a claim includes solutions to more than one problem it includes more

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<sup>17</sup> *Free World Trust* at paragraph 52

<sup>18</sup> *Halford v Seed Hawk Inc.*, 2006 FCA 275 at paragraph 14

<sup>19</sup> The Office does not consider the “self-inflicted wound” factor to be relevant during examination.

<sup>20</sup> See section [9.04.03](#) of the MOPOP for a discussion of combinations and the meaning of “unitary result”.

than one invention.<sup>21</sup>

If a claim includes solutions to more than one problem, examination should focus on one solution to a problem in performing the purposive construction. The initial choice of solution should be guided by the description, selecting the solution given the greatest emphasis by the inventors. If it becomes necessary to consider a different solution, the analysis should be undertaken anew.

On occasion it may be the case that elements or sets of elements in a claim do not interact with each other to achieve a unitary result; this may reflect an “aggregation” rather than a combination.<sup>22</sup> A consideration of the problem and solution emphasized by the inventor in the description may assist the examiner to select only the element or set of elements that work together in the claim that provide the operable solution.

### **Purposive construction and examiner’s reports**

In most cases, an examiner reading a claim will automatically ascribe appropriate meanings to the terms of a claim in light of the teachings of the description and the examiner’s technical expertise. It is not necessary to explain these conclusions in a report, unless it becomes apparent that there is some relevant disagreement between the examiner and the applicant as to the significance of certain terms. In such instances, it is only necessary to explicitly address the construction of the contested terms.

Similarly, in some cases it will be possible to conclude that a claim does not comply with the *Patent Act* or *Patent Rules* without explicitly determining whether a given element is or is not essential. A prior art document that discloses all the elements of a claim, for example, will anticipate the claimed subject-matter regardless of whether each element is essential or not. Here again, examiners are not required to detail in reports parts of their analysis that are not in issue.

Where an examiner’s conclusions regarding a specific element are relevant to the identification of a perceived defect, the examiner should provide reasons to support their conclusions, e.g. emphasize the identified problem and solution and those elements essential to providing that solution.

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<sup>21</sup> Examiners should be mindful that, in this context, the identification of multiple problems and solutions within a single claim is not to be confused with lack of unity of invention within the meaning of section 36 of the *Patent Rules* (which emphasizes that the subject matter defined by the claims are to be linked by a single general inventive concept).

<sup>22</sup> *Re Application for Patent of Prince Corp.*, 1982, 2 C.P.R. (3d) 223 (CD 942); and *Shmuel HersHKovitz v. Tyco Safety Products Canada Ltd.*, 2009 FC 256 at paragraph 148