

CHAPTER 6 — CLAIM CONSTRUCTION

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EXECUTIVE SUMMARY:

The question to be asked in construing a claim of a patent is:

“What would the claim have meant to a skilled reader as of the relevant date?”
(Chapter 6.1).

Claim construction consists of the following:

1) The claim language must be read in an informed and purposive way. The words chosen by the inventor should be read in the sense the inventor is presumed to have intended, and in a way that is sympathetic to accomplishment of the inventor’s purpose expressed or implicit in the text of the claims (Chapter 6.6).

2) Read the patent as a whole, and construe the claims in the context of the patent (Chapter 6.7.2.1).

3) Read the patent as if you were the person or persons to whom it was addressed. (Chapter 6.7.1.2). If the disclosure expressly defines certain terms to have certain meanings, use those definitions when interpreting the claims (Chapter 6.7.2.2). Otherwise, a word or phrase should be given the ordinary meaning it would have had to such person or persons as of the relevant date, as used within the context of the patent. (Chapter 6.7).

4) The relevant date for construing the patent claims is either:

- a) the date of issuance of the patent, for patents applied for before October 1, 1989; or
- b) the date of publication of the patent application, for patents applied for on or after October 1, 1989 (Chapter 6.7.1.1).

5) To determine whether a claim element is essential or not, ask (Chapter 6.8.1):

- 1) Was it obvious to the skilled reader at the relevant date that a variant of a particular element would not make a difference to the way in which the invention works? If modifying or omitting the element changes the way the invention works, and that was obvious at the relevant date, then the element is essential; (Chapter 6.8.2) or
- 2) According to the intent of the inventor, expressed or inferred from the claims, was a particular element essential irrespective of its practical effect? If the element appears to have been intended to be essential, then the element is essential (Chapter 6.8.3).

If the claim element was not found to be essential under either Q1 or Q2, then the element is non-essential (Chapter 6.9.3). Both Catnic questions should be asked in order to determine non-essential features (Chapter 6.9.1.3).

Claim differentiation “claim differentiation” presumes that patent claims are drafted so as not to be redundant¹ and that different claims have different scopes. If it is at all possible, each claim must be construed independently of the others and be given an effective and distinct meaning.² Where a dependent claim differs from its parent claim by only a single feature, it is difficult to argue that the different feature has not been made essential to that claim.³ (Chapter 6.7.2.8)

6. Claim Construction

6.1 INTRODUCTION: “WHAT DOES THE CLAIM MEAN?”

Patents, and the lawsuits that result from them, have been described by embittered litigants as “... a world where men substitute words for realities and then talk about the words”⁴ and by judges as a forum where lawyers engage

¹ *Halford v. Seed Hawk Inc.*, 2004 FC 88, 2004 CarswellNat 342, 2004 CarswellNat 7412 (F.C.) per Pelletier J. at para. 98, reconsideration / rehearing refused 2004 CarswellNat 882, 2004 CarswellNat 4795 (F.C.), affirmed 2006 CarswellNat 2397, 2006 CarswellNat 4150 (F.C.A.); See also *Bridgeview Manufacturing Inc. v. 931409 Alberta Ltd.*, 2010 FCA 188, 2010 CarswellNat 4009, 2010 CarswellNat 2314 (F.C.A.) per Sharlow J.A., Nadon & Trudel JJ.A. concurring at paras. 27, 33, leave to appeal refused 2011 CarswellNat 1109, 2011 CarswellNat 1110 (S.C.C.).

² *The Canadian Law and Practice Relating to Letters Patent for Inventions* by Harold G. Fox (Fox), quoted by Justice Snider in *Hoffmann-La Roche Ltd. v. Mayne Pharma (Canada) Inc.*, 2005 FC 814, 2005 CarswellNat 5176, 2005 CarswellNat 1941, 41 C.P.R. (4th) 505 (F.C.) (Hoffmann (2005)), at para. 43; *Eli Lilly & Co. v. Apotex Inc.*, 2009 FC 991, 2009 CarswellNat 3042, 2009 CarswellNat 6607 (F.C.) per Gauthier J. at paras. 90 and 122, affirmed 2010 CarswellNat 5866, 2010 CarswellNat 3443 (F.C.A.), leave to appeal refused 2011 CarswellNat 1368, 2011 CarswellNat 1369 (S.C.C.), additional reasons 2011 CarswellNat 4151 (F.C.).

³ *Hayhurst*; “*The Art of Claiming and Reading a Claim*” in *Patent Law of Canada* (1994), edited by G.F. Henderson, Q.C., at 198 quoted with approval in *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 163 [C.P.R.], para. 79, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.). See *Glaston Services Ltd. Oy v. Horizon Glass & Mirrors Ltd.*, 2010 FC 1191, 2010 CarswellNat 5395, 2010 CarswellNat 4556 (F.C.) per Mandamin J. where dependent claim 3 added the limitation of “said pneumatic spring is a pneumatic cylinder for carrying the roller between the rest position and the working position” (at para. 48), the Court held at para 65 that it was an essential element of that claim that the pneumatic spring is provided by a pneumatic cylinder “... since it is specifically claimed ...”

⁴ “It is a long time since I have attended a gathering of the scientific world—a world in which I am at home — one in which men deal with realities and where truth is, in fact, the goal. For the past ten years I have been in exile from this world and an explorer in another — a world where men substitute words for realities and then talk about the words. Truth in that world seems merely to be the avowed object. Now I undertook to reconcile the objects of these two worlds and for a time I believed that could be accomplished. Perhaps I still believe it—or perhaps it is all a dream.”

Edwin Howard Armstrong, inventor of regeneration and FM radio, in an address to the annual convention of the Institute of Radio Engineers, Philadelphia, U.S.A., May 29, 1934 quoted by Tom Lewis in “*Empire of the Air, The Men Who Made Radio*”; Edward Burlingame Books, 1991, referring to his losses in the hands of the U.S. judicial system.

in “... the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge.”⁵

Whatever the case, the meaning given to a patent claim can be critical to the outcome of a patent lawsuit. When a patent claim’s validity is at issue, the patent owner may want the claim to be construed narrowly, so it does not include a certain piece of prior art that would render the claim invalid as claiming something that is not “new”. When infringement of the claim is at stake, the patent owner may want the claim to be construed broadly so as to encompass the defence t’s product or method.⁶

Claim construction is the term used to describe the process of construing the claims of a patent to give them meaning, which meaning is then compared to an allegedly infringing device or method to determine infringement or to prior art to determine validity. As will be seen in Chapter 7, there is no infringement if an essential element is missing or modified in an allegedly infringing product or method. There may still be infringement if non-essential elements are substituted or omitted.⁷

The task of claim construction is to answer the question: “What does the claim mean?”. Purposive construction is essentially a contextual exercise with a primary focus on the language of the claims as viewed objectively by the notional person of skill.⁸

Purposive construction of a claim is similar to construction of a statute. In *Re Rizzo & Rizzo Shoes Ltd.*, Justice Iacobucci, discussed statutory interpretation as contextual:

... Elmer Driedger in *Construction of Statutes* (2nd ed. 1983) best encapsulates the approach upon which I prefer to rely. He recognizes that statutory interpretation cannot be founded on the wording of the legislation alone. At 87 he states: “Today

Mr. Armstrong committed suicide by jumping out of his 13th floor apartment building in New York City on February 1, 1954. By 1967, Marion Armstrong, Edwin Armstrong’s widow, had won the last of all of Armstrong’s FM patent lawsuits.

⁵ *Catnic Components Ltd. v. Hill & Smith Ltd.* (1981), [1982] R.P.C. 183 (U.K. H.L.) per Lord Diplock, affirmed (1982), [1983] F.S.R. 512 (U.K. H.L.).

⁶ In patent academic circles this has sometimes been referred to as the ‘Angora Cat’ (“*Pfizer Canada Inc. v. Pharmascience Inc.*”, 2013 FC 120, 2013 CarswellNat 177, 2013 CarswellNat 1248, 111 C.P.R. (4th) 88 (F.C.) at para. 74 (per Hughes J.)).

Professor Mario Franzosi likens a patentee to an Angora cat. When validity is challenged, the patentee says his patent is very small: the cat with its fur smoothed down, cuddly and sleepy. But when the patentee goes on the attack, the fur bristles, the cat is twice the size with teeth bared and eyes ablaze.

⁷ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J., at para. 31(f).

⁸ *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2013 FC 947, 2013 CarswellNat 4788, 2013 CarswellNat 3398 (F.C.) per Barnes J. at para. 29, additional reasons 2013 CarswellNat 3777, 2013 CarswellNat 4789 (F.C.), affirmed 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring.

there is only one principle or approach, namely, the words of an Act are to be read in their entire context and in their grammatical and ordinary sense harmoniously with the scheme of the Act, the object of the Act, and the intention of Parliament.”⁹

The Supreme Court of Canada has phrased the question of claim construction as inventor-centric: What was the inventor intending to cover by the claims?

The words chosen by the inventor will be read in the sense the inventor is presumed to have intended.¹⁰

Others, it is suggested more properly, center the question around the notional reader of the patent and ask: “What would a skilled reader have understood the inventor to have meant?”¹¹

The question can therefore be more fully phased as:

What would the claim have meant to a skilled reader as of the relevant date?

6.2 HISTORY OF CLAIMING

A patent’s claims define the monopoly in words and numbers. The ambit of the invention must be circumscribed by definite claims.¹²

Section 27(4) of the *Patent Act*¹³ requires the patentee to end the patent with the claims:

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.

The earliest patents, granted by Royal Prerogative, were given in name only and did not include any description.¹⁴ Patent specifications which described the article or method patented did not appear until the early eighteenth century and took “the form of statements enrolled with the Chancery Courts.” By the mid

⁹ *Rizzo & Rizzo Shoes Ltd.*, Re, 1998 CarswellOnt 1, 1998 CarswellOnt 2, [1998] 1 S.C.R. 27 (S.C.C.) per Iacobucci J. at para. 21.

¹⁰ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J., at para. 51.

¹¹ *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2005 CarswellNat 4401, 2005 CarswellNat 7441, 46 C.P.R. (4th) 244 (F.C.) per Hughes J. at para. 39, affirmed 2007 CarswellNat 6, 2007 CarswellNat 1052 (F.C.A.) quoting with approval, Lord Hoffman in *Kirin-Amgen Inc. v. Transkaryotic Therapies Inc. (No. 2)* (2004), 331 N.R. 1 (U.K. H.L.).

¹² *Canadian Celanese Ltd. v. B.V.D. Co.*, 1937 CarswellNat 44, [1937] S.C.R. 221 (S.C.C.) (per Davis J.) at 233 [S.C.R.], varied 1939 CarswellNat 80 (Jud. Com. of Privy Coun.).

¹³ R.S.C. 1985, c. P-4 as amended. All references to the *Patent Act* in this chapter refer to R.S.C. 1985, c. P-4 unless otherwise noted.

¹⁴ Harold G. Fox, *The Canadian Law and Practice Relating to Letters Patent for Inventions*, 4th ed. (Toronto: Carswell, 1969), at 162.

to late eighteenth century, the patentee had to make a sufficient statement of his conception as consideration for the monopoly.¹⁵

Early patent specifications often ended with phrases such as “A device substantially as described herein” or with a listing of the features of the invention that the patentee considered new and inventive.¹⁶ For example, the first Canadian patent granted under the 1869 *Patent Act*, for a machine for measuring liquids, states at the end “What I claim as my invention is a fluid meter which operates and is so constructed as described.”¹⁷

Claims, as a distinct part of the specification defining the monopoly, were not required at English common law.¹⁸ In 1877 in *Plimpton v. Spiller*, Lord James of the English Court of Appeal considered that the purpose of a claim was to disclaim that which was old:

It is important to bear in mind that there is nothing in the Act or in the patent law which says anything about claims. A patentee gets a patent for his invention, and he is obliged to specify that invention in such a way as to shew to the public not only the mode of giving practical effect to that invention, but what the limits of the invention are for which his patent is taken out; and the real object of what is called a claim, which is now much more commonly put in than it used to be formerly, is not to claim anything which is not mentioned in the specification, but to disclaim something. A man who has invented something gives in detail the whole of the machine in his specification. In doing that he is of necessity very frequently obliged to give details of the things which are perfectly known and in common use — he describes new combinations of old things to produce a new result, or something of that kind. Therefore, having described his invention, and the mode of carrying that invention into effect, by way of security, he says: “But take notice I do not claim the whole of that machine, I do not claim the whole of that *modus operandi*, but that which is new, and that which I claim is that which I am now about to state.” That really is the legitimate object of a claim, and you must always construe a claim with reference to the whole context of the specification.¹⁹

Similarly, Lord Blackburn from the House of Lords commented:

¹⁵ Gordon F. Henderson, “An Introduction to Patent Law” in Gordon F. Henderson, ed., *Patent Law of Canada* (Scarborough, Ont.: Carswell, 1994), 1 at 11 [Henderson]; Donald S. Chisum, *Chisum on Patents*, vol. 3 (New York: Matthew Binder & Co., Inc., 2000) at 8-5. The requirement to include a specification in a patent arose via the common law in England and by statute in the U.S.

¹⁶ Blanco White, *Patents for Inventions*, 4th ed., (London: Stevens & Sons, 1979) at 1-305 cited by Justice Hughes in *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2005 FC 1725, 2005 CarswellNat 4401, 2005 CarswellNat 7441, 46 C.P.R. (4th) 244 (F.C.) at para. 16, affirmed 2007 CarswellNat 6, 2007 CarswellNat 1052 (F.C.A.) [White].

¹⁷ Canadian Patent No. 1 “A Machine for Measuring Liquids”, reproduced at http://www.collectionscanada.ca/archivianet/patents/001038-119.02-e.php?patent_id_nbr=1&page_sequence_nbr=1&referer=023020-2700-e.html.

¹⁸ Harold G. Fox, *The Canadian Law and Practice Relating to Letters Patent for Inventions*, 4th ed. (Toronto: Carswell, 1969), at 193.

¹⁹ *Plimpton v. Spiller* (1877), 6 Ch. D. 412 (C.A.) at 426-427.

You may have a perfectly good specification without the word “claim” or the thing claim in it at all, but nevertheless a claiming clause is commonly inserted at the end of a patent, and that is of immense importance in enabling us to construe the specification and to see, looking at the whole specification, whether a thing is included in it or not.²⁰

In the U.S., the modern version of patent claims arose earlier than in England. In 1822, the U.S. Supreme Court in *Evans v. Eaton*²¹ stipulated that a patentee was required to describe in the specification explicitly “what the party claims as his own invention”.²²

The 1836 U.S. *Patent Act* adopted this rule by requiring that the inventor “shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery.”²³ The U.S. *Patent Act of 1870* formally required that claims be a distinct section of the specification by stating in s. 26 that the inventor “... shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery ...”²⁴

In the Canadian *Patent Act* passed in 1869,²⁵ which was modeled after earlier US patent statutes,²⁶ s. 14 required the specification to “... state clearly and distinctly the contrivances and things which he claims as new, and for the use of which he claims an exclusive property and privilege.” The current language of s. 27(4) was introduced in 1923:²⁷

14(1) ... It shall end with a claim or claims stating distinctly the things or combinations which the applicant regards as new and in which he claims an exclusive property and privilege.²⁸

Britain followed the U.S. and Canada in creating a statutory requirement for the patent specification to end with claims in 1883.²⁹

²⁰ *Dudgeon v. Thomson & Donaldson* (1877), (1877-78) L.R. 3 App. Cas. 34 (U.K. H.L.) at 54.

²¹ *Evans v. Eaton*, 20 U.S. 356, 5 L.Ed. 472, 7 Wheat. 356 (1822).

²² Donald S. Chisum; *Chisum on Patents*, vol. 3; New York: Matthew Binder & Co., Inc., 2000; at 8-6.

²³ *Patent Act of 1836*, Ch. 357, 5 Stat. 117 s. 6.

²⁴ *Patent Act of 1870*, Ch. 230, 16 Stat. 198 at s. 26.

²⁵ Dom. Stat. 32 & 33 Vic., c. 11.

²⁶ *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at para. 45 citing H. Fox, *The Canadian Law and Practice Relating to Letters Patent for Invention*, 4th ed. (Toronto: Carswell, 1969) at 193-194.

²⁷ Gordon A. Asher, “Legislative History of the Patent Act”, (1960) 33 C.P.R. 64 at 106. Section 14 of the Patent Act, 1923 states: The specification shall... end with a claim or claims stating distinctly the things or combinations which the applicant regards as new and in which he claims an exclusive property and privilege.

²⁸ *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at para. 51.

²⁹ *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at para. 51.

The enactment of s. 14(1) of the *Patent Act* in 1933 resulted in the claims being the focus of the analysis of the monopoly:

It follows that the nature of the invention protected by a patent and the extent of the monopoly thereby granted must be ascertained from the claims. The claims should be construed with reference to the specification and to the drawings, but, as pointed out by Lindley, M.R., in *The Pneumatic Tyre Company Limited v. The Tubeless Pneumatic Tyre and Capon Headon Limited* (1); whether the patentee has discovered a new thing or whether he has not, his monopoly is confined to what he has claimed as his invention.³⁰

The Canadian *Patent Act* was further amended to provide for the requirement of claims which must particularly, distinctly and in explicit terms set out the monopoly.

It did so in ss. 36(1)(e) and again in ss. 36(2). These provisions became ss. 34(1)(e) and 34(2) in later versions:

34. Specification— (1). An applicant shall in the specification of his invention

(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 appertains, 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 thereof and the best mode in which he has contemplated the application of that principle;

(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; and

(e) particularly indicate and distinctly claim the part, improvement or combination that he claims as his invention.

(2) *Claims to be stated distinctly*—The specifications referred to in subsection (1) shall end with a claim or claims stating distinctly and in explicit terms the things or combinations that the applicant regards as new and in which he claims an exclusive property or privilege.³¹

³⁰ *Gillette Safety Razor Co. v. Pal Blade Corp.*, 1933 CarswellNat 34, [1933] S.C.R. 142 (S.C.C.) per Rinfret J. at 147 [S.C.R.]; quoted in *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at para. 51.

³¹ *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at para. 52.

The art of a claim drafter is to write a claim using as few claim elements as possible to define the invention with the least (or most efficient use of) words. To adopt de Saint-Exupery's explanation of perfection in design:

It seems that perfection is attained, not when you have nothing more to add, but when you have nothing more to take away.³²

6.3 HISTORY OF CLAIM CONSTRUCTION

6.3.1 *The Two Part Test: Literal and Substantive Infringement*

It has been often stated in the case law that it is the duty of the court to interpret the claims, not to rewrite them.³³ Prior to the Supreme Court of Canada decisions in *Whirlpool*³⁴ and *Free World*³⁵ in 2000 however, there were essentially two lines of case law:

1. one line of case law which required "all elements" of the claim to be considered relevant; and
2. another line of case law which did not require "all elements" of the claim to be needed, which analyzed the patent to determine the "pith and marrow" or "pith and substance" of the invention, effectively

³² Il semble que la perfection soit atteinte non quand il n'y a plus rien à ajouter, mais quand il n'y a plus rien à retrancher. (Terre des Hommes, 1939). Or, on a more pedestrian level, as John Cleese ("Creativity in Management", Pro-Arts, 1991) described the sculptor who, when asked how he had sculpted a very fine elephant, explained that he'd taken a big block of marble and then knocked away all the bits that didn't look like an elephant.

³³ *Eli Lilly & Co. v. O'Hara Manufacturing Ltd.*, 1989 CarswellNat 504, 26 C.P.R. (3d) 1 (Fed. C.A.) per Pratte J.A. at 7 [C.P.R.]; See also *J.K. Smit & Sons Inc. v. McClintock*, 1939 CarswellNat 64, [1940] S.C.R. 279 (S.C.C.) per Duff C.J., at 285 [S.C.R.]. More recently in *Halford v. Seed Hawk Inc.*, 2004 CarswellNat 342, 2004 CarswellNat 7412, 31 C.P.R. (4th) 434 (F.C.) per Pelletier J. at 464-465 [C.P.R.], para. 82, reconsideration / rehearing refused 2004 CarswellNat 882, 2004 CarswellNat 4795 (F.C.), affirmed 2006 CarswellNat 2397, 2006 CarswellNat 4150 (F.C.A.) stated:

One way of dealing with the problem of variants is to employ broad descriptions of the elements so as to encompass possible variants ... In my view, this approach does not respect the language of patent (sic) as it amounts to a recharacterization of the elements of the claim using language the inventor did not use when drafting his claims.

The Court of Appeal did not disturb this finding: *Halford v. Seed Hawk Inc.*, 2006 FCA 275, 2006 CarswellNat 2397, 2006 CarswellNat 4150 (F.C.A.), (Sexton J.A., Sharlow & Malone J.J.A.)

³⁴ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J., reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

³⁵ *Free World Trust c. Ectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J.

allowed a claim to be re-written so as to vary or ignore a claim element.

The earlier case law applied these two approaches in the context of determining patent infringement, describing them as two different forms of infringement:

1. Literal or textual infringement, where each and every one of the claim elements were found in the defendant's device; and
2. Substantive infringement, or taking the "pith and substance" of the invention, where one or more of the claim elements were either missing from the defendants device or had been substituted by equivalent features which achieved the same purpose as what had been claimed.

Literal infringement was determined first, failing which, substantive infringement was examined.

Even as early as 1936, the Supreme Court of Canada in *Smith Incubator Co. v. Seiling*, recognized these two different approaches:

According to one of these [approaches] it is proper to consider what is "the pith and substance" or the "spirit" of the invention and to give effect to the patent accordingly. The other is to regard the claims as definitely determining the scope of the monopoly which the patent purports to grant and to give or refuse them effect according to the expressions they contain when these expressions are properly construed and their meaning determined.³⁶

Courts have acknowledged that the concept of "pith and substance" is illogical in view of the current-day concept of requiring inventors to clearly and decisively claim their invention and provide clear boundaries to patents:

Copying an invention by taking its "pith and marrow" without textual infringement of the patent is an old and familiar abuse which the law has never been powerless to prevent. It may be that in doing so, there is some illogicality, but our law has always preferred good sense to strict logic. The illogicality arises in this way. On the one hand the patentee is tied strictly to the invention which he claims and the mode of effecting an improvement which he says is his invention. Logically, it would seem to follow that if another person is ingenuous enough to effect that improvement by a slightly different method, he will not infringe. But it has long been recognized that there "may be an essence or substance of the invention underlying the mere accident of form; and that invention, like every other invention, may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or

³⁶ *Smith Incubator Co. v. Seiling*, 1937 CarswellNat 46, [1937] S.C.R. 251 (S.C.C.) per Rinfret J. at 259 [S.C.R.].

different combination”. (Per James L.G. in *Clark-vs-Adie*, [1873] L.R. 10 Ch. 667). It was in *Clark-vs-Adie* that Lord Cairns used the expression “pith and marrow of the invention”: [1877] 2 App.Cas.315 at 320.³⁷

In *Whirlpool*³⁸ and *Free World*,³⁹ rather than choosing between these mutually contradictory approaches, the Supreme Court of Canada endorsed a scheme for claim construction that incorporated both approaches. As discussed below, *Whirlpool*,⁴⁰ *Free World*⁴¹ and the U.K. House of Lords decision that inspired them, *Catnic*,⁴² have merely replaced the old two part infringement test with a very similar form of two part claim construction test without resolving the inherent contradiction between the two.

6.3.1.1 *Literal Infringement*

In the older cases, if the words of the claim, upon a plain reading of them, aptly described the defendant’s device or process, then there was said to be “literal” or “textual” infringement.⁴³

Under literal infringement, in effect, all claim elements were considered to be essential to the invention and thus, the absence of any claimed element resulted in a finding of no literal infringement. It was therefore an “all elements” test.

All the claim elements were considered important because it was the claim that determined the scope of the monopoly:

In our view, the rule is that the claims must be regarded as definitely determining the scope of the monopoly, having regard to the due and proper construction of the expressions they contain.⁴⁴

³⁷ *C. Van der Lely N.V. v. Bamfords Ltd.*, [1963] R.P.C. 61 (U.K. H.L.) at 75 per Lord Reid.

³⁸ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J., reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

³⁹ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J.

⁴⁰ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J., reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

⁴¹ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J.

⁴² *Catnic Components Ltd. v. Hill & Smith Ltd.* (1981), [1982] R.P.C. 183 (U.K. H.L.) per Lord Diplock, affirmed (1982), [1983] F.S.R. 512 (U.K. H.L.).

⁴³ *McPhar Engineering Co. v. Sharpe Instruments Ltd.*, 1960 CarswellNat 42, [1956-60] Ex. C.R. 467, 21 Fox Pat. C. 1 (Can. Ex. Ct.) at 5-6 [Fox Pat. C.].

⁴⁴ *Smith Incubator Co. v. Seiling*, 1937 CarswellNat 46, [1937] S.C.R. 251 (S.C.C.) per Rinfret J. at 259-260 [S.C.R.], quoted by Justice Binnie in *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 186 [C.P.R.], para. 35.

The Court has analogized patent claims to “fences” and “boundaries”, “ ... giving the “fields” of the monopoly a comfortable pretence of bright line demarcation”:⁴⁵

By his claims the inventor puts fences around the fields of his monopoly and warns the public against trespassing on his property. His fences must be clearly placed in order to give the necessary warning and he must not fence in any property that is not his own. The terms of a claim must be free from avoidable ambiguity or obscurity and must not be flexible; they must be clear and precise so that the public will be able to know not only where it must not trespass but also where it may safely go.⁴⁶

One of the earliest and most often cited case on claim construction relating to literal infringement is *Electrical & Musical Industries Ltd. v. Lissen Ltd.*⁴⁷ where Lord Russell of Killowen held at page 39:

The function of the claims is to define clearly and with precision the monopoly claimed, so that others may know the exact boundaries of the area within which they will be trespassers. Their primary object is to limit and not to extend the monopoly. What is not claimed is disclaimed. The claims must undoubtedly be read as part of the entire document, and not as a separate document; but the forbidden field must be found in the language of the claims and not elsewhere. It is not permissible, in my opinion, by reference to some language used in the earlier part of the specification to change a claim which by its own language is a claim for one subject-matter into a claim for another and a different subject-matter, which is what you do when you alter the boundaries of the forbidden territory. A patentee who describes an invention in the body of a specification obtains no monopoly unless it is claimed in the claims. As Lord Cairns said, there is no such thing as infringement of the equity of a patent (*Dudgeon v. Thomson*, L.R. 3 App. Cas. 34). [emphasis added]

A more recent example of a strict construction approach is *Eli Lilly & Co. v. O'Hara Manufacturing Ltd.*⁴⁸ where the patent licensee, Thomas Engineering, manufactured a tablet coating machine that comprised a drum and a vacuum plenum claimed to be “flexibly biased against the drum”. Thomas Engineering later discovered that their device worked just as well with the plenum fixed in place and with the plenum close to but not touching the drum. O'Hara copied

⁴⁵ *Free World Trust c. Electro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 178 [C.P.R.], para. 14.

⁴⁶ *Minerals Separation North American Corp. v. Noranda Mines Ltd.*, 1947 CarswellNat 8, [1947] Ex. C.R. 306 (Can. Ex. Ct.) per Thorson P. at 352 [Ex. C.R.], reversed 1949 CarswellNat 19 (S.C.C.), affirmed 1952 CarswellNat 2 (Jud. Com. of Privy Coun.).

⁴⁷ *Electrical & Musical Industries Ltd. v. Lissen Ltd.* (1938), 56 R.P.C. 23 (U.K. H.L.). See also *Canamould Extrusions Ltd. v. Driangle Inc.*, 2003 FCT 244, 2003 CarswellNat 554, 2003 CarswellNat 1905 (Fed. T.D.) at para. 32, affirmed 2004 FCA 63, 2004 CarswellNat 970, 2004 CarswellNat 386 (F.C.A.) per Layden-Stevenson J.: “An inventor is not obliged to claim a monopoly on everything new, ingenious and useful disclosed in the specification. The usual rule is that what is not claimed is disclaimed.”

⁴⁸ *Eli Lilly & Co. v. O'Hara Manufacturing Ltd.*, 1989 CarswellNat 504, 26 C.P.R. (3d) 1 (Fed. C.A.) per Pratte J.A.

the model with the drum fixed in place and was sued for infringement. The issue was whether “flexibly biased against the drum” was an essential element of the claim at issue. The Federal Court of Appeal effectively asked, “How can a claim element not be considered essential when the patentee put it in the claim?”:

... the patentee is tied strictly to the invention which he claims and the mode of effecting an improvement which he says is his invention.⁴⁹

The Federal Court of Appeal held that, because the O’Hara device lacked the feature of “flexibly biasing the plenum against the drum”, there was no infringement. More importantly, the Court said that it could not rewrite the patent claim to omit the feature that was later discovered to be unnecessary.

A court must interpret the claims; it cannot redraft them. When an inventor has clearly stated in the claims that he considered a requirement as essential to his invention, a court cannot decide otherwise for the sole reason that he was mistaken.⁵⁰

6.3.1.2 Substantive Infringement

In contrast to literal infringement, substantive infringement was, in effect, infringing the equity of the patent by “unfairly” making a minor variation to the invention as “literally” claimed.

Non-essential elements could not only be varied and there still be infringement, but they could also be omitted altogether from the defendant’s product or method, and there still be infringement:

The principle is, indeed, no more than a particular application of the more general principle that a person who takes what in the familiar, though oddly mixed metaphor is called the pith and marrow of the invention is an infringer. If he takes the pith and marrow of the invention he commits an infringement even though he omits an unessential part. So, too, he commits an infringement if, instead of omitting an unessential part, he substitutes for that part a mechanical equivalent.⁵¹

Infringing the pith and substance of the invention presupposed that a patent claim, as drafted, was narrower (by including more limitations) than the “pith and substance” of the invention. The court, considering it unfair to permit a

⁴⁹ *Eli Lilly & Co. v. O’Hara Manufacturing Ltd.*, 1989 CarswellNat 504, 26 C.P.R. (3d) 1 (Fed. C.A.) per Pratte J.A. at 5-6 [C.P.R.].

⁵⁰ *Eli Lilly & Co. v. O’Hara Manufacturing Ltd.*, 1989 CarswellNat 504, 26 C.P.R. (3d) 1 (Fed. C.A.) per Pratte J.A. at 7 [C.P.R.].

⁵¹ *R.C.A. Photophone v. Gaumont-British Picture Corp.* (1935), 53 R.P.C. 167 (C.A.) per Romer J. at 197. See also *McPhar Engineering Co. v. Sharpe Instruments Ltd.*, 1960 CarswellNat 42, [1956-60] Ex. C.R. 467, 21 Fox Pat. C. 1 (Can. Ex. Ct.) at 525 [Ex. C.R.], 55 [Fox Pat. C.].

minor modification to avoid infringement, exercised its equitable jurisdiction to “stretch” the scope of the claim by allowing the claim to encompass articles or processes lacking the feature or having a modified feature (a variant). The “pith and substance” of the invention was, in effect, the invention as described by a hypothetical claim that was broader than what was written because one or more elements have been omitted or replaced with an equivalent.

The substantive infringement test was thus a “not all elements” test.

In *Free World*, Justice Binnie recognized the long history of “substantive infringement” under Canadian patent law but also recognized the harm it caused to predictability:

It has been established, at least since *Grip Printing and Publishing Co. of Toronto v. Butterfield* (1885), 11 S.C.R. 291, that a patent owner has a remedy against an alleged infringer who does not take the letter of the invention but nevertheless appropriates its substance (or “pith and marrow”).

...

“It is obviously an important public policy to control the scope of “substantive infringement”. A purely literal application of the text of the claims would allow a person skilled in the art to make minor and inconsequential variations in the device and thereby to appropriate the substance of the invention with a copycat device while staying just outside the monopoly. A broader interpretation, on the other hand, risks conferring on the patentee the benefit of inventions that he had not in fact made but which could be deemed with hindsight to be “equivalent” to what in fact was invented. This would be unfair to the public and unfair to competitors. It is important that the patent system be fair as well as predictable in its operation.”⁵²

One of the leading cases in Canada for infringement of the “pith and substance” of a patent is *McPhar Engineering Co. v. Sharpe Instruments Ltd.*⁵³ In the *McPhar* case, the claims called for “... means to suspend said transmitting coil to hang freely in a vertical plane but orientable in azimuth ...” and “... a transmitting coil suspended to hang vertically and orientable in azimuth”. Figure 1 from the patent is shown in Figure 1 below.

⁵² *Free World Trust c. E' lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 183 [C.P.R.], paras. 28 and 29. It should be noted that the *Grip Printing* case that Justice Binnie cited as authority for the proposition of “substantive infringement” predated the Canadian statutory requirement for a patent to end with claims.

⁵³ *McPhar Engineering Co. v. Sharpe Instruments Ltd.*, 1960 CarswellNat 42, [1956-60] Ex. C.R. 467, 21 Fox Pat. C. 1 (Can. Ex. Ct.).

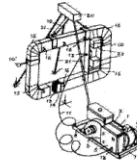


Figure 1: McPhar Patent Drawing

In contrast, the defendant mounted its coil on top of a tripod, allowing free rotation about the azimuth (vertical axis).

The Court held that there was infringement under the “pith and substance” doctrine:

“Thus it is established law that if a person takes the substance of an invention he is guilty of infringement and it does not matter whether he omits a feature that is not essential to it or substitutes an equivalent for it.”⁵⁴ [emphasis added.]

One of the most liberal examples of claim re-writing that occurred under the “pith and substance” approach occurred in *Baxter Travenol Laboratories of Canada Ltd. v. Cutter (Canada) Ltd.*⁵⁵ The claims of the *Baxter* patent described the use of a “cannula” (which is a tube similar to a hypodermic needle) to puncture a membrane in a tube connecting two bags used for blood collection and allow fluid passage between the two bags. Figures 1 and 2 from the patent are shown in Figure 2 below.

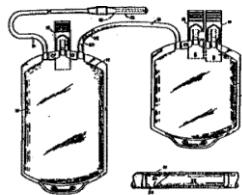


Figure 2: Baxter Patent Drawing

Instead of a cannula, the Cutter device used a vaned spike (like a tent peg) which punctured the membrane allowing the blood to flow around it.

The Court of Appeal held that there was infringement by the taking of the pith and substance of the patent:

⁵⁴ *McPhar Engineering Co. v. Sharpe Instruments Ltd.*, 1960 CarswellNat 42, [1956-60] Ex. C.R. 467, 21 Fox Pat. C. 1 (Can. Ex. Ct.) at 55 [Fox Pat. C.].

⁵⁵ 1983 CarswellNat 508, 68 C.P.R. (2d) 179 (Fed. C.A.), leave to appeal refused 1983 CarswellNat 825 (S.C.C.).

It seems to me to be plain that the Cutter spike is, as found by the learned trial judge, the functional equivalent of the cannula referred to in claims 1, 2 and 4. Both are operated by the technician in the same way. Both rupture the membrane and establish a channel or channels through which blood or its components or anticoagulants can flow. Both do it in the same way. The evidence shows that the cannula ruptures the membrane by causing a transverse slit which permits the blood to flow around the outside wall of the cannula as well as through its lumen.

Moreover, both devices are in the tube and are unattached.

Further, in my view, the precise structure or configuration of the device to be used to rupture the membrane and establish a flow channel is not an essential element of the invention. As I see it, it would not matter whether a cannula or a vaned spike or a device of some other sort, such as, for example, a device of the like proportions with a semicircular cross section, were used or whether it would cut out in whole or in part or merely rupture the membrane. The substance of the invention, its “pith and marrow”, would be taken so long as the rupturing device had the essential elements of being in the tube and being unattached. I think therefore that the substance of the invention has been taken and that all the claims of the patent were infringed by the Cutter device.⁵⁶

Obviously, a spike is not a tube. Had Baxter wanted to protect a spike, it could have — and should have — claimed something broader than a cannula that would have encompassed a cannula, the vaned spike and “a device of like proportions with a semicircular cross-section” (e.g. a “membrane piercing means”).

6.3.2 *Catnic*

From the 1980’s until *Free World*,⁵⁷ Canadian patent claim construction has been strongly influenced by the *Catnic*⁵⁸ case, a decision of the U.K. House of Lords, which, while purporting to “clarify” the old pith and substance infringement test, in fact, restated it in more tortured language as a claim construction method. This test has been difficult for later courts to apply.

In the *Catnic* case, Catnic’s patent claimed a lintel (the bar that spans the top of a window to support the weight of the bricks laid above it) having a rear wall member “extending vertically”. A cross-sectional view of the *Catnic* lintel from

⁵⁶ *Baxter Travenol Laboratories of Canada Ltd. v. Cutter (Canada) Ltd.*, 1983 CarswellNat 508, 68 C.P.R. (2d) 179 (Fed. C.A.) at 198-199 [C.P.R.], leave to appeal refused 1983 CarswellNat 825 (S.C.C.).

⁵⁷ *Free World Trust c. E' lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J.

⁵⁸ *Catnic Components Ltd. v. Hill & Smith Ltd.* (1981), [1982] R.P.C. 183 (U.K. H.L.) per Lord Diplock, affirmed (1982), [1983] F.S.R. 512 (U.K. H.L.).

the *Catnic* patent drawings is shown in Figure 3 below. The rear wall is highlighted.

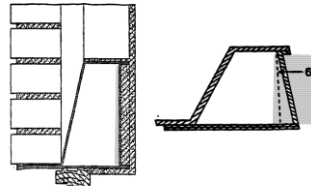


Figure 3: Catnic Patent Drawing

Figure 4: Hill Lintel

Hill's lintel differed from what was illustrated in the *Catnic* patent in that the rear wall was inclined 6 or 8 degrees off vertical, as shown and highlighted in Figure 4 above. The sloping of the rear wall made the Hill lintels 0.6 to 1.2% weaker in their load bearing capacities than the *Catnic* lintels. Functionally, it was a negligible difference.

The trial judge, Whitford J., held that there was no literal infringement but there was infringement under the “pith and marrow” doctrine. The Court of Appeal held that the limitation that the rear member should “extend vertically” was an essential feature and, being changed or absent, there could be no infringement of the “pith and marrow”.

The House of Lords overturned and found there to be infringement. Lord Diplock attempted to put an end to the “pith and substance” infringement test and replace it with a supposedly simpler test of claim construction: “purposive construction”.

... both parties to this appeal have tended to treat ‘textual infringement’ and infringement of the ‘pith and marrow’ of an invention as if they were separate causes of action, the existence of the former to be determined as a matter of construction only and of the latter upon some broader principle of colourable invasion. There is, in my view, no such dichotomy; there is but a single cause of action and to treat it otherwise, particularly in cases like that which is the subject of the instant appeal, is liable to lead to confusion.⁵⁹

Lord Diplock created a test to be used when considering whether a variant from what was (presumably) literally claimed,⁶⁰ nevertheless should be considered to be within the claims:

⁵⁹ *Catnic Components Ltd. v. Hill & Smith Ltd.* (1981), [1982] R.P.C. 183 (U.K. H.L.) per Lord Diplock at 242, affirmed (1982), [1983] F.S.R. 512 (U.K. H.L.).

⁶⁰ Ironically, at 244 of the *Catnic* decision, Lord Diplock appears to have concluded that Hill's structure was included within the meaning of the term “extending vertically” as it would have been understood by a bricklayer, in the context of the *Catnic* patent:

It may be that when used by a geometer addressing himself to fellow geometers, such expressions descriptive of relative position as “horizontal”, “parallel”, “vertical” and “vertically” are to be understood

My Lords, a patent specification is a unilateral statement by the patentee, in words of his own choosing, addressed to those likely to have a practical interest in the subject matter of his invention (i.e. “skilled in the art”), by which he informs them what he claims to be the essential features of the new product or process for which the letters patent grant him a monopoly. It is called “pith and marrow” of the claim. A patent specification should be given a purposive construction rather than a purely literal one derived from applying to it the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge. The question in each case is: whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used, would understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that any variant would fall outside the monopoly claimed, even though it could have no material effect upon the way the invention worked.

The question, of course, does not arise where the variant would in fact have a material effect upon the way the invention worked. Nor does it arise unless at the date of publication of the specification it would be obvious to the informed reader that this was so. Where it is not obvious, in the light of then-existing knowledge, the reader is entitled to assume that the patentee thought at the time of the specification that he had good reason for limiting his monopoly so strictly and had intended to do so, even though subsequent work by him or others in the field of the invention might show the limitation to have been unnecessary. It is to be answered in the negative only when it would be apparent to any reader skilled in the art that a particular descriptive word or phrase used in a claim cannot have been intended by the patentee, who was also skilled in the art, to exclude minor variants which, to the knowledge of both him and the readers to whom the patent was addressed, could have no material effect upon the way in which the invention worked.⁶¹

The Catnic test can be summarized as two questions that determine whether a claim element is essential:

1. Does the variant materially affect the way the invention works⁶² and was that obvious at the date of publication? If “Yes”, then the element is essential. If “No”, then ask question #2;

as words of precision only; but when used in a description of a manufactured product intended to perform the practical function of a weight-bearing box girder in supporting courses of brickwork over window and door spaces in buildings, it **seems to me that the expression “extending vertically”** as descriptive of the position of what in use will be the upright member of a trapezoid-shaped box girder, is **perfectly capable of meaning positioned near enough to the exact geometrical vertical to enable it in actual use to perform satisfactorily all the functions that it could perform if it were precisely vertical**; and having regard to those considerations to which I have just referred **that is the sense in which in my opinion “extending vertically” would be understood by a builder familiar with ordinary building operation.** [emphasis added]

Therefore, arguably, the Hill device was within the claim language as it would have been read by a skilled bricklayer and was not a variant at all.

⁶¹ *Catnic Components Ltd. v. Hill & Smith Ltd.* (1981), [1982] R.P.C. 183 (U.K. H.L.) per Lord Diplock at 242-243, affirmed (1982), [1983] F.S.R. 512 (U.K. H.L.).

⁶² Which begs the question: What invention? The one as literally described by the claim? The

2. Would it be apparent to a skilled reader that strict compliance with a particular descriptive word or phrase was intended by the patentee to be essential so as to exclude the minor variant? (In other words, did the patentee intend to include the variant when using that term?) If “No”, then the element is non-essential. If “Yes”, then it is essential.

The first question is similar to the “pith and substance” cases. As to the first question, since form follows function, any change to a claim element will, in most cases, in some way, change how the invention works — unless the element is irrelevant to the operation of the invention. What then is “material”? A more proper question to ask, therefore, is whether the change to the way the invention works was, for all practical purposes, negligible, as was the case in *Catnic* (0.6 to 1.2% weaker).

The second question of the *Catnic* test requires the Court to find an intention to limit the claim to strict compliance with the limiting word or phrase. This sounds like the old “literal infringement” approach. But how is that word or phrase to be construed? Acontextually and literally, or contextually and purposively? The former is narrow and limiting; the latter can expand or contract the meaning of the word or phrase based on its context.

In reality, the patentee would have drafted the claim from the viewpoint of what was intended to be included rather than what was to be excluded. Non-included matters might not have been considered at all.⁶³ Would things that were not even considered by the patentee be included because they could never have been intended to be excluded?

Lord Diplock held that the 6 or 8 degrees angle of the Hill lintel rear wall made “no material difference to the way the lintel worked when used in building operations”⁶⁴ and that “[n]o plausible reason has been advanced why any rational patentee should want to place so narrow a limitation on his invention”⁶⁵ that it be at “precisely 90° to both horizontal plates”.⁶⁶ The Hill lintel was thus held to be within the *Catnic* claim.

Catnic, although not expressly saying so, provided a means of determining the scope of a word in a patent claim by determining with what degree of precision it is being used: “extending vertically” was interpreted to mean “extending within a few degrees of vertical” almost in the same manner that mechanical

preferred embodiment disclosed in the patent? Or a hypothetical embodiment that is described by the claim?

⁶³ *Daily v. Etablissements Fernand Berchet* (1992), [1993] R.P.C. 357 (C.A. (Civ. Div.)) at 363.

⁶⁴ *Catnic Components Ltd. v. Hill & Smith Ltd.* (1981), [1982] R.P.C. 183 (U.K. H.L.) per Lord Diplock at 244, affirmed (1982), [1983] F.S.R. 512 (U.K. H.L.).

⁶⁵ *Catnic Components Ltd. v. Hill & Smith Ltd.* (1981), [1982] R.P.C. 183 (U.K. H.L.) per Lord Diplock at 244, affirmed (1982), [1983] F.S.R. 512 (U.K. H.L.).

⁶⁶ *Catnic Components Ltd. v. Hill & Smith Ltd.* (1981), [1982] R.P.C. 183 (U.K. H.L.) per Lord Diplock at 244, affirmed (1982), [1983] F.S.R. 512 (U.K. H.L.).

devices are designed according to certain engineering tolerances (e.g., “plus or minus 0.01 mm”). In that respect, Lord Diplock’s second question might be phrased as: “With what degree of precision was the patentee using this word or phrase?” or, making it more reader-centric: “What would the skilled reader have understood to be the degree of precision of this word or phrase?” Expressed in non-engineering or geometer parlance, “How broadly or narrowly was the patentee using this word or phrase?”

The second question of the *Catnic* test was an evolution of the “literal infringement” test but instead of limiting the construction to the literal meaning of the word or phrase, it expanded (or contracted) it to include things a reader would understand to have been intended to have been included and to not include things that would have been intended to be excluded.

A problem with the *Catnic* test was that it presupposed that there was a variant from what was claimed — that every article or method under consideration was different from what was claimed by virtue of a “variant”, making it difficult to apply as a general rule when no variants were present or under consideration.⁶⁷ It also required the person construing the claim to “peek ahead” at the infringement or validity issue to determine what variant to consider during claim construction.

Although the *Catnic* test was first recognized in *Procter & Gamble Co. v. Calgon Interamerican Corp.*⁶⁸ and used subsequently in a few more cases,⁶⁹ it was not until the O’Hara⁷⁰ decision in 1989, that the Federal Court of Appeal fully adopted the *Catnic* test into Canadian jurisprudence.

6.3.3 Improver

The *Improver* case related to a depilatory device sold under the brand “Epilady”. The device had a rotating, arcuate, helical steel spring:

The arcuate form of the spring causes the gaps between the windings to open on its convex side but to be pressed together on the concave side. When the spring is held close to the skin and rotated by the motor at about 6,000 revolutions per minute,

⁶⁷ As discussed below in Chapter 6.10.1, according to the House of Lords in *Kirin-Amgen* some 20 years later, the *Catnic* questions should never have been applied generally, but only in special circumstances.

⁶⁸ *Procter & Gamble Co. v. Calgon Interamerican Corp.*, 1982 CarswellNat 604, 61 C.P.R. (2d) 1 (Fed. C.A.), leave to appeal refused 1982 CarswellNat 761 (S.C.C.).

⁶⁹ *Baxter Travenol Laboratories of Canada Ltd. v. Cutter (Canada) Ltd.*, 1983 CarswellNat 508, 68 C.P.R. (2d) 179 (Fed. C.A.), leave to appeal refused 1983 CarswellNat 825 (S.C.C.); *Johnson Controls Inc. v. Varta Batteries Ltd.*, 1984 CarswellNat 581, 80 C.P.R. (2d) 1 (Fed. C.A.), leave to appeal refused (1984), 56 N.R. 398n (S.C.C.); *Ductmate Industries Inc. v. Exanno Products Ltd.*, 1984 CarswellNat 603, 2 C.P.R. (3d) 289 (Fed. T.D.).

⁷⁰ *Eli Lilly & Co. v. O’Hara Manufacturing Ltd.*, 1989 CarswellNat 504, 26 C.P.R. (3d) 1 (Fed. C.A.) per Pratte J.A. at 7 [C.P.R.].

hairs enter the gaps on its convex side and are gripped between the windings as the rotational movement brings them round to the concave side. The effect is to pluck them out of the skin.⁷¹

Claim 1 referred to “... a helical spring (24) comprising a plurality of adjacent windings arranged to be driven by said motor means ... said helical spring (24) including an arcuate hair engaging portion arranged to define a convex side whereat the windings are spread apart and a concave side corresponding thereto whereat the windings are pressed together...”⁷² Remington, the defendant, had a device that had a rotating arcuate rubber rod with many closely spaced circumferential slits cut into it. When rotated, the slits of the Remington rod opened on its convex side and closed on its concave side engaging and plucking the hair.

In the *Improver*⁷³ case, Justice Hoffman (as he then was a judge on the Patents Court) rewrote the *Catnic* test making it one that interpreted the language of the claim, permitting variants from the primary or acontextual meaning of terms rather than one permitting the omission or variation of terms:

If the issue was whether a feature embodied in an alleged infringement which fell outside the primary, literal or acontextual meaning of a descriptive word or phrase in the claim [“a variant”] was nevertheless within its language as properly interpreted, the court should ask itself the following three questions:

1. Does the variant have a material effect upon the way the invention works? If yes, then the variant is outside the claim. If no?
2. Would this (i.e., that the variant had no material effect) have been obvious at the date of publication of the patent to a reader of the patent skilled in the art? If no, the variant is outside the claim. If yes?
3. Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention? If yes, then the variant is outside the claim.

On the other hand, a negative answer to the last question would lead to the conclusion that the patentee was intending the word or phrase to have not a literal but a figurative meaning (the figure being a form of synecdoche or metonymy) denoting a class of things which include the variant and the literal meaning, the

⁷¹ *Improver Corp. v. Remington Consumer Products Ltd.* (1989), [1990] F.S.R. 181 (Eng. Patents Ct.) at 184.

⁷² *Improver Corp. v. Remington Consumer Products Ltd.* (1989), [1990] F.S.R. 181 (Eng. Patents Ct.) at 187.

⁷³ *Improver Corp. v. Remington Consumer Products Ltd.* (1989), [1990] F.S.R. 181 (Eng. Patents Ct.).

latter being the most perfect, best-known or striking example of the class.⁷⁴
[emphasis added]

Hoffman, J.’s latter point appears to be a genus—species point whereby sometimes a general term is used to describe something specific, or vice versa, as discussed further in Chapter 6.7.4, below. A synecdoche is a figure of speech in which a part is made to represent the whole or vice versa, as in “Toronto won by six runs”, meaning “Toronto’s baseball team”), “wheels” refers to a car and “grey hair” refers to an older person. A metonymy is a word that is related to the thing being described, but is not necessarily part of it, as in “crown” refers to a monarch and “The pen is mightier than the sword” refers to written words and military force respectively. Using literary devices such as these is not recommended for claim drafting, however it should be noted that in *Whirlpool*, the term “vaness” in a prior art patent (a broad term) was construed to refer to “rigid vanes” (a narrow term), making the use of “vaness”, in that context, a synecdoche.

Hoffman’s restatement of *Catnic* effectively defined *Catnic*’s “strict compliance with a particular word or phrase” to first ask:

1. What was “the primary, literal or acontextual meaning of a descriptive word or phrase”?; and then ask;
2. Was the patentee using the word or phrase not in a literal manner but, instead, in a figurative manner that included the variant and the literal meaning?⁷⁵

It is curious that in *Improver*, when purportedly doing a purposive construction, Hoffman J. suggested first looking at the “primary, literal or acontextual meaning” of words in the claim and determining whether the variant fell outside that “literal” meaning. This appears to echo the older “literal infringement” test *Catnic* had tried to abandon and, as discussed below in Chapter 6.7, appears to be contrary to the Canadian principle of claim construction that words are to be

⁷⁴ *Improver Corp. v. Remington Consumer Products Ltd.* (1989), [1990] F.S.R. 181 (Eng. Patents Ct.) at 189. Justice Hoffman held that the rubber rod worked in the same way as the helical spring (p. 192), and this would have been obvious at the relevant time (p. 193), but that the term “helical spring” could not be given a “wide generic construction”. The rubber rod was not an approximation of a helical spring. The spring could not be regarded as “inessential” nor could the change from a metal spring to a rubber rod be a minor variant. The skilled man would be entitled to think that the patentee had good reason to limit himself, as he obviously did, to a helical coil (p. 197).

⁷⁵ This may have been an unintentional overstatement. If the word or phrase was intended to have a meaning narrower than the literal meaning, then it would not include the literal meaning. For example, in *Whirlpool* (discussed below) the otherwise broad, non-qualified term “vaness” was defined not to include “all” vanes (flexible and rigid) but instead was limited to the “rigid vanes” of the prior art.

given the ordinary meaning they would have to skilled readers of the patent, in the context of the patent.

He might more simply have asked, “ How broadly or narrowly is this word or phrase being used in the context of the claim (and thus in the context of the patent)?”

6.3.4 The Evolution of Claim Construction – a Chart

The chart below summarizes the evolution of claim construction in Canada.

	Q #1(a)	Q #1(b) (or Improver Q #2)	Q #2 (or Improver Q #3)	Process
pith and sub- stance	taking the substance		literal infringe- ment	Ask Q #2 first; if not, ask Q #1.
<i>Catnic</i>	Does the variant change the way the in- vention works?	Was that obvious at the time?	Was a particular descriptive word or phrase used in a claim intended by the patentee to exclude minor variants?	Ask Q #1(a): If “No”, ask Q #1(b). If “Yes”, the element is essential and the variant is outside the claim. Ask Q #1(b): If “Yes”, then ask Q #2. If “No”, the variant is outside the claim. Ask Q #2: If “No”, the element is non-essential and the variant is inside the claim. If “Yes”, the element is essential and the variant is outside the claim.
<i>Impro- ver</i>	Does the variant change the way the in- vention works?	Was that obvious at the time?	Was strict com- pliance with the primary meaning of the claim ele- ment an essential requirement of	[ditto] Ask Q #1(a): If “No”, ask Q #1(b). If “Yes”, the element is essential and the variant is outside the claim.

		<p>the invention? (Or was the word intended to have not a literal but a figurative meaning that included more [or less] than the literal?)</p>	<p>Ask Q #2: If “ No” , the element is non-essential and the variant is inside the claim. If “ Yes” , the element is essential and the variant is outside the claim.</p>
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6.4 THE FIRST DUTY OF THE COURT

The first duty of the Court in a patent trial is to construe the claims in issue⁷⁶ in order to give them meaning and to determine their scope.⁷⁷

⁷⁶ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 146 [C.P.R.], para. 43, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *Electrical & Musical Industries Ltd. v. Lissen Ltd.* (1938), 56 R.P.C. 23 (U.K. H.L.) (per Lord Russell of Killowen) at 39; *Lovell Manufacturing Co. v. Beatty Brothers Ltd.*, 1962 CarswellNat 22, 41 C.P.R. 18 (Can. Ex. Ct.) Per Thomson P. at

It has always been a fundamental rule of claim construction that the claims receive one and the same interpretation for all purposes.⁷⁸

General rules of claim construction have been clearly established:

- Claims are to be construed before issues of infringement⁷⁹ or validity⁸⁰ are determined so that a consistent reading of the patent is applied to both; and
- Consideration of an allegedly infringing variant will only take place once the essential scope of the patent has been determined,⁸¹

The latter rule may necessarily be breached under the current “essential element” test because, as discussed below in Chapter 6.7.1.4, the test requires, at least, a determination of what is the variant at issue (as found in the defendant’s device or process).

70-71 [C.P.R.]; *American Cyanamid Co. v. Berk Pharmaceuticals Ltd.* (1973), [1976] R.P.C. 231 (Eng. Ch. Div.) at 234.

⁷⁷ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 146 [C.P.R.], paras. 43 and 45, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *Dableh v. Ontario Hydro*, 1996 CarswellNat 2592, 1996 CarswellNat 735, 68 C.P.R. (3d) 129 (Fed. C.A.) per Strayer J. (Linden and Robertson J.J.A. concurring) at 143 [C.P.R.], leave to appeal refused 1997 CarswellNat 3240 (S.C.C.); *Amfac Foods Inc. v. Irving Pulp & Paper Ltd.*, 1986 CarswellNat 637, 12 C.P.R. (3d) 193 (Fed. C.A.) at 198 [C.P.R.].

⁷⁸ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 149 [C.P.R.], para. 49(b), reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.);

⁷⁹ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 146 [C.P.R.], para. 43, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *Dableh v. Ontario Hydro*, 1996 CarswellNat 2592, 1996 CarswellNat 735, 68 C.P.R. (3d) 129 (Fed. C.A.) per Strayer J. (Linden and Robertson J.J.A. concurring) at 142-143 [C.P.R.], leave to appeal refused 1997 CarswellNat 3240 (S.C.C.); *Lundbeck Canada Inc. v. Canada (Minister of Health)*, 2010 FCA 320, 2010 CarswellNat 4425, 2010 CarswellNat 4426 (F.C.A.) per Noël J.A., Pelletier and Trudel J.J.A. concurring at para. 72, leave to appeal refused 2011 CarswellNat 3240, 2011 CarswellNat 3241 (S.C.C.), leave to appeal refused 2011 CarswellNat 3229, 2011 CarswellNat 3230 (S.C.C.), leave to appeal refused 2011 CarswellNat 3242, 2011 CarswellNat 3243 (S.C.C.).

⁸⁰ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 146 [C.P.R.], para. 43, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *American Cyanamid Co. v. Berk Pharmaceuticals Ltd.* (1973), [1976] R.P.C. 231 (Eng. Ch. Div.) at 234; *Xerox of Canada Ltd. v. IBM Canada Ltd.*, 1977 CarswellNat 669, 33 C.P.R. (2d) 24 (Fed. T.D.) per Collier J. at 43 [C.P.R.] quoting *American Cyanamid Co. v. Berk Pharmaceuticals Ltd.* (1973), [1976] R.P.C. 231 (Eng. Ch. Div.) at 234; *Lundbeck Canada Inc. v. Canada (Minister of Health)*, 2010 FCA 320, 2010 CarswellNat 4425, 2010 CarswellNat 4426 (F.C.A.) per Noël J.A., Pelletier and Trudel J.J.A. concurring at para. 72, leave to appeal refused 2011 CarswellNat 3240, 2011 CarswellNat 3241 (S.C.C.), leave to appeal refused 2011 CarswellNat 3229, 2011 CarswellNat 3230 (S.C.C.), leave to appeal refused 2011 CarswellNat 3242, 2011 CarswellNat 3243 (S.C.C.).

⁸¹ *Janssen Pharmaceutica Inc. v. Apotex Inc.*, 2001 CarswellNat 1631, 2001 CarswellNat 3174, 13 C.P.R. (4th) 410 (Fed. C.A.) per Linden J.A., Isaac and Malone J.J.A. concurring at 425 [C.P.R.], para. 36.

6.4.1 Claim Construction is the Job of the Court

6.4.2 Claim Construction: a Legal, not a Factual Question: a “Question of Law”

If claim construction is the judge asking “What would a POSITA understand the claim to mean?”, does that make the question a factual one or a legal one?

As discussed below, since at least 1934,⁸² the Supreme Court of Canada has consistently held that claim construction is a question of law for the judge to decide. The construction of a patent is for the court, like that of any other legal document.⁸³

In *Whirlpool*, Justice Binnie observed that the “role of the expert was not to interpret the patent claims but to put the trial judge in the position of being able to do so in a knowledgeable way”,⁸⁴ finding that “claims construction is a matter of law for the judge”.⁸⁵

Likewise, in the U.K., the construction of a patent is a question of law⁸⁶ for the judge.⁸⁷ In Australia, the construction of a patent is a question of law and it is for the Court, not for any witness, however expert, to construe the specification.⁸⁸

It is suggested that claim construction is a question of law because it is the interpretation of a legal document, requiring the application of legal rules and principles of claim construction, discussed below. Claim construction requires the correct application of the legal skills of the judge, not the scientific or technical skills of an expert.

⁸² *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) at paras. 61 & 76, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.), *Western Electric Co. v. Baldwin International Radio of Canada Ltd.*, 1934 CarswellNat 38, [1934] S.C.R. 570 (S.C.C.) at 572 [S.C.R.].

⁸³ *Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd.*, 1974 CarswellNat 378, 1974 CarswellNat 378F, [1976] 1 S.C.R. 555 (S.C.C.) at 563 [S.C.R.], quoted in *Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd.*, 1981 CarswellNat 582F, 1981 CarswellNat 582, [1981] 1 S.C.R. 504 (S.C.C.) at 522-523 [S.C.R.].

⁸⁴ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) at para. 57, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); followed in *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2005 CarswellNat 4401, 2005 CarswellNat 7441, 46 C.P.R. (4th) 244 (F.C.) per Hughes J. at 250 [C.P.R.], para. 10, affirmed 2007 CarswellNat 6, 2007 CarswellNat 1052 (F.C.A.).

⁸⁵ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) at para. 61, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

⁸⁶ *Eli Lilly Canada Inc. v. Pharmascience and Laboratoire Riva Inc.*, 2021 FCA 127, 2021 CarswellNat 2269 (F.C.A.) at para. 9.

⁸⁷ *British Celanese v. Courtaulds*, [1935] 52 R.P.C. 171 (H.L.) at 196.

⁸⁸ See for example *Meat and Livestock Australia Ltd. (ACN 081 678 364) v. Branhaven LLC and Another*, [2020] FCAFC 171, 154 I.P.R. 402 at para. 101 citing *Jupiters Ltd. v. Neurizon Pty Ltd.*, [2005] FCAFC 90, 222 A.L.R. 155 [*Jupiters*] at para. 67; *Commissioner of Patents v. Rokt Pte Ltd.*, [2020] FCAFC 86, 379 A.L.R. 86 at para. 71, citing *Jupiters* at para 67 and *De cor Corp. Pty Ltd. v. Dart Industries Inc.* (1988), [1988] FCA 399, 13 I.P.R. 385 at 400 [I.P.R.].

It is suggested that the judge's "legal" contribution to claim construction is the correct application of the established legal rules and principles⁸⁹ of claim construction, discussed throughout this chapter.⁹⁰

Because there are no jury trials in the Federal Court and all questions are decided by the trial judge, this distinction makes little difference there. There are significant implications on appeal, because the appellate court has different standards of review for findings of fact, findings of law and mixed questions of fact and law (discussed below).

Because claim construction is a question of law, direct evidence as to the meaning of the claims should be inadmissible.⁹¹ Experts are not permitted to usurp the functions of the trier of fact.⁹² The closer the expert's opinion approaches an opinion on the ultimate issue, the stricter the application of these principles should be.⁹³ Some judges, however, allow evidence to be given on an ultimate issue, but give that evidence whatever weight they consider appropriate.⁹⁴

6.4.2.1 Factual Findings during Claim Construction

It is a well-established principle that a patent specification is addressed not to the public generally, but to persons skilled in the particular art.⁹⁵ Claim construction is to be done on the basis that the addressee is a person skilled in

⁸⁹ Such as those set out in *Free World Trust c. E' lectro Santé Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 184-185 [C.P.R.], para. 31.

⁹⁰ For example, the language of a patent's claims is to be given primacy; See *Free World* at para 31(a)-(d); Express definitions must be followed; See *Minerals Separation North American Corp. v. Noranda Mines Ltd.*, 1952 CarswellNat 2, 15 C.P.R. 133 (Jud. Com. of Privy Coun.) at 144-145 [C.P.R.]. See also *Bombardier Recreational Products Inc. v. Arctic Cat, Inc.*, 2018 FCA 172, 2018 CarswellNat 5338, 2018 CarswellNat 5339 (F.C.A.) per Gauthier J.A., Pelletier & de Montigny JJ.A., concurring at para. 43, leave to appeal refused 2019 CarswellNat 1959, 2019 CarswellNat 1960 (S.C.C.) where "[t]here was no definition in the disclosure limiting the ordinary meaning of this term of art."; Interpret the claims, do not redraft them; See *Eli Lilly & Co. v. O'Hara Manufacturing Ltd.*, 1989 CarswellNat 504, 26 C.P.R. (3d) 1 (Fed. C.A.) [O'Hara] at 7 [C.P.R.]; Do not read limitations from the disclosure into a claim that are not there; See *Regents of the University of California v. I-MED Pharma Inc.*, 2018 FC 164, 2018 CarswellNat 760, 2018 CarswellNat 1890 (F.C.) at paras. 134 and 135, affirmed 2019 FCA 179, 2019 CarswellNat 2428, 2019 CarswellNat 14703 (F.C.A.) at para. 47.

⁹¹ *Novartis AG v. Dexcel-Pharma Limited*, [2008] EWHC 1266 (Pat), [2008] All E.R. (D) 97 at para. 21; quoted in *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) at para. 18.

⁹² *R. v. Mohan*, 1994 CarswellOnt 1155, 1994 CarswellOnt 66, [1994] 2 S.C.R. 9 (S.C.C.) per Sopinka J. at 24 [S.C.R.].

⁹³ *R. v. Mohan*, 1994 CarswellOnt 1155, 1994 CarswellOnt 66, [1994] 2 S.C.R. 9 (S.C.C.) per Sopinka J. at 25 [S.C.R.].

⁹⁴ *Xerox of Canada Ltd. v. IBM Canada Ltd.*, 1977 CarswellNat 669, 33 C.P.R. (2d) 24 (Fed. T.D.) per Collier J. at 36-37 [C.P.R.]; referred to recently by Justice Hughes in *Pason Systems Corp. v. Canada (Commissioner of Patents)*, 2006 FC 753, 2006 CarswellNat 1656, 2006 CarswellNat 3810 (F.C.) at para. 27 as a "Jenny Craig" order in that it put it all in, "subject to weight".

⁹⁵ *Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd.*, 1981 CarswellNat 582F, 1981 CarswellNat 582, [1981] 1 S.C.R. 504 (S.C.C.) at 521 [S.C.R.].

the art, and the knowledge such a person is expected to possess is to be taken into consideration⁹⁶ and is to be construed by the standard of what such a person would understand on reading it.⁹⁷

It is suggested that a prerequisite to claim construction is for the judge to understand the jargon of the technology: “What would have been the ordinary meanings to the POSITA, in the art/field, of the terms used in the claims and the rest of the patent?” The judge is required to take into account the evidence as to how persons skilled in the art would understand certain words and phrases used in the patent, but it is for the judge to decide what the patent means.⁹⁸

Construction, therefore, turns heavily on the evidence of a person skilled in the art (person of ordinary skill in the art or “POSITA”).⁹⁹

The judge’s assessment of the expert evidence as well as his or her factual conclusions as to the state of the art¹⁰⁰ and expert evidence that affects the Federal Court’s construction (particularly where the Federal Court has preferred the testimony of one expert over that of others),¹⁰¹ are factual

⁹⁶ *Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd.*, 1974 CarswellNat 378, 1974 CarswellNat 378F, [1976] 1 S.C.R. 555 (S.C.C.) at 563 [S.C.R.], quoted in *Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd.*, 1981 CarswellNat 582F, 1981 CarswellNat 582, [1981] 1 S.C.R. 504 (S.C.C.) at 522-523 [S.C.R.].

⁹⁷ *Jules R. Gilbert Ltd. v. Sandoz Patents Ltd.*, 1972 CarswellNat 438, 1972 CarswellNat 438F, [1974] S.C.R. 1336 (S.C.C.) per Pigeon J. at 1347 [S.C.R.].

⁹⁸ *Apotex Inc. v. Sanofi-Aventis Canada Inc.*, 2013 FCA 186, 2013 CarswellNat 2585, 2013 CarswellNat 11461, 447 N.R. 313 (F.C.A.) per Pelletier J.A. at para. 33, varied on reconsideration 2013 CarswellNat 12471, 2013 CarswellNat 3404 (F.C.A.), leave to appeal allowed 2014 CarswellNat 117, 2014 CarswellNat 118 (S.C.C.), citing *Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd.*, 1981 CarswellNat 582F, 1981 CarswellNat 582, [1981] 1 S.C.R. 504 (S.C.C.) at 521-525 [S.C.R.].

⁹⁹ *Unilever PLC v. Procter & Gamble Inc.*, 1995 CarswellNat 375, 61 C.P.R. (3d) 499, 184 N.R. 378 (Fed. C.A.) at 506-507 [C.P.R.]; *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Stratas J.A., Pelletier and Webb J.J.A. concurring at para. 15.

¹⁰⁰ *Astrazeneca Canada Inc. v. Mylan Pharmaceuticals ULC*, 2012 FCA 109, 2012 CarswellNat 979, 2012 CarswellNat 2008, 432 N.R. 292 (F.C.A.) at para. 20; *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd.*, 2012 FCA 333, 2012 CarswellNat 5802, 2012 CarswellNat 5270, [2014] 2 F.C. 459 (F.C.A.) at para. 44; *Eurocopter c. Bell Helicopter Textron Canada Ltée*, 2013 FCA 219, 2013 CarswellNat 6962, 2013 CarswellNat 3455, 449 N.R. 111 (F.C.A.) at paras. 73-74, reconsideration / rehearing refused 2013 CarswellNat 4333, 2013 CarswellNat 4334 (F.C.A.); *Weatherford Canada Ltd. v. Corlac Inc.*, 2011 FCA 228, 2011 CarswellNat 2835, 2011 CarswellNat 3714 (F.C.A.) per Layden-Stevenson J.A., Nadon & Evans J.J.A. concurring at paras. 24 & 27, leave to appeal refused 2012 CarswellNat 846, 2012 CarswellNat 847 (S.C.C.); *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Stratas J.A., Pelletier and Webb J.J.A. concurring at para. 15; *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at paras. 23 & 26 and applied at para. 49.

¹⁰¹ *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Stratas J.A., Pelletier and Webb J.J.A. concurring at para. 15; *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at paras. 24 & 26.

findings that will not be reversed on appeal absent palpable and overriding error, and are entitled to deference.¹⁰²

But that is where it ends¹⁰³ or should end.

It is suggested such deference should apply only to *factual* evidence and *factual* findings, and not a technical expert's legal opinion on the construction of the patent (discussed below).

6.4.2.2 Construing the Claims

6.4.2.3 Standard of Review on Appeal: "Correctness"

Because the construction of a claim is a "question of law", the standard of review on appeal should be whether the claim construction by the lower court was "correct",¹⁰⁴ as the Court of Appeal is equally able to determine questions of law.¹⁰⁵

Appellate review is only concerned with legal errors that bear on the outcome of the case. If the error would not have affected the Federal Court's judgment, the appeal must be dismissed. An inconsequential legal error will not result in the appeal being allowed.¹⁰⁶

¹⁰² *Zero Spill Systems (Int'l) Inc. v. Heide*, 2015 FCA 115, 2015 CarswellNat 1357, 2015 CarswellNat 9212 (F.C.A.) per Stratas J.A., Dawson & Near JJ.A. concurring at para. 43, leave to appeal refused 2016 CarswellAlta 51, 2016 CarswellAlta 52 (S.C.C.), leave to appeal refused 2016 CarswellNat 12321, 2016 CarswellNat 12322 (S.C.C.), citing *Astrazeneca Canada Inc. v. Mylan Pharmaceuticals ULC*, 2012 FCA 109, 2012 CarswellNat 979, 2012 CarswellNat 2008, 432 N.R. 292 (F.C.A.) at para. 20; *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd.*, 2012 FCA 333, 2012 CarswellNat 5802, 2012 CarswellNat 5270, [2014] 2 F.C. 459 (F.C.A.) at para. 44; *Eurocopter c. Bell Helicopter Textron Canada Lte e*, 2013 FCA 219, 2013 CarswellNat 6962, 2013 CarswellNat 3455, 449 N.R. 111 (F.C.A.) at paras. 73-74, reconsideration / rehearing refused 2013 CarswellNat 4333, 2013 CarswellNat 4334 (F.C.A.) and *Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd.*, 1981 CarswellNat 582F, 1981 CarswellNat 582, 122 D.L.R. (3d) 203, [1981] 1 S.C.R. 504 (S.C.C.) at 537 [S.C.R.].

¹⁰³ *Halford v. Seed Hawk Inc.*, 2001 FCT 1154, 2001 CarswellNat 3884, 2001 CarswellNat 2519 (Fed. T.D.) at para. 24.

¹⁰⁴ *Apotex Inc. v. Sanofi-Aventis Canada Inc.*, 2013 FCA 186, 2013 CarswellNat 2585, 2013 CarswellNat 11461, 447 N.R. 313 (F.C.A.) per Pelletier J.A. at paras. 32-33, varied on reconsideration 2013 CarswellNat 12471, 2013 CarswellNat 3404 (F.C.A.), leave to appeal allowed 2014 CarswellNat 117, 2014 CarswellNat 118 (S.C.C.), citing *Housen v. Nikolaisen*, 2002 SCC 33, 2002 CarswellSask 178, 2002 CarswellSask 179, [2002] 2 S.C.R. 235 (S.C.C.) at para. 6.

¹⁰⁵ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at para. 76, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); and *Apotex Inc. v. Sanofi-Aventis Canada Inc.*, 2013 FCA 186, 2013 CarswellNat 2585, 2013 CarswellNat 11461, 447 N.R. 313 (F.C.A.) at paras. 32-33, varied on reconsideration 2013 CarswellNat 12471, 2013 CarswellNat 3404 (F.C.A.), leave to appeal allowed 2014 CarswellNat 117, 2014 CarswellNat 118 (S.C.C.); *Apotex Inc. v. AstraZeneca Canada Inc.*, 2017 FCA 9, 2017 CarswellNat 40, 2017 CarswellNat 10632 (F.C.A.) per Gauthier J.A., Pelletier & Scott JJ.A. concurring at para. 29, leave to appeal refused 2017 CarswellNat 2529, 2017 CarswellNat 2530 (S.C.C.).

¹⁰⁶ *Zero Spill Systems (Int'l) Inc. v. Heide*, 2015 FCA 115, 2015 CarswellNat 1357, 2015 CarswellNat 9212 (F.C.A.) per Stratas J.A., Dawson & Near JJ.A. concurring at para. 54, leave to appeal

Following the long established line of authorities, the Federal Court of Appeal confirmed in 2017 that construction is a question of law, and that questions of law are reviewable on the correctness standard: “[w]hile it was argued that the standard of review for patent construction is palpable and overriding error, the Supreme Court has consistently applied correctness”.¹⁰⁷ In 2021, the Federal Court of Appeal likewise followed that it is “well established” that construction is a question of law.¹⁰⁸

Factual findings are subject to a different standard of review on appeal: in order for the Court of Appeal to intervene, there must have been a “palpable and overriding error”: for example, the state of the art,¹⁰⁹ how particular words would be understood by the POSITA.¹¹⁰

Palpable and overriding error is a highly deferential standard of review.¹¹¹ “Palpable” means an error that is obvious. “Overriding” means an error that goes to the very core of the outcome of the case.¹¹²

refused 2016 CarswellAlta 51, 2016 CarswellAlta 52 (S.C.C.), leave to appeal refused 2016 CarswellNat 12321, 2016 CarswellNat 12322 (S.C.C.).

¹⁰⁷ *Apotex Inc. v. AstraZeneca Canada Inc.*, 2017 FCA 9, 2017 CarswellNat 40, 2017 CarswellNat 10632 (F.C.A.) per Gauthier, J.A., Pelletier & Scott J.J.A. concurring at para. 29, leave to appeal refused 2017 CarswellNat 2529, 2017 CarswellNat 2530 (S.C.C.) citing *Whirlpool Corp. v. Camco Inc.*, 2000 SCC 67, 2000 CarswellNat 2846, 2000 CarswellNat 2861, [2000] 2 S.C.R. 1067 (S.C.C.) at para. 76, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.), and *Apotex Inc. v. Sanofi-Aventis Canada Inc.*, 2013 FCA 186, 2013 CarswellNat 2585, 2013 CarswellNat 11461, 447 N.R. 313 (F.C.A.) at paras. 32-33, varied on reconsideration 2013 CarswellNat 12471, 2013 CarswellNat 3404 (F.C.A.), leave to appeal allowed 2014 CarswellNat 117, 2014 CarswellNat 118 (S.C.C.).

¹⁰⁸ *Canmar Foods Ltd. v. TA Foods Ltd.*, 2021 FCA 7, 2021 CarswellNat 76, 2021 CarswellNat 5131 (F.C.A.) at para. 21.

¹⁰⁹ *Halford v. Seed Hawk Inc.*, 2006 FCA 275, 2006 CarswellNat 2397, 2006 CarswellNat 4150 (F.C.A.) at para. 11; See also *Weatherford Canada Ltd. v. Corlac Inc.*, 2011 FCA 228, 2011 CarswellNat 2835, 2011 CarswellNat 3714, 95 C.P.R. (4th) 101 (F.C.A.) at para. 24, leave to appeal refused 2012 CarswellNat 846, 2012 CarswellNat 847 (S.C.C.) and *Eurocopter c. Bell Helicopter Textron Canada Ltee*, 2013 FCA 219, 2013 CarswellNat 6962, 2013 CarswellNat 3455, 449 N.R. 111 (F.C.A.) at para. 74, reconsideration / rehearing refused 2013 CarswellNat 4333, 2013 CarswellNat 4334 (F.C.A.).

¹¹⁰ *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd.*, 2012 FCA 333, 2012 CarswellNat 5802, 2012 CarswellNat 5270, [2014] 2 F.C. 459 (F.C.A.) at para. 44; See also *Apotex Inc. v. AstraZeneca Canada Inc.*, 2017 FCA 9, 2017 CarswellNat 40, 2017 CarswellNat 10632 (F.C.A.) per Gauthier J.A., Pelletier & Scott J.J.A. concurring at para. 9, leave to appeal refused 2017 CarswellNat 2529, 2017 CarswellNat 2530 (S.C.C.); *AFDPetroleum Ltd. v. Frac Shack Inc.*, 2018 FCA 140, 2018 CarswellNat 3775, 2018 CarswellNat 12343 (F.C.A.) at para. 40; *Tensar Technologies, Limited v. Enviro-Pro Geosynthetics, Ltd.*, 2021 FCA 3, 2021 CarswellNat 36, 2021 CarswellNat 4326 (F.C.A.) at para. 29; *Apotex Inc. v. AstraZeneca Canada Inc.*, 2017 FCA 9, 2017 CarswellNat 40, 2017 CarswellNat 10632 (F.C.A.) per Gauthier J.A., Pelletier & Scott J.J.A. concurring at para. 30, leave to appeal refused 2017 CarswellNat 2529, 2017 CarswellNat 2530 (S.C.C.).

¹¹¹ *L. (H.) v. Canada (Attorney General)*, 2005 SCC 25, 2005 CarswellSask 268, 2005 CarswellSask 273, [2005] 1 S.C.R. 401 (S.C.C.); *Peart v. Peel (Regional Municipality) Police Services Board*, 2006 CarswellOnt 6912, 217 O.A.C. 269 (Ont. C.A.) at paras. 158-159, leave to appeal refused 2007 CarswellOnt 1882, 2007 CarswellOnt 1883 (S.C.C.); *Waxman v. Waxman*, 2004 CarswellOnt 1715, 186 O.A.C. 201 (Ont. C.A.), additional reasons 2004 CarswellOnt 6554 (Ont. C.A.), additional reasons 2004 CarswellOnt 3955 (Ont. C.A.), additional reasons 2004 CarswellOnt 4941

When arguing palpable and overriding error, it is not enough to pull at leaves and branches and leave the tree standing. The entire tree must fall.¹¹³

Mixed fact and law is also to be reviewed on a standard of palpable and overriding error, unless the error involves an extricable error of law, in which case the standard of correctness applies.¹¹⁴

Because the Court puts itself in the position of a hypothetical person (the POSITA) in a hypothetical factual scenario, the role of the court in claim construction is unlike the traditional role of the court in determining a “legal question” requiring either statutory interpretation, or the analysis of jurisprudence.

6.4.2.4 A Divergence in the Standard of Review Towards “Palpable and Overriding Error”

In January 2015, in *Teva Pharmaceuticals USA Inc. v. Sandoz Inc. et al.*,¹¹⁵ the United States Supreme Court differentiated findings of fact leading up to claim construction and claim construction itself, referring to the former as “subsidiary factual disputes”. It not only confirmed that construction is ultimately a legal

(Ont. C.A.), additional reasons 2004 CarswellOnt 3956 (Ont. C.A.), leave to appeal refused 2005 CarswellOnt 1217, 2005 CarswellOnt 1218 (S.C.C.), cited in *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Stratas J.A., Pelletier and Webb J.J.A. concurring at para. 15 and *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at para. 24, also referring to *South Yukon Forest Corp. v. R.*, 2012 FCA 165, 2012 CarswellNat 1674, 2012 CarswellNat 3024, 431 N.R. 286 (F.C.A.) at para. 45, leave to appeal refused 2012 CarswellNat 4787, 2012 CarswellNat 4788 (S.C.C.).

¹¹² *Zero Spill Systems (Int'l) Inc. v. Heide*, 2015 FCA 115, 2015 CarswellNat 1357, 2015 CarswellNat 9212 (F.C.A.) per Stratas J.A., Dawson & Near J.J.A. concurring at para. 49, leave to appeal refused 2016 CarswellAlta 51, 2016 CarswellAlta 52 (S.C.C.), leave to appeal refused 2016 CarswellNat 12321, 2016 CarswellNat 12322 (S.C.C.); *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Stratas J.A., Pelletier and Webb J.J.A. concurring at para. 15 and *ABB Technology AG*, quoted in *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at para. 24.

¹¹³ *South Yukon Forest Corp. v. R.*, 2012 FCA 165, 2012 CarswellNat 1674, 2012 CarswellNat 3024, 431 N.R. 286 (F.C.A.) at para. 45, leave to appeal refused 2012 CarswellNat 4787, 2012 CarswellNat 4788 (S.C.C.); cited in *Zero Spill Systems (Int'l) Inc. v. Heide*, 2015 FCA 115, 2015 CarswellNat 1357, 2015 CarswellNat 9212 (F.C.A.) per Stratas J.A., Dawson & Near J.J.A. concurring at para. 49, leave to appeal refused 2016 CarswellAlta 51, 2016 CarswellAlta 52 (S.C.C.), leave to appeal refused 2016 CarswellNat 12321, 2016 CarswellNat 12322 (S.C.C.); quoted in *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at para. 24.

¹¹⁴ *Apotex Inc. v. Sanofi-Aventis Canada Inc.*, 2013 FCA 186, 2013 CarswellNat 2585, 2013 CarswellNat 11461, 447 N.R. 313 (F.C.A.) per Pelletier J. at para. 32, varied on reconsideration 2013 CarswellNat 12471, 2013 CarswellNat 3404 (F.C.A.), leave to appeal allowed 2014 CarswellNat 117, 2014 CarswellNat 118 (S.C.C.).

¹¹⁵ *Teva Pharmaceuticals USA Inc. v. Sandoz Inc. et al.*, Doc. 13-854, 574 U.S. __ (2015) at 11-14.

question, it reconciled correctness review and the deference to be accorded to the underpinning factual findings. The Court held that:

1. the ultimate task of construing patent claims is a legal question reviewed *de novo*. Interpretation of evidence “intrinsic to the patent,” i.e., “the patent claims and specification, along with the prosecution history,” is treated as a determination of law;
2. In contrast, “subsidiary factual disputes” (e.g., findings relating to “the background science or the meaning of a term in the relevant art during the relevant time period”), are reviewable on the basis of clear error.¹¹⁶

The American standard of review *de novo* is analogous to the Canadian “correctness” standard for questions of law; “clear error” is analogous to the Canadian standard of “palpable and overriding error” for review of findings of fact.

Canadian courts took notice and suggested a similar (but modified) approach be taken.

In 2015 in *Cobalt*,¹¹⁷ the Federal Court of Appeal cited *Teva Pharmaceuticals USA Inc. v. Sandoz Inc. et al.*¹¹⁸ as support for the proposition that “deference should be accorded to the interpretations of patents reached by those who have seen the experts and have evaluated them”.¹¹⁹ This mischaracterized *Teva Pharmaceuticals USA Inc. v. Sandoz Inc. et al.*, which differentiated between subsidiary *factual* findings (to which deference should be given) and *legal* conclusions on claim construction (which should not).

In *Cobalt*, the Federal Court of Appeal offered “observations” for the Supreme Court to consider in reviewing the standard of review in a future case.¹²⁰ The Federal Court of Appeal stated that the “[i]nterpretations of the specification ... be reviewed on the basis of palpable and overriding error when they are heavily dependent on expert testimony, as they usually are.”¹²¹ The rationales supporting an appeal court adopting a deferential approach to the construction of patents where expert evidence has played a significant role seemed overwhelming to the court.¹²² The correctness review is not required for consistency and certainty.¹²³ The court asked how the appeal court was

¹¹⁶ *Teva Pharmaceuticals USA Inc. v. Sandoz Inc. et al.*, Doc. 13-854, 574 U.S. ____ (2015) at 12.

¹¹⁷ *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Pelletier J.A., Stratas & Webb JJ.A. concurring at para. 22.

¹¹⁸ *Teva Pharmaceuticals USA Inc. v. Sandoz Inc. et al.*, Doc. 13-854, 574 U.S. ____ (2015); no pinpoint within *Teva USSC* is identified in para 22. of *Cobalt*.

¹¹⁹ *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Pelletier J.A., Stratas & Webb JJ.A. concurring at para. 22.

¹²⁰ *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Pelletier J.A., Stratas & Webb JJ.A. concurring at para. 16.

¹²¹ *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Pelletier J.A., Stratas & Webb JJ.A. concurring at para. 24.

supposed to “cleave off those aspects of claim construction that flow from the trial judge’s appreciation of expert evidence from the words of the claim *per se*?”¹²⁴

However, the Court in *Cobalt* followed the established standard of review for claim construction – correctness – because “[t]hat is the law I must apply in these appeals.”¹²⁵

Also, in 2015 in *ABB Technology AG v. Hyundai Heavy Industries Co.*,¹²⁶ the Federal Court of Appeal moved further giving deference to the trial court¹²⁷ “in its appreciation of the evidence, particularly the expert evidence, that affects that [claim] construction”¹²⁸ echoing *Cobalt*. Also included in *ABB* as fact evidence subject to deference were “questions of patent construction that are heavily suffused with the Federal Court’s appreciation and assessment of the experts.”¹²⁹ The Court then referred to its *Cobalt* decision where it “queried whether ... the time has come to reconsider the view that appellate courts are to review patent construction on the basis of correctness”,¹³⁰ but again applied the standard of review of correctness “... pending any future consideration of the matter by the Supreme Court of Canada.”¹³¹

In *Apotex Inc. v. AstraZeneca Canada Inc.*,¹³² Justice Gauthier held that the Federal Court is entitled to deference in respect of its appreciation of the expert

¹²² *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Stratas J.A., Pelletier and Webb J.J.A. concurring at para. 21.

¹²³ *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Stratas J.A., Pelletier and Webb J.J.A. concurring at para. 20 citing *Housen v. Nikolaisen*, 2002 SCC 33, 2002 CarswellSask 178, 2002 CarswellSask 179, [2002] 2 S.C.R. 235 (S.C.C.) at paras. 8-37.

¹²⁴ *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Stratas J.A., Pelletier and Webb J.J.A. concurring at para. 20.

¹²⁵ *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Pelletier J.A., Stratas & Webb J.J.A. concurring at paras. 16 & 24.

¹²⁶ *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring.

¹²⁷ *Astrazeneca Canada Inc. v. Mylan Pharmaceuticals ULC*, 2012 FCA 109, 2012 CarswellNat 979, 2012 CarswellNat 2008, 432 N.R. 292 (F.C.A.) at para. 24.

¹²⁸ *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at paras. 23-24; See also *Western Oilfield Equipment Rentals Ltd. et al. v. M-I L.L.C.*, 2021 FCA 24, 2021 CarswellNat 234 (F.C.A.) that held at para. 17 that because “... claim construction is typically assisted by expert evidence, and the weighing of such evidence by the trial judge is reviewed on a standard of palpable and overriding error”; *Seedlings Life Science Ventures, LLC v. Pfizer Canada ULC*, 2021 FCA 154, 2021 CarswellNat 2805 (F.C.A.) at para. 14.

¹²⁹ *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at para. 26.

¹³⁰ *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at para. 27.

¹³¹ *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at para. 28.

¹³² *Apotex Inc. v. AstraZeneca Canada Inc.*, 2017 FCA 9, 2017 CarswellNat 40, 2017 CarswellNat

evidence as to how a person of ordinary skill in the art would understand specific wording.¹³³ Such an opinion is unobjectionable if it did not extend to claim construction itself.

In two decisions from 2018/2019, deferring to the expert’s “understanding of the patent” transmogrified into deferring to the expert’s “understanding of the claims”. The Federal Court of Appeal further diverged from construction as a question of law, to include expert evidence on claim construction itself, as a question of fact reviewable on the basis of palpable and overriding error. In the first decision, it found that “... the appreciation of expert evidence as to how a POSITA would understand the claims ...”¹³⁴ was reviewable on the palpable and overriding error basis. In the second decision, it further found that “... the appreciation of expert evidence as to how a skilled person would construe the claims ... is a question of fact reviewable on a palpable and overriding error standard.”¹³⁵ These are the opinions of scientific/technical experts on claim construction: evidence that was formerly held to be inadmissible.

In 2021, the Federal Court of Appeal referenced and followed these divergent cases in *Western Oilfield* and *Seedlings*.¹³⁶

In *ViiV Healthcare Company v. Gilead Sciences Canada, Inc.*,¹³⁷ the Federal Court of Appeal departed yet further. Although the Federal Court of Appeal acknowledged that claim construction is a question of law, the Court never addressed whether the claim construction adopted by the lower court was “correct”. Instead, it found that construction was to be reviewed on a palpable and overriding error basis.¹³⁸

10632 (F.C.A.) per Gauthier J.A., Pelletier & Scott JJ.A. concurring at para. 29, leave to appeal refused 2017 CarswellNat 2529, 2017 CarswellNat 2530 (S.C.C.).

¹³³ *Apotex Inc. v. AstraZeneca Canada Inc.*, 2017 FCA 9, 2017 CarswellNat 40, 2017 CarswellNat 10632 (F.C.A.) per Gauthier J.A., Pelletier & Scott JJ.A. concurring) at para. 29, leave to appeal refused 2017 CarswellNat 2529, 2017 CarswellNat 2530 (S.C.C.).

¹³⁴ *Bombardier Recreational Products Inc. v. Arctic Cat, Inc.*, 2018 FCA 172, 2018 CarswellNat 5338, 2018 CarswellNat 5339 (F.C.A.) per Gauthier J.A., Pelletier & de Montigny JJ.A., concurring at para. 16, leave to appeal refused 2019 CarswellNat 1959, 2019 CarswellNat 1960 (S.C.C.).

¹³⁵ *Tearlab Corporation v. I-MED Pharma Inc.*, 2019 FCA 179, 2019 CarswellNat 2428, 2019 CarswellNat 14703 (F.C.A.) at para. 29.

¹³⁶ *Western Oilfield Equipment Rentals Ltd. et al. v. M-IL.L.C.*, 2021 FCA 24, 2021 CarswellNat 234 (F.C.A.) at paras. 17, 26, 29, 41, 43 and 45; *Seedlings Life Science Ventures, LLC v. Pfizer Canada ULC*, 2021 FCA 154, 2021 CarswellNat 2805 (F.C.A.) at paras. 14, 23 and 38.

¹³⁷ 2021 FCA 122, 2021 CarswellNat 2094 (F.C.A.) per Stratas J.A., Laskin & Mactavish JJ.A. concurring.

¹³⁸ *ViiV Healthcare Company v. Gilead Sciences Canada, Inc.*, 2021 FCA 122, 2021 CarswellNat 2094 (F.C.A.) per Stratas J.A., Laskin & Mactavish JJ.A. concurring at paras. 56 & 66.

In 2021, the Federal Court of Appeal also said that “[t]he standard of review on questions of construction of patent claims is complicated. The argument that the claim construction is a matter of law and that the standard of review should be correctness ‘is not that simple.’”¹³⁹

The divergent standards of review for claim construction will now need to be resolved by the Supreme Court.

6.4.2.5 *A Suggested Resolution for the Standard of Review for Claim Construction*

As is apparent from the two scenarios below, doing other than correctness review is an unprincipled approach and leads to absurd and potentially inconsistent construction outcomes. It is not harmonious with the approach to statutory interpretation.

1. a trial judge who construes the claims (1) after deciding separate introductory questions of fact, or (2) without the assistance of experts, will be subject to review on the higher standard of correctness; but
2. as in *ViiV v. Gilead*, a trial judge who adopts or relies on a scientific/technical expert’s opinion on claim construction (at least in part) will be subject to review on the basis of the lower standard of palpable and overriding error.

The latter scenario removes the appellate court’s ability to correct construction errors of law made by a trial judge, tying an appellate court’s hands, and thwarting the principle of universality: “the principle of universality requires appellate courts to ensure that the same legal rules are applied in similar situations”.¹⁴⁰

It is suggested that, for both scenarios, claim construction should be reviewed on the same standard: correctness.

If Canadian courts decide to consider some aspects of claim construction as findings of facts, it is respectfully suggested that the judge:

1. Make factual findings as to what the terms in the claims would have meant *in the field* to the POSITA at the relevant time, based on expert testimony; and then

¹³⁹ *Seedlings Life Science Ventures, LLC v. Pfizer Canada ULC*, 2021 FCA 154, 2021 CarswellNat 2805 (F.C.A.) [*Seedlings*] at para. 14.

¹⁴⁰ *Housen v. Nikolaisen*, 2002 CarswellSask 178, 2002 CarswellSask 179, [2002] 2 S.C.R. 235 (S.C.C.) at para. 9.

2. Make a legal conclusion as to whether the terms *as used in the context of the patent* require the court to change the expert's interpretation so as to give the claim terms a proper legal construction.

On appeal, the former (factual) conclusions would be subject to deference and to a “palpable or overriding error” standard on appeal; the latter (legal) conclusion would not be subject to deference and would be subject to a correctness standard as being a “question of law”.

6.4.3 Onus on Construction

Onus does not come into play at the construction stage of a patent proceeding.¹⁴¹

In Patent Medicine Notice of Compliance (“PM(NOC)”) proceedings, the second party (the generic) must set forth in the Notice of Allegation “the legal and factual basis” for the para. 5(1)(b) allegation and do so in a sufficiently complete manner as to enable the patentee to assess its course of action in response to the allegation.¹⁴² That sometimes includes a pleaded construction for the claims of the patent.¹⁴³

The onus is on the party bringing the application to prove infringement and in one case, apparently, the parties agreed that the Applicant had the burden of proving infringement and construction of the patent on a balance of probabilities on the one hand¹⁴⁴, but, on the other hand, held that the Applicant had the onus of proving that the claim construction pleaded in the opposing party's Notice of Allegation was not justified.¹⁴⁵ The more precise statement is probably that the onus is on the Applicant to show that the

¹⁴¹ *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2005 CarswellNat 4401, 2005 CarswellNat 7441, 46 C.P.R. (4th) 244 (F.C.) per Hughes J. at 250 [C.P.R.], para. 10, affirmed 2007 CarswellNat 6, 2007 CarswellNat 1052 (F.C.A.).

¹⁴² *Bristol-Myers Squibb Co. v. Apotex Inc.*, 2009 FC 137, 2009 CarswellNat 341, 2009 CarswellNat 6722 (F.C.) per Hughes J. at para. 130; *AB Hassle v. Canada (Minister of National Health & Welfare)*, 2000 CarswellNat 1146, 2000 CarswellNat 5837, 7 C.P.R. (4th) 272 (Fed. C.A.) per Stone J.A. at para. 130; *Eli Lilly Canada Inc. v. Novopharm Ltd.*, 2009 FC 301, 2009 CarswellNat 7007, 2009 CarswellNat 1479, 76 C.P.R. (4th) 407 (F.C.) per Hughes J. at para. 78; *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at para. 95.

¹⁴³ In *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at paras. 97 and 99, reference is made to Pharmascience characterizing a Swiss-type claim in issue to be directed not to the manufacture of a tablet but rather to a particular dosage.

¹⁴⁴ In *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at paras. 97 and 99, reference is made to Pharmascience characterizing a Swiss-type claim in issue to be directed not to the manufacture of a tablet but rather to a particular dosage.

¹⁴⁵ *Abbott Laboratories v. Canada (Minister of Health)*, 2006 CarswellNat 185, 2006 CarswellNat 2419, 46 C.P.R. (4th) 324 (F.C.) per Campbell J. at 351 [C.P.R.], para. 50, affirmed 2007 CarswellNat 1592, 2007 CarswellNat 426 (F.C.A.).

allegation of non-infringement is not justified and thus the Applicant must prove infringement, but that claim construction is up to the Court.

At a Canadian patent trial where there are no juries, the judge hears all the evidence at trial and determines claim construction after hearing final argument and renders the construction for the first time in the Reasons for Judgment, usually issued several weeks or months after trial.

6.4.3.1 Patent as a “Regulation”

It has been said that the Court should construe a patent just as it would construe any other document such as a written contract,¹⁴⁶ However, Justice Binnie considered a patent to be a regulation:

In fact, a patent is more than just “other writing”. The words of the claims are initially proposed by the applicant, but they are thereafter negotiated with the Patent Office, and in the end are 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. When the patent issues, it is an enactment within the definition of “regulation” in s. 2(1) of the Interpretation Act, R.S.C., 1985, c. I-21 ...

A patent must therefore be given such interpretation according to s. 12 of the *Interpretation Act* “as best ensures the attainment of its objects.”¹⁴⁷

In a formal sense, although a patent is a “law” under the *Interpretation Act*,¹⁴⁸ the Federal Court of Appeal has drawn a distinction between “letters patent” (which is the certificate bearing the seal of the Canadian Intellectual Property Office issued to an inventor upon issuance of the patent) and the specification (which is not to be considered “letters patent”).¹⁴⁹ Thus, the Federal Court of Appeal concludes, the interpretation of the specification may then be reviewed on the basis of palpable and overriding error when they are heavily dependent

¹⁴⁶ *Lovell Manufacturing Co. v. Beatty Brothers Ltd.*, 1962 CarswellNat 22, 41 C.P.R. 18, 23 Fox Pat. C. 112 (Can. Ex. Ct.) per Thomson P. at 70-71 [C.P.R.], 126 [Fox Pat. C.]; *Ransbury Co. v. Aerostyle Ltd.*, [1968] R.P.C. 287 (H.L.) at 297 per Lord Upjohn.

¹⁴⁷ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 149-150 [C.P.R.], para. 49(e), reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.);

¹⁴⁸ *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Stratas J.A., Pelletier and Webb J.J.A. concurring at para. 19.

¹⁴⁹ *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Stratas J.A., Pelletier and Webb J.J.A. concurring at para. 23, citing William Hayhurst “The Distinction between ‘Letters Patent’ and Patent Specification: How Did We Get Where We Are?” [2001] E.I.P.R. N-71 at N-73, [2002] E.I.P.R. N-90 at N-92 and IPIC Bulletin, July 2002 at p. 5: While the patent itself is subject to the Canadian *Interpretation Act*, R.S., c. I-23, the accompanying patent specification — which is not drafted by Parliament or its delegates — is not. The consequent purposive construction is not a consequence of the *Interpretation Act*, but rational thinking. Rodney Kyle has taken the opposite view: (1991) 8 CIPR 1, (2002) 18 CIPR 50 and (2003) 19 CIPR 95.

on expert testimony, as they usually are.¹⁵⁰ With respect, this view probably goes too far the other way, ignoring the fact that, sometimes, a legal interpretation should be done of the construction of terms provided by the expert in the context of the patent and the claims (see above section 4.4.1.1). In any case, the specification remains a legal document, but even legal documents may be subject to review on a deferential basis.¹⁵¹

6.4.3.2 Markman Hearings

In U.S. patent cases, since the mid-1990's, claim construction has been done in a pretrial proceeding called a "Markman hearing". It was not until *Markman v. Westview Instruments Inc.*,¹⁵² that the United States Supreme Court ruled that claim construction is a matter of law that should be decided by a judge alone.¹⁵³ This conclusion paved the way for "Markman hearings" where the judge construes the claims of a patent without any consideration of infringement or validity issues. The interpretation however, is not necessarily determined once and for all: the judge may vary the interpretation given to the claims as further evidence comes forward as the case approaches trial.

Although a *Markman* hearing should resolve claim construction issues early in an action, the lack of finality of the decision and therefore, the lack of rights of appeal from *Markman* hearing decisions until after a full trial on the merits and a high rate of erroneous *Markman* decisions make the process less efficient than it could be.

In May 2003, the Federal Court Trial Division's decision in *Realsearch Inc. v. Valon Kone Brunette Ltd.*¹⁵⁴ entertained a motion akin to the American *Markman* hearing. The motion was based on Rule 107(1) of the Federal Court Rules, 1998, which states that "the court may, at any time, order the trial of an issue or that issues in a proceeding be determined separately."¹⁵⁵

Although the trial level judge held that the preliminary determination of the meaning of certain phrases in the patent claim would expedite litigation and

¹⁵⁰ *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Stratas J.A., Pelletier and Webb J.J.A. concurring at para. 24.

¹⁵¹ *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Stratas J.A., Pelletier and Webb J.J.A. concurring at para. 24 citing *Creston Moly Corp. v. Sattva Capital Corp.*, 2014 SCC 53, 2014 CarswellBC 2267, 2014 CarswellBC 2268, [2014] 2 S.C.R. 633 (S.C.C.).

¹⁵² *Markman v. Westview Instruments Inc.*, 517 U.S. 370 (Pa. S.C., 1996). Under U.S. law, questions of law can be considered by a judge alone as they are not caught by the Seventh Amendment to the United States Constitution which codifies the right to a trial by jury for certain civil actions.

¹⁵³ U.S. Const. amend. VII.

¹⁵⁴ *Realsearch Inc. v. Valon Kone Brunette Ltd.*, 2003 CarswellNat 1520, 2003 CarswellNat 3565, 27 C.P.R. (4th) 274 (Fed. T.D.), reversed 2004 CarswellNat 107, 2004 CarswellNat 751, 31 C.P.R. (4th) 101 (F.C.A.).

¹⁵⁵ S.O.R./1998-106, s. 107(1).

lead to a greater number of settlements,¹⁵⁶ the Federal Court of Appeal held that there was insufficient evidence to suggest that a *Markman*-type preliminary determination would save time or money in that case¹⁵⁷ and allowed the appeal, declaring that they would not be adopting a *Markman*-type proceeding into Canadian law.¹⁵⁸ The court cautioned against the use of pre-trial determinations by quoting from a House of Lords decision: “preliminary points of law are too often treacherous short cuts. Their price can be delay and expense.”¹⁵⁹ The Federal Court of Appeal expressed concern that the appellant may be at a disadvantage by not having the whole action tried at the same time in front of the same judge, while somewhat contradictorily, acknowledged that claim construction must be done without an eye to the infringing article.¹⁶⁰ Additionally, the appeal judges raised the concern that a delay in the trial on the merits may result in a loss of important evidence due to memory loss or death.¹⁶¹

It is important to note that the court did not completely close the door to the possibility of such a proceeding under different facts:

It is not to suggest that a *Markman*-type order would not be available in any circumstances under the rule which, admittedly, is broadly phrased.¹⁶²

6.4.4 Use of Expert Witnesses

The task of the Court is to construe the claims of the patent with the aid of expert witnesses.¹⁶³ Patents are to be read through the eyes of the skilled reader.¹⁶⁴ The skilled reader approaches the patent with an appreciation of the

¹⁵⁶ *Realsearch Inc. v. Valon Kone Brunette Ltd.*, 2003 CarswellNat 1520, 2003 CarswellNat 3565, 27 C.P.R. (4th) 274 (Fed. T.D.) at 279 [C.P.R.], para. 13. reversed 2004 CarswellNat 107, 2004 CarswellNat 751 (F.C.A.).

¹⁵⁷ *Realsearch Inc. v. Valon Kone Brunette Ltd.*, 2004 CarswellNat 107, 2004 CarswellNat 751, 31 C.P.R. (4th) 101 (F.C.A.) at 111 [C.P.R.], para. 18.

¹⁵⁸ *Realsearch Inc. v. Valon Kone Brunette Ltd.*, 2004 CarswellNat 107, 2004 CarswellNat 751, 31 C.P.R. (4th) 101 (F.C.A.) at 112 [C.P.R.], para. 21.

¹⁵⁹ *Tilling v. Whiteman* (1979), [1980] A.C. 1 (U.K. H.L.) at 25.

¹⁶⁰ *Realsearch Inc. v. Valon Kone Brunette Ltd.*, 2004 CarswellNat 107, 2004 CarswellNat 751, 31 C.P.R. (4th) 101 (F.C.A.) at 111 [C.P.R.], para. 17.

¹⁶¹ *Realsearch Inc. v. Valon Kone Brunette Ltd.*, 2004 CarswellNat 107, 2004 CarswellNat 751, 31 C.P.R. (4th) 101 (F.C.A.) at 111 [C.P.R.], para. 18.

¹⁶² *Realsearch Inc. v. Valon Kone Brunette Ltd.*, 2004 CarswellNat 107, 2004 CarswellNat 751, 31 C.P.R. (4th) 101 (F.C.A.) at 111 [C.P.R.], para. 19.

¹⁶³ *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2007 FCA 209, 2007 CarswellNat 1434, 2007 CarswellNat 4252, 60 C.P.R. (4th) 81 (F.C.A.) per Nadon J.A., Linden and Sexton J.J.A. concurring at para. 39, leave to appeal refused 2007 CarswellNat 3850, 2007 CarswellNat 3851 (S.C.C.).

¹⁶⁴ *Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd.*, 1974 CarswellNat 378, 1974 CarswellNat 378F, [1976] 1 S.C.R. 555 (S.C.C.) per Pigeon J. at 563 [S.C.R.]; *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at para. 53, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat

common general knowledge in the art to which the patent relates.¹⁶⁵ This is not usually within the purview of the judge, so almost always, the parties adduce evidence to explain how the skilled reader would read and understand the patent.¹⁶⁶

The role of an expert is to assist in putting the Court in the position of a person skilled in the art as of the relevant time.¹⁶⁷

It is a matter of accepted law that the task of construing a patent's claim lies within the exclusive domain of the trial judge. In strict legal theory it is the role of expert witnesses, that is those skilled in the art, to provide the judge with the technical knowledge necessary to construe a patent as though he or she were so skilled. Where the experts disagree, it is incumbent on the trial judge to make a binding determination.¹⁶⁸

To the extent that the claim is now to be “construed”, that is the function of the Court alone. Experts may assist in two ways; first, they may inform the Court as to the knowledge that a person skilled in the art would have had at the relevant time, so as to bring that knowledge to bear reading both the description and the claims; second, an expert may assist in explaining any technical terms not within the experience expected of a Court. Thus, while construction is for a Court alone, the

284 (S.C.C.); *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Pelletier J.A., Stratas & Webb J.J.A. concurring at para. 14; *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at para. 25.

¹⁶⁵ *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Pelletier J.A., Stratas & Webb J.J.A. concurring at para. 14; *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at para. 25.

¹⁶⁶ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at paras. 57-62, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *Free World Trust c. E lectro Sante Inc.*, 2000 SCC 66, 2000 CarswellQue 2728, 2000 CarswellQue 2731, [2000] 2 S.C.R. 1024 (S.C.C.) at para. 81; *Astrazeneca Canada Inc. v. Mylan Pharmaceuticals ULC*, 2012 FCA 109, 2012 CarswellNat 979, 2012 CarswellNat 2008 (F.C.A.) at para. 20; *Cobalt Pharmaceuticals Co. v. Bayer Inc.*, 2015 FCA 116, 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.) per Pelletier J.A., Stratas & Webb J.J.A. concurring at para. 15; *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at para. 39; *Tearlab Corporation v. I-MED Pharma Inc.*, 2019 FCA 179, 2019 CarswellNat 2428, 2019 CarswellNat 14703 (F.C.A.) at para. 29.

¹⁶⁷ *Halford v. Seed Hawk Inc.*, 2006 FCA 275, 2006 CarswellNat 2397, 2006 CarswellNat 4150, 54 C.P.R. (4th) 130 (F.C.A.) at para. 11. See also *Eurocopter c. Bell Helicopter Textron Canada Ltè e*, 2010 FC 1328, 2010 CarswellNat 5016, 2010 CarswellNat 5684 (F.C.) per Martineau J. at para. 16: “...the expert must be able to give evidence about what an appropriately skilled person would have known and understood at the time in question.”

¹⁶⁸ *Dableh v. Ontario Hydro*, 1996 CarswellNat 2592, 1996 CarswellNat 735, [1996] 3 F.C. 751 (Fed. C.A.) at para. 33, leave to appeal refused 1997 CarswellNat 3240 (S.C.C.) quoted at *Eli Lilly Canada Inc. v. Apotex Inc.*, 2008 FC 142, 2008 CarswellNat 1821, 2008 CarswellNat 308, 63 C.P.R. (4th) 406 (F.C.) per Hughes J. at para. 26, affirmed 2009 CarswellNat 833, 2009 CarswellNat 3956 (F.C.A.), leave to appeal refused 2009 CarswellNat 3235, 2009 CarswellNat 3236 (S.C.C.).

Court may have to make certain factual findings as to the knowledge of a person skilled in the art. The findings of the Court in this respect may best be considered as findings of mixed fact and law.¹⁶⁹

R. v. Mohan,¹⁷⁰ stated that although there was once a general rule that excluded expert evidence in respect of an ultimate issue, and the rule is no longer of general application, the concerns underlying it remain.¹⁷¹

Expert evidence, to be necessary, must likely be outside the experience and knowledge of a judge or jury and must be assessed in light of its potential to distort the fact-finding process. Necessity should not be judged by too strict a standard. The possibility that evidence will overwhelm the jury and distract them from their task can often be offset by proper instructions. Experts, however, must not be permitted to usurp the functions of the trier of fact causing a trial to degenerate to a contest of experts.¹⁷²

In *Mohan*,¹⁷³ the Supreme Court of Canada established that the admissibility of expert evidence on a question of fact depends on four criteria:

- (a) relevance — Does it relate to a fact in issue so as to establish it? Is its value worth what it costs in terms of its impact on the trial process? Is its probative value outweighed by its prejudicial effect? Will it assist the fact finder or confuse and confound? Will it be objectively assessed or overwhelm with “mystic infallibility”?¹⁷⁴
- (b) necessity in assisting the trier of fact — Can the expert furnish the Court with scientific information outside the judge’s experience and knowledge? Will it help the judge appreciate the technical matters in issue? Would the judge be unlikely to form a correct judgment without the assistance?¹⁷⁵

¹⁶⁹ *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at para. 70.

¹⁷⁰ *R. v. Mohan*, 1994 CarswellOnt 1155, 1994 CarswellOnt 66, [1994] 2 S.C.R. 9 (S.C.C.) per Sopinka J. at 24 [S.C.R.].

¹⁷¹ *R. v. Mohan*, 1994 CarswellOnt 1155, 1994 CarswellOnt 66, [1994] 2 S.C.R. 9 (S.C.C.) per Sopinka J. at 24 [S.C.R.].

¹⁷² *R. v. Mohan*, 1994 CarswellOnt 1155, 1994 CarswellOnt 66, [1994] 2 S.C.R. 9 (S.C.C.) per Sopinka J. at 24 [S.C.R.].

¹⁷³ *R. v. Mohan*, 1994 CarswellOnt 1155, 1994 CarswellOnt 66, [1994] 2 S.C.R. 9 (S.C.C.) per Sopinka J. at 20 [S.C.R.].

¹⁷⁴ *R. v. Mohan*, 1994 CarswellOnt 1155, 1994 CarswellOnt 66, [1994] 2 S.C.R. 9 (S.C.C.) per Sopinka J. at 20-23 [S.C.R.]. In *Eurocopter c. Bell Helicopter Textron Canada Ltee*, 2010 FC 1328, 2010 CarswellNat 5016, 2010 CarswellNat 5684 (F.C.) per Martineau J. at paras. 9-10, the court considered evidence from a retired Patent Office Examiner to be irrelevant when it dealt with the evaluation that the patent-in-issue would have undergone during the examination process and how a patent examiner would respond to the Defendant’s invalidity argument.

¹⁷⁵ *R. v. Mohan*, 1994 CarswellOnt 1155, 1994 CarswellOnt 66, [1994] 2 S.C.R. 9 (S.C.C.) per Sopinka J. at 23-25 [S.C.R.]. In *Eurocopter c. Bell Helicopter Textron Canada Ltee*, 2010 FC 1328, 2010

This pre-condition is often expressed in terms as to whether the evidence would be helpful to the trier of fact. The word “helpful” is not quite appropriate and sets too low a standard. However, I would not judge necessity by too strict a standard. What is required is that the opinion be necessary in the sense that it provide information “which is likely to be outside the experience and knowledge of a judge or jury”: as quoted by Dickson J. in *R. v. Abbey*, *supra*. As stated by Dickson J., the evidence must be necessary to enable the trier of fact to appreciate the matters in issue due to their technical nature.

- (c) the absence of any exclusionary rule separate and apart from the opinion rule itself;¹⁷⁶ and
- (d) a properly qualified expert — someone who has acquired special or peculiar knowledge through study or experience in respect of the matters on which he or she undertakes to testify.¹⁷⁷

The court will give little or no weight to the evidence of an expert whose qualifications are narrower than that of the POSITA.¹⁷⁸ Such a witness could not be a proper proxy for the POSITA because the extent of his/her knowledge is different than that of the POSITA.¹⁷⁹

CarswellNat 5016, 2010 CarswellNat 5684 (F.C.) per Martineau J. at paras. 9-10, the court found that evidence relating to the patent examination process and the ?le wrapper was unnecessary.

¹⁷⁶ *R. v. Mohan*, 1994 CarswellOnt 1155, 1994 CarswellOnt 66, [1994] 2 S.C.R. 9 (S.C.C.) per Sopinka J. at 25 [S.C.R.]. In *Eurocopter c. Bell Helicopter Textron Canada Ltee*, 2010 FC 1328, 2010 CarswellNat 5016, 2010 CarswellNat 5684 (F.C.) per Martineau J. at paras. 11 and 13, the court noted that evidence as to domestic law is not admissible.

¹⁷⁷ *R. v. Mohan*, 1994 CarswellOnt 1155, 1994 CarswellOnt 66, [1994] 2 S.C.R. 9 (S.C.C.) per Sopinka J. at 25 [S.C.R.]. *Eli Lilly & Co. v. Apotex Inc.*, 2009 FC 991, 2009 CarswellNat 3042, 2009 CarswellNat 6607 (F.C.) per Gauthier J. at para. 94, affirmed 2010 CarswellNat 5866, 2010 CarswellNat 3443 (F.C.A.), leave to appeal refused 2011 CarswellNat 1368, 2011 CarswellNat 1369 (S.C.C.), additional reasons 2011 CarswellNat 4151 (F.C.): They should establish in their affidavit the basis on which they are qualified to provide evidence on how a person skilled in the art at the relevant time would construe the patents and what common general knowledge this person would possess.

¹⁷⁸ See for example, Mr. Mellinger in *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at para. 72, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); Mr. Pielemeier; Dr. Olah and Dr. Martin in *Eli Lilly & Co. v. Apotex Inc.*, 2009 FC 991, 2009 CarswellNat 3042, 2009 CarswellNat 6607 (F.C.) at paras. 68-69, 73 & 94, affirmed 2010 FCA 240, 2010 CarswellNat 5866, 2010 CarswellNat 3443 (F.C.A.), leave to appeal refused 2011 CarswellNat 1368, 2011 CarswellNat 1369 (S.C.C.), additional reasons 2011 CarswellNat 4151 (F.C.); and Mr. Cowley in *Bombardier Recreational Products Inc. v. Arctic Cat, Inc.*, 2018 FCA 172, 2018 CarswellNat 5338, 2018 CarswellNat 5339 (F.C.A.) per Gauthier J.A., Pelletier & De Montigny JJ.A., concurring at paras. 30-32, leave to appeal refused 2019 CarswellNat 1959, 2019 CarswellNat 1960 (S.C.C.).

¹⁷⁹ *Bombardier Recreational Products Inc. v. Arctic Cat, Inc.*, 2018 FCA 172, 2018 CarswellNat 5338, 2018 CarswellNat 5339 (F.C.A.) per Gauthier J.A., Pelletier & de Montigny JJ.A., concurring at paras. 31-32, leave to appeal refused 2019 CarswellNat 1959, 2019 CarswellNat 1960 (S.C.C.), citing *Whirlpool* at paras. 70-72.

A summary of the attributes of the POSITA and a statement of the common general knowledge that omitted a previously stated attribute of the POSITA was held to be a palpable and overriding error by a trial judge.¹⁸⁰

Judges should not blindly adopt an expert's conclusion.¹⁸¹ Adopting in whole the construction of a patent proposed by one party's experts cannot be said to be a reviewable error.¹⁸² It is open to a trial judge to prefer certain evidence and that weighing can only be set aside on the basis of palpable and overriding error.¹⁸³

Sometimes judges can give the patent a construction different from that put forward by the parties¹⁸⁴ or without relying on the experts.¹⁸⁵ A judge is not bound by the expert's opinion.¹⁸⁶ The Federal Court is not obligated to accept evidence provided that its rationale is explicit or evident from its reasons viewed in light of the record and is acceptable.¹⁸⁷

¹⁸⁰ *AFD Petroleum Ltd. v. Frac Shack Inc.*, 2018 FCA 140, 2018 CarswellNat 3775, 2018 CarswellNat 12343 (F.C.A.) per Gleason J.A., Webb & Laskin J.J.A. concurring at paras. 42 & 43.

¹⁸¹ *Novartis Pharmaceuticals Canada Inc. v. RhoxalPharma Inc.*, 2005 CarswellNat 1327, 2005 CarswellNat 457, 38 C.P.R. (4th) 193 (F.C.A.) at 209 [C.P.R.], para. 59.

¹⁸² *Abbott Laboratories v. Canada (Minister of Health)*, 2007 FCA 83, 2007 CarswellNat 1592, 2007 CarswellNat 426, 58 C.P.R. (4th) 97 (F.C.A.) per Noe' l J.A., Nadon and Malone J.J.A. concurring at para. 31.

¹⁸³ *Zero Spill Systems (Int'l) Inc. v. Heide*, 2015 FCA 115, 2015 CarswellNat 1357, 2015 CarswellNat 9212 (F.C.A.) per Stratas J.A., Dawson & Near J.J.A. concurring at para. 48, leave to appeal refused 2016 CarswellAlta 51, 2016 CarswellAlta 52 (S.C.C.), leave to appeal refused 2016 CarswellNat 12321, 2016 CarswellNat 12322 (S.C.C.); citing *Astrazeneca Canada Inc. v. Mylan Pharmaceuticals ULC*, 2012 FCA 109, 2012 CarswellNat 979, 2012 CarswellNat 2008, 432 N.R. 292 (F.C.A.) at para. 20; *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd.*, 2012 FCA 333, 2012 CarswellNat 5802, 2012 CarswellNat 5270, [2014] 2 F.C. 459 (F.C.A.) at para. 44; *Eurocopter c. Bell Helicopter Textron Canada Ltée*, 2013 FCA 219, 2013 CarswellNat 6962, 2013 CarswellNat 3455, 449 N.R. 111 (F.C.A.) at paras. 73-74, reconsideration / rehearing refused 2013 CarswellNat 4333, 2013 CarswellNat 4334 (F.C.A.).

¹⁸⁴ *Canamould Extrusions Ltd. v. Driangle Inc.*, 2003 CarswellNat 554, 2003 CarswellNat 1905, 25 C.P.R. (4th) 343 (Fed. T.D.) at 361 [C.P.R.], paras. 46-48, affirmed 2004 CarswellNat 970, 2004 CarswellNat 386, 30 C.P.R. (4th) 129 (F.C.A.).

¹⁸⁵ *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2007 FC 188, 2007 CarswellNat 1836, 2007 CarswellNat 1201, 55 C.P.R. (4th) 412, [2007] F.C.J. No. 274 (F.C.) per Hughes J. and *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2007 FC 187, 2007 CarswellNat 1763, 2007 CarswellNat 428, [2007] F.C.J. No. 273 (F.C.) per Hughes J., referred to in *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2007 FC 446, 2007 CarswellNat 976, 2007 CarswellNat 2196, 59 C.P.R. (4th) 166 (F.C.) per Barnes J. at paras. 31 and 35, affirmed 2007 CarswellNat 2107, 2007 CarswellNat 2573 (F.C.A.).

¹⁸⁶ *Eurocopter c. Bell Helicopter Textron Canada Ltée*, 2013 FCA 219, 2013 CarswellNat 6962, 2013 CarswellNat 3455 (F.C.A.) (per Mainville J.A., Noe' l and Trudel J.J.A. concurring) at para. 74, reconsideration / rehearing refused 2013 CarswellNat 4333, 2013 CarswellNat 4334 (F.C.A.).

¹⁸⁷ *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at para. 59, citing generally *Barclays Bank PLC v. Metcalfe & Mansfield Alternative Investments VII Corp.*, 2013 ONCA 494, 2013 CarswellOnt 11271, 365 D.L.R. (4th) 15 (Ont. C.A.) at para. 90, leave to appeal refused 2014 CarswellOnt 450, 2014 CarswellOnt 451 (S.C.C.).

Where judges have allowed experts to give opinions on virtually every issue, including infringement or validity, they then give that evidence whatever weight they consider appropriate.¹⁸⁸

6.4.4.1. *When Experts Construe the Claims*

There has been a concern that experts could usurp the functions of the trier of fact. These concerns were the basis of the rule which excluded expert evidence in respect of the ultimate issue of fact, a rule that is no longer of general application.¹⁸⁹

An expert can testify on the ‘ultimate question’ of obviousness, which is not one of law.¹⁹⁰ Once the claims are construed, it is a question of fact.¹⁹¹

An odd practice has developed in patent cases that has allowed technical/scientific experts to construe the patent claims, an exercise which has long been considered to be a question of law, not fact.

As part of the preparation of their expert report/affidavit, expert witnesses are instructed by their counsel on the legal rules of claim construction. The experts then provide, as part of their reports, their opinions on what the terms used in the patent would have meant to the POSITA at the relevant time. In other words, the expert construes the claim.¹⁹²

¹⁸⁸ *Xerox of Canada Ltd. v. IBM Canada Ltd.*, 1977 CarswellNat 669, 33 C.P.R. (2d) 24 (Fed. T.D.) per Collier J. at 36-37 [C.P.R.]; referred to recently by Justice Hughes in *Pason Systems Corp. v. Canada (Commissioner of Patents)*, 2006 FC 753, 2006 CarswellNat 1656, 2006 CarswellNat 3810 (F.C.) at para. 27 as a “Jenny Craig” order in that it put it all in, “subject to weight”.

¹⁸⁹ *R. v. Mohan*, 1994 CarswellOnt 1155, 1994 CarswellOnt 66, [1994] 2 S.C.R. 9 (S.C.C.) per Sopinka J. at 24 [S.C.R.].

¹⁹⁰ *Technip France SA’s Patent*, [2004] R.P.C. 46 per Jacob LJ, at paras. 12-180.

¹⁹¹ *Packers Plus Energy Services Inc. v. Essential Energy Services Ltd.*, 2019 FCA 96, 2019 CarswellNat 1338, 2019 CarswellNat 14362 (F.C.A.) (Gleason J.A., Boivin & Rivoalen JJ.A. concurring) at para. 30, leave to appeal refused 2019 CarswellNat 8115, 2019 CarswellNat 8116 (S.C.C.). *AFD Petroleum Ltd. v. Frac Shack Inc.*, 2018 FCA 140, 2018 CarswellNat 3775, 2018 CarswellNat 12343 (F.C.A.) at para. 38; *Apotex Inc. v. Allergan Inc.*, 2015 FCA 137, 2015 CarswellNat 3400, 2015 CarswellNat 12193 (F.C.A.) at para. 7; *Halford v. Seed Hawk Inc.*, 2006 FCA 275, 2006 CarswellNat 2397, 2006 CarswellNat 4150 (F.C.A.) per Sexton, Sharlow & Malone JJ.A. at para. 39, citing *Housen v. Nikolaisen*, 2002 CarswellSask 178, 2002 CarswellSask 179, [2002] 2 S.C.R. 235 (S.C.C.) at para. 10. *General Tire & Rubber Co. v. Firestone Tyre & Rubber Co.*, [1972] R.P.C. 457 (U.K. H.L.) at 504; *Martinray Industries Ltd. v. Fabricants National Dagendor Manufacturing Ltd.*, 1991 CarswellNat 221, 41 C.P.R. (3d) 1 (Fed. T.D.) at 30 [C.P.R.]; *Rothmans, Benson & Hedges Inc. v. Imperial Tobacco Ltd./Ltee*, 1993 CarswellNat 1393, 47 C.P.R. (3d) 188, [1993] F.C.J. No. 135 (Fed. C.A.) at 198 [C.P.R.].

¹⁹² See *Eli Lilly & Co. v. Apotex Inc.*, 2009 FC 991, 2009 CarswellNat 3042, 2009 CarswellNat 6607 (F.C.) per Gauthier J. at para. 94, affirmed 2010 CarswellNat 5866, 2010 CarswellNat 3443 (F.C.A.), leave to appeal refused 2011 CarswellNat 1368, 2011 CarswellNat 1369 (S.C.C.), additional reasons 2011 CarswellNat 4151 (F.C.). where two scientific experts’ affidavits were rejected because “[t]hey have failed to establish in their affidavit the basis on which they are [scientifically] qualified to comment on how a person skilled in the art (hereinafter POSITA) at the relevant time would construe the patents ...”

If claim construction is a question of law for the court, then a non-lawyer scientific or technical expert is providing a legal opinion. Such an opinion is likely inadmissible under *Mohan* for several reasons:

1. It is unnecessary as Canadian judges do not need evidence as to Canadian law.¹⁹³
2. The scientific or technical expert is not qualified to give a legal opinion; doing so is beyond their expertise.¹⁹⁴

If a trial judge accepts and adopts such opinion as to claim construction, he/she presumably adopts the expert's application of the rules of claim construction so as to make the construction his/her own.

6.4.4.2 Areas Where Experts Have Been Permitted to Give Evidence

Historically, experts have been prevented from giving opinion evidence as to the construction of the claims of the patent.¹⁹⁵

Experts have been permitted to give evidence on the following issues:

- prior art and the knowledge in the industry:
- the state of the prior art¹⁹⁶ and the state of knowledge in the craft, art or science to which the specification is directed.¹⁹⁷ The evidence

¹⁹³ *R. v. Mohan*, 1994 CarswellOnt 1155, 1994 CarswellOnt 66, [1994] 2 S.C.R. 9 (S.C.C.) per Sopinka J. at 25 [S.C.R.]. In *Eurocopter c. Bell Helicopter Textron Canada Ltee*, 2010 FC 1328, 2010 CarswellNat 5016, 2010 CarswellNat 5684 (F.C.) per Martineau J. at paras. 11 and 13.

¹⁹⁴ *R. v. Mohan*, 1994 CarswellOnt 1155, 1994 CarswellOnt 66, [1994] 2 S.C.R. 9 (S.C.C.) per Sopinka J. at 25 [S.C.R.]. *Eli Lilly & Co. v. Apotex Inc.*, 2009 FC 991, 2009 CarswellNat 3042, 2009 CarswellNat 6607 (F.C.) per Gauthier J. at para. 94, affirmed 2010 CarswellNat 5866, 2010 CarswellNat 3443 (F.C.A.), leave to appeal refused 2011 CarswellNat 1368, 2011 CarswellNat 1369 (S.C.C.), additional reasons 2011 CarswellNat 4151 (F.C.).

¹⁹⁵ *Baxter Travenol Laboratories of Canada Ltd. v. Cutter (Canada) Ltd.*, 1983 CarswellNat 508, 68 C.P.R. (2d) 179 (Fed. C.A.) per Thurlow C.J. at 193 [C.P.R.], leave to appeal refused 1983 CarswellNat 825 (S.C.C.); *Amfac Foods Inc. v. Irving Pulp & Paper Ltd.*, 1984 CarswellNat 575, 80 C.P.R. (2d) 59 (Fed. T.D.) at 82-83 [C.P.R.], affirmed 1986 CarswellNat 637, 12 C.P.R. (3d) 193 (Fed. C.A.) per Strayer J.; *Halford v. Seed Hawk Inc.*, 2001 CarswellNat 3884, 2001 CarswellNat 2519, 16 C.P.R. (4th) 189 (Fed. T.D.) per Pelletier J. at 195, para. 23. However, see *Jay-Lor International Inc. v. Penta Farm Systems Ltd.*, 2007 FC 358, 2007 CarswellNat 1218, 2007 CarswellNat 6121, 59 C.P.R. (4th) 228 (F.C.) per Snider J. at para. 58 where the Court accepted the evidence of an expert witness as to what elements were essential to the invention, which evidence was not disputed by the other party's expert.

¹⁹⁶ *Halford v. Seed Hawk Inc.*, 2006 FCA 275, 2006 CarswellNat 2397, 2006 CarswellNat 4150 (F.C.A.) at para. 11; *Weatherford Canada Ltd. v. Corlac Inc.*, 2011 FCA 228, 2011 CarswellNat 2835, 2011 CarswellNat 3714, 95 C.P.R. (4th) 101 (F.C.A.) at para. 24, leave to appeal refused 2012 CarswellNat 846, 2012 CarswellNat 847 (S.C.C.) and *Eurocopter c. Bell Helicopter Textron*

need not come from a person who was skilled in the art at the time so long as the witness is now in a position to give evidence about what the appropriately skilled person would have known and understood at the relevant time;¹⁹⁸

- what the prior art references (including prior patents) meant or revealed to them;¹⁹⁹
- the main innovations of the invention.

... a statement as to the innovative element of a device or patent ... falls into the same category as expert opinion on anticipation or obviousness. It is a comment about the state of the prior art.²⁰⁰

Canada Ltée, 2013 FCA 219, 2013 CarswellNat 6962, 2013 CarswellNat 3455, 449 N.R. 111 (F.C.A.) at para. 74, reconsideration / rehearing refused 2013 CarswellNat 4333, 2013 CarswellNat 4334 (F.C.A.); *Halford v. Seed Hawk Inc.*, 2001 CarswellNat 3884, 2001 CarswellNat 2519, 16 C.P.R. (4th) 189 (Fed. T.D.) per Pelletier J. at 194 [C.P.R.], para. 19; *Xerox of Canada Ltd. v. IBM Canada Ltd.*, 1977 CarswellNat 669, 33 C.P.R. (2d) 24 (Fed. T.D.) per Collier J. at 36 [C.P.R.].

¹⁹⁷ *Xerox of Canada Ltd. v. IBM Canada Ltd.*, 1977 CarswellNat 669, 33 C.P.R. (2d) 24 (Fed. T.D.) per Collier J. at 32 [C.P.R.]; *Calgon Carbon Corp. v. North Bay (City)*, 2006 FC 1373, 2006 CarswellNat 3735, 56 C.P.R. (4th) 281 (F.C.) per Mosley J. at para. 84, affirmed 2008 CarswellNat 535, 2008 CarswellNat 2136 (F.C.A.); *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at para. 70:

Experts may assist in two ways; first, they may inform the Court as to the knowledge that a person skilled in the art would have had at the relevant time, so as to bring that knowledge to bear reading both the description and the claims; second, an expert may assist in explaining any technical terms not within the experience expected of a Court.

Eurocopter c. Bell Helicopter Textron Canada Ltée, 2010 FC 1328, 2010 CarswellNat 5016, 2010 CarswellNat 5684 (F.C.) per Martineau J. at para. 16:

...the expert must be able to give evidence about what an appropriately skilled person would have known and understood at the time in question.

¹⁹⁸ *Halford v. Seed Hawk Inc.*, 2006 FCA 275, 2006 CarswellNat 2397, 2006 CarswellNat 4150 (F.C.A.), (Sexton J.A., Sharlow & Malone JJ.A.) at para. 16:

Expert evidence as to the state of the art at a particular point in time need not come from a person who has the requisite skills. It is sufficient if the witness is in a position to give evidence about what the appropriately skilled person would have known and understood at the relevant time.

See also *Crila Plastic Industries Ltd. v. Ninety-Eight Plastic Trim Ltd.*, 1987 CarswellNat 735, 18 C.P.R. (3d) 1 (Fed. C.A.) per Urie J.A., Mahoney and Stone JJ.A. concurring; *Janssen-Ortho Inc. v. Novopharm Ltd.*, 2006 FC 1234, 2006 CarswellNat 3249, 2006 CarswellNat 4811 (F.C.) at para. 90, additional reasons 2006 CarswellNat 5592, 2006 CarswellNat 3655, 57 C.P.R. (4th) 6 (F.C.), affirmed 2007 FCA 217, 2007 CarswellNat 1556, 2007 CarswellNat 3072, 59 C.P.R. (4th) 116 (F.C.A.) per Hughes J., affirmed on reconsideration 2007 CarswellNat 2584, 2007 CarswellNat 7091 (F.C.A.), leave to appeal refused 2007 CarswellNat 4172, 2007 CarswellNat 4173 (S.C.C.), quoted in *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at para. 36.

¹⁹⁹ *Xerox of Canada Ltd. v. IBM Canada Ltd.*, 1977 CarswellNat 669, 33 C.P.R. (2d) 24 (Fed. T.D.) per Collier J. at 36 [C.P.R.].

²⁰⁰ *Halford v. Seed Hawk Inc.*, 2001 CarswellNat 3884, 2001 CarswellNat 2519, 16 C.P.R. (4th) 189 (Fed. T.D.) per Pelletier J. at 197 [C.P.R.], para. 31.

- What words or phrases in the patent mean to the expert and those in the industry (if they cannot be understood by reading the specification);²⁰¹
- the explanation of technical terms, words and phrases;²⁰²

The judge is entitled to the assistance of experts in understanding the terms used in the patent as well as the underlying science. But that is where it ends. The judge must construe the patent and until he does, there is no basis upon which an expert can offer an opinion as to infringement since the expert cannot substitute his view of the proper construction of the patent for the judge's.²⁰³

- what the patent specification meant to the expert?²⁰⁴ (In other words, what would the words in the claims or specification have meant to the expert at the date when the claims are to have been construed?)²⁰⁵
- What the patent teaches:
 - the understanding which the expert has of the teaching of the patent.²⁰⁶
 - What a person skilled in the art would have understood from reading the patent at the relevant time.²⁰⁷ An expert need not be

²⁰¹ *Shire Biochem Inc. v. Canada (Minister of Health)*, 2008 FC 538, 2008 CarswellNat 2815, 2008 CarswellNat 1240, 67 C.P.R. (4th) 94 (F.C.) per Hughes J. at para. 23.

²⁰² *Xerox of Canada Ltd. v. IBM Canada Ltd.*, 1977 CarswellNat 669, 33 C.P.R. (2d) 24 (Fed. T.D.) per Collier J. at 32 [C.P.R.].

²⁰³ *Halford v. Seed Hawk Inc.*, 2001 CarswellNat 3884, 2001 CarswellNat 2519, 16 C.P.R. (4th) 189 (Fed. T.D.) per Pelletier J. at 195 [C.P.R.], para. 24.

²⁰⁴ *Xerox of Canada Ltd. v. IBM Canada Ltd.*, 1977 CarswellNat 669, 33 C.P.R. (2d) 24 (Fed. T.D.) per Collier J. at 36 [C.P.R.].

²⁰⁵ *Amfac Foods Inc. v. Irving Pulp & Paper Ltd.*, 1984 CarswellNat 575, 80 C.P.R. (2d) 59 (Fed. T.D.) per Strayer J. at 82-83 [C.P.R.], affirmed 1986 CarswellNat 637 (Fed. C.A.); *Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd.*, 1974 CarswellNat 378, 1974 CarswellNat 378F, 17 C.P.R. (2d) 97 (S.C.C.) per Pigeon J. at 104 [C.P.R.]; In *Halford v. Seed Hawk Inc.*, 2001 CarswellNat 3884, 2001 CarswellNat 2519, 16 C.P.R. (4th) 189 (Fed. T.D.) per Pelletier J. at 193 [C.P.R.], para. 17, Pelletier J. interpreted this to be "a different matter than evidence as to the proper construction of the patents in suit"; *Airseal Controls Inc. v. M & I Heat Transfer Products Ltd.*, 1997 CarswellNat 1912, 77 C.P.R. (3d) 126 (Fed. C.A.) at 127 [C.P.R.]; *Calgon Carbon Corp. v. North Bay (City)*, 2006 FC 1373, 2006 CarswellNat 3735, 56 C.P.R. (4th) 281 (F.C.) per Mosley J. at para. 84, affirmed 2008 CarswellNat 535, 2008 CarswellNat 2136 (F.C.A.).

²⁰⁶ *Halford v. Seed Hawk Inc.*, 2001 CarswellNat 3884, 2001 CarswellNat 2519, 16 C.P.R. (4th) 189 (Fed. T.D.) per Pelletier J. at 196-197 [C.P.R.], para. 28.

²⁰⁷ *Amfac Foods Inc. v. Irving Pulp & Paper Ltd.*, 1984 CarswellNat 575, 80 C.P.R. (2d) 59 (Fed. T.D.) per Strayer J. at 82-83 [C.P.R.], affirmed 1986 CarswellNat 637 (Fed. C.A.). But see *Baxter Travenol Laboratories of Canada Ltd. v. Cutter (Canada) Ltd.*, 1983 CarswellNat 508, 68 C.P.R.

alive or grown up at the time of the relevant event or time period in order to express an opinion on the past.²⁰⁸

- The effect of the variant on the way the invention works:
 - Comparing how the invention works compared to the defendant's device—an assessment of mechanical equivalency (which is not relevant to the question of infringement);²⁰⁹
 - 1. Does the variant have a material effect on the way the invention works?; and 2. Would an affirmative answer to Q. 1 have been obvious to a person skilled in the art at the date of publication? As the first question in *Catnic* and the first two questions of the trial level test in *Improver*, these are questions of fact which do not primarily involve questions of construction and are used to provide the factual background against which the specification must be construed;²¹⁰
 - Evidence about the technical inter-relationship between rival claim meanings and the teaching of the specification, to explain the effect of rival claim constructions and whether under a particular construction, the patent would achieve the patent's technical objective.²¹¹

Relevant to the question of infringement:

- juxtaposing in two columns, without comment, the claims of the patent and the features of the defendant's device which may have some relationship to the element described in the claim;²¹²

(2d) 179 (Fed. C.A.) per Thurlow C.J. at 193 [C.P.R.], leave to appeal refused 1983 CarswellNat 825 (S.C.C.) where it was said that an expert cannot provide evidence as to the meaning of a word in the patent.

²⁰⁸ *Weatherford Canada Ltd. v. Corlac Inc.*, 2010 FC 602, 2010 CarswellNat 3622, 2010 CarswellNat 1651 (F.C.) per Phelan J. at para. 136, reversed in part 2011 CarswellNat 2835, 2011 CarswellNat 3714 (F.C.A.), leave to appeal refused 2012 CarswellNat 846, 2012 CarswellNat 847 (S.C.C.).

²⁰⁹ *Halford v. Seed Hawk Inc.*, 2001 CarswellNat 3884, 2001 CarswellNat 2519, 16 C.P.R. (4th) 189 (Fed. T.D.) per Pelletier J. at 197 [C.P.R.], para. 30.

²¹⁰ *Canamould Extrusions Ltd. v. Driangle Inc.*, 2004 CarswellNat 970, 2004 CarswellNat 386, 30 C.P.R. (4th) 129 (F.C.A.) per Stone J.A. at 142 [C.P.R.], para. 25, affirming 2003 CarswellNat 554, 2003 CarswellNat 1905, 25 C.P.R. (4th) 343 (Fed. T.D.).

²¹¹ *Shire Biochem Inc. v. Canada (Minister of Health)*, 2008 FC 538, 2008 CarswellNat 2815, 2008 CarswellNat 1240, 67 C.P.R. (4th) 94 (F.C.) per Hughes J. at para. 10.

²¹² *Halford v. Seed Hawk Inc.*, 2001 CarswellNat 3884, 2001 CarswellNat 2519, 16 C.P.R. (4th) 189 (Fed. T.D.) per Pelletier J. at 196 [C.P.R.], para. 27.

- making reference to the “essence of the invention” making a list to enumerate the essential features of the claims so as to decide the issue of infringement.²¹³

Because the role of the expert is to assist the trial judge to interpret the patent claims in a knowledgeable way, it is dubious that the direction on the law of claim construction provided to an expert by a lawyer will result in an opinion that is to be preferred to the opinion of an equally qualified expert who was not been given such a direction.²¹⁴

6.5 THE PRINCIPLES OF CLAIM CONSTRUCTION IN FREE WORLD AND WHIRLPOOL

In 2000, Mr. Justice Binnie of the Supreme Court of Canada restated the test for claim construction under Canadian patent law in two cases: *Free World*²¹⁵ and *Whirlpool*.²¹⁶ In *Free World*, he articulated what he saw as “the principles” of claim construction.

The *Free World* principles were based, in part, upon the tests in *Catnic*²¹⁷ and *Improver*²¹⁸ whose principles were cited with approval in *Free World*.²¹⁹ Justice

²¹³ *Halford v. Seed Hawk Inc.*, 2001 CarswellNat 3884, 2001 CarswellNat 2519, 16 C.P.R. (4th) 189 (Fed. T.D.) per Pelletier J. at 196-197 [C.P.R.], paras. 27 and 29.

²¹⁴ *Janssen-Ortho Inc. v. Canada (Minister of Health)*, 2010 FC 42, 2010 CarswellNat 1445, 2010 CarswellNat 199 (F.C.) per Zinn J. at para. 109, additional reasons 2010 CarswellNat 2356, 2010 CarswellNat 442 (F.C.).

²¹⁵ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J.

²¹⁶ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J., reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

²¹⁷ *Catnic Components Ltd. v. Hill & Smith Ltd.* (1981), [1982] R.P.C. 183 (U.K. H.L.) per Lord Diplock at 242-243, affirmed (1982), [1983] F.S.R. 512 (U.K. H.L.):

My Lords, a patent specification is a unilateral statement by the patentee, in words of his own choosing, addressed to those likely to have a practical interest in the subject matter of his invention (i.e., “skilled in the art”), by which he informs them what he claims to be the essential features of the new product or process for which the letters patent grant him a monopoly. It is called “pith and marrow” of the claim. A patent specification should be given a purposive construction rather than a purely literal one derived from applying to it the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge. The question in each case is: whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used, would understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that any variant would fall outside the monopoly claimed, even though it could have no material effect upon the way the invention worked.

The question, of course, does not arise where the variant would in fact have a material effect upon the way the invention worked. Nor does it arise unless at the date of publication of the specification it would be obvious to the informed reader that this was so. Where it is not obvious, in the light of then-existing knowledge, the reader is entitled to assume that the patentee thought at the time of the specification that he had good reason for limiting his monopoly so strictly and had intended to do so, even though subsequent work by him or others in the field of the invention might show the limitation to have been unnecessary. It is to be answered in the negative only when it would be apparent to any reader skilled in the art that a particular descriptive word or phrase used in a claim cannot have been intended by the patentee, who was also skilled in the art, to exclude minor variants which, to the knowledge of both him and the readers to

Binnie repeated the language of Lord Diplock in *Catnic* that there are not two tests for infringement, literal and “pith and substance”, but merely one based upon a “purposive construction”:

There appears to be a continuing controversy in some quarters as to whether there are two approaches to infringement (literal and substantive) or only one approach, namely infringement of the claims as written but “purposively” construed.

In the two-step approach, the court construes the claims and determines whether the device accused of infringement has literally taken the invention. If not, the court proceeds to the second step of asking itself whether “in substance” the invention was wrongfully appropriated. On occasion, treatment of the second step in specific cases has attracted criticism as being subjective and unduly discretionary. Once the inquiry is no longer anchored in the language of the claims, the court may be heading into unknown waters without a chart. The one-step approach has to build flexibility and common sense into the initial claims construction because there is no second step.²²⁰

In *Free World* Justice Binnie put forward several principles of claim construction that he used to reject the appellant’s arguments.²²¹ These principles can therefore be considered as the Supreme Court of Canada’s latest statement of the test for claim construction and infringement:

- (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.

whom the patent was addressed, could have no material effect upon the way in which the invention worked.

²¹⁸ *Improver Corp. v. Remington Consumer Products Ltd.* (1989), [1990] F.S.R. 181 (Eng. Patents Ct.).

²¹⁹ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 184 [C.P.R.], para. 31

²²⁰ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 190 [C.P.R.], paras. 45 and 46, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

²²¹ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 184-185 [C.P.R.], para. 31.

- (e) The claims 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;
 - (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, resorting to extrinsic evidence of the inventor's intention.
- (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.²²²

These “principles” fall clearly into two sets:

- those which stress the importance of the language of the claims ((a) to (d)); and
- those which deal with essential and non-essential elements ((e)(iii) and (iv)).

In this respect, the *Free World* principles are a concatenation of the “literal” and “pith and substance” approaches. Justice Binnie clearly intended to adopt an approach which included both previous approaches:

In *Catnic*, as in the earlier case law, the scope of the monopoly remains a function of the written claims but, as before, flexibility and fairness is achieved by differentiating the essential features (“the pith and marrow”) from the unessential, based on a knowledgeable reading of the whole specification

²²² *Free World Trust v. Electro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 184 [C.P.R.], para. 31.

through the eyes of the skilled addressee rather than on the basis of “the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge” (*Catnic, supra*, p. 243).²²³

6.6 “PURPOSIVE” CONSTRUCTION

The overarching direction from *Free World* is that the claims are to be given a “purposive construction”: The claim language must be read in an informed and purposive way.²²⁴

Purposive construction is not unique to patent law and has had a long history in contract law²²⁵ and statutory construction.²²⁶ Purposive construction tries to interpret a contract or statute in a manner consistent with the intention of its drafters as inferred from the contract or statute itself and its contextual setting.²²⁷ Words in the contract or statute are to be given their natural and ordinary meaning — one that is consistent with common sense.²²⁸

Mr. Justice Binnie succinctly described the act of claim construction in *Free World*:

The words chosen by the inventor will be read in the sense the inventor is presumed to have intended, and in a way that is sympathetic to accomplishment of the inventor’s purpose expressed or implicit in the text of the claims.²²⁹

Purposive construction does not ask “What did the patentee say?” which might be a literal interpretation, but rather, “What was the inventor trying to say?” or,

²²³ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 184 [C.P.R.], para. 31.

²²⁴ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 183-184 [C.P.R.], para. 31(c).

²²⁵ *Ford v. Beech* (1848), 11 Q.B. 852 (Eng. Q.B.) and *Smith v. Packhurst* (1741), 3 Atk. 135 (Eng. Ch. Div.).

²²⁶ Ruth Sullivan, *Sullivan and Driedger on the Construction of Statutes*, 4th ed. (Markham: Butterworths, 2002) at 196.

²²⁷ With respect to statutes: Elmer Driedger, *Construction of Statutes*, 2nd ed. (Toronto: Butterworths, 1983) at 87:

Today there is only one principle or approach, namely, the words of an act are to be read in their entire context and in their grammatical and ordinary sense harmoniously with the scheme of the act, the object of the act, and the intention of parliament.

As for a contract, the question is how it would be interpreted by a reasonable person: *Investors Compensation Scheme Ltd. v. West Bromwich Building Society* (1997), [1998] 1 W.L.R. 896 (U.K. H.L.) at 913:

The meaning which a document (or any other utterance) would convey to a reasonable man is not the same thing as the meaning of its words. The meaning of words is a matter of dictionaries and grammars; the meaning of the document is what the parties using those words against the relevant background would reasonably have understood to mean.

²²⁸ *Investors Compensation Scheme Ltd. v. West Bromwich Building Society* (1997), [1998] 1 W.L.R. 896 (U.K. H.L.).

²²⁹ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 191-192 [C.P.R.], para. 51.

better yet, “What would a skilled reader have understood the patent to mean?”²³⁰

Perhaps the best example of the application of purposive construction is where the claim contains an easily recognizable drafting error. Although information provided in a patent should be presumed to be correct, accurate and sufficient²³¹ a purposive construction would recognize the error and give the claim its “intended meaning”. For example:

As a preliminary matter, it is noted that claim 23 erroneously refers to an “antimicrobial” infection. Both parties accept that the intended reference in claim 23 is to a “microbial” infection. It is agreed that the error is of no consequence to the within application.²³²

The error in that case was purely drafting in nature, and in the context of the patent as a whole, it was clear what the patentee was intending to claim. Purposive construction gave the Court the flexibility to be able to render justice.

Similarly, where a claim referred to “... a microorganism of the genus *Aspergillus terreus*” but the genus is *Aspergillus* and the specie is *terreus*, the Court concluded that the patentee must have been referring to the species *Apergillus terreus* and not the genus *Aspergillus*. To say it meant the latter would ignore the plain meaning of the term *terreus*, as used in the claim.²³³

In *Bombardier Recreational Products Inc. v. Arctic Cat Inc.*,²³⁴ the court noted that there were obvious errors in the figures of the patents in issue but held that “such obvious errors would not take astray the POSITA who would have readily and easily noticed the numerous and obvious errors”²³⁵ and “would locate

²³⁰ *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at para. 69.

²³¹ *Eli Lilly Canada Inc. v. Novopharm Ltd.*, 2009 FC 301, 2009 CarswellNat 7007, 2009 CarswellNat 1479 (F.C.) at para. 94; *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J. at para. 121.

²³² *Pfizer Canada Inc. v. Novopharm Ltd.*, 2005 CarswellNat 5544, 2005 CarswellNat 3114, 42 C.P.R. (4th) 502 (F.C.) per Blanchard J. at 523-524 [C.P.R.], para. 54. See also *Eli Lilly & Co. v. Apotex Inc.*, 2009 FC 991, 2009 CarswellNat 3042, 2009 CarswellNat 6607 (F.C.) per Gauthier J. at para. 159, affirmed 2010 CarswellNat 5866, 2010 CarswellNat 3443 (F.C.A.), leave to appeal refused 2011 CarswellNat 1368, 2011 CarswellNat 1369 (S.C.C.), additional reasons 2011 CarswellNat 4151 (F.C.).

²³³ *Apotex Inc. v. Merck & Co.*, 2010 FC 1265, 2010 CarswellNat 5009 (F.C.) per Snider J. at paras. 88-92, 95 and 99, affirmed 2011 CarswellNat 6152, 2011 CarswellNat 7182 (F.C.A.), leave to appeal refused 2012 CarswellNat 2442, 2012 CarswellNat 2443 (S.C.C.).

²³⁴ *Bombardier Recreational Products Inc. v. Arctic Cat Inc.*, 2017 FC 207, 2017 CarswellNat 605, 2017 CarswellNat 10520 (F.C.) per Roy J., reversed in part 2018 CarswellNat 5338, 2018 CarswellNat 5339 (F.C.A.), leave to appeal refused 2019 CarswellNat 1959, 2019 CarswellNat 1960 (S.C.C.).

²³⁵ *Bombardier Recreational Products Inc. v. Arctic Cat Inc.*, 2017 FC 207, 2017 CarswellNat 605, 2017 CarswellNat 10520 (F.C.) per Roy J. at para. 320, reversed in part 2018 CarswellNat 5338, 2018 CarswellNat 5339 (F.C.A.), leave to appeal refused 2019 CarswellNat 1959, 2019 CarswellNat 1960 (S.C.C.).

without much difficulty a substitute for the obviously mistaken dimensions of the figures found in the Patents.”²³⁶

Notwithstanding the above, purposive construction should not allow a patentee to broaden or expand the scope of a claim, and therefore, does not ask “What should the patentee have said?” If a patentee failed to claim as broadly as he or she could have, purposive construction should be of no assistance.

Purposive construction will also not allow a patentee to correct an error, other than a drafting error, as discussed above. Where a patentee included a limitation in a claim that he later discovered was unnecessary, the Court of Appeal stated:

A court must interpret the claims; it cannot redraft them. When an inventor has clearly stated in the claims that he considered a requirement as essential to his invention, a court cannot decide otherwise for the sole reason that he was mistaken.²³⁷

The Supreme Court has further written as follows:

... if the inventor has misspoken or otherwise created an unnecessary or troublesome limitation in the claims, it is a self-inflicted wound. The public is entitled to rely on the words used *provided* the words used are interpreted fairly and knowledgeably.²³⁸ (emphasis in the original)

²³⁶ *Bombardier Recreational Products Inc. v. Arctic Cat Inc.*, 2017 FC 207, 2017 CarswellNat 605, 2017 CarswellNat 10520 (F.C.) per Roy J. at para. 322, reversed in part 2018 CarswellNat 5338, 2018 CarswellNat 5339 (F.C.A.), leave to appeal refused 2019 CarswellNat 1959, 2019 CarswellNat 1960 (S.C.C.).

²³⁷ *Eli Lilly & Co. v. O'Hara Manufacturing Ltd.*, 1989 CarswellNat 504, 26 C.P.R. (3d) 1 (Fed. C.A.) per Pratte J. at 7 [C.P.R.].

²³⁸ *Free World Trust c. E' lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 192 [C.P.R.]. The comment regarding a “self-inflicted wound” has been repeated in *Canamould Extrusions Ltd. v. Driangle Inc.*, 2003 FCT 244, 2003 CarswellNat 554, 2003 CarswellNat 1905 (Fed. T.D.) at para. 32, affirmed 2004 FCA 63, 2004 CarswellNat 970, 2004 CarswellNat 386 (F.C.A.) per Layden-Stevenson J. at para. 19; *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2007 FCA 209, 2007 CarswellNat 1434, 2007 CarswellNat 4252, 60 C.P.R. (4th) 81 (F.C.A.) per Nadon J.A., Linden & Sexton J.J.A., concurring at para. 39, leave to appeal refused 2007 CarswellNat 3850, 2007 CarswellNat 3851 (S.C.C.); *Lundbeck Canada Inc. v. Canada (Minister of Health)*, 2010 FCA 320, 2010 CarswellNat 4425, 2010 CarswellNat 4426, 88 C.P.R. (4th) 325 (F.C.A.) per Noe J.A., Pelletier & Trudel J.J.A., concurring at para. 110, leave to appeal refused 2011 CarswellNat 3240, 2011 CarswellNat 3241 (S.C.C.), leave to appeal refused 2011 CarswellNat 3229, 2011 CarswellNat 3230 (S.C.C.), leave to appeal refused 2011 CarswellNat 3242, 2011 CarswellNat 3243 (S.C.C.); *Bauer Hockey Corp. v. Easton Sports Canada Inc.*, 2011 FCA 83, 2011 CarswellNat 4827, 2011 CarswellNat 561, 92 C.P.R. (4th) 103 (F.C.A.) per Noe J.A., Lévesque & Trudel J.J.A., concurring at para. 53.

6.6.1 Rejection of “Form and Substance” Approach

A purposive construction also seemingly rejects analyzing the “substance of the claim” and ignoring the form of the claim to investigate “what really has been invented” or “what has been discovered”.

In many U.K. decisions involving software-related patents, the courts had looked beyond the form of the claim (usually for an article which is patentable subject matter) to enquire into the true nature of the invention as a mathematical algorithm (and hence, non-patentable subject matter). The *Amazon.com* case,²³⁹ the Federal Court rejected the Commissioner of Patent’s approach in looking at “the substance of the invention”. It is not wrong to speak of “what has been invented” so long as this is determined with reference to the essential elements as disclosed through purposive construction.²⁴⁰

It is the “subject matter defined by the claims” not “the invention” or “what the inventor claims to have invented” that is the subject of patentable subject matter, novelty, utility and obviousness under ss. 27(3), (4) and (8) of the *Patent Act*.²⁴¹

6.7 STEP 1: WHAT DO THE WORDS AND PHRASES IN THE CLAIM MEAN?

Logically, the Court cannot determine whether a claim element is essential or non-essential until it understands the meaning of a particular word or phrase in the claim containing the particular claim element. Therefore, the Court must first give meaning to the words and phrases in the claims.

The question to be asked is what would a skilled person understand the claim to mean in the context of the rest of the patent.²⁴²

The claims are to be interpreted by applying the common vocabulary of the art.²⁴³ Caution must be exercised where there is no common nomenclature in the art.²⁴⁴

²³⁹ *Amazon.com Inc., Re*, 2010 FC 1011, 2010 CarswellNat 3730, 2010 CarswellNat 3731 (F.C.) per Phelan J., reversed 2011 CarswellNat 4865, 2011 CarswellNat 5990 (F.C.A.).

²⁴⁰ *Amazon.com Inc., Re*, 2010 FC 1011, 2010 CarswellNat 3730, 2010 CarswellNat 3731 (F.C.) per Phelan J. at para. 40, reversed 2011 CarswellNat 4865, 2011 CarswellNat 5990 (F.C.A.).

²⁴¹ *Amazon.com Inc., Re*, 2011 FCA 328, 2011 CarswellNat 4865, 2011 CarswellNat 5990 (F.C.A.) per Sharlow J.A., Trudel & Stratas JJ.A. concurring at para. 39.

²⁴² *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at para. 69.

²⁴³ *Lubrizol Corp. v. Imperial Oil Ltd.*, 1990 CarswellNat 594, 33 C.P.R. (3d) 1 (Fed. T.D.) at 12-13 [C.P.R.], reversed in part on other grounds 1992 CarswellNat 1049, 45 C.P.R. (3d) 449 (Fed. C.A.) at 467 [C.P.R.], additional reasons 1993 CarswellNat 1964 (Fed. C.A.), leave to appeal refused 1993 CarswellNat 2472 (S.C.C.); *Kramer v. Lawn Furniture Inc.*, 1974 CarswellNat 464, 13

The terms of the specification, including the claims, must be given meaning and purpose by the skilled addressee applying his or her knowledge in the field to which the patent relates.²⁴⁵ It is not the meaning the words may have had to lay or unskilled reader.²⁴⁶ For example: if a claim used the word “bolt”, what would that term mean in the context of that patent? Depending upon the art to which the patent is directed, it could mean a threaded screw to be used in conjunction with a nut as a fastener, an 8 foot length of a tree trunk²⁴⁷ or a length of cloth wrapped around a cardboard spindle.

Unless a term has been defined in a dictionary sense in the disclosure, or by reference to a publicly available document,²⁴⁸ a word or phrase should be given its ordinary meaning.²⁴⁹ The words should be given a natural and not a strained meaning.²⁵⁰

6.7.1 Pre-Construction Set-Up

The judge must put himself or herself in the proper mindset to read the patent, taking into consideration who is to be considered to be reading the patent, with the appropriate skills, at the appropriate time and with the appropriate attitude.

Although the interpretation of the claims is a matter for the Court, the Judge may (and in most technologies, probably should) be assisted by the evidence of an expert who is knowledgeable in the field to which the claim is directed.²⁵¹

C.P.R. (2d) 231 (Fed. T.D.) per Addy J. 231 at 237 [C.P.R.], affirmed 1979 CarswellNat 799 (Fed. T.D.).

²⁴⁴ *Bauer Hockey Corp. v. Easton Sports Canada Inc.*, 2010 FC 361, 2010 CarswellNat 3031, 2010 CarswellNat 796 (F.C.) per Gauthier J. at paras. 160-162, affirmed 2011 CarswellNat 4827, 2011 CarswellNat 561 (F.C.A.).

²⁴⁵ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 152-153 [C.P.R.], paras. 52-53, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

²⁴⁶ *American Cyanamid Co. v. Berk Pharmaceuticals Ltd.* (1973), [1976] R.P.C. 231 (Eng. Ch. Div.) at 234.

²⁴⁷ as used in as used in *Nekoosa Packaging Corp. v. AMCA International Ltd.*, 1989 CarswellNat 556, 27 C.P.R. (3d) 153 (Fed. T.D.) at 163 [C.P.R.], additional reasons 1990 CarswellNat 1103 (Fed. T.D.), affirmed 1994 CarswellNat 2980 (Fed. C.A.).

²⁴⁸ *AlliedSignal Inc. v. DuPont Canada Inc.*, 1995 CarswellNat 699, 61 C.P.R. (3d) 417 (Fed. C.A.) per Desjardins J.A. at 430 [C.P.R.], leave to appeal refused 1995 CarswellNat 2832 (S.C.C.).

²⁴⁹ *United Merchants & Manufacturers Inc. v. A.J. Freiman Ltd.*, 1965 CarswellNat 29, 47 C.P.R. 97 (Can. Ex. Ct.) per Noe J. at 108 [C.P.R.]; *Reliance Electric Industrial Co. v. Northern Telecom Ltd.*, 1993 CarswellNat 319, 47 C.P.R. (3d) 55 (Fed. T.D.) at 60 [C.P.R.], affirmed 1994 CarswellNat 1333, 55 C.P.R. (3d) 299 (Fed. C.A.); *Apotex Inc. v. Syntex Pharmaceuticals International Ltd.*, 1999 CarswellNat 4895, 1999 CarswellNat 869, 1 C.P.R. (4th) 22 (Fed. T.D.) at 38 [C.P.R.]; *Abbott Laboratories v. Canada (Minister of Health)*, 2005 CarswellNat 2247, 2005 CarswellNat 4992, 42 C.P.R. (4th) 121 (F.C.) at 154 [C.P.R.], affirmed 2006 CarswellNat 2914, 2006 CarswellNat 1384 (F.C.A.), leave to appeal refused 2007 CarswellNat 240, 2007 CarswellNat 241 (S.C.C.).

²⁵⁰ *Henricksen v. Tallon Ltd.*, [1965] R.P.C. 434 (U.K. H.L.) at 446.

²⁵¹ *Brooks v. Steele* (1896), 14 R.P.C. 46 (C.A.) at 73, quoted with approval in *Western Electric Co. v.*

As discussed above in Chapter 6.4.4, the role of the expert is not to interpret the patent claims but to put the trial judge in the position of being able to do so in a knowledgeable way.²⁵² Such evidence may relate to the state of the art at the date of the patent, the meaning of technical terms and the working of the invention.²⁵³

Of course, the Court is not bound by expert opinion as to the meaning of words in the claims,²⁵⁴ and the Court's construction of a claim must prevail over that of an expert's, unless clearly unacceptable.²⁵⁵ Further, a Court may come to its own conclusion and may decide not to follow the expert evidence of both the plaintiff and the defendant.²⁵⁶ However, where a Judge construes a technical term in a contrary manner to that construed by both the parties and their respective expert witnesses, the finding of the Trial Judge must be seen as being made without regard to the evidence.²⁵⁷

6.7.1.1 The Relevant Date

A pre-1989 *Patent Act* patent is to be construed as at the date it issued.²⁵⁸ The time between filing and issuance of “Old Act” patents can be significant. Words

- Baldwin International Radio of Canada Ltd.*, 1934 CarswellNat 38, [1934] S.C.R. 570 (S.C.C.) at 573 [S.C.R.].
- ²⁵² *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 156 [C.P.R.], para. 57, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).
- ²⁵³ *Reliance Electric Industrial Co. v. Northern Telecom Ltd.*, 1993 CarswellNat 319, 47 C.P.R. (3d) 55 (Fed. T.D.) per Reed J. at 61 [C.P.R.], affirmed 1994 CarswellNat 1333 (Fed. C.A.).
- ²⁵⁴ *Western Electric Co. v. Baldwin International Radio of Canada Ltd.*, 1934 CarswellNat 38, [1934] S.C.R. 570 (S.C.C.) at 592-593 [S.C.R.].
- ²⁵⁵ *Mobil Oil Corp. v. Hercules Canada Inc.*, 1995 CarswellNat 1833, 63 C.P.R. (3d) 473 (Fed. C.A.) per Marceau J., 481-482 [C.P.R.], leave to appeal refused 1996 CarswellNat 3159 (S.C.C.).
- ²⁵⁶ *Gold v. Serratus Mountain Products Ltd.*, 2004 CarswellNat 2589, 2004 CarswellNat 4923, 35 C.P.R. (4th) 481 (F.C.) per Blais J. at 485-486 [C.P.R.], paras. 15-18, affirmed 2006 CarswellNat 581, 2006 CarswellNat 2265 (F.C.A.).
- ²⁵⁷ *Dablehy. Ontario Hydro*, 1996 CarswellNat 2592, 1996 CarswellNat 735, 68 C.P.R. (3d) 129 (Fed. C.A.) at 145 [C.P.R.], leave to appeal refused 1997 CarswellNat 3240 (S.C.C.).
- ²⁵⁸ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 155 [C.P.R.], para. 55, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *Free World Trust c. E lectro Santé Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 193 [C.P.R.], para. 54; *AlliedSignal Inc. v. DuPont Canada Inc.*, 1995 CarswellNat 699, 61 C.P.R. (3d) 417 (Fed. C.A.) per Desjardins J.A. at 426 [C.P.R.], leave to appeal refused 1995 CarswellNat 2832 (S.C.C.); *Western Electric Co. v. Baldwin International Ltd.*, 1933 CarswellNat 48, [1934] S.C.R. 94 (S.C.C.) per Duff C.J. at 582 [S.C.R.]; *Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd.*, 1974 CarswellNat 378, 1974 CarswellNat 378F, [1976] 1 S.C.R. 555 (S.C.C.) at 560 [S.C.R.] (“la date de la delivrance du brevet” in the more speci?e French language text); *Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd.*, 1981 CarswellNat 582F, 1981 CarswellNat 582, 122 D.L.R. (3d) 203, [1981] 1 S.C.R. 504 (S.C.C.) at 523 [S.C.R.]; *Janssen-Ortho Inc. v. Novopharm Ltd.*, 2007 FCA 217, 2007 CarswellNat 1556, 2007 CarswellNat 3072, 59 C.P.R. (4th) 116 (F.C.A.) per Sharlow J.A. at para. 4, affirmed on reconsideration 2007

and phrases may have changed in meaning during the interim.²⁵⁹ Where an old-*Act* patent had a claim corrected shortly after grant, the corrected claim was construed as of the date of the correction.²⁶⁰

Patents issuing from patent applications filed on or after October 1, 1989²⁶¹ are to be construed as at their date of publication.²⁶²

On that date, the invention is disclosed to the public, those interested have some ability to oppose the grant of the patent applied for, and the applicant for the patent is eventually allowed to claim reasonable compensation (s. 55(2)), provided the patent is ultimately granted, from and after the “laid open” date. The public, the patentee, its competitors and potential infringers all have an interest and/or concern from that date forward. The notional skilled addressee has a text available for interpretation. In summary, public disclosure and the triggering of legal consequences on the “laid open” date, as well as the policy considerations that underpinned the earlier case law, favour that date over the other possibilities as the critical date for the purpose of claims construction.²⁶³

Likewise, the substitutability of non-essential elements is to be determined as at “... the time they are revealed to the target audience of persons skilled in the relevant art”,²⁶⁴ namely the “laid open” date for patents filed after October 1, 1989.²⁶⁵

For NOC proceedings, the claims are to be considered in the form in which they are as of the date of the hearing.²⁶⁶

CarswellNat 2584, 2007 CarswellNat 7091 (F.C.A.), leave to appeal refused 2007 CarswellNat 4172, 2007 CarswellNat 4173 (S.C.C.).

²⁵⁹ *Shire Biochem Inc. v. Canada (Minister of Health)*, 2008 FC 538, 2008 CarswellNat 2815, 2008 CarswellNat 1240, 67 C.P.R. (4th) 94 (F.C.) per Hughes J. at para. 23.

²⁶⁰ *Laboratoires Servier v. Apotex Inc.*, 2008 FC 825, 2008 CarswellNat 3000, 2008 CarswellNat 5245, 67 C.P.R. (4th) 241 (F.C.) per Snider J. at para. 106, additional reasons 2008 CarswellNat 4195, 2008 CarswellNat 3444 (F.C.), affirmed 2009 CarswellNat 1922, 2009 CarswellNat 5775 (F.C.A.), leave to appeal refused 2010 CarswellNat 660, 2010 CarswellNat 661 (S.C.C.).

²⁶¹ *Patent Act*, c. P-4.

²⁶² *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. paras. 52-54, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *Free World Trust c. E' lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J., paras. 54-56.

²⁶³ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 155 [C.P.R.], para. 56, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.) and *Free World Trust c. E' lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 193 [C.P.R.], para. 54. Pursuant to s.10, the publication date is no earlier than 18 months after the earlier of the filing date or the priority date unless earlier publication was requested on behalf of the applicant.

²⁶⁴ *Free World Trust c. E' lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 192 [C.P.R.], para. 52.; *Quadco Equipment Inc. v. Timberjack Inc.*, 2002 CarswellNat 233, 2002 CarswellNat 6151, 17 C.P.R. (4th) 224 (Fed. T.D.) at para. 28.

²⁶⁵ *Free World Trust c. E' lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 193 [C.P.R.], para. 54.

6.7.1.2 *The Skilled Reader: The Person of Ordinary Skill in the Art (“POSITA”)*

The patent is to be considered as read by and understood from the viewpoint of the addressee of the patent: a skilled worker in the field of the invention of the patent,²⁶⁷ who is not necessarily an ordinary member of the public.²⁶⁸

The words and phrases used in the claim at issue are to be interpreted as understood by a person who is possessed of all the technical knowledge required to fully understand the terms used and the principles involved;²⁶⁹ the person of ordinary skill in the art, or “POSITA”.

The patent is not addressed to an ordinary member of the public, but to a worker skilled in the art described by Dr. Fox as:

a hypothetical person possessing the ordinary skill and knowledge of the particular art to which the invention relates, and a mind willing to understand a specification that is addressed to him. This hypothetical person has sometimes been equated with the “reasonable man” used as a standard in negligence cases. He is assumed to be a man who is going to try to achieve success and not one who is looking for difficulties or seeking failure.²⁷⁰

²⁶⁶ *Sanofi-Aventis Canada Inc. v. Hospira Healthcare Corp.*, 2009 FC 1077, 2009 CarswellNat 5905, 2009 CarswellNat 3524 (F.C.) per Zinn J. at paras. 104 and 121-122, as that is the relevant date for assessing the justification for an NOA: *Merck Frosst Canada Inc. v. Canada (Minister of National Health & Welfare)*, 1998 CarswellNat 1059, 1998 CarswellNat 1060, [1998] 2 S.C.R. 193 (S.C.C.) (per Iacobucci J.).

²⁶⁷ *Rodi v. Wienenberger*, [1969] R.P.C. 367 (H.L.) per Lord Upjohn at 391; *Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd.*, 1974 CarswellNat 378, 1974 CarswellNat 378F, 17 C.P.R. (2d) 97 (S.C.C.) per Pigeon J. at 104 [C.P.R.].

²⁶⁸ *Free World Trust c. E. lectro Santo Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 189 [C.P.R.], para. 44; *Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd.*, 1981 CarswellNat 582F, 1981 CarswellNat 582, 122 D.L.R. (3d) 203, [1981] 1 S.C.R. 504 (S.C.C.) at 521 [S.C.R.]; *Minerals Separation North American Corp. v. Noranda Mines Ltd.*, 1947 CarswellNat 8, [1947] Ex. C.R. 306, [1950] S.C.R. 36 (S.C.C.) at 317 [Ex. C.R.], reversed 1949 CarswellNat 19 (S.C.C.), affirmed 1952 CarswellNat 2, 15 C.P.R. 133 (Jud. Com. of Privy Coun.); *The Edison Bell Phonograph Corporation, Limited v. Smith and Young*, [1894] 11 R.P.C. 389 at 396.

²⁶⁹ *Kramer v. Lawn Furniture Inc.*, 1974 CarswellNat 464, 13 C.P.R. (2d) 231 (Fed. T.D.) per Addy J. 231 at 237 [C.P.R.], affirmed 1979 CarswellNat 799 (Fed. T.D.), quoted in *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2005 CarswellNat 4401, 2005 CarswellNat 7441, 46 C.P.R. (4th) 244 (F.C.) per Hughes J. at 253 [C.P.R.], para. 19, affirmed 2007 CarswellNat 6, 2007 CarswellNat 1052 (F.C.A.).

²⁷⁰ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 155 [C.P.R.], para. 56, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.) and *Free World Trust c. E. lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at para. 44, quoting H. G. Fox, *The Canadian Law and Practice Relating to Letters Patent for Inventions* (4th ed. 1969), at p. 184.

Only those familiar with the field of the invention can be expected to make anything of the claims.²⁷¹ The introductory language of the patent can give guidance as to the person(s) to whom the patent is directed.²⁷²

The knowledge that the skilled reader is expected to possess is to be taken into account.²⁷³ For example, where a patent is for an electrocardiograph cream, it must be obvious that a cream for use with skin contact electrodes is not to be made up with ingredients that are toxic or irritating or are apt to stain or discolour the skin. The man skilled in the art will just as well appreciate this necessity if the cream to be made is described as “compatible with normal skin” as if it is described as containing only ingredients compatible with normal skin.²⁷⁴

It is the “common knowledge” shared by competent “ordinary workers” that is brought to bear on the interpretation.²⁷⁵

The worker should be an “ordinary” worker in the field, not the least qualified or slowest witted,²⁷⁶ operating on the basis of common knowledge in the trade, and not someone with specialized knowledge that is not also within the knowledge of other workers in the field. An expert burdened with inside information of a company is not a satisfactory proxy for the “ordinary worker”.²⁷⁷

²⁷¹ *American Cyanamid Co. v. Berk Pharmaceuticals Ltd.* (1973), [1976] R.P.C. 231 (Eng. Ch. Div.) at 234.

²⁷² *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at para. 41.

²⁷³ *Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd.*, 1974 CarswellNat 378, 1974 CarswellNat 378F, 17 C.P.R. (2d) 97 (S.C.C.) per Pigeon J. at 104 [C.P.R.].

²⁷⁴ *Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd.*, 1974 CarswellNat 378, 1974 CarswellNat 378F, 17 C.P.R. (2d) 97 (S.C.C.) per Pigeon J. at 104 [C.P.R.]. The Court distinguished this circumstance to one where the claims included inoperative embodiments:

The situation here is completely unlike that in either the *Minerals Separation case* or in *Société des Usines Chimiques Rhône-Poulenc et al. v. Jules R. Gilbert Ltd. et al.* (1968), 55 C.P.R. 207, 69 D.L.R. (2d) 353, [1968] S.C.R. 950. In those cases the object of the patent was some substances of a definite chemical composition: xanthates in the first, substituted diamines in the second. Unfortunately for the patentees, the claims covered at the same time some xanthates which would not yield the desirable result in one use, and, in the other, some isomers which would not be therapeutically valuable. This is what was held fatal to the validity of the patents.

²⁷⁵ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 155 [C.P.R.], para. 56, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.) and *Free World Trust c. e` lectro Santo Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at para. 44, quoting H. G. Fox, *The Canadian Law and Practice Relating to Letters Patent for Inventions* (4th ed. 1969), at p. 204, *Terrell on the Law of Patents* (15th ed. 2000), at p. 125, and I. Goldsmith, *Patents of Invention* (1981), at p. 116.

²⁷⁶ *Janssen-Ortho Inc. v. Novopharm Ltd.*, 2006 FC 1234, 2006 CarswellNat 3249, 2006 CarswellNat 4811, 57 C.P.R. (4th) 6 (F.C.) per Hughes J. at para. 90, additional reasons 2006 CarswellNat 5592, 2006 CarswellNat 3655 (F.C.), affirmed 2007 CarswellNat 1556, 2007 CarswellNat 3072 (F.C.A.), affirmed on reconsideration 2007 CarswellNat 2584, 2007 CarswellNat 7091 (F.C.A.), leave to appeal refused 2007 CarswellNat 4172, 2007 CarswellNat 4173 (S.C.C.).

²⁷⁷ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th)

In some cases, the addressee can be a team of people with different expertise:²⁷⁸

... a composite of scientists researchers and technicians bringing to their combined expertise to bear on the problem at hand: “This is particularly true where the invention relates to a science or art that transcends several scientific disciplines.”²⁷⁹

Any assessment of the evidence (concerning the state of scientific knowledge at the relevant time, or how a reasonable POSITA would understand the patent, for example) made by the Judge in the course of reaching his or her conclusion on the construction of the patent is reviewable for palpable and overriding error.²⁸⁰ The attributes of the POSITA and the extent of the POSITA’s common general knowledge are matters of fact or mixed fact and law from which a legal issue cannot be extricated. In accordance with principles of appellate review, such findings may be set aside only if they disclose a palpable and overriding error.²⁸¹

129 (S.C.C.) per Binnie J. at 159 [C.P.R.], para. 70, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

²⁷⁸ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 159 [C.P.R.], paras. 70-74, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.), *General Tire & Rubber Co. v. Firestone Tyre & Rubber Co.* (1972), [1971] R.P.C. 173 (U.K. Ch.D.) at 232, affirmed [1972] R.P.C. 457 (U.K. H.L.) per Sachs, L.J.) at 482; *American Cyanamid Co. v. Ethicon*, [1979] R.P.C. 215 (Eng. Ch. Div.) per Graham, J. at 245-246; *Laboratoires Servier v. Canada (Minister of Health)*, 2015 FC 108, 2015 CarswellNat 304, 2015 CarswellNat 9917 (F.C.) per Roy J. at paras. 52 & 57; *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) at paras. 32 to 42; *Apotex Inc. v. Sanofi-Aventis Canada Inc.*, 2011 FC 1486, 2011 CarswellNat 5423, 2011 CarswellNat 6168 (F.C.), additional reasons 2012 CarswellNat 1017, 2012 CarswellNat 1480 (F.C.), appeal dismissed as moot 2013 CarswellNat 2584, 2013 CarswellNat 6946 (F.C.A.), reversed 2013 CarswellNat 2585, 2013 CarswellNat 11461 (F.C.A.), varied on reconsideration 2013 CarswellNat 12471, 2013 CarswellNat 3404 (F.C.A.), leave to appeal allowed 2014 CarswellNat 117, 2014 CarswellNat 118 (S.C.C.); *Pfizer Canada Inc. v. Pharmascience Inc.*, 2013 FC 120, 2013 CarswellNat 177, 2013 CarswellNat 1248 (F.C.) at para. 28; *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J. at para. 68; *MediaTube Corp. v. Bell Canada*, 2017 FC 6, 2017 CarswellNat 18, 2017 CarswellNat 3277 (F.C.) per Locke J. at para. 30, affirmed 2019 CarswellNat 2404, 2019 CarswellNat 14152 (F.C.A.), leave to appeal refused 2020 CarswellNat 826, 2020 CarswellNat 827 (S.C.C.).

²⁷⁹ *Bayer AG v. Novopharm Ltd.*, 2006 FC 379, 2006 CarswellNat 1547, 2006 CarswellNat 2208, 48 C.P.R. (4th) 46 (F.C.) per Phelan J. at para. 47 quoting *Bayer AG v. Apotex Inc.*, 1995 CarswellOnt 2282, 60 C.P.R. (3d) 58 (Ont. Gen. Div.) at 79 [C.P.R.], additional reasons 1995 CarswellOnt 258 (Ont. Gen. Div.), affirmed 1998 CarswellOnt 3777 (Ont. C.A.), leave to appeal refused 1999 CarswellOnt 5724 (S.C.C.), varied 1998 CarswellOnt 3777 (Ont. C.A.) quoting *Mobil Oil Corp. v. Hercules Canada Inc.*, 1994 CarswellNat 682, 57 C.P.R. (3d) 488 (Fed. T.D.) per Weston J. at 494 [C.P.R.], reversed in part 1995 CarswellNat 1833 (Fed. C.A.), leave to appeal refused 1996 CarswellNat 3159 (S.C.C.).

²⁸⁰ *Astrazeneca Canada Inc. v. Mylan Pharmaceuticals ULC*, 2012 FCA 109, 2012 CarswellNat 979, 2012 CarswellNat 2008, 432 N.R. 292 (F.C.A.) at para. 20 quoted in *AFD Petroleum Ltd. v. Frac Shack Inc.*, 2018 FCA 140, 2018 CarswellNat 3775, 2018 CarswellNat 12343 (F.C.A.) per Gleason J.A., Webb & Laskin JJ.A. concurring at para. 39.

²⁸¹ *AFD Petroleum Ltd. v. Frac Shack Inc.*, 2018 FCA 140, 2018 CarswellNat 3775, 2018 CarswellNat 12343 (F.C.A.) per Gleason J.A., Webb & Laskin JJ.A. concurring at para. 38, citing *Housen v. Nikolaisen*, 2002 SCC 33, 2002 CarswellSask 178, 2002 CarswellSask 179, [2002] 2 S.C.R. 235 (S.C.C.) at paras. 10 & 37.

6.7.1.3 Objective Attitude or Biased for Really Useful Inventions

The patent should be read by a mind willing to understand, not a mind desirous of misunderstanding.²⁸² A “mind willing to understand” necessarily pays close attention to the purpose and intent of the author.²⁸³

The patent ought not to be construed malevolently, but need not be construed benevolently²⁸⁴ nor harshly.²⁸⁵ It must be fairly and reasonably construed, being fair to both the patentee and the public.²⁸⁶ It must be done dispassionately.²⁸⁷

Some cases have suggested the Court should have a pro-patent bias in cases involving “a genuine, great and important invention, which, as in some cases, one might almost say, produces a revolution in a given art or manufacture ...” or that a patent should be approached with a judicial anxiety to support a really useful invention.²⁸⁸ In such cases, where there are two different constructions, there ought to be a bias “... in favour of the real and genuine invention, to adopt that construction which supports an invention”²⁸⁹ rather than one that destroys it.²⁹⁰

Other cases have said that if there is more than one construction that can be reasonably reached, the Court must favour the construction which upholds the

²⁸² *Lister v. Norton Brothers and Co.*, [1886] 3 R.P.C. 199 at 203.

²⁸³ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 149 [C.P.R.], para. 49(c), reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

²⁸⁴ *Lister v. Norton Brothers and Co.*, [1886] 3 R.P.C. 199 at 203.

²⁸⁵ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at para. 49, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at para. 37.

²⁸⁶ *Henricksen v. Tallon Ltd.*, [1965] R.P.C. 434 (U.K. H.L.) at 446; *Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd.*, 1981 CarswellNat 582F, 1981 CarswellNat 582, 56 C.P.R. (2d) 145 (S.C.C.) per Dickson J. at 157 [C.P.R.].

²⁸⁷ *American Cyanamid Co. v. Berk Pharmaceuticals Ltd.* (1973), [1976] R.P.C. 231 (Eng. Ch. Div.) at 234.

²⁸⁸ *Hinks & Son v. Safety Lighting Co.* (1876), 4 Ch. D. 607 (Eng. Ch. Div.) per Sir George Jessel quoted in *Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd.*, 1981 CarswellNat 582F, 1981 CarswellNat 582, 56 C.P.R. (2d) 145 (S.C.C.) per Dickson J. at 157 [C.P.R.].

²⁸⁹ *Otto v. Linford* (1882), 46 L.T. (N.S.) 35 per Jessel M.R. at 39, quoted in *Wandscheer v. Sicard Ltd.*, 1947 CarswellNat 19, 8 C.P.R. 35 (S.C.C.) per Taschereau J. at 52-53 [C.P.R.]; *Jules R. Gilbert Ltd. v. Sandoz Patents Ltd.*, 1970 CarswellNat 378, 64 C.P.R. 14 (Can. Ex. Ct.) per Thurlow J. at 40 [C.P.R.], reversed in part 1972 CarswellNat 438, 1972 CarswellNat 438F (S.C.C.).

²⁹⁰ *Bourgault Industries Ltd. v. Flexi-Coil Ltd.*, 1998 CarswellNat 5284, 1998 CarswellNat 2125, 80 C.P.R. (3d) 1 (Fed. T.D.) per Campbell J. at 39 [C.P.R.], affirmed on reconsideration 1998 CarswellNat 5189, 1998 CarswellNat 554 (Fed. T.D.), affirmed 1999 CarswellNat 4756, 1999 CarswellNat 380 (Fed. C.A.), leave to appeal refused 2000 CarswellNat 393, 2000 CarswellNat 394 (S.C.C.) citing *Jules R. Gilbert Ltd. v. Sandoz Patents Ltd.*, 1970 CarswellNat 378, 64 C.P.R. 14 (Can. Ex. Ct.), reversed in part 1972 CarswellNat 438, 1972 CarswellNat 438F (S.C.C.).

patent.²⁹¹ In *GlaxoSmithKline Inc. v. Apotex Inc.*,²⁹² the Court appears to have avoided one construction solely to avoid a finding of invalidity: “GSK’s interpretation should be rejected as it would lead to an invalid patent due to lack of utility, a result that is inconsistent with the aims of the purposive approach.” Similarly, with respect to novelty, the court has said:

In my view, where two possible interpretations of a patent are available, but only one produces a novel invention, that interpretation is the one to be preferred. While it is not impossible that a patent may disclose something already covered by the prior art, one should prefer an interpretation that avoids that result if possible.²⁹³

A bias towards construing a claim so as to support the validity of a patent appears to contradict the case law saying that claims are to be construed before issues of validity are to be considered.²⁹⁴ The court has recognized this inconsistency: one can favour a construction that upholds the patent only if one has considered what is necessary to uphold the patent.²⁹⁵

This bias may also be reflected in the comments that the patent should be read to afford protection to what has been invented and not defeat the patent based on technicalities²⁹⁶ and that one should not be too astute or technical in raising objections to the specifications.²⁹⁷

²⁹¹ *Pollard Banknote Ltd. v. BABN Technologies Corp.*, 2016 FC 883, 2016 CarswellNat 3400, 2016 CarswellNat 10897 (F.C.) per Locke J. at para. 77, additional reasons 2016 CarswellNat 8063, 2016 CarswellNat 11587 (F.C.), citing *Letourneau v. Clearbrook Iron Works Ltd.*, 2005 FC 1229, 2005 CarswellNat 5521, 2005 CarswellNat 3008 (F.C.) at paras. 37 and 38, affirmed 2006 CarswellNat 1465, 2006 CarswellNat 240 (F.C.A.), and *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2005 FC 1725, 2005 CarswellNat 4401, 2005 CarswellNat 7441 (F.C.) at para. 52, affirmed 2007 CarswellNat 6, 2007 CarswellNat 1052 (F.C.A.).

²⁹² 2003 CarswellNat 1649, 2003 CarswellNat 6924, 27 C.P.R. (4th) 114 (Fed. T.D.) at para. 47.

²⁹³ *Janssen-Ortho Inc. v. Canada (Minister of Health)*, 2010 FC 42, 2010 CarswellNat 1445, 2010 CarswellNat 199 (F.C.) per Zinn J. at para. 147, additional reasons 2010 CarswellNat 2356, 2010 CarswellNat 442 (F.C.).

²⁹⁴ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 146 [C.P.R.], para. 43, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *American Cyanamid Co. v. Berk Pharmaceuticals Ltd.* (1973), [1976] R.P.C. 231 (Eng. Ch. Div.) at 234; *Xerox of Canada Ltd. v. IBM Canada Ltd.*, 1977 CarswellNat 669, 33 C.P.R. (2d) 24 (Fed. T.D.) per Collier J. at 43 [C.P.R.] quoting *American Cyanamid Co. v. Berk Pharmaceuticals Ltd.* (1973), [1976] R.P.C. 231 (Eng. Ch. Div.) at 234; *Dableh v. Ontario Hydro*, 1996 CarswellNat 2592, 1996 CarswellNat 735, 68 C.P.R. (3d) 129 (Fed. C.A.) per Strayer J. (Linden and Robertson J.J.A. concurring) at 143 [C.P.R.], leave to appeal refused 1997 CarswellNat 3240 (S.C.C.); *Lundbeck Canada Inc. v. Canada (Minister of Health)*, 2010 FCA 320, 2010 CarswellNat 4425, 2010 CarswellNat 4426 (F.C.A.) per Noël J.A., Pelletier and Trudel J.J.A. concurring at para. 72, leave to appeal refused 2011 CarswellNat 3240, 2011 CarswellNat 3241 (S.C.C.), leave to appeal refused 2011 CarswellNat 3229, 2011 CarswellNat 3230 (S.C.C.), leave to appeal refused 2011 CarswellNat 3242, 2011 CarswellNat 3243 (S.C.C.).

²⁹⁵ *Pollard Banknote Ltd. v. BABN Technologies Corp.*, 2016 FC 883, 2016 CarswellNat 3400, 2016 CarswellNat 10897 (F.C.) per Locke J. at para. 78, additional reasons 2016 CarswellNat 8063, 2016 CarswellNat 11587 (F.C.).

²⁹⁶ *Lubrizol Corp. v. Imperial Oil Ltd.*, 1992 CarswellNat 1049, 45 C.P.R. (3d) 449, 98 D.L.R. (4th) 1 (Fed. C.A.), additional reasons 1993 CarswellNat 1964 (Fed. C.A.), leave to appeal refused 1993

6.7.1.4 With an Eye on the Defendant's Product

Generally, a patent must not be construed with an eye on the allegedly infringing device in respect of infringement or with an eye to the prior art in respect of validity to avoid its effect.²⁹⁸ As one judge described it: the claims are to be construed, “as if the defendant had never been born”.²⁹⁹

Although judicial blindness is a laudable principle, in fact, there are usually only a few claim elements (words or phrases in the claims) that are at issue in the lawsuit. It therefore makes sense for the Court, when it construes a claim, to focus on that part of the claim that is at issue. It would be highly impractical to construe the claims without knowing what specific terms or phrases give rise to interpretive difficulties.³⁰⁰ The Court is not to construe a claim without

CarswellNat 2472 (S.C.C.); *Western Electric Co. v. Baldwin International Ltd.*, 1933 CarswellNat 48, [1934] S.C.R. 94 (S.C.C.) at 132-133 [S.C.R.]; *Diversified Products Corp. v. Tye-Sil Corp.*, 1991 CarswellNat 903, 35 C.P.R. (3d) 350 (Fed. C.A.) per Dery J.A. at 362 [C.P.R.]; *Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd.*, 1974 CarswellNat 378, 1974 CarswellNat 378F, 17 C.P.R. (2d) 97 (S.C.C.) per Pigeon J. at 104 [C.P.R.]; *Procter & Gamble Co. v. Calgon Interamerican Corp.*, 1982 CarswellNat 604, 61 C.P.R. (2d) 1 (Fed. C.A.) at 8 [C.P.R.], leave to appeal refused 1982 CarswellNat 761 (S.C.C.); *Unilever PLC. v. Procter & Gamble Inc.*, 1995 CarswellNat 375, [1995] F.C.J. No. 1005, 61 C.P.R. (3d) 499 (Fed. C.A.) at para. 23; *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at para. 49, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at para. 37.

²⁹⁷ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at para. 49, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *Henricksen v. Tallon Ltd.*, [1965] R.P.C. 434 (U.K. H.L.); *Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd.*, 1981 CarswellNat 582F, 1981 CarswellNat 582, 56 C.P.R. (2d) 145 (S.C.C.) per Dickson J. at 157 [C.P.R.]; *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at para. 37.

²⁹⁸ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 148-149 [C.P.R.], paras. 43 and 49(a), reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); citing *Dableh v. Ontario Hydro*, 1996 CarswellNat 2592, 1996 CarswellNat 735, 68 C.P.R. (3d) 129 (Fed. C.A.) per Strayer J. (Linden and Robertson J.J.A. concurring) at 143 [C.P.R.], leave to appeal refused 1997 CarswellNat 3240 (S.C.C.); *Rodi v. Wienberger*, [1969] R.P.C. 367 (H.L.) per Lord Upjohn at 391(2); *American Cyanamid Co. v. Berk Pharmaceuticals Ltd.* (1973), [1976] R.P.C. 231 (Eng. Ch. Div.) at 234; *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2005 CarswellNat 4401, 2005 CarswellNat 7441, 46 C.P.R. (4th) 244 (F.C.) per Hughes J. at para. 35, affirmed 2007 CarswellNat 6, 2007 CarswellNat 1052 (F.C.A.); *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2007 FCA 209, 2007 CarswellNat 1434, 2007 CarswellNat 4252, 60 C.P.R. (4th) 81 (F.C.A.) per Nadon J.A., Linden and Sexton J.J.A. concurring, at para. 39, leave to appeal refused 2007 CarswellNat 3850, 2007 CarswellNat 3851 (S.C.C.).

²⁹⁹ Judge Peter Ford, of the UK Patents County Court in an address to the American Intellectual Property Law Association Mid-Winter Meeting, January 28, 1993. See also *Nokia Corp. v. Interdigital Technology Corp.*, [2007] EWHC 3077 (England P.C.) (Pat per Pumfrey J.) quoted in *Shire Biochem Inc. v. Canada (Minister of Health)*, 2008 FC 538, 2008 CarswellNat 2815, 2008 CarswellNat 1240, 67 C.P.R. (4th) 94 (F.C.) per Hughes J. at para. 22.

³⁰⁰ *JSeedlings Life Science Ventures, LLC v. Pfizer Canada ULC*, 2020 FC 1, 2020 CarswellNat 6,

knowing where the disputes between the parties lie. Arguments and evidence need to be directed to the point or points in dispute or “where the shoe pinches”³⁰¹

Although the structure of the defendant’s allegedly infringing device is irrelevant to issues of construction, the Court must at least be aware of what elements of the claim are alleged by the defendant not to be present in the defendant’s device.³⁰²

The same cannot be said for experts. It is preferable to have the expert interpret the claims before being told of the nature of the alleged infringement or prior art.

In *Teva Canada Innovation v. Apotex Inc.*,³⁰³ the manner in which the experts were retained and instructed, provided the court with a reason to prefer the evidence of the Apotex experts over those of Teva. Because the Apotex experts did not know the alcohol that Apotex had used in its products when they construed the patent, their interpretation was undertaken in accordance with the direction from the Supreme Court of Canada.³⁰⁴ The Teva experts’ evidence was to be accorded less weight.³⁰⁵

Teva’s counsel provided their experts with extracts from the ANDS and NOA at the outset to alert them to the issues that were relevant.³⁰⁶ Instead counsel could direct the experts’ attention to the issues by asking whether the terms “pentahydric or hexahydric alcohols” as used in the patent at issue would connote a molecule or a moiety without alerting the experts to the specifics of the allegedly infringing substance.³⁰⁷

2020 CarswellNat 4901 (F.C.) (per Grammond J) at para. 43, additional reasons 2020 CarswellNat 1401, 2020 CarswellNat 1402 (F.C.), affirmed 2021 CarswellNat 2805 (F.C.A.).

³⁰¹ *Shire Biochem Inc. v. Canada (Minister of Health)*, 2008 FC 538, 2008 CarswellNat 2815, 2008 CarswellNat 1240, 67 C.P.R. (4th) 94 (F.C.) per Hughes J. at para. 22 quoting Justice Floyd of the England and Wales High Court (Patent Court) in *Qualcomm Inc. v. Nokia Corp.*, [2008] EWHC 329 (England P.C.) at paras. 7 to 11, who in turn quoted the late Justice Pumphrey (as he then was) in *Nokia Corp. v. Interdigital Technology Corp.*, [2007] EWHC 3077 (England P.C.), “it is essential to see where the shoe pinches so that one can concentrate on the important points.”

³⁰² Judge Peter Ford, of the UK Patents County Court in an address to the American Intellectual Property Law Association Mid-Winter Meeting, January 28, 1993. See also *Nokia Corp. v. Interdigital Technology Corp.*, [2007] EWHC 3077 (England P.C.) (Pat per Pumphrey J.) quoted in quoted in *Shire Biochem Inc. v. Canada (Minister of Health)*, 2008 FC 538, 2008 CarswellNat 2815, 2008 CarswellNat 1240, 67 C.P.R. (4th) 94 (F.C.) per Hughes J. at para. 22.

³⁰³ *Teva Canada Innovation v. Apotex Inc.*, 2014 FC 1070, 2014 CarswellNat 6535, 2014 CarswellNat 8571 (F.C.) per Gleason J. at para. 94.

³⁰⁴ *Teva Canada Innovation v. Apotex Inc.*, 2014 FC 1070, 2014 CarswellNat 6535, 2014 CarswellNat 8571 (F.C.) per Gleason J. at para. 94.

³⁰⁵ *Teva Canada Innovation v. Apotex Inc.*, 2014 FC 1070, 2014 CarswellNat 6535, 2014 CarswellNat 8571 (F.C.) per Gleason J. at para. 94.

³⁰⁶ *Teva Canada Innovation v. Apotex Inc.*, 2014 FC 1070, 2014 CarswellNat 6535, 2014 CarswellNat 8571 (F.C.) per Gleason J. at para. 94.

6.7.2 Use of the Patent Specification

6.7.2.1 The Patent Should be Read as a Whole

Mr. Justice Binnie endorsed a “purposive construction” to give the terms in the claim the meaning intended by the patentee based on a reading of the claims in the context of the patent as a whole.³⁰⁸ Regard may be had to the whole of the patent specification, including the drawings and the disclosure.³⁰⁹

The concept of reading the patent as a whole is not new: even in 1886, the Court held that the patent should be construed (and read) as a whole³¹⁰ to provide background to assist in the interpretation of the claim or to supply the vocabulary necessary for the interpretation of the claim.³¹¹

In *Consolboard*, Dickson J. considered that the whole of the specification (including the disclosure and the claims) should be looked at “to ascertain the nature of the invention”.³¹² Similarly, Taschereau J. stated in *Metalliflex Ltd. v. Rodi & Wienenberger AG*:

The claims, of course, must be construed with reference to the entire specifications, and the latter may therefore be considered in order to assist in apprehending and construing a claim, but the patentee may not be allowed to expand his monopoly specifically expressed in the claims “by borrowing this or that gloss from other parts of the specifications”.³¹³

³⁰⁷ *Teva Canada Innovation v. Apotex Inc.*, 2014 FC 1070, 2014 CarswellNat 6535, 2014 CarswellNat 8571 (F.C.) per Gleason J. at para. 96.

³⁰⁸ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at para. 49, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at para. 37.

³⁰⁹ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 150 [C.P.R.], para. 49(f), reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *Janssen-Ortho Inc. v. Novopharm Ltd.*, 2007 FCA 217, 2007 CarswellNat 1556, 2007 CarswellNat 3072, 59 C.P.R. (4th) 116 (F.C.A.) per Sharlow J.A. at para. 4, affirmed on reconsideration 2007 CarswellNat 2584, 2007 CarswellNat 7091 (F.C.A.), leave to appeal refused 2007 CarswellNat 4172, 2007 CarswellNat 4173 (S.C.C.); *Eli Lilly Canada Inc. v. Apotex Inc.*, 2008 FC 142, 2008 CarswellNat 1821, 2008 CarswellNat 308, 63 C.P.R. (4th) 406 (F.C.) per Hughes J. at para. 30, affirmed 2009 CarswellNat 833, 2009 CarswellNat 3956 (F.C.A.), leave to appeal refused 2009 CarswellNat 3235, 2009 CarswellNat 3236 (S.C.C.); *Apotex Inc. v. AstraZeneca Canada Inc.*, 2017 FCA 9, 2017 CarswellNat 40, 2017 CarswellNat 10632 (F.C.A.) per Gauthier J.A., Pelletier & Scott J.J.A. concurring at para. 48, leave to appeal refused 2017 CarswellNat 2529, 2017 CarswellNat 2530 (S.C.C.).

³¹⁰ *Lister v. Norton Brothers and Co.*, [1886] 3 R.P.C. 199 at 203.

³¹¹ *Lister v. Norton Brothers and Co.*, [1886] 3 R.P.C. 199 at 203.

³¹² *Kramer v. Lawn Furniture Inc.*, 1974 CarswellNat 464, 13 C.P.R. (2d) 231 (Fed. T.D.) per Addy J. at 237 [C.P.R.], affirmed 1979 CarswellNat 799 (Fed. T.D.), quoted in *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2005 CarswellNat 4401, 2005 CarswellNat 7441, 46 C.P.R. (4th) 244 (F.C.) per Hughes J. at para. 19, affirmed 2007 CarswellNat 6, 2007 CarswellNat 1052 (F.C.A.).

³¹³ *Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd.*, 1981 CarswellNat 582F, 1981 CarswellNat 582, [1981] 1 S.C.R. 504 (S.C.C.) at 520 [S.C.R.].

Reference may be made to the disclosure in order to understand what the claims say³¹⁴ but such reference cannot be used to vary the scope or ambit of the claims.³¹⁵

6.7.2.2. Patentee as Lexicographer

A patentee can be his or her own lexicographer, expressly defining in the disclosure certain terms to have certain meanings within the patent. Such definitions apply to the words used in the claims, thereby defining their scope.³¹⁶ Considering the disclosure may help to determine if the inventor gave

³¹⁴ 1960 CarswellQue 303, [1961] S.C.R. 117 (S.C.C.) at 122 [S.C.R.] quoting from *Ingersoll Sargeant Drill Co. v. Consolidated Pneumatic Tool Co.* (1907), 25 R.P.C. 61 (U.K. H.L.).

³¹⁵ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 156 [C.P.R.], para. 59, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *Sanofi-Synthelabo Canada Inc. v. Apotex Inc.*, 2008 SCC 61, 2008 CarswellNat 3844, 2008 CarswellNat 3845, [2008] 3 S.C.R. 265 (S.C.C.) at para. 77, *Apotex Inc. v. AstraZeneca Canada Inc.*, 2017 FCA 9, 2017 CarswellNat 40, 2017 CarswellNat 10632 (F.C.A.) per Gauthier J.A., Pelletier & Scott J.J.A. concurring at para. 48, leave to appeal refused 2017 CarswellNat 2529, 2017 CarswellNat 2530 (S.C.C.). (Under previous case law, such recourse was permitted only where the words of the claim were ambiguous: *Minerals Separation North American Corp. v. Noranda Mines Ltd.*, 1949 CarswellNat 19, 12 C.P.R. 99 (S.C.C.) per Rand, J. at 36 [C.P.R.], affirmed 1952 CarswellNat 2 (Jud. Com. of Privy Coun.); *Procter & Gamble Co. v. Calgon Interamerican Corp.*, 1982 CarswellNat 604, 61 C.P.R. (2d) 1 (Fed. C.A.) per Urie J.A. at 8-11 [C.P.R.], leave to appeal refused 1982 CarswellNat 761 (S.C.C.); *British-Hartford-Fairmont Syndicate Ltd. v. Jackson Brothers (Knottingley) Ltd.* (1932), 49 R.P.C. 495 (C.A.), per Romer J. at 556; *Monsanto Canada Inc. v. Schmeiser*, 2002 CarswellNat 2199, 2002 CarswellNat 3496, 21 C.P.R. (4th) 1 (Fed. C.A.) at 15 [C.P.R.], para. 37, additional reasons 2002 CarswellNat 3280, 2002 CarswellNat 3871 (Fed. C.A.), reversed in part on other grounds 2004 CarswellNat 1391, 2004 CarswellNat 1392, [2004] 1 S.C.R. 902 (S.C.C.).

³¹⁶ *Western Electric Co. v. Baldwin International Radio of Canada Ltd.*, 1934 CarswellNat 38, [1934] S.C.R. 570 (S.C.C.) at 582 [S.C.R.]:

“I do not believe that any member of the class of people to whom this specification is addressed could have much doubt that the specification is employing these phrases in the sense defined by the specification itself. As I have already said, there is no evidence that they were terms of art having a generally understood signification in the art at the date of the patent, and even if there had been such evidence, I should have regarded it as quite immaterial, because the **inventor has made it plain that he is not using these phrases in any sense caught from the air, or from some general usage, but with a precise signification which he has defined in his specification.**” [emphasis added]

The use of a lexicon was referred to in *Smith Incubator Co. v. Seiling*, 1937 CarswellNat 46, [1937] S.C.R. 251 (S.C.C.) per Duff C.J. at 256, 259 [S.C.R.], para. 9 and by Rinfret J. speaking for the majority, at para. 23:

“As often observed, of course, the claims must be construed in the light of the rest of the specification; and that is to say, that the specification must be considered in order to assist in comprehending and construing the meaning — and possibly the special meaning — in which the words or the expressions contained in the claims are used (*Ingersoll v. Consolidated*).

Minerals Separation North American Corp. v. Noranda Mines Ltd., 1952 CarswellNat 2, 15 C.P.R. 133 (Jud. Com. of Privy Coun.) per Lord Reid at 144-145 [C.P.R.]:

“... it is possible for a patentee to make his own dictionary in this way. If he has put something in the earlier part of the specification which plainly tells the reader that for the purpose of the specification he is using a particular word with a meaning which he sets out, then the reader knows that when he comes to the claims he must read that word as having that meaning.

Electrical & Musical Industries Ltd. v. Lissen Ltd. (1938), 56 R.P.C. 23 (U.K. H.L.) (per Lord Russell of Killowen) at 41:

a particular meaning to an expression or word in the claim by adopting a special lexicon.³¹⁷

In *Ernest Scragg & Sons Ltd. v. Leeson Corp.*³¹⁸ Thorson P. held:

In my opinion, the decisions to which I have referred establish that the applicant for a patent may in the specification define the meaning of terms or expressions used by him in the claims and thereby make the specification a dictionary for the purpose of interpreting the said terms or expressions as they appear in the claims and that, if he has made his intention plain to the person of ordinary skill in the relevant art to whom the patent is assumed to be addressed that the terms or expressions referred are to be read with the meaning defined for them in the specification, the Court, in pursuance of its duty of fair construction of the claims, must construe the said terms or expressions as having such meaning.

Definitions are supposed to rule. If the patentee has put something in the earlier part of the specification which plainly tells the reader that for the purpose of the specification it is using a particular word with a meaning which is set out, then the reader knows that when he/she comes to the claims, he/she must read that word as having that meaning.³¹⁹

The fact that a term may have an accepted and ordinary meaning is immaterial if it is made plain in the specification that the term is being used in a particular sense.³²⁰

A definition of one term in a claim can be used to interpret another term in the claim. In *Pfizer Canada Inc. v. Novopharm Ltd.*³²¹ the term “adverse food

“I would point out that there is no question here of words in Claim 1 bearing any special or unusual meaning by reason either of a dictionary found elsewhere in the Specification or of technical knowledge possessed by persons skilled in the art. The *prima facie* meaning of words used in a claim may not be either true meaning when read in the light of such a dictionary or of such technical knowledge; and in those circumstances a claim, when so construed, may bear a meaning different from that which it would have borne had no such assisting light been available. That is construing a document in accordance with the recognized canons of construction. But I know of no canon or principle which will justify one in departing from the unambiguous and grammatical meaning of a claim and narrowing or extending its scope by reading into it words which are not in it; or which will justify one in using stray phrases in the body of a specification for the purpose of narrowing or widening the boundaries of the monopoly fixed by the plain words of a claim.”

Bombardier Recreational Products Inc. v. Arctic Cat Inc., 2017 FC 207, 2017 CarswellNat 605, 2017 CarswellNat 10520 (F.C.) per Roy J. at para. 325, reversed in part 2018 CarswellNat 5338, 2018 CarswellNat 5339 (F.C.A.), leave to appeal refused 2019 CarswellNat 1959, 2019 CarswellNat 1960 (S.C.C.).

³¹⁷ *Apotex Inc. v. AstraZeneca Canada Inc.*, 2017 FCA 9, 2017 CarswellNat 40, 2017 CarswellNat 10632 (F.C.A.) per Gauthier J.A., Pelletier & Scott J.J.A. concurring) at para. 48, leave to appeal refused 2017 CarswellNat 2529, 2017 CarswellNat 2530 (S.C.C.).

³¹⁸ 1964 CarswellNat 18, 45 C.P.R. 1, 26 Fox Pat. C. 1 (Can. Ex. Ct.) per Thorson P. at 59-61 [C.P.R.], 58-60 [Fox Pat. C.].

³¹⁹ *Minerals Separation North American Corp. v. Noranda Mines Ltd.*, 1952 CarswellNat 2, 15 C.P.R. 133 (Jud. Com. of Privy Coun.) per Lord Reid at 144-145 [C.P.R.].

³²⁰ *Lundbeck Canada Inc. v. Ratiopharm Inc.*, 2009 FC 1102, 2009 CarswellNat 3880, 2009 CarswellNat 5784 (F.C.) per Mactavish J. at para. 52.

effect” was used in the claim and was defined with reference to “gastric residence time” which could only apply to a drug that had been ingested. The Court therefore concluded that “pharmaceutical dosage form” meant “oral pharmaceutical dosage form”.³²²

Where the disclosure defined “... [h]alogen which may be represented as Hal in the formulae can be a chlorine, bromine, iodine, or fluorine, in which chlorine and bromine are most preferable”, fluorine was considered to be included in the halogen (Hal) described in claim 1, although it was evident that it was not the preferred halogen.³²³

6.7.2.3 Use of the Abstract

The *Patent Act* does not require that a patent contain an abstract, however the Patent Rules provide that an application shall contain one, but only for searching purposes.³²⁴ Thus, the abstract would appear to have no legal weight and is specifically excluded by Patent Rule 79(1) to be used to interpret the scope of the claims. Nevertheless, in *Monsanto Canada Inc. v. Schmeiser*³²⁵ the Supreme Court made incidental reference to the abstract as part of the specification it examined in doing a purposive construction of the patent claims.

6.7.2.4 Use of the Preamble to the Claim

The preamble of the claim can sometimes be used to limit the things encompassed by the claim to things that work and exclude things that do not.

In *Burton Parsons*, the preamble of the claim said that it was compatible with normal skin.³²⁶ The Court held that it must be obvious that a cream for use with skin contact electrodes is not to be made up of ingredients that are toxic or

³²¹ 2005 CarswellNat 5544, 2005 CarswellNat 3114, 42 C.P.R. (4th) 502 (F.C.) per Blanchard J.

³²² *Pfizer Canada Inc. v. Novopharm Ltd.*, 2005 CarswellNat 5544, 2005 CarswellNat 3114, 42 C.P.R. (4th) 502 (F.C.) per Blanchard J. at 526 [C.P.R.], para. 62. The Court also looked at other portions of the disclosure which made it clear that the invention was directed to an oral dose.

³²³ *Eli Lilly & Co. v. Apotex Inc.*, 2009 FC 991, 2009 CarswellNat 3042, 2009 CarswellNat 6607 (F.C.) per Gauthier J. at paras. 197-198, affirmed 2010 CarswellNat 5866, 2010 CarswellNat 3443 (F.C.A.), leave to appeal refused 2011 CarswellNat 1368, 2011 CarswellNat 1369 (S.C.C.), additional reasons 2011 CarswellNat 4151 (F.C.).

³²⁴ (*Patent Rules*, SOR/96-423, Rule 79(1)): “An application shall contain an abstract that provides technical information and that cannot be taken into account for the purpose of interpreting the scope of protection sought or obtained.” The purpose of the abstract would therefore appear to be for use as a search tool, see Rule 79(5).

³²⁵ *Monsanto Canada Inc. v. Schmeiser*, 2004 CarswellNat 1391, 2004 CarswellNat 1392, 31 C.P.R. (4th) 161 (S.C.C.) at 172 [C.P.R.], para. 18; distinguished in *Laboratoires Servier v. Apotex Inc.*, 2009 FCA 222, 2009 CarswellNat 1922, 2009 CarswellNat 5775, 392 N.R. 96 (F.C.A.) at para. 104, leave to appeal refused 2010 CarswellNat 660, 2010 CarswellNat 661 (S.C.C.).

³²⁶ “An electrocardiograph cream for use with skin contact electrodes and compatible with normal skin, comprising ...”

irritating or are apt to stain or discolour the skin. The man skilled in the art will just as well appreciate this necessity if the cream to be made is described as “compatible with normal skin”, as if it contains only ingredients compatible with normal skin.³²⁷

Where a claim claimed “A process of producing the compounds of structural formula [I, II, III and IV] which comprises ...” using *Aspergillus terreus*. It was known that some strains of *Aspergillus terreus* were non-producing. The Court construed the claim such that the use of the word “producing” in the preamble told a skilled person that non-producing strains were excluded.³²⁸

6.7.2.5 “Comprising” or “Consisting of”

The terms “comprising”, “consisting of” and “consisting essentially of” are transitional words or phrases used in the beginning of a claim to join the preamble to the claim elements.

The Canadian Patent Office’s Canadian Manual of Patent Office Practice (MPOP),³²⁹ a guide for Patent Office practice, recognizes that the choice of transitional phrase indicates whether the recitation is open or closed to additional elements.

The term “comprising” is frequently used in patent claims to separate the “fencing” function from the part of the claim that indicates what is the function of the claim.³³⁰

It is no vaguer than “includes”.³³¹ It is generally understood to mean “includes, but is not limited to”.³³²

³²⁷ *Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd.*, 1974 CarswellNat 378, 1974 CarswellNat 378F, 17 C.P.R. (2d) 97 (S.C.C.) per Pigeon J. at 104 [C.P.R.]. The Court distinguished this circumstance to one where the claims included inoperative embodiments:

The situation here is completely unlike that in either the *Minerals Separation case* or in *Société des Usines Chimiques Rhône-Poulenc et al. v. Jules R Gilbert Ltd. et al.* (1968), 55 C.P.R. 207, 69 D.L.R. (2d) 353, [1968] S.C.R. 950. In those cases the object of the patent was some substances of a definite chemical composition: xanthates in the first, substituted diamines in the second. Unfortunately for the patentees, the claims covered at the same time some xanthates which would not yield the desirable result in one use, and, in the other, some isomers which would not be therapeutically valuable. This is what was held fatal to the validity of the patents.

³²⁸ *Apotex Inc. v. Merck & Co.*, 2010 FC 1265, 2010 CarswellNat 5009 (F.C.) per Snider J. at paras. 83 and 118, affirmed 2011 CarswellNat 6152, 2011 CarswellNat 7182 (F.C.A.), leave to appeal refused 2012 CarswellNat 2442, 2012 CarswellNat 2443 (S.C.C.).

³²⁹ Chapter 11.01, 1998 edition updated September 2014, Available at <[http://www.cipo.gc.ca/eic/site/cipointernet-internetopic.nsf/vwapj/rpbb-mopop-eng.pdf/\\$?le/rpbb-mopop-eng.pdf](http://www.cipo.gc.ca/eic/site/cipointernet-internetopic.nsf/vwapj/rpbb-mopop-eng.pdf/$?le/rpbb-mopop-eng.pdf)>.

³³⁰ *Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd.*, 1973 CarswellNat 34, 1973 CarswellNat 34F, 10 C.P.R. (2d) 126 (Fed. C.A.) per Jockett, C.J. at 140-141 [C.P.R.], reversed on other grounds 1974 CarswellNat 378, 1974 CarswellNat 378F (S.C.C.), quoted in *Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd.*, 1974 CarswellNat 378, 1974 CarswellNat 378F, 17 C.P.R. (2d) 97 (S.C.C.) per Pigeon J. at 104 [C.P.R.].

In *Johnson & Johnson Inc. v. Boston Scientific Ltd. / Boston Scientifique Ltée*,³³³ although the Court agreed that the word “comprising” meant “includes, but not limited to”, the court stated that if the claimed device is said to include certain elements, it must not require any additional elements in order to function as described and intended in the patent. If the claimed device requires a specific element in order to function, that element must be found within the claim.³³⁴ Justice Layden-Stevenson, while on the Federal Court of Appeal continued such an interpretation in *Purdue Pharma v. Canada (Attorney General)*³³⁵ where she held that the inclusion of an additional element requires some justification and that there must be a basis for it within the confines of the patent.

Similarly, the US Patent and Trademark Office Manual of Patent Examining Procedure (MPEP)³³⁶ Chapter 2111.03 cites US case law supporting the interpretation of “comprising” as being synonymous with “including” or “containing”³³⁷ and being open-ended and not excluding other elements or method steps. In contrast, the term “consisting of” excludes elements or steps not specified in the claim. The term “consisting essentially of” is said to limit the claim to the specified materials or steps and those that do not materially affect the basic and novel characteristics of the invention.

³³¹ *Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd.*, 1974 CarswellNat 378, 1974 CarswellNat 378F, 17 C.P.R. (2d) 97 (S.C.C.) per Pigeon J. at 107 [C.P.R.].

³³² *Schering-Plough Canada Inc. v. Pharmascience Inc.*, 2009 FC 1128, 2009 CarswellNat 5541, 2009 CarswellNat 4628 (F.C.) per Snider J. at para. 46 (“...the word “comprising” is not limiting. That is, what follows the word “comprising” does not necessarily identify everything that is included in the composition.”) and para. 150 (where “[a]ll of the experts accepted that use of the word “comprising” does not mean “limited to.”)

³³³ *Johnson & Johnson Inc. v. Boston Scientific Ltd. / Boston Scientifique Ltée*, 2008 FC 552, 2008 CarswellNat 3312, 2008 CarswellNat 1375, 71 C.P.R. (4th) 123 (F.C.) per Layden-Stevenson J., additional reasons 2008 CarswellNat 2118, 2008 CarswellNat 4560 (F.C.).

³³⁴ *Johnson & Johnson Inc. v. Boston Scientific Ltd. / Boston Scientifique Ltée*, 2008 FC 552, 2008 CarswellNat 3312, 2008 CarswellNat 1375, 71 C.P.R. (4th) 123 (F.C.) per Layden-Stevenson J. at paras. 207-213, additional reasons 2008 CarswellNat 2118, 2008 CarswellNat 4560 (F.C.). If this is adding a utility requirement to claim construction, then it appears to be a departure from the Federal Court of Appeal in *Dableh v. Ontario Hydro*, 1996 CarswellNat 2592, 1996 CarswellNat 735, 68 C.P.R. (3d) 129 (Fed. C.A.) per Strayer J. (Linden and Robertson J.J.A. concurring) at 143 [C.P.R.], leave to appeal refused 1997 CarswellNat 3240 (S.C.C.) and *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 146 [C.P.R.], para. 43, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.), in holding that claim construction should precede considerations of validity (utility being one aspect of validity). The Court appears to have confounded determining the essential elements of the claim (claim construction under *Whirlpool*) versus determining whether the invention as claimed will work (utility).

³³⁵ *Purdue Pharma v. Canada (Attorney General)*, 2011 FCA 132, 2011 CarswellNat 1205, 2011 CarswellNat 2212 (F.C.A.) at para. 22.

³³⁶ Edition, March 2014, available at: <http://www.uspto.gov/web/offices/pac/mpep/index.html>.

³³⁷ Also as found in *Sanofi-Aventis Canada Inc. v. Hospira Healthcare Corp.*, 2009 FC 1077, 2009 CarswellNat 5905, 2009 CarswellNat 3524 (F.C.) per Zinn J. at para. 157.

The phrase “consisting essentially of” is “closed”, being limited to the elements recited in the claim.³³⁸ In *Abbott Laboratories v. Canada (Minister of Health)*³³⁹ the court interpreted a claim relating to an abridged antibacterial composition. The composition was “abridged” to remove a component or component from the prior art composition so as to be more streamlined (presumably to make), less costly and possibly smaller in size and thus better tolerated by patients.³⁴⁰

The prior art was an antibacterial composition that had some thirteen elements plus a colour dye that was recognized as being irrelevant to the issues in the case. Claim 1 claimed an abridged antibacterial composition “consisting essentially of” nine of the components from the prior art antibacterial composition. The claim did not recite four components from the non-abridged prior art composition: pre-gelatinized starch, 200 proof alcohol (ethanol), stearic acid and talc.³⁴¹

Two different definitions of “consisting essentially of” were proffered by the opposing parties:

Having only the recited components	or	Having the recited components and more, but not having at least one of the four components that was in the prior art composition
A plain reading of Claim 1 using the traditionally used meaning of “consisting essentially of” would lead a reader to believe that the claim was limited to the nine components recited.		The term “abridged composition” was explicitly defined in the disclosure as containing clarithromycin (the active ingredient) “... and from which at least one of” the other 12 ³⁴² components of the prior art antibacterial composition “... have been omitted.” ³⁴³

³³⁸ *Abbott Laboratories v. Canada (Minister of Health)*, 2006 CarswellNat 185, 2006 CarswellNat 2419, 46 C.P.R. (4th) 324 (F.C.) per Campbell J., affirmed 2007 CarswellNat 1592, 2007 CarswellNat 426 (F.C.A.).

³³⁹ *Abbott Laboratories v. Canada (Minister of Health)*, 2006 CarswellNat 185, 2006 CarswellNat 2419, 46 C.P.R. (4th) 324 (F.C.) per Campbell J., affirmed 2007 CarswellNat 1592, 2007 CarswellNat 426 (F.C.A.).

³⁴⁰ *Abbott Laboratories v. Canada (Minister of Health)*, 2006 CarswellNat 185, 2006 CarswellNat 2419, 46 C.P.R. (4th) 324 (F.C.) per Campbell J. at 349 [C.P.R.], para. 49, affirmed 2007 CarswellNat 1592, 2007 CarswellNat 426 (F.C.A.).

³⁴¹ *Abbott Laboratories v. Canada (Minister of Health)*, 2006 CarswellNat 185, 2006 CarswellNat 2419, 46 C.P.R. (4th) 324 (F.C.) per Campbell J. at 353 [C.P.R.], para. 56, affirmed 2007 CarswellNat 1592, 2007 CarswellNat 426 (F.C.A.).

³⁴² The removal of the dye was irrelevant.

³⁴³ *Abbott Laboratories v. Canada (Minister of Health)*, 2006 CarswellNat 185, 2006 CarswellNat 2419, 46 C.P.R. (4th) 324 (F.C.) per Campbell J. at 353 [C.P.R.], para. 56, affirmed 2007 CarswellNat 1592, 2007 CarswellNat 426 (F.C.A.).

		Claim 3, claimed “The composition of Claim 1 which is essentially ethanol-free.” This suggested that Claim 1 can include ethanol (If it could not, then Claim 3 would be redundant) and therefore Claim 1 could include more than just the recited components. Thus “consisting essentially of” could not mean “consisting only of”. ³⁴⁴
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The court adopted the meaning set out in the right hand column above, having given the term a definition as used contextually as required by *Whirlpool*.³⁴⁵ The Court expressly rejected American jurisprudence and practice as support for a literal interpretation of the phrase “consisting essentially of” as having no support in Canadian law.³⁴⁶ It is respectfully suggested that this interpretation of “consisting essentially of” should be applied with caution as the case departs from the principle discussed in Chapter 6.7.2.6 above that the Court cannot limit the claims by simply saying that the inventor must have meant to only claim what he had described in the disclosure.³⁴⁷

See however *Biovail Pharmaceuticals Inc. v. Canada (Minister of National Health & Welfare)* (2005), 37 C.P.R. (4th) 487 (F.C.) per Harrington J. at 505—506, paras. 57—60, where the Court held that a claim that claimed very generally (“a solid pharmaceutical carrier which affords a continuous release of active ingredient in a controlled manner”) was limited to the only form that was disclosed (an osmotic pressure system) because that “was what the inventors had in mind” as evidenced by the disclosure. In the alternative, the Court (more properly, it is suggested) held that the claim was invalid for covetous claiming (p. 506, para. 60).

Although not using the transitional phrase “comprising”, the use of a “use” claim is not necessarily limited to the use of that medicine alone. Where a use

³⁴⁴ *Abbott Laboratories v. Canada (Minister of Health)*, 2006 CarswellNat 185, 2006 CarswellNat 2419, 46 C.P.R. (4th) 324 (F.C.) per Campbell J. at 353 [C.P.R.], para. 57, affirmed 2007 CarswellNat 1592, 2007 CarswellNat 426 (F.C.A.).

³⁴⁵ *Abbott Laboratories v. Canada (Minister of Health)*, 2006 CarswellNat 185, 2006 CarswellNat 2419, 46 C.P.R. (4th) 324 (F.C.) per Campbell J. at 353 and 357 [C.P.R.], paras. 56, 58 and 64, affirmed 2007 CarswellNat 1592, 2007 CarswellNat 426 (F.C.A.).

³⁴⁶ *Abbott Laboratories v. Canada (Minister of Health)*, 2006 CarswellNat 185, 2006 CarswellNat 2419, 46 C.P.R. (4th) 324 (F.C.) per Campbell J. at 359 [C.P.R.], para. 68, affirmed 2007 CarswellNat 1592, 2007 CarswellNat 426 (F.C.A.).

³⁴⁷ If the claims are broader than the disclosure and go beyond the invention, the patent will be declared invalid: *Canadian Celanese Ltd. v. B.V.D. Co.*, 1937 CarswellNat 44, [1937] S.C.R. 221 (S.C.C.) (per Davis, J.) at 236-237 [S.C.R.], varied 1939 CarswellNat 80 (Jud. Com. of Privy Coun.); *Amfac Foods Inc. v. Irving Pulp & Paper Ltd.*, 1986 CarswellNat 637, 12 C.P.R. (3d) 193 (Fed. C.A.) per Urie J.

claim referred to the use of finasteride for the preparation of a medicament, the Court construed that such claims were not limited to the use of the named drug alone.³⁴⁸ Similarly, a patent claim including a signal representing changes in drilling pressure does not mean a signal representing only changes in drilling fluid pressure.³⁴⁹

6.7.2.6 Use of the Disclosure and Drawings

In construing the patent claims, regard may be had to the whole of the specification, including the drawings and the disclosure.³⁵⁰

Older cases provided that the claims were to be read in the context of the rest of the patent, “not as if the claim was an isolated sentence having no connection with or reference to what precedes it.”³⁵¹

Some pre-*Free World* cases said that recourse to the disclosure was unnecessary where the words of the claim were plain and unambiguous.³⁵² They said that the specification is not the dictionary by which the scope and effect of the terms of the claim is to be ascertained, in particular where the claim is expressed in simple and direct language or in wide or general terms whose meaning is plain and unequivocal.³⁵³ Such case law was not thought to have survived *Free World*,³⁵⁴ which requires the words of the claims to be construed in the context

³⁴⁸ *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at paras. 103-105. The Court was assisted in that the description referred to the inclusion of other active drugs. See also *Astrazeneca AB v. Apotex Inc.*, 2007 CarswellNat 1857, 2007 CarswellNat 3459, 60 C.P.R. (4th) 199 (F.C.) at paras. 21-25, 32 and 33, additional reasons 2007 CarswellNat 3755, 2007 CarswellNat 2688 (F.C.), per Barnes J. (at paras. 22 and 23).

³⁴⁹ *Varco Canada Ltd. v. Pason Systems Corp.*, 2013 FC 750, 2013 CarswellNat 3356, 2013 CarswellNat 4866 (F.C.) per Phelan J. at para. 172.

³⁵⁰ *Smith Incubator Co. v. Seiling*, 1937 CarswellNat 46, [1937] S.C.R. 251 (S.C.C.); *Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd.*, 1974 CarswellNat 378, 1974 CarswellNat 378F, [1976] 1 S.C.R. 555 (S.C.C.); *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 152-153 [C.P.R.], para. 52, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *Canamould Extrusions Ltd. v. Driangle Inc.*, 2004 CarswellNat 970, 2004 CarswellNat 386, 30 C.P.R. (4th) 129 (F.C.A.) at 143 [C.P.R.], para. 26, affirming 2003 CarswellNat 554, 2003 CarswellNat 1905, 25 C.P.R. (4th) 343 (Fed. T.D.) per Stone J.A.; *McKay v. Weatherford Canada Ltd.*, 2008 FCA 369, 2008 CarswellNat 5666, 2008 CarswellNat 4491 (F.C.A.) per Trudel J.A. at para. 20, leave to appeal refused 2009 CarswellNat 855, 2009 CarswellNat 856 (S.C.C.).

³⁵¹ *Edison-Bell Phonographic Corp. v. Smith* (1894), 11 R.P.C. 389 (Unknown Court) at 396; See also: *Plimpton v. Spiller* (1877), 6 Ch. D. 412 (C.A.) at 426-427; *Smith Incubator Co. v. Seiling*, 1937 CarswellNat 46, [1937] S.C.R. 251 (S.C.C.) per Duff C. at 255 [S.C.R.].

³⁵² *Procter & Gamble Co. v. Calgon Interamerican Corp.*, 1982 CarswellNat 604, 61 C.P.R. (2d) 1 (Fed. C.A.) per Urie J.A. at 11, leave to appeal refused 1982 CarswellNat 761 (S.C.C.). The principle is at odds with the competing principle that the patentee can be her/his own lexicographer, expressly defining terms in the disclosure.

³⁵³ *Minerals Separation North American Corp. v. Noranda Mines Ltd.*, 1947 CarswellNat 8, [1947] Ex. C.R. 306, 12 C.P.R. 99 at 102, 6 Fox Pat. C. 130 (Can. Ex. Ct.) per Thorson P., at 185 [Fox Pat. C.], reversed 1949 CarswellNat 19 (S.C.C.), affirmed 1952 CarswellNat 2 (Jud. Com. of Privy Coun.).

of the rest of the patent, but sometimes live on again, having been repeated by the Federal Court of Appeal in *Schmeiser*³⁵⁵ and *Mylan*.³⁵⁶

The disclosure is read to understand or confirm³⁵⁷ what is meant by a word or phrase in the claims but not to enlarge or contract the scope of the claim as written and thus understood.³⁵⁸ The specification can be reviewed to determine what meaning was reasonably intended by the inventors.³⁵⁹ One should not reach a firm conclusion as to the meaning of words in the claims being construed without having tested one's initial interpretation against the words of the disclosure.³⁶⁰ It is unsafe in many instances to conclude that a term is plain and unambiguous in a claim without a careful review of the specification.³⁶¹

³⁵⁴ Dino P. Clarizio; "Whirlpool and Free World Trust: Claim Construction and the Test for Patent Infringement" (2001), 18 C.I.P.R. 139 at 142. See *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2007 FCA 209, 2007 CarswellNat 1434, 2007 CarswellNat 4252, 60 C.P.R. (4th) 81 (F.C.A.) per Nadon J.A., Linden and Sexton JJ.A. concurring at para. 88, leave to appeal refused 2007 CarswellNat 3850, 2007 CarswellNat 3851 (S.C.C.), where the Court described as incorrect the approach of an expert who based his opinion on the basis that "[I]f a term is used in a clear and unambiguous manner in the claim, then the term should be defined based solely on its usage in the claim itself" and that "if the definition of a term cannot be clearly and unambiguously determined from a claim, then a patent disclosure should be consulted to ascertain the definition of the term".

The contrary position was stated, without authority cited, in *Weatherford Canada Ltd. v. Corlac Inc.*, 2010 FC 602, 2010 CarswellNat 3622, 2010 CarswellNat 1651 (F.C.) per Phelan J. at para. 119, reversed in part 2011 CarswellNat 2835, 2011 CarswellNat 3714 (F.C.A.), leave to appeal refused 2012 CarswellNat 846, 2012 CarswellNat 847 (S.C.C.): "Regard to the disclosure portion of the patent's specification is unnecessary where the terms used in the claim are plain and unambiguous but may be used where there is ambiguity." See also *Janssen-Ortho Inc. v. Canada (Minister of Health)*, 2010 FC 42, 2010 CarswellNat 1445, 2010 CarswellNat 199 (F.C.) per Zinn J. at para. 115 (without citing authorities or distinguishing *Free World*), additional reasons 2010 CarswellNat 2356, 2010 CarswellNat 442 (F.C.).

³⁵⁵ *Monsanto Canada Inc. v. Schmeiser*, 2002 FCA 309, 2002 CarswellNat 2199, 2002 CarswellNat 3496 (Fed. C.A.) at para. 37, additional reasons 2002 CarswellNat 3280, 2002 CarswellNat 3871 (Fed. C.A.), reversed in part 2004 SCC 34, 2004 CarswellNat 1391, 2004 CarswellNat 1392 (S.C.C.); *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J. at para. 74.

³⁵⁶ *Mylan Pharmaceuticals ULC v. Eli Lilly Canada Inc.*, 2016 FCA 119, 2016 CarswellNat 9923, 2016 CarswellNat 1168, [2017] 2 F.C.R. 280 (F.C.A.) per Rennie J.A., Dawson & Trudel JJ.A. concurring, at para. 39.

³⁵⁷ *Janssen-Ortho Inc. v. Canada (Minister of Health)*, 2010 FC 42, 2010 CarswellNat 1445, 2010 CarswellNat 199 (F.C.) per Zinn J. at para. 115, additional reasons 2010 CarswellNat 2356, 2010 CarswellNat 442 (F.C.).

³⁵⁸ *Free World Trust c. E' lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 192 [C.P.R.], para. 52. *Biovail Pharmaceuticals Inc. v. Canada (Minister of National Health & Welfare)*, 2005 CarswellNat 65, 2005 CarswellNat 1993, 37 C.P.R. (4th) 487 (F.C.) per Harrington J. at para. 15.

³⁵⁹ *Apotex Inc. v. Merck & Co.*, 2010 FC 1265, 2010 CarswellNat 5009 (F.C.) per Snider J. at para. 102, affirmed 2011 CarswellNat 6152, 2011 CarswellNat 7182 (F.C.A.), leave to appeal refused 2012 CarswellNat 2442, 2012 CarswellNat 2443 (S.C.C.).

³⁶⁰ *Janssen-Ortho Inc. v. Canada (Minister of Health)*, 2010 FC 42, 2010 CarswellNat 1445, 2010 CarswellNat 199 (F.C.) per Zinn J. at para. 119, additional reasons 2010 CarswellNat 2356, 2010 CarswellNat 442 (F.C.); *MediaTube Corp. v. Bell Canada*, 2017 FC 6, 2017 CarswellNat 18, 2017 CarswellNat 3277 (F.C.) per Locke J. at para. 37, affirmed 2019 CarswellNat 2404, 2019 CarswellNat 14152 (F.C.A.), leave to appeal refused 2020 CarswellNat 826, 2020 CarswellNat 827 (S.C.C.).

³⁶¹ *Leo Pharma Inc. v. Teva Canada Ltd.*, 2015 FC 1237, 2015 CarswellNat 7731, 2015 CarswellNat 7732 (F.C.) per Locke J. at para. 83, additional reasons 2016 CarswellNat 707, 2016 CarswellNat

When that is done, if the disclosure suggests another interpretation of the terms used in the claims, then to resort to the meanings given in the disclosure is proper, subject to the proviso that the invention that is protected is what is expressed in the claims which cannot be added to by anything in the disclosure that has not found its way into the claims as drafted.³⁶²

The claims take precedence over the disclosure.³⁶³ A patentee cannot use general language in the claim and subsequently restrict or expand it to qualify what is expressed in the claim by borrowing from other parts of the patent.³⁶⁴

It is a basic principle that the description of the preferred embodiments is not meant to include all the possible embodiments of the invention claimed.³⁶⁵ The ambit of the monopoly claimed cannot be diminished merely because in the disclosure, the patentee has described the invention in more restricted terms than in the claim itself.³⁶⁶ The claims should not be limited to the specific examples or embodiments described in the patent,³⁶⁷ particularly where the

708 (F.C.), affirmed 2017 CarswellNat 779, 2017 CarswellNat 10635 (F.C.A.), affirmed 2017 CarswellNat 778, 2017 CarswellNat 10634 (F.C.A.), citing *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 152-153 [C.P.R.], para. 52, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.), quoting from W.L. Hayhurst, “The Art of Claiming and Reading a Claim”, in G.F. Henderson, ed., *Patent Law of Canada* (Toronto: Carswell, 1994) at p. 190. See also *MediaTube Corp. v. Bell Canada*, 2017 FC 6, 2017 CarswellNat 18, 2017 CarswellNat 3277 (F.C.) per Locke J. at para. 36, affirmed 2019 CarswellNat 2404, 2019 CarswellNat 14152 (F.C.A.), leave to appeal refused 2020 CarswellNat 826, 2020 CarswellNat 827 (S.C.C.).

³⁶² *Janssen-Ortho Inc. v. Canada (Minister of Health)*, 2010 FC 42, 2010 CarswellNat 1445, 2010 CarswellNat 199 (F.C.) per Zinn J. at paras. 119-120, additional reasons 2010 CarswellNat 2356, 2010 CarswellNat 442 (F.C.). Expressed in more flowery language:

The purpose of claim construction, at the end of the exercise, is to ascertain what exactly is contained within the garden bounded by the fences set out by the inventor. To wander afield, outside the garden’s fences, picking sunflowers and petunias, and then say the garden is a flower garden, when all that one can see when standing within the garden’s fences are red zinnias, illustrates why one must first have some view of the scope of the garden from the inside before one traipses through the adjoining fields seeking clarification or confirmation of the nature of the garden. Without such an initial view, one may inappropriately borrow the flora outside to define that which grows inside the fence. In short, one should not take an unescorted and unchaperoned romp through the disclosure; one must have a guide or compass which one obtains from first examining all of the claims of the patent.

³⁶³ *Biovail Pharmaceuticals Inc. v. Canada (Minister of National Health & Welfare)*, 2005 CarswellNat 65, 2005 CarswellNat 1993, 37 C.P.R. (4th) 487 (F.C.) per Harrington J. “It cannot be emphasized too strenuously that the claims are the only definitive statement of the invention represented by the patent. The patentee is legally bound by and limited to the recitations contained in the claims of his patent”, Mills, J.G. et al., *Patent Law Fundamentals*, Thomson-West, page 14-5.

³⁶⁴ *Ingersoll Sargeant Drill Co. v. Consolidated Pneumatic Tool Co.* (1907), 25 R.P.C. 61 (U.K. H.L.) per Sir Mark Romer at 83; *Electrical & Musical Industries Ltd. v. Lissen Ltd.* (1938), 56 R.P.C. 23 (U.K. H.L.) (per Lord Russell of Killowen) at 41.

³⁶⁵ *Bombardier Recreational Products Inc. v. Arctic Cat, Inc.*, 2018 FCA 172, 2018 CarswellNat 5338, 2018 CarswellNat 5339 (F.C.A.) per Gauthier J.A., Pelletier & de Montigny J.A., concurring at para. 54, leave to appeal refused 2019 CarswellNat 1959, 2019 CarswellNat 1960 (S.C.C.).

³⁶⁶ *British-Hartford-Fairmont Syndicate Ltd. v. Jackson Brothers (Knottingley) Ltd.* (1932), 49 R.P.C. 495 (C.A.), per Romer J. at 556.

patent describes a drawing as representing a “preferred embodiment”, as it does not necessarily exhaust the invention.³⁶⁸ The figures can be only “exemplary”, disclosing one embodiment, but the claims can encompass more than the embodiment disclosed.³⁶⁹ The Court cannot limit the claims by simply saying that the inventor must have meant to only claim what he had described in the disclosure.³⁷⁰

Most patents contain language emphasizing that the examples are merely illustrative and should not limit the scope of the invention and the Courts have referred to such language so as not to do so.³⁷¹

See however:

- *Biovail Pharmaceuticals Inc. v. Canada (Minister of National Health & Welfare)*³⁷² where the Court held that a claim that claimed very generally (“a solid pharmaceutical carrier which affords a continuous release of active ingredient in a controlled manner”) was limited to the only form that was disclosed (an osmotic pressure system)

³⁶⁷ *Lovell Manufacturing Co. v. Beatty Brothers Ltd.*, 1962 CarswellNat 22, 41 C.P.R. 18 (Can. Ex. Ct.) per Thomson P. at 134 [C.P.R.]; *Dableh v. Ontario Hydro*, 1996 CarswellNat 2592, 1996 CarswellNat 735, 68 C.P.R. (3d) 129 (Fed. C.A.) per Strayer J. (Linden and Robertson J.J.A. concurring) at 144-147 [C.P.R.], leave to appeal refused 1997 CarswellNat 3240 (S.C.C.); *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at para. 54, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *Weatherford Canada Ltd. v. Corlac Inc.*, 2010 FC 602, 2010 CarswellNat 3622, 2010 CarswellNat 1651 (F.C.) per Phelan J. at para. 119, reversed in part 2011 CarswellNat 2835, 2011 CarswellNat 3714 (F.C.A.), leave to appeal refused 2012 CarswellNat 846, 2012 CarswellNat 847 (S.C.C.). See *Pfizer Canada Inc. v. Pharmascience Inc.*, 2013 FC 120, 2013 CarswellNat 177, 2013 CarswellNat 1248, 111 C.P.R. (4th) 88 (F.C.) per Hughes J. at para. 82, where the court interpreted the general term “Pain” to include all of the pains listed in the disclosure and all of the pains listed in the claims. The term “... but not limited to” in the disclosure was “limited to those pains that, as of [the publication date], would be reasonably related to the named pains.”; *Bombardier Recreational Products Inc. v. Arctic Cat, Inc.*, 2018 FCA 172, 2018 CarswellNat 5338, 2018 CarswellNat 5339 (F.C.A.) per Gauthier J.A., Pelletier & de Montigny J.J.A., concurring at paras. 40-50, leave to appeal refused 2019 CarswellNat 1959, 2019 CarswellNat 1960 (S.C.C.).

³⁶⁸ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 154 [C.P.R.], para. 54, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

³⁶⁹ *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at para. 57.

³⁷⁰ If the claims are broader than the disclosure and go beyond the invention, the patent will be declared invalid: *Canadian Celanese Ltd. v. B.V.D. Co.*, 1937 CarswellNat 44, [1937] S.C.R. 221 (S.C.C.) (per Davis J.) at 236-237 [S.C.R.], varied 1939 CarswellNat 80 (Jud. Com. of Privy Coun.); *Amfac Foods Inc. v. Irving Pulp & Paper Ltd.*, 1986 CarswellNat 637, 12 C.P.R. (3d) 193 (Fed. C.A.) per Urie J.

³⁷¹ *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2007 FC 91, 2007 CarswellNat 146, 2007 CarswellNat 3685, 56 C.P.R. (4th) 96 (F.C.) at para. 52, reversed 2008 CarswellNat 2714, 2008 CarswellNat 788 (F.C.A.).

³⁷² 2005 CarswellNat 65, 2005 CarswellNat 1993, 37 C.P.R. (4th) 487 (F.C.) per Harrington J. at 505-506 [C.P.R.], at paras. 57-60.

because that “was what the inventors had in mind” as evidenced by the disclosure. In the alternative, the Court (more properly, it is suggested) held that the claim was invalid for covetous claiming.³⁷³

- Similarly, in *ViiV Healthcare Company et al. v. Gilead Sciences Canada, Inc.*³⁷⁴, the claim claimed an “optionally substituted heterocycle” which was expressly defined in the description to include a non-aromatic ring that could be saturated or unsaturated.³⁷⁵ The expert witnesses agreed that if it was unsaturated, it could contain an additional ring.³⁷⁶ There were three kinds of possible rings known to the POSITA: spiro, fused, and bridged.³⁷⁷ The definitions did not specify what kind of additional ring it would be. The patent said the additional rings were more preferably fused or spiro. No examples of bridged additional ring were provided in the patent.³⁷⁸ Although there was no disagreement among the experts that the term “unsaturated non-aromatic ring” included an additional ring, the Court found the word “heterocycle” in the claim to be “decidedly unclear”, permitting resort to the disclosure. The Court then limited the type of additional ring to those of the more preferred embodiments: spiro and fused rings.³⁷⁹ In contrast, Justice Manson held that claim 1 was not limited to 5- to 7-membered rings only (whereas Claims 11 and 16 did so limit Ring A) because the definitions described them as being “preferably” that size.³⁸⁰

³⁷³ *Biovail Pharmaceuticals Inc. v. Canada (Minister of National Health & Welfare)*, 2005 CarswellNat 65, 2005 CarswellNat 1993, 37 C.P.R. (4th) 487 (F.C.) per Harrington J. at 506 [C.P.R.], para. 60.

³⁷⁴ *ViiV Healthcare Company v. Gilead Sciences Canada, Inc.*, 2020 FC 486, 2020 CarswellNat 1166, 2020 CarswellNat 2386 (F.C.) per Manson J., affirmed 2021 FCA 122, 2021 CarswellNat 2094 (F.C.A.) per Stratas J.A., Laskin & Mactavish JJ.A. concurring.

³⁷⁵ *ViiV Healthcare Company v. Gilead Sciences Canada, Inc.*, 2020 FC 486, 2020 CarswellNat 1166, 2020 CarswellNat 2386 (F.C.) per Manson J. at para. 106, affirmed 2021 FCA 122, 2021 CarswellNat 2094 (F.C.A.) per Stratas J.A., Laskin & Mactavish JJ.A. concurring.

³⁷⁶ *ViiV Healthcare Company v. Gilead Sciences Canada, Inc.*, 2020 FC 486, 2020 CarswellNat 1166, 2020 CarswellNat 2386 (F.C.) per Manson J. at para. 109, affirmed 2021 FCA 122, 2021 CarswellNat 2094 (F.C.A.) per Stratas J.A., Laskin & Mactavish JJ.A. concurring.

³⁷⁷ *ViiV Healthcare Company v. Gilead Sciences Canada, Inc.*, 2020 FC 486, 2020 CarswellNat 1166, 2020 CarswellNat 2386 (F.C.) per Manson J. at paras. 83, affirmed 2021 FCA 122, 2021 CarswellNat 2094 (F.C.A.) per Stratas J.A., Laskin & Mactavish JJ.A. concurring.

³⁷⁸ *ViiV Healthcare Company v. Gilead Sciences Canada, Inc.*, 2020 FC 486, 2020 CarswellNat 1166, 2020 CarswellNat 2386 (F.C.) per Manson J. at paras. 49 & 123, affirmed 2021 FCA 122, 2021 CarswellNat 2094 (F.C.A.) per Stratas J.A., Laskin & Mactavish JJ.A. concurring.

³⁷⁹ *ViiV Healthcare Company v. Gilead Sciences Canada, Inc.*, 2020 FC 486, 2020 CarswellNat 1166, 2020 CarswellNat 2386 (F.C.) per Manson J. at para. 134, affirmed 2021 FCA 122, 2021 CarswellNat 2094 (F.C.A.) per Stratas J.A., Laskin & Mactavish JJ.A. concurring. In contrast, at para. 114 the Court held that Ring A in Claim 1 was not limited to 5- to 7-membered rings because the court saw no such limitation in Claim 1: the definitions of heterocycle and heteroring said they were “preferably 5- to 7- membered rings, but are not limited to these sizes.”

³⁸⁰ *ViiV Healthcare Company v. Gilead Sciences Canada, Inc.*, 2020 FC 486, 2020 CarswellNat 1166,

The specifications and drawings should not be used to vary or enlarge the claims except in so far as the vocabulary, as supplied by the specification, reasonably and fairly provides for such a variation or enlargement.³⁸¹ For example, in *Nekoosa Packaging Corp. v. AMCA International Ltd.*,³⁸² Justice Cullen construed a tree processor as “processing” into “wood chips” as that was what was so closely enunciated in the description:

The present invention is concerned with production of wood chips suitable for use as raw material for pulp and paper mills “...That is the ‘process means’ and ‘processing’, namely converting a tree to chips. The description does not read, ‘production of chips and other products suitable, etc.’” ... Pulpwood has several different meanings and so does raw material for a pulp mill, but not in the context in which they are used in the patent and context is the guide.³⁸³

Similarly, in *Bridgeview Manufacturing Inc. v. 931409 Alberta Ltd.*,³⁸⁴ an improvement to a hay bale processor was claimed. There were only three kinds of bale processors.³⁸⁵ The patent repeatedly referred to the processor having “manipulation rollers” which were a characteristic only of the roller processor type.³⁸⁶ The “Background of the Invention” section of the patent referred to a roller processor as a “typical machine” and that the invention of the patent was an improvement of that type of manipulator.³⁸⁷ Considering the entire patent, the court concluded that it was a manipulation roller only.³⁸⁸

2020 CarswellNat 2386 (F.C.) per Manson J. at para. 114, affirmed 2021 CarswellNat 2094 (F.C.A.).

³⁸¹ *Kramer v. Lawn Furniture Inc.*, 1974 CarswellNat 464, 13 C.P.R. (2d) 231 (Fed. T.D.) per Addy J. at 237 [C.P.R.], affirmed 1979 CarswellNat 799 (Fed. T.D.), quoted in *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2005 CarswellNat 4401, 2005 CarswellNat 7441, 46 C.P.R. (4th) 244 (F.C.) per Hughes J. at para. 19, affirmed 2007 CarswellNat 6, 2007 CarswellNat 1052 (F.C.A.).

³⁸² *Nekoosa Packaging Corp. v. AMCA International Ltd.*, 1989 CarswellNat 556, 27 C.P.R. (3d) 153 (Fed. T.D.) per Cullen J., additional reasons 1990 CarswellNat 1103 (Fed. T.D.), affirmed 1994 CarswellNat 2980 (Fed. C.A.).

³⁸³ *Nekoosa Packaging Corp. v. AMCA International Ltd.*, 1989 CarswellNat 556, 27 C.P.R. (3d) 153 (Fed. T.D.) per Cullen J. at 168-169 [C.P.R.], additional reasons 1990 CarswellNat 1103 (Fed. T.D.), affirmed 1994 CarswellNat 2980 (Fed. C.A.).

³⁸⁴ *Bridgeview Manufacturing Inc. v. 931409 Alberta Ltd.*, 2009 FC 50, 2009 CarswellNat 712, 2009 CarswellNat 155 (F.C.) per Campbell J., reversed in part on other grounds 2010 FCA 188, 2010 CarswellNat 4009, 2010 CarswellNat 2314 (F.C.A.) per Sharlow J.A., Nadon & Trudel JJ.A. concurring, leave to appeal refused 2011 CarswellNat 1109, 2011 CarswellNat 1110 (S.C.C.).

³⁸⁵ *Bridgeview Manufacturing Inc. v. 931409 Alberta Ltd.*, 2009 FC 50, 2009 CarswellNat 712, 2009 CarswellNat 155 (F.C.) per Campbell J., at para. 26, reversed in part on other grounds 2010 FCA 188, 2010 CarswellNat 4009, 2010 CarswellNat 2314 (F.C.A.) per Sharlow J.A., Nadon & Trudel JJ.A. concurring, leave to appeal refused 2011 CarswellNat 1109, 2011 CarswellNat 1110 (S.C.C.).

³⁸⁶ *Bridgeview Manufacturing Inc. v. 931409 Alberta Ltd.*, 2009 FC 50, 2009 CarswellNat 712, 2009 CarswellNat 155 (F.C.) per Campbell J., at para. 26, reversed in part on other grounds 2010 FCA 188, 2010 CarswellNat 4009, 2010 CarswellNat 2314 (F.C.A.) per Sharlow J.A., Nadon & Trudel JJ.A. concurring, leave to appeal refused 2011 CarswellNat 1109, 2011 CarswellNat 1110 (S.C.C.).

³⁸⁷ *Bridgeview Manufacturing Inc. v. 931409 Alberta Ltd.*, 2009 FC 50, 2009 CarswellNat 712, 2009 CarswellNat 155 (F.C.) at paras. 16-17, 25-27, 29 and 31, reversed in part on other grounds 2010 FCA 188, 2010 CarswellNat 4009, 2010 CarswellNat 2314 (F.C.A.) per Sharlow J.A., Nadon &

Similarly, in *Regents of the University of California v. I-MED Pharma Inc.*,³⁸⁹ the claim term “sample receiving chip” was interpreted to have two elements: a substrate and

In a case with unusual claims, the claims specifically mentioned a figure of the patent, claiming that a composition “... has a plasma concentration/time curve which is substantially the same as that of Figure 7”,³⁹⁰ the court held that construction required a subjective (graphical, qualitative) consideration of the key characteristics of Figure 7 in the context of the patent.³⁹¹ The patent described Figures 7 & 8 as being similar to Figure 1 which hinted that the common characteristics of Figures 1 and 7 were important, as were the differences between Figure 7 and 8 (as they were not described as being similar).³⁹²

Where there were two way of measuring “optical purity” and the disclosure only referred to one way (in terms of enantiomeric excess) and the claims did not specify which way to measure optical purity, the Court held that a skilled reader would recognize that the units in the claim would be the same as those used in the disclosure.³⁹³

Even if a disclosure says that a claimed drug can be used with other drugs, implicitly or explicitly, the Court should not import such a limitation into the claims. Unless the use claimed specifically employs such words, as “alone” or “not in conjunction with other compounds”, it would be improper to read such a limitation into the claim.³⁹⁴

Trudel JJ.A. concurring at paras. 13, 29 and 32, leave to appeal refused 2011 CarswellNat 1109, 2011 CarswellNat 1110 (S.C.C.).

³⁸⁸ Although Justice Campbell said he gave the term an “expanded interpretation” 2009 FC 50, 2009 CarswellNat 712, 2009 CarswellNat 155 (F.C.) at para. 31, reversed in part on other grounds 2010 CarswellNat 4009, 2010 CarswellNat 2314 (F.C.A.), leave to appeal refused 2011 CarswellNat 1109, 2011 CarswellNat 1110 (S.C.C.)], he actually read it narrowly, as confirmed by the Federal Court of Appeal [2010 FCA 188, 2010 CarswellNat 4009, 2010 CarswellNat 2314 (F.C.A.) at para. 24, leave to appeal refused 2011 CarswellNat 1109, 2011 CarswellNat 1110 (S.C.C.).

³⁸⁹ 2018 FC 164, 2018 CarswellNat 760, 2018 CarswellNat 1890 (F.C.) per Manson J., affirmed 2019 CarswellNat 2428, 2019 CarswellNat 14703 (F.C.A.)

³⁹⁰ *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J. at para. 124.

³⁹¹ *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J. at para. 129.

³⁹² *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J. at paras. 127 & 145.

³⁹³ *Astrazeneca Canada Inc. v. Apotex Inc.*, 2010 FC 714, 2010 CarswellNat 2717 (F.C.) per Hughes J. at para. 70, additional reasons 2011 CarswellNat 2772, 2011 CarswellNat 3602 (F.C.).

³⁹⁴ *Abbott Laboratories Ltd. v. Canada (Minister of Health)*, 2006 FC 1411, 2006 CarswellNat 5153, 2006 CarswellNat 3898, 304 F.T.R. 104 (Eng.) (F.C.) at para. 26, per von Finckenstein J., affirmed 2007 FCA 251, 2007 CarswellNat 1872, 2007 CarswellNat 3844, 367 N.R. 120 (F.C.A.) at para. 16; *Pfizer Canada Inc. v. Ratiopharm Inc.*, 2010 FC 612, 2010 CarswellNat 3366, 2010 CarswellNat 1620 (F.C.) per Kelen J. at para. 75.

The invalidity of a claim cannot be avoided by attempting to narrow the scope of a claim based on language used in the disclosure. To do so would be like throwing scientific dust in the eyes of the Court.³⁹⁵ The reason for this is that patent drafters might make the claim very wide upon one interpretation, in order to prevent as many people as possible from competing with the patentee's business, and then try to rely on carefully prepared sentences within the disclosure to limit the claim so as to be valid.³⁹⁶ If the disclosure states in the "Summary of the Invention" section that there are certain "objects" to the invention, one cannot read those objects into a claim so as to limit the claim.³⁹⁷

Free World also provides that:

... the ingenuity of the patent lies not in the identification of a desirable result but in teaching one particular means to achieve it. The claims cannot be stretched to monopolize anything that achieves the desirable result. It is not legitimate, for example, to obtain a patent for a particular method that grows hair on bald men and thereafter claim anything that grows hair on bald men infringes.³⁹⁸

This principle reflects that one cannot properly claim all solutions to a problem, but should not be interpreted to mean that one cannot claim more generally than the specific embodiment described in the patent.

6.7.2.7 Use of the Variants Clause

Patent disclosures often end with a so-called variants clause, an example of which is provided below:

From the above detailed description of the invention, the operation and construction of same should be apparent. While there are herein shown and described preferred embodiments of the invention, it is nevertheless understood that various changes may be made with respect thereto without departing from the principle and scope of the invention as measured by the claims appended hereto.

Such clauses have been recognized by the courts so as not to limit the scope of the claims to the preferred embodiments illustrated in the figures.³⁹⁹ The

³⁹⁵ *Electrical & Musical Industries Ltd. v. Lissen Ltd.* (1938), 56 R.P.C. 23 (U.K. H.L.) (per Lord Russell of Killowen) at 43.

³⁹⁶ *Natural Colour Kinematograph Co. v. Bioschemes Ltd.* (1915), 32 R.P.C. 256 (U.K. H.L.) at 266; *Minerals Separation North American Corp. v. Noranda Mines Ltd.*, 1949 CarswellNat 19, 12 C.P.R. 99 (S.C.C.) per Rand J., affirmed 1952 CarswellNat 2 (Jud. Com. of Privy Coun.); *Mullard Radio Valve Co. v. Philco Radio & T.V. Corp. of Great Britain* (1936), 53 R.P.C. 323 (U.K. H.L.) per Lord MacMillan at 352.

³⁹⁷ *Molins v. Industrial Machinery Co.* (1937), 55 R.P.C. 31 (C.A.) per Greene, M.R. at 39; *Amfac Foods Inc. v. Irving Pulp & Paper Ltd.*, 1986 CarswellNat 637, 12 C.P.R. (3d) 193 (Fed. C.A.) per Urie J. at 205 [C.P.R.].

³⁹⁸ *Free World Trust c. Electro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 184 [C.P.R.], para. 32.

wording of such clause is intended to permit minor variations but will not save from invalidity a claim missing an essential element.⁴⁰⁰ The variation must still come within the meaning of the claims.⁴⁰¹

6.7.2.8 *Dependant Claims, Claim Differentiation and Claim Consistency*

Justice Zinn has proposed that when one looks beyond the language of the claims at issue, one ought first look at the dependant claims as an aid to interpreting the independent claims, before one resorts to the disclosure.⁴⁰²

The concept of “claim differentiation” presumes that patent claims are drafted so as not to be redundant⁴⁰³ and that different claims have different scopes. If it is at all possible, each claim must be construed independently of the others and be given an effective and distinct meaning.⁴⁰⁴ The starting assumption must be that claims are not redundant, and only if a purposive analysis shows that claims are in effect duplicated can a redundant construction be adopted.⁴⁰⁵

³⁹⁹ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at para. 54, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *Bombardier Recreational Products Inc. v. Arctic Cat, Inc.*, 2018 FCA 172, 2018 CarswellNat 5338, 2018 CarswellNat 5339 (F.C.A.) per Gauthier J.A., Pelletier & de Montigny JJ.A., concurring at paras. 43 & 55, leave to appeal refused 2019 CarswellNat 1959, 2019 CarswellNat 1960 (S.C.C.).

⁴⁰⁰ *Amfac Foods Inc. v. Irving Pulp & Paper Ltd.*, 1986 CarswellNat 637, 12 C.P.R. (3d) 193 (Fed. C.A.) at 205 [C.P.R.].

⁴⁰¹ *Improver Corp. v. Remington Consumer Products Ltd.* (1989), [1990] F.S.R. 181 (Eng. Patents Ct.) at 197.

⁴⁰² *Janssen-Ortho Inc. v. Canada (Minister of Health)*, 2010 FC 42, 2010 CarswellNat 1445, 2010 CarswellNat 199 (F.C.) per Zinn J. at para. 116, additional reasons 2010 CarswellNat 2356, 2010 CarswellNat 442 (F.C.).

⁴⁰³ *Halford v. Seed Hawk Inc.*, 2004 FC 88, 2004 CarswellNat 342, 2004 CarswellNat 7412 (F.C.) per Pelletier J. at para. 98, reconsideration / rehearing refused 2004 CarswellNat 882, 2004 CarswellNat 4795 (F.C.), affirmed 2006 CarswellNat 2397, 2006 CarswellNat 4150 (F.C.A.); *Abbott Laboratories v. Canada (Minister of Health)*, 2007 FCA 83, 2007 CarswellNat 1592, 2007 CarswellNat 426 (F.C.A.) per Noe J.A., Nadon & Malone JJ.A. concurring at para. 33; See also *Bridgeview Manufacturing Inc. v. 931409 Alberta Ltd.*, 2010 FCA 188, 2010 CarswellNat 4009, 2010 CarswellNat 2314 (F.C.A.) per Sharlow J.A., Nadon & Trudel JJ.A. concurring at paras. 27, 33, leave to appeal refused 2011 CarswellNat 1109, 2011 CarswellNat 1110 (S.C.C.).

⁴⁰⁴ *The Canadian Law and Practice Relating to Letters Patent for Inventions* by Harold G. Fox (Fox), quoted by Justice Snider in *Hoffmann-La Roche Ltd. v. Mayne Pharma (Canada) Inc.*, 2005 FC 814, 2005 CarswellNat 5176, 2005 CarswellNat 1941, 41 C.P.R. (4th) 505 (F.C.) (Hoffmann (2005)), at para. 43; *Eli Lilly & Co. v. Apotex Inc.*, 2009 FC 991, 2009 CarswellNat 3042, 2009 CarswellNat 6607 (F.C.) per Gauthier J. at paras. 90 and 122, affirmed 2010 CarswellNat 5866, 2010 CarswellNat 3443 (F.C.A.), leave to appeal refused 2011 CarswellNat 1368, 2011 CarswellNat 1369 (S.C.C.), additional reasons 2011 CarswellNat 4151 (F.C.).

⁴⁰⁵ *The Canadian Law and Practice Relating to Letters Patent for Inventions* by Harold G. Fox (Fox), quoted by Justice Snider in *Hoffmann-La Roche Ltd. v. Mayne Pharma (Canada) Inc.*, 2005 FC 814, 2005 CarswellNat 5176, 2005 CarswellNat 1941, 41 C.P.R. (4th) 505 (F.C.) (Hoffmann (2005)), at para. 43; *Eli Lilly & Co. v. Apotex Inc.*, 2009 FC 991, 2009 CarswellNat 3042, 2009 CarswellNat 6607 (F.C.) per Gauthier J. at paras. 90 and 122, affirmed 2010 CarswellNat 5866,

Patents usually have an independent claim and one or more dependent claims. Patent Rule 87(1) provides that claims do not have to be re-written; they can incorporate subject matter from an earlier claim by reference.⁴⁰⁶ Accordingly, any dependent claim shall be understood as including all the limitations contained in the claim to which it refers or, if the dependent claim refers to more than one other claim, all the limitations contained in the particular claims in relation to which it is considered.⁴⁰⁷

A dependent claim usually narrows the scope of the claim from which it depends.⁴⁰⁸ Thus a dependent claim, assuming claim differentiation, encompasses a subset of the independent claim. As discussed in Chapter 6.3.1.1 above, these subsets can also be analogized as nested fences.⁴⁰⁹

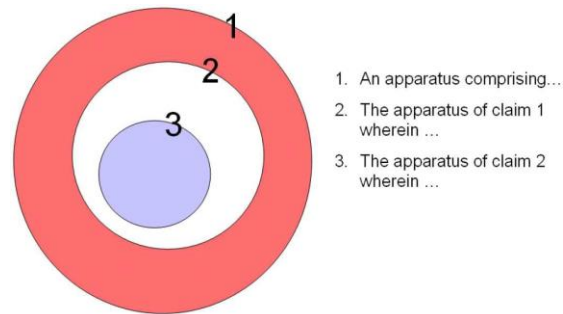


Figure 5 Nested, Dependent Claims

The independent “parent” claim in Figure 5 above is represented by circle (or fence) #1; the dependent claims are represented by inner circles #2 and #3. Claim #2 is dependent from claim #1; claim #3 is dependent from claim #2.⁴¹⁰ As a result:

2010 CarswellNat 3443 (F.C.A.), leave to appeal refused 2011 CarswellNat 1368, 2011 CarswellNat 1369 (S.C.C.), additional reasons 2011 CarswellNat 4151 (F.C.).

⁴⁰⁶ *Abbott Laboratories v. Canada (Minister of Health)*, 2007 FCA 83, 2007 CarswellNat 1592, 2007 CarswellNat 426, 58 C.P.R. (4th) 97 (F.C.A.) per Noe J.J.A., Nadon and Malone J.J.A. concurring at para. 33.

⁴⁰⁷ Patent Rule 87(1) provides; “Subject to subsection (2), any claim that includes all the features of one or more other claims (in this section referred to as a “dependent claim”) shall refer by number to the other claim or claims and shall state the additional features claimed.”

⁴⁰⁸ *Bridgeview Manufacturing Inc. v. 931409 Alberta Ltd.*, 2009 FC 50, 2009 CarswellNat 712, 2009 CarswellNat 155 (F.C.) per Campbell J. at para. 27, reversed in part on other grounds 2010 FCA 188, 2010 CarswellNat 4009, 2010 CarswellNat 2314 (F.C.A.) per Sharlow J.A., Nadon & Trudel J.J.A. concurring at para. 33, leave to appeal refused 2011 CarswellNat 1109, 2011 CarswellNat 1110 (S.C.C.) citing *Abbott Laboratories v. Canada (Minister of Health)*, 2007 FCA 83, 2007 CarswellNat 1592, 2007 CarswellNat 426 (F.C.A.) at para. 33 and *Nekoosa Packaging Corp. v. AMCA International Ltd.*, 1994 CarswellNat 2980, 172 N.R. 387 (Fed. C.A.) at para. 37.

⁴⁰⁹ *Free World Trust v. Electro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 178 [C.P.R.], para. 14.

1. The apparatuses found in circle #2 have all the characteristics of those in circle #1. Likewise, the apparatuses found in circle #3 have all the characteristics of the apparatuses within circles #1 and #2.⁴¹¹ Any dependent claim includes all the limitations of its parent claim(s).⁴¹²
2. The apparatuses found in Circle #1 (representing the parent claim) include what is found in Circles #2 and #3.⁴¹³ A parent claim must be read to include what is in its dependent claim.⁴¹⁴ The parent claim cannot be read so as to exclude what is in its dependent claims. In other words, the parent claim cannot be given a construction which is inconsistent with its dependent claims.⁴¹⁵
3. Assuming Claims #1 and #2 are not redundant, Circle #1 (the parent claim) is not limited to the apparatuses found in Circle #2 (the dependent claim).⁴¹⁶ Because the parent claim is understood to be

⁴¹⁰ For example, with reference to Figure 5 illustrating “nested” claims, if a patent could be granted with a claim 1 claiming “all lawyers in a courtroom”, dependant claim 2 could be for “the lawyers of claim 1 wherein said lawyers are right-handed” and claim 3 could be for “the lawyers of claim 2 wherein said lawyers wear glasses.”

⁴¹¹ In the example given, Claim 3 would include lawyers in the courtroom who are right-handed and wear glasses. Claim 2 would include lawyers in the courtroom who wear glasses (those of Claim 3) as well as those that do not (those in the white region). Claim 1 would include right-handed lawyers (those of Claim 2) and those that are not right-handed (those in the red region).

⁴¹² *Halford v. Seed Hawk Inc.*, 2004 FC 88, 2004 CarswellNat 342, 2004 CarswellNat 7412 (F.C.) per Pelletier J. at paras. 91 and 95, reconsideration / rehearing refused 2004 CarswellNat 882, 2004 CarswellNat 4795 (F.C.), affirmed 2006 CarswellNat 2397, 2006 CarswellNat 4150 (F.C.A.) and *Bridgeview Manufacturing Inc. v. 931409 Alberta Ltd.*, 2010 FCA 188, 2010 CarswellNat 4009, 2010 CarswellNat 2314 (F.C.A.) per Sharlow J.A., Nadon & Trudel JJ.A. concurring at para. 27, leave to appeal refused 2011 CarswellNat 1109, 2011 CarswellNat 1110 (S.C.C.) citing *Patent Rules* SOR/96-423, s. 87(3) which provides:

Any dependent claim shall be understood as including all the limitations contained in the claim to which it refers or, if the dependent claim refers to more than one other claim, all the limitations contained in the particular claim or claims in relation to which it is considered.

⁴¹³ Obviously Circle #1 contains circles #2 and #3. Therefore, at least some of the apparatuses in Circle #1 have the characteristics of those in Circles #2 and #3. For claim 1 to be consistent with claim 2, claim 1 must include what is in claim 2 (right-handed lawyers) and claim 3 (right-handed lawyers with eyeglasses).

⁴¹⁴ *Johnson & Johnson Inc. v. Boston Scientific Ltd. / Boston Scientifique Lte e*, 2008 FC 552, 2008 CarswellNat 3312, 2008 CarswellNat 1375, 71 C.P.R. (4th) 123 (F.C.) per Layden-Stevenson J. at para. 222, additional reasons 2008 CarswellNat 2118, 2008 CarswellNat 4560 (F.C.).

⁴¹⁵ *Halford v. Seed Hawk Inc.*, 2004 FC 88, 2004 CarswellNat 342, 2004 CarswellNat 7412 (F.C.) per Pelletier J. at para. 91, reconsideration / rehearing refused 2004 CarswellNat 882, 2004 CarswellNat 4795 (F.C.), affirmed 2006 CarswellNat 2397, 2006 CarswellNat 4150 (F.C.A.); *Heffco Inc. v. Dreco Energy Services Ltd.*, 1997 CarswellNat 659, 1997 CarswellNat 4283, 73 C.P.R. (3d) 284 (Fed. T.D.) per Campbell J., at 298 [C.P.R.]; *Dimplex North America Ltd. v. CFM Corp.*, 2006 FC 586, 2006 CarswellNat 4718, 2006 CarswellNat 1365 (F.C.) per Mosley J. at para. 65, additional reasons 2006 CarswellNat 6048, 2006 CarswellNat 3881 (F.C.), affirmed 2007 CarswellNat 3089, 2007 CarswellNat 2868 (F.C.A.).

⁴¹⁶ Again, with reference to the example, assuming there is no claim redundancy, claim 1 cannot be limited to right-handed lawyers, otherwise claim 2 would be redundant. The feature added in claim

broader than the dependent claim,⁴¹⁷ a dependent claim cannot be used to narrow the scope of the parent claim.⁴¹⁸ The limitation in the dependent claim should not be “read-in” to the parent claim so as to limit it, whether to avoid invalidity⁴¹⁹ or to escape infringement.⁴²⁰

4. Accordingly, there will be a red region in Circle #1 that contains apparatuses that have the characteristics of claim #1 but which do not have the characteristics of claim #2. In other words, the parent claim should be interpreted to include things that do not have the limitations added by the dependant claim #2,⁴²¹ otherwise, the dependent claim would be redundant.

2 of being right-handed, is not to be imposed on all the lawyers in the courtroom of claim 1. Likewise claim 2 must include the lawyers of claim 3 (right-handed lawyers who wear glasses) but is not limited to right-handed lawyers who wear glasses, so would include right-handed lawyers that do not wear glasses.

⁴¹⁷ See *Bauer Hockey Corp. v. Easton Sports Canada Inc.*, 2010 FC 361, 2010 CarswellNat 3031, 2010 CarswellNat 796 (F.C.) per Gauthier J. at para. 147, affirmed 2011 CarswellNat 4827, 2011 CarswellNat 561 (F.C.A.) where Gauthier J. recognized that a feature in a dependant claim “does not inform” the construction of the parent claim 1, because “Claim 1 is wider than claim 4.”

⁴¹⁸ See however *MediaTube Corp. v. Bell Canada*, 2017 FC 6, 2017 CarswellNat 18, 2017 CarswellNat 3277 (F.C.) per Locke J. at paras. 45-53, affirmed 2019 CarswellNat 2404, 2019 CarswellNat 14152 (F.C.A.), leave to appeal refused 2020 CarswellNat 826, 2020 CarswellNat 827 (S.C.C.), where the court had to determine whether the terms “audio/video signals”, “demodulated input signal” and “output of the redistributor” in claim 1 excluded digital signals and was limited to analog signals. A dependent claim included limitations that referred only to analog signal characteristics. The disclosure referred to only analog audio/video signals after demodulation but referred to input signals “of any format” [meaning analog or digital]. The court concluded that the reader would have understood that the patentee contemplated only analog signals after demodulation. Claim 1 also referred to “conductors” and a “twisted pair of a telephone wire which carries a telephone signal”. The court concluded that the former did not include the latter and that the claim did not encompass both audio/video signals travelling downstream over the twisted pair and control signals travelling upstream [paras. 54-63]. The disclosure suggested that a single twisted pair was unsuitable for the signals [para. 59]. Claim 1 also referred to a “server”. The court concluded that a server could be a distributed network of elements but did not include a packet-switching network because those send digital, not analog signals [para. 67]. With respect to an “unused twisted pair”, having it carry other signals would have a material effect on the way the invention works, and the skilled reader would have understood that strict compliance with the primary meaning of “unused” was an essential requirement of the invention [para. 89].

⁴¹⁹ The independent claim, without the limitation read into it, may be so broad as to include prior art and hence, be invalid.

⁴²⁰ *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760 (Fed. Cir., 1983) quoted in *Halford v. Seed Hawk Inc.*, 2004 FC 88, 2004 CarswellNat 342, 2004 CarswellNat 7412 (F.C.) per Pelletier J. at para. 93, reconsideration / rehearing refused 2004 CarswellNat 882, 2004 CarswellNat 4795 (F.C.), affirmed 2006 CarswellNat 2397, 2006 CarswellNat 4150 (F.C.A.). The independent claim with the limitation read-in may not describe the allegedly infringing structure, whereas without the limitation read-in, the claim may cover it. See also: *Wolens v. Woolworth*, 703 F.2d 983 (7th Cir., 1983) at 988 and *D.M.I. Inc. v. Deere & Co.*, 755 F.2d 1570 (Fed. Cir., 1985) at 1574.

⁴²¹ See:

Pfizer Canada Inc. v. Canada (Minister of Health), 2007 FC 91, 2007 CarswellNat 146, 2007 CarswellNat 3685, 56 C.P.R. (4th) 96 (F.C.) at paras. 51-53, reversed on other grounds 2008 CarswellNat 2714, 2008 CarswellNat 788 (F.C.A.), where the patent explicitly did not limit the patent to the racemate and clearly

This is why, for the purpose of anticipation and obviousness analyses, where validity must be determined on a claim-by-claim basis, each claim must be construed because eventually, a narrowed claim may be sufficiently narrow to escape these prior art attacks, even though the broader claims may be invalid.⁴²²

Although claim differentiation is a rebuttable presumption, the presumption is especially strong when the limitation in the dependent claim in dispute is the only meaningful distinction between the parent claim and the dependent claim.⁴²³ If two claims are identical in other respects, one infers, on a purposive construction, that the claims were intended to describe alternative devices.⁴²⁴

stated that it included both enantiomers (a racemate being a mixture, in equal parts, of two enantiomers). Where a dependent claim covered only racemates, the independent claim was not limited to racemates, but covered both racemates and enantiomers;

•*Abbott Laboratories v. Canada (Minister of Health)*, 2007 FCA 83, 2007 CarswellNat 1592, 2007 CarswellNat 426, 58 C.P.R. (4th) 97 (F.C.A.) per Noe J.J.A., Nadon and Malone J.J.A. concurring at para. 31, where a dependent claim said that the composition was “essentially ethanol-free”, the independent claim was read to include ethanol, even though it was not in the listed ingredients of claim 1.

•*Eli Lilly Canada Inc. v. Apotex Inc.*, 2008 FC 142, 2008 CarswellNat 1821, 2008 CarswellNat 308, 63 C.P.R. (4th) 406 (F.C.) per Hughes J. at para. 53, affirmed 2009 CarswellNat 833, 2009 CarswellNat 3956 (F.C.A.), leave to appeal refused 2009 CarswellNat 3235, 2009 CarswellNat 3236 (S.C.C.): In a case where the independent claim referred to “osteoporosis” or “bone loss” in humans and the dependent claims limits the treatment to “aging post-menopausal females” and “the treatment of a patient without eliciting significant estrogenic responses in primary sex tissues”, the Court held that the independent claims were not limited to the treatment of females: “It cannot be said that claims 1 or 3 incorporate the limitations of claims 15 or 17.”

•*Bridgeview Manufacturing Inc. v. 931409 Alberta Ltd.*, 2009 FC 50, 2009 CarswellNat 712, 2009 CarswellNat 155 (F.C.) per Campbell J. at paras. 27 & 30, reversed in part 2010 CarswellNat 4009, 2010 CarswellNat 2314 (F.C.A.), leave to appeal refused 2011 CarswellNat 1109, 2011 CarswellNat 1110 (S.C.C.) where a dependent claim specified that a manipulator was “rotatably” mounted, the court concluded that “[t]his could mean that Claim 1 covers a manipulator that does not rotate.”

•*Bauer Hockey Corp. v. Easton Sports Canada Inc.*, 2010 FC 361, 2010 CarswellNat 3031, 2010 CarswellNat 796 (F.C.) per Gauthier J. at para. 147, affirmed 2011 CarswellNat 4827, 2011 CarswellNat 561 (F.C.A.) where dependant claim 4 may well have had as an essential element to shape a portion of a skate boot before sewing on the foxing portion, parent claim 1 was wider in that it covered skate boots where the foxing portions were not sewn.

•See however *Johnson & Johnson Inc. v. Boston Scientific Ltd. / Boston Scientifique Ltée*, 2008 FC 552, 2008 CarswellNat 3312, 2008 CarswellNat 1375, 71 C.P.R. (4th) 123 (F.C.) per Layden-Stevenson J., at para. 222, additional reasons 2008 CarswellNat 2118, 2008 CarswellNat 4560 (F.C.) where dependent claims 5 and 6 of the patent at issue alternately characterized the slots of claim 1 as being hexagonal when expanded (and thus rectangular complete slots (bounded on all sides) before expansion) and, parallelograms when expanded (and hence linear slits bounded on all sides, before expansion), the Court concluded that all slots of parent claim 1 were bounded on all sides and did not include half slots that were not completely enclosed.

•*Eli Lilly & Co. v. Apotex Inc.*, 2009 FC 991, 2009 CarswellNat 3042, 2009 CarswellNat 6607 (F.C.) per Gauthier J. at para. 162, affirmed 2010 CarswellNat 5866, 2010 CarswellNat 3443 (F.C.A.), leave to appeal refused 2011 CarswellNat 1368, 2011 CarswellNat 1369 (S.C.C.), additional reasons 2011 CarswellNat 4151 (F.C.) where the limitations of dependent claim 18 were not read into claim 1 as these limitations were claim 18’s only distinguishing features from claim 1.

⁴²² *Zero Spill Systems (Int’l) Inc. v. Heide*, 2015 FCA 115, 2015 CarswellNat 1357, 2015 CarswellNat 9212 (F.C.A.) per Stratas J.A., Dawson & Near J.J.A. concurring at paras. 94 & 104, leave to appeal refused 2016 CarswellAlta 51, 2016 CarswellAlta 52 (S.C.C.), leave to appeal refused 2016 CarswellNat 12321, 2016 CarswellNat 12322 (S.C.C.). See also *AFDPetroleum Ltd. v. Frac Shack Inc.*, 2018 FCA 140, 2018 CarswellNat 3775, 2018 CarswellNat 12343 (F.C.A.) per Gleason J.A., Webb & Laskin J.J.A. concurring at para. 47.<

The tendency for an interpretation of a claim to render it redundant cannot overcome a purposive interpretation of the specification.⁴²⁵

Claim differentiation can also be used to determine whether a claim element is essential. Where one claim differs from another in only a single feature it is difficult to argue that the different feature has not been made essential to that claim.⁴²⁶ The function of the feature would be essential, but its precise form might not be and one would still have to determine the proper scope of the meaning of the phrase describing the added feature in the context of the patent.

There is a presumption of claim consistency, according to which the same words must be given the same meaning throughout the claims and within any claim of a patent.⁴²⁷

Different words usually refer to different things. Where two claims are identical in other respects, but different terms are used to describe a component, one infers on a purposive construction that the claims were intended to describe alternative (that is, different) components.⁴²⁸ Similarly, where an essential feature of a patent is defined in a specific way and a different more expansive

⁴²⁵ *Bridgeview Manufacturing Inc. v. 931409 Alberta Ltd.*, 2010 FCA 188, 2010 CarswellNat 4009, 2010 CarswellNat 2314 (F.C.A.) per Sharlow J.A., Nadon & Trudel JJ.A. concurring at para. 33, leave to appeal refused 2011 CarswellNat 1109, 2011 CarswellNat 1110 (S.C.C.) (citing *Abbott Laboratories v. Canada (Minister of Health)*, 2007 FCA 83, 2007 CarswellNat 1592, 2007 CarswellNat 426 (F.C.A.) at para. 33, and *Nekoosa Packaging Corp. v. AMCA International Ltd.*, 1994 CarswellNat 2980, 172 N.R. 387 (Fed. C.A.) at para. 37). Arguably, the construction did not necessarily make the dependant claim redundant: claim 5 required at least 2 manipulator rollers. The parent claim could have included only 1 roller and thus not rendered claim 5 redundant.

⁴²⁶ Hayhurst; “The Art of Claiming and Reading a Claim” in Patent Law of Canada (1994), edited by G.F. Henderson, Q.C., at 198 quoted with approval in *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 163 [C.P.R.], para. 79, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.). See *Glaston Services Ltd. Oy v. Horizon Glass & Mirrors Ltd.*, 2010 FC 1191, 2010 CarswellNat 5395, 2010 CarswellNat 4556 (F.C.) per Mandamin J. where dependent claim 3 added the limitation of “said pneumatic spring is a pneumatic cylinder for carrying the roller between the rest position and the working position” (at para. 48), the Court held at para 65 that it was an essential element of that claim that the pneumatic spring is provided by a pneumatic cylinder “... since it is specifically claimed ...”

⁴²⁷ *Nova Chemicals Corp. v. Dow Chemical Co.*, 2016 FCA 216, 2016 CarswellNat 11635, 2016 CarswellNat 4304 (F.C.A.) per de Montigny J.A., Webb & Boivin JJ.A. concurring) at para. 82, leave to appeal refused 2017 CarswellNat 1451, 2017 CarswellNat 1452 (S.C.C.); *Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd.*, 1972 CarswellNat 531, 7 C.P.R. (2d) 198 (Fed. T.D.) at 225-226 [C.P.R.], reversed 1973 CarswellNat 34, 1973 CarswellNat 34F, 10 C.P.R. (2d) 126, [1973] F.C. 405 (Fed. C.A.), reversed 1974 CarswellNat 378, 1974 CarswellNat 378F, [1976] 1 S.C.R. 555, 17 C.P.R. (2d) 97 (S.C.C.); *Johnson & Johnson Inc. v. Boston Scientific Ltd. / Boston Scientific Ltée*, 2008 FC 552, 2008 CarswellNat 3312, 2008 CarswellNat 1375, 71 C.P.R. (4th) 123 (F.C.) at paras. 208 and 213, additional reasons 2008 CarswellNat 2118, 2008 CarswellNat 4560 (F.C.).

⁴²⁸ *Whirlpool Corp. v. Camco Inc.*, 2000 SCC 67, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at para. 79, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

term is also introduced that can include the specific term, one would not generally interpret the two terms as denoting the same thing. The usual purpose of using different words is to distinguish one feature from another and not to express synonymy.⁴²⁹

6.7.2.9 *Dependent Claims: “... any of Claims ...”*

Section 27(5) of the post October 1, 1996 *Patent Act* provides:

(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.

Where a claim was dependent from three claims (claim 7, 8 or 9), and two of those claims were held to be invalid (claims 8 and 9), the Court held that the dependent claim was valid “as far as it includes claim 7”.⁴³⁰ Similarly, in a case where the dependent claim referred was said to comprise a compound selected from compounds selected from compounds according to any of claims 1-7, to refer to the claims separately and thus could be construed to refer to one specific claim (claim 4) only.⁴³¹

In contrast, a Markush claim, in the form of a method using a solvent “selected from a group consisting of (a number of individually names compounds)”, was interpreted to include all members of the group, the inutility of some of which would invalidate the claim.⁴³²

6.7.2.10 *Other Independent Claims*

It is inappropriate to use one independent claim to aid in the construction of another independent claim.⁴³³ If one were to incorporate the elements of one

⁴²⁹ *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2013 FC 947, 2013 CarswellNat 4788, 2013 CarswellNat 3398 (F.C.) per Barnes J. at para. 29, additional reasons 2013 CarswellNat 3777, 2013 CarswellNat 4789 (F.C.), affirmed 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near JJ.A. concurring at para. 48, wherein the term “a moveable switch contact element” was held to include “sliding contact switches” and a “knife blade switch”.

⁴³⁰ *Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd.*, 1978 CarswellNat 693, 39 C.P.R. (2d) 191 (Fed. T.D.) at 212 [C.P.R.], reversed on other grounds 1979 CarswellNat 206, 41 C.P.R. (2d) 94 (Fed. C.A.), reversed 1981 CarswellNat 582F, 1981 CarswellNat 582, [1981] 1 S.C.R. 504 (S.C.C.) at 538 [S.C.R.].

⁴³¹ *G.D. Searle & Co. v. Novopharm Ltd.*, 2007 FC 81, 2007 CarswellNat 202, 2007 CarswellNat 2324, 56 C.P.R. (4th) 1 (F.C.), reversed on other grounds 2007 FCA 173, 2007 CarswellNat 3019, 2007 CarswellNat 993, 58 C.P.R. (4th) 1 (F.C.A.), leave to appeal refused 2007 CarswellNat 3623, 2007 CarswellNat 3624 (S.C.C.).

⁴³² *Abbott Laboratories v. Canada (Minister of Health)*, 2005 CarswellNat 3363, 2005 CarswellNat 5434, 45 C.P.R. (4th) 81 (F.C.) per Phelan J. at paras. 47 & 57, affirmed 2007 CarswellNat 890, 2007 CarswellNat 2377 (F.C.A.).

independent claim into the elements of another independent claim, one would disregard the right of the inventors to adopt different ways of defining their monopoly and describing different aspects of an invention.⁴³⁴

Where some claims include an element and others do not, the court can conclude that the element is essential in one set of claims but not in another.⁴³⁵

In contrast to claim dependency, where a patent separately claims a class of chemical compounds and a single compound within that class, each separate claim is considered to disclose separate inventions and each claim stands on its own.⁴³⁶

a) Method Claims: Order of Steps

Where a person of skill in the art would recognize, at the time of publication of the application, that the steps could be done in a different order to achieve the exact same result, and where the steps were not numbered in the claim, the court held that the order of the steps in a claimed method were not an essential element of the claim.⁴³⁷

6.7.3 Use of External Material

Generally, claims are to be interpreted without the use of material external to the patent.⁴³⁸ An exception is found where the patent refers to external documents to define terms within the patent.⁴³⁹

⁴³³ *Bauer Hockey Corp. v. Easton Sports Canada Inc.*, 2010 FC 361, 2010 CarswellNat 3031, 2010 CarswellNat 796 (F.C.) per Gauthier J. at para. 148, affirmed 2011 CarswellNat 4827, 2011 CarswellNat 561 (F.C.A.).

⁴³⁴ *Eli Lilly & Co. v. Apotex Inc.*, 2009 FC 991, 2009 CarswellNat 3042, 2009 CarswellNat 6607 (F.C.) per Gauthier J. at para. 123, affirmed 2010 CarswellNat 5866, 2010 CarswellNat 3443 (F.C.A.), leave to appeal refused 2011 CarswellNat 1368, 2011 CarswellNat 1369 (S.C.C.), additional reasons 2011 CarswellNat 4151 (F.C.).

⁴³⁵ *Merck & Co. v. Canada (Minister of Health)*, 2010 FC 1042, 2010 CarswellNat 3959, 2010 CarswellNat 4670 (F.C.) per O'Reilly J. at para. 22:
... many of the patent's claims are specifically addressed to a co-formulation of a CAI with a beta blocker. In my view, co-formulation is an essential element of those claims. Others, namely the use claims (16-20), address both co-administration of the two agents and co-formulations. Co-formulation, therefore, is not an essential element of those claims.

⁴³⁶ See *C.H. Boehringer Sohn v. Bell-Craig Ltd.*, 1962 CarswellNat 16, [1962] Ex. C.R. 201 (Can. Ex. Ct.), affirmed 1963 CarswellNat 45, [1963] S.C.R. 410 (S.C.C.); *Hoechst Pharmaceuticals of Canada Ltd. v. Gilbert & Co.*, 1964 CarswellNat 60, [1965] 1 Ex. C.R. 710 (Can. Ex. Ct.), affirmed 1965 CarswellNat 52, [1966] S.C.R. 189 (S.C.C.); *Merck & Co. v. Apotex Inc.*, 2006 FCA 323, 2006 CarswellNat 3206, 2006 CarswellNat 5302, 55 C.P.R. (4th) 1 (F.C.A.), leave to appeal refused 2007 CarswellNat 1097, 2007 CarswellNat 1098, [2006] S.C.C.A. No. 507 (S.C.C.); *Laboratoires Servier v. Apotex Inc.*, 2008 FC 825, 2008 CarswellNat 3000, 2008 CarswellNat 5245, 67 C.P.R. (4th) 241 (F.C.) per Snider J. at paras. 125-129 & 133, additional reasons 2008 CarswellNat 4195, 2008 CarswellNat 3444 (F.C.), affirmed 2009 CarswellNat 1922, 2009 CarswellNat 5775 (F.C.A.), leave to appeal refused 2010 CarswellNat 660, 2010 CarswellNat 661 (S.C.C.).<

One patent should not be construed with reference to another patent.⁴⁴⁰ In determining whether a patent claims a device or a drug, resort should not be had to whether a product is regulated under the Food and Drugs Regulations, as a drug and not as a device, and by the Patented Medicine Prices Review Board.⁴⁴¹ A court is not entitled to consider such extraneous matters as the content of a new drug submission filed pursuant to the Food and Drug Regulations, C.R.C. 1978, c. 870 to determine whether a patent claims the drug itself.⁴⁴²

Parole evidence is admissible to explain the meanings of words or technical matters and to inform the Court of relevant surrounding circumstances.⁴⁴³

Notes made by an inventor are not relevant in construing the claims,⁴⁴⁴ nor is the testimony of the inventor.⁴⁴⁵ The inventor is not the best witness to assist with claim construction. The inventor will have a strong self-interest and may not be reading the claim as an objective, first-time reader.⁴⁴⁶

6.7.3.1 Dictionaries

Dictionaries sometimes include definitions used by persons skilled in the art; sometimes not. Therefore, although dictionary definitions can be used, they are not determinative; it is the meaning of the term as used in the context of the patent that is paramount:

Though patent construction must be tied to the language of the patent, a simple “dictionary” or “grammatical” approach to patent construction is to be avoided. The terms of the specification, including the claims, must be given

⁴⁴⁰ *GD Searle & Co. v. Canada (Minister of Health)*, 2008 FC 437, 2008 CarswellNat 865, 2008 CarswellNat 5023, 65 C.P.R. (4th) 451 (F.C.) per Gauthier J. at para. 50, affirmed 2009 CarswellNat 284, 2009 CarswellNat 1394 (F.C.A.).

⁴⁴¹ *Novartis Pharmaceuticals Canada Inc. v. Canada (Minister of Health)*, 2003 FCA 299, 2003 CarswellNat 2701, 2003 CarswellNat 1957, 28 C.P.R. (4th) 1 (F.C.A.) per Malone J.A., Linden and Sexton J.J.A. concurring at para. 22.

⁴⁴² *Merck Frosst Canada & Co. v. Canada (Minister of Health)*, 2001 FCA 136, 2001 CarswellNat 850, 2001 CarswellNat 5057, 12 C.P.R. (4th) 383 (Fed. C.A.) at para. 9.

⁴⁴³ *Canadian General Electric Co. v. Fada Radio Ltd.*, 1929 CarswellNat 64, 47 R.P.C. 69 (Jud. Com. of Privy Coun.) at 90 [R.P.C.].

⁴⁴⁴ *Johnson Controls Inc. v. Varta Batteries Ltd.* (1984), 80 C.P.R. (2d) 1 (Fed. C.A.) at 27–28, leave to appeal refused (1984), 56 N.R. 398n (S.C.C.).

⁴⁴⁵ *Lovell Manufacturing Co. v. Beatty Brothers Ltd.*, 1962 CarswellNat 22, 41 C.P.R. 18 (Can. Ex. Ct.) Per Thomson P. at 37–38 [C.P.R.]; *Eli Lilly & Co. v. O'Hara Manufacturing Ltd.*, 1989 CarswellNat 504, 26 C.P.R. (3d) 1 (Fed. C.A.) per Pratte J.A. at 7 [C.P.R.].

⁴⁴⁶ *Lovell Manufacturing Co. v. Beatty Brothers Ltd.*, 1962 CarswellNat 22, 41 C.P.R. 18 (Can. Ex. Ct.) per Thorson P.; *Johnson Controls Inc. v. Varta Batteries Ltd.*, 1984 CarswellNat 581, 80 C.P.R. (2d) 1 (Fed. C.A.) per Urie J. at 27–28 [C.P.R.], leave to appeal refused (1984), 56 N.R. 398n (S.C.C.); *Reliance Electric Industrial Co. v. Northern Telecom Ltd.*, 1993 CarswellNat 319, 47 C.P.R. (3d) 55 (Fed. T.D.) per Reed J. at 64 [C.P.R.], affirmed 1994 CarswellNat 1333 (Fed. C.A.); *Nekoosa Packaging Corp. v. AMCA International Ltd.*, 1994 CarswellNat 2980, 56 C.P.R. (3d) 470 (Fed. C.A.) per Robertson J.A. at 476 [C.P.R.].

meaning and purpose by the skilled addressee applying his or her knowledge in the field to which the patent relates.⁴⁴⁷

A dictionary definition should never trump the meaning of the word to persons in the relevant art. In *Western Electric Co. v. Baldwin International Radio of Canada Ltd.*⁴⁴⁸ the Court cited earlier authority dealing with the word “conduit” as used in a patent claim. Duff C.J. accepted the proposition that “[y]ou are not to look into the dictionary to see what ‘conduit’ means, but you are to look at the specification in order to see the sense in which the patentees have used it”. This analysis is consistent with the American approach where it has been held that evidence demonstrating that skilled persons in the art give a word a special meaning to a disputed term in a claim renders a contrary definition from a dictionary irrelevant.⁴⁴⁹

Dictionaries have been referred to when the term in issue has no special meaning in the art. In the *Solvay Pharma* case, resort was had to a dictionary definition when the term “regulation” was referred to in the claims but nowhere else in the description.⁴⁵⁰

In *Whirlpool*, Mr. Justice Binnie dismissed the defendant’s (appellant’s) submission that a broad, dictionary definition should be used to interpret the word “vane” when a more narrow definition would have been understood in the industry:

A second difficulty with the appellants’ dictionary approach is that it urges the Court to look at the words through the eyes of a grammarian or etymologist rather than through the eyes and with the common knowledge of a worker of ordinary skill in the field to which the patent relates. An etymologist or grammarian might agree with the appellants that a vane of any type is still a vane. However, the patent specification is not addressed to grammarians, etymologists or to the public generally, but to skilled individuals sufficiently versed in the art to which the patent relates to enable them on a technical level to appreciate the nature and description of the invention: H. G. Fox, *The Canadian Law and Practice Relating to Letters*

⁴⁴⁷ *Whirlpool Corp. v. Camco Inc.*, 2000 SCC 67, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 152-153 [C.P.R.], paras. 52-53, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2007 FCA 209, 2007 CarswellNat 1434, 2007 CarswellNat 4252, 60 C.P.R. (4th) 81 (F.C.A.) per Nadon J.A., Linden and Sexton JJ.A. concurring at para. 53, leave to appeal refused 2007 CarswellNat 3850, 2007 CarswellNat 3851 (S.C.C.).

⁴⁴⁸ *Western Electric Co. v. Baldwin International Radio of Canada Ltd.*, 1934 CarswellNat 38, [1934] S.C.R. 570 (S.C.C.) at 572 [S.C.R.]; quoted with approval in *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 152 [C.P.R.], para. 52, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

⁴⁴⁹ *Vanderlande Industries Nederland BV v. International Trade Commission*, 366 F.3d 1311 (Fed. Cir., 2004).

⁴⁵⁰ *Solvay Pharma Inc. v. Apotex Inc.*, 2008 FC 308, 2008 CarswellNat 589, 2008 CarswellNat 6520, 64 C.P.R. (4th) 246 (F.C.) per Gauthier J. at para. 31.

Patent for Inventions (4th ed. 1969), at p. 185. The court, writes Dr. Fox, at 203, must place itself:

... in the position of some person acquainted with the surrounding circumstances as to the state of the art and the manufacture at the time, and making itself acquainted with the technical meaning in that art or manufacture that any particular word or words may have.⁴⁵¹

Nevertheless, the purposive approach is not an invitation to the Court to ignore the ordinary rules of grammar and syntax.⁴⁵² If an essential feature of a patent is defined in a specific way and a different more expansive term is also introduced than can include the specific term, one would not generally interpret the two terms as denoting the same thing. The usual purpose of using different words is to distinguish one feature from another and not to express synonymy.⁴⁵³

6.7.3.2 *File Wrapper Estoppel*

The “file wrapper”⁴⁵⁴ is the name given to the file in the Patent Office containing the correspondence between the inventor’s patent agent and the Patent Office Examiner during the prosecution (obtaining) of the patent. It sometimes contains statements made on behalf of the inventor as to what is the invention or how it differs from the prior art.

In the United States, statements made by the patent agent on behalf of the inventors during the prosecution of the patent in the Patent Office as to the scope of the invention and its differences from the prior art can be used at trial to limit the scope of the patent claims (file wrapper estoppel). In particular, a patent owner is precluded from claiming the benefit of the doctrine of equivalents to recapture ground conceded at the request of the Patent Office during prosecution.⁴⁵⁵

⁴⁵¹ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 153 [C.P.R.], para. 53, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

⁴⁵² *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2013 FC 947, 2013 CarswellNat 4788, 2013 CarswellNat 3398 (F.C.) at para. 29, additional reasons 2013 CarswellNat 3777, 2013 CarswellNat 4789 (F.C.), affirmed 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.),

⁴⁵³ *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2013 FC 947, 2013 CarswellNat 4788, 2013 CarswellNat 3398 (F.C.) at para. 29, additional reasons 2013 CarswellNat 3777, 2013 CarswellNat 4789 (F.C.), affirmed 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.),

⁴⁵⁴ It is sometimes called the “file history” or “prosecution history”.

⁴⁵⁵ *Warner-Jenkinson Co. Inc. v. Hilton Davis Chemical Co.*, [1997] SCT-QL 50.

a) Old Law Prohibiting it in Canada

Before December 2018, Canadian case law prohibited the use of the file wrapper to construe the claims, however the origin of this case law predated cases dealing with statutory interpretation that examine legislative history. The Canadian or foreign patent application file relating to the patent at issue could not be admitted into evidence in Canada to limit the construction put on the claims.⁴⁵⁶ A person attacking the validity of a patent could not rely upon statements and submissions made to the Canadian Patent Office during the prosecution of the application as admissions as to what are essential features of the invention.

Just as a patentee could not have his patent broadened by showing his intention to claim a broader invention through evidence of what transpired during the prosecution of his patent application, neither should an alleged infringer be able to resort to such evidence to show it is narrower in scope than the patent states. To do so would be to override the words of the patent as issued which, in my understanding, are to be determinative of the scope of the patent.⁴⁵⁷

File wrappers were ruled inadmissible when they related to changes made during the application⁴⁵⁸ or when proffered to stop a party from denying that certain claim elements were “essential”.⁴⁵⁹ Pleadings referring to a declaration made by an inventor in the course of the prosecution of a U.S. patent application, in support of an allegation that the claims were broader than the invention made by the inventors, were struck out.⁴⁶⁰

In *Free World*, Mr. Justice Binnie confirmed the rejection of file wrapper estoppel for Canada for two reasons: (1) the intention of the inventor is to be determined from reading the patent claims and not from extrinsic evidence (a self-fulfilling conclusion); and (2) such extrinsic evidence would undermine the

⁴⁵⁶ *Free World Trust c. E' lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 198 [C.P.R.], paras. 66-67; *Lovell Manufacturing Co. v. Beatty Brothers Ltd.*, 1962 CarswellNat 22, 41 C.P.R. 18 (Can. Ex. Ct.) per Thorson P. at 29-35 [C.P.R.]; *Dominion Rubber Co. v. Acton Rubber Ltd.*, 1963 CarswellNat 24, 42 C.P.R. 7 (Can. Ex. Ct.) at 12 [C.P.R.]; *Dennison Manufacturing Co. v. Dymo of Canada Ltd.*, 1975 CarswellNat 500, 23 C.P.R. (2d) 155 (Fed. T.D.) per Mahoney J.; *Eli Lilly & Co. v. O'Hara Manufacturing Ltd.*, 1988 CarswellNat 2440, 20 C.P.R. (3d) 342 (Fed. T.D.) per Pinard J. at 367-369 [C.P.R.], reversed 1989 CarswellNat 504 (Fed. C.A.); *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2006 FC 790, 2006 CarswellNat 2188, 2006 CarswellNat 3635 (F.C.) per Lemieux J. at paras. 17, 25.

⁴⁵⁷ *P.L.G. Research Ltd. v. Jannock Steel Fabricating Co.*, 1991 CarswellNat 873, 35 C.P.R. (3d) 346 (Fed. T.D.) per Strayer J., affirmed 1992 CarswellNat 666, 41 C.P.R. (3d) 492 (Fed. C.A.) per Mahoney J.A, Hugessen and Decary JJ.A. concurring.

⁴⁵⁸ *Ductmate Industries Inc. v. Exanno Products Ltd.*, 1984 CarswellNat 603, 2 C.P.R. (3d) 289 (Fed. T.D.) per Reed J. at 308-309 [C.P.R.].

⁴⁵⁹ *Amfac Foods Inc. v. Irving Pulp & Paper Ltd.*, 1984 CarswellNat 575, 80 C.P.R. (2d) 59 (Fed. T.D.) per Strayer J. at 86 and 87 [C.P.R.], affirmed 1986 CarswellNat 637 (Fed. C.A.).

⁴⁶⁰ *Bayer Healthcare AG v. Sandoz Canada Inc.*, 2007 FC 964, 2007 CarswellNat 3170, 61 C.P.R. (4th) 127 (F.C.) per O'Keefe J. at paras. 3 and 16-18, affirmed 2008 CarswellNat 3819, 2008 CarswellNat 5392 (F.C.A.).

public notice function of the claims (odd logic given that the admission against interest would be on the public record in the file history):

In my view, those references to the inventor's intention refer to an objective manifestation of that intent in the patent claims, as interpreted by the person skilled in the art, and do not contemplate extrinsic evidence such as statements or admissions made in the course of patent prosecution. To allow such extrinsic evidence for the purpose of defining the monopoly would undermine the public notice function of the claims, and increase uncertainty as well as fuelling the already overheated engines of patent litigation. The current emphasis on purposive construction, which keeps the focus on the language of the claims, seems also to be inconsistent with opening the Pandora's box of file wrapper estoppel. If significant representations are made to the Patent Office touching the scope of the claims, the Patent Office should insist where necessary on an amendment to the claims to reflect the representation.⁴⁶¹

In *Distrimed Inc. v. Dispill Inc.*,⁴⁶² the claim elements of upwardly projecting protuberance(s) and holes were added to the claims by the applicant, in order to overcome a rejection during prosecution.⁴⁶³ After reviewing the prohibition Justice Montigny used an amendment of a claim during prosecution as evidence of the essentiality of a claim element:

I am not convinced that the letter referred to by the Defendants to the Counterclaim falls squarely within the compass of that exclusion. While statements or admissions made in the course of patent prosecution shall not be used for the purpose of interpreting a claim, this is not what the Court is called upon to do in the case at bar. A change in the wording of a claim as a result of an objection from the Patent Office is an objective fact from which an inference may be drawn, and is not the same as representations made to the Patent Office. A purposive construction should obviously focus on the wording of a claim, obviously, but this is a far cry from saying that nothing else should be considered.⁴⁶⁴

In 2016, Justice Locke asked whether it was time to revisit the rule against using extrinsic evidence in claim construction.⁴⁶⁵ In *Pollard*, he looked at the file history after construing the claim to corroborate a construction and to express that it was “remarkable”⁴⁶⁶ and “breathhtaking”⁴⁶⁷ that the patentee took a

⁴⁶¹ *Free World Trust c. E lectro Santé Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 197-198 [C.P.R.], para. 66.

⁴⁶² *Distrimed Inc. v. Dispill Inc.*, 2013 FC 1043, 2013 CarswellNat 3663, 2013 CarswellNat 5722 (F.C.) (per de Montigny J.).

⁴⁶³ *Distrimed Inc. v. Dispill Inc.*, 2013 FC 1043, 2013 CarswellNat 3663, 2013 CarswellNat 5722 (F.C.) (per de Montigny J.) at para. 207.

⁴⁶⁴ *Distrimed Inc. v. Dispill Inc.*, 2013 FC 1043, 2013 CarswellNat 3663, 2013 CarswellNat 5722 (F.C.) (per de Montigny J.) at para. 210.

⁴⁶⁵ *Pollard Banknote Ltd. v. BABN Technologies Corp.*, 2016 FC 883, 2016 CarswellNat 3400, 2016 CarswellNat 10897 (F.C.) per Locke J. at para. 80, additional reasons 2016 CarswellNat 8063, 2016 CarswellNat 11587 (F.C.).

⁴⁶⁶ *Pollard Banknote Ltd. v. BABN Technologies Corp.*, 2016 FC 883, 2016 CarswellNat 3400, 2016

position at trial “quite different” from that taken during prosecution, noting that excluding such extrinsic evidence resulted in a very different construction of one phrase in a claim than would otherwise have been the case.⁴⁶⁸

File wrappers may be admissible for purposes other than claim construction,⁴⁶⁹ for example, to clarify facts,⁴⁷⁰ or admit that something is a chemical process.⁴⁷¹

b) Section 53.1

Section 53.1 was added to the *Patent Act* effective December 13, 2018.⁴⁷² It permits file wrapper communication to be used as evidence to rebut representations by the patentee as to the construction of a claim in a patent at issue:

53.1 (1) In any action or proceeding respecting a patent, a written communication, or any part of such a communication, may be admitted into evidence to rebut any representation made by the patentee in the action or proceeding as to the construction of a claim in the patent if

- (a) it is prepared in respect of
 - (i) the prosecution of the application for the patent,
 - (ii) a disclaimer made in respect of the patent, or
 - (iii) a request for re-examination, or a re-examination proceeding, in respect of the patent; and
- (b) it is between
 - (i) the applicant for the patent or the patentee; and

CarswellNat 10897 (F.C.) per Locke J. at para. 235, additional reasons 2016 CarswellNat 8063, 2016 CarswellNat 11587 (F.C.).

⁴⁶⁷ *Pollard Banknote Ltd. v. BABN Technologies Corp.*, 2016 FC 883, 2016 CarswellNat 3400, 2016 CarswellNat 10897 (F.C.) per Locke J. at para. 237, additional reasons 2016 CarswellNat 8063, 2016 CarswellNat 11587 (F.C.).

⁴⁶⁸ *Pollard Banknote Ltd. v. BABN Technologies Corp.*, 2016 FC 883, 2016 CarswellNat 3400, 2016 CarswellNat 10897 (F.C.) per Locke J. at para. 239, additional reasons 2016 CarswellNat 8063, 2016 CarswellNat 11587 (F.C.).

⁴⁶⁹ *Foseco Trading A.G. v. Canadian Ferro Hot Metal Specialties Ltd.*, 1991 CarswellNat 194, 36 C.P.R. (3d) 35 (Fed. T.D.) at 47 [C.P.R.].

⁴⁷⁰ *Novartis AG v. Apotex Inc.*, 2001 CarswellNat 2297, 2001 CarswellNat 6172, 15 C.P.R. (4th) 417 (Fed. T.D.) per Blais J. at 442 [C.P.R.], affirmed 2002 CarswellNat 3179, 2002 CarswellNat 6014 (Fed. C.A.).

⁴⁷¹ *Laboratoire Pentagone Ltee v. Parke, Davis & Co.*, 1967 CarswellQue 12, 55 C.P.R. 105 (S.C.C.) per Martland J. at 117 [C.P.R.] or, in the case of a Canadian trade-mark application for a gelatine capsule band, it was considered relevant that the applicant applied for a U.S. utility patent on the band: *Parke, Davis & Co. v. Empire Laboratories Ltd.*, 1964 CarswellNat 382, 43 C.P.R. 1 (S.C.C.) per Hall J. at 9 [C.P.R.].

⁴⁷² *The Budget Implementation Act, 2018, No. 2*, Statutes of Canada 2018, c.27, received Royal Assent on December 13, 2018.

- (ii) the Commissioner, an officer or employee of the Patent Office or a member of a re-examination board.

Divisional application

(2) For the purposes of this section, the prosecution of a divisional application is deemed to include the prosecution of the original application before that divisional application is filed.

Reissued patent

(3) For the purposes of this section, a written communication is deemed to be prepared in respect of the prosecution of the application for a reissued patent if it is prepared in respect of

- (a) the prosecution of the application for the patent that was surrendered and from which the reissued patent results; or
- (b) the application for reissuance.

Subsection 53.1(1) is a detailed provision that contemplates admitting into evidence certain portions of a patent's prosecution history for a certain purpose: "to rebut any representation made by the patentee in the action or proceeding as to the construction of a claim in the patent."⁴⁷³ To the extent a party wishes to introduce written communications made in the course of prosecution of the patent, these communications are only admissible for that limited purpose.⁴⁷⁴ If this provision had been intended simply to brush aside the general prohibition against reliance on a patent's prosecution history for the purposes of claim construction, it could have been much shorter.⁴⁷⁵

The purpose of ss. 53.1(1) would seem to be to provide a tool to use against patentees who take one position concerning the meaning of a claim during prosecution of a patent application and another during litigation on the resulting patent.⁴⁷⁶ Without identifying the representation made by the patentee

⁴⁷³ *Bauer Hockey Ltd. v. Sport Masko Inc. (CCM Hockey)*, 2021 FCA 166, 2021 CarswellNat 3026, 2021 CarswellNat 3027 (F.C.A.) per Locke J.A., de Montigny & Rivoalen JJ.A. concurring at para. 36.

⁴⁷⁴ *Canmar Foods Ltd. and TA Foods Ltd., Re*, 2019 FC 1233, 2019 CarswellNat 5163, 2019 CarswellNat 6002 (F.C.) per Manson J. at para. 63, affirmed 2021 FCA 7, 2021 CarswellNat 76, 2021 CarswellNat 5131 (F.C.A.) per de Montigny J.A., Pelletier & Rivoalen JJ.A. concurring at para. 63.

⁴⁷⁵ *Bauer Hockey Ltd. v. Sport Masko Inc. (CCM Hockey)*, 2021 FCA 166, 2021 CarswellNat 3026, 2021 CarswellNat 3027 (F.C.A.) per Locke J.A., de Montigny & Rivoalen JJ.A. concurring at para. 36.

⁴⁷⁶ *Bauer Hockey Ltd. v. Sport Masko Inc. (CCM Hockey)*, 2021 FCA 166, 2021 CarswellNat 3026, 2021 CarswellNat 3027 (F.C.A.) per Locke J.A., de Montigny & Rivoalen JJ.A. concurring at para. 37.

in the action, it may be difficult to determine whether that representation is inconsistent with something said during prosecution.⁴⁷⁷

6.7.3.3 *Prior Art*

Reference to the prior art is not required for claim construction,⁴⁷⁸ however prior art may assist the court in defining the scientific or engineering landscape into which the invention was introduced. It could also assist the court in understanding how terms and phrases used in the claims were in common use in the art and thereby assist in giving meaning to terms or phrases in the patent.

Internal documents cannot be used to corroborate the views of experts as to the common general understanding of a person skilled in the art.⁴⁷⁹

A patent must not be read with an eye on the prior art in respect of validity to avoid its effect.⁴⁸⁰ Whether a claim is invalid for obviousness or lack of novelty is irrelevant to its proper construction.⁴⁸¹

6.7.3.4 *Testimony of the Inventor*

Under the *Free World* test, the identification of elements as essential or non-essential is supposed to be made “... (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.”⁴⁸² Although Pratte J.A. commented at p. 7 in *O’Hara*,⁴⁸³ that in claims interpretation the Court “is merely trying to find out

⁴⁷⁷ *Bauer Hockey Ltd. v. Sport Maska Inc. (CCM Hockey)*, 2021 FCA 166, 2021 CarswellNat 3026, 2021 CarswellNat 3027 (F.C.A.) per Locke J.A., de Montigny & Rivoalen JJ.A. concurring at para. 37.

⁴⁷⁸ *Amfac Foods Inc. v. Irving Pulp & Paper Ltd.*, 1986 CarswellNat 637, 12 C.P.R. (3d) 193 (Fed. C.A.) per Urie J. at 197 [C.P.R.].

⁴⁷⁹ *Bauer Hockey Corp. v. Easton Sports Canada Inc.*, 2010 FC 361, 2010 CarswellNat 3031, 2010 CarswellNat 796 (F.C.) per Gauthier J. at paras. 158-159, affirmed 2011 CarswellNat 4827, 2011 CarswellNat 561 (F.C.A.).

⁴⁸⁰ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 148-149 [C.P.R.], para. 49(a), reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *Zero Spill Systems (Int’l) Inc. v. Heide*, 2015 FCA 115, 2015 CarswellNat 1357, 2015 CarswellNat 9212 (F.C.A.) per Stratas J.A., Dawson & Near JJ.A. concurring at para. 51, leave to appeal refused 2016 CarswellAlta 51, 2016 CarswellAlta 52 (S.C.C.), leave to appeal refused 2016 CarswellNat 12321, 2016 CarswellNat 12322 (S.C.C.).

⁴⁸¹ *Molins v. Industrial Machinery Co.* (1937), 55 R.P.C. 31 (C.A.) at 39; *Dableh v. Ontario Hydro*, 1996 CarswellNat 2592, 1996 CarswellNat 735, 68 C.P.R. (3d) 129 (Fed. C.A.) per Strayer J. (Linden and Robertson JJ.A. concurring) at 142-143 [C.P.R.], leave to appeal refused 1997 CarswellNat 3240 (S.C.C.).

⁴⁸² *Free World Trust c. Electro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at para. 31.

⁴⁸³ *Eli Lilly & Co. v. O’Hara Manufacturing Ltd.*, 1989 CarswellNat 504, 26 C.P.R. (3d) 1 (Fed. C.A.).

what was the intention of the inventor”, those references to the inventor’s intention refer to an objective manifestation of that intent in the patent claims, as interpreted by the person skilled in the art, and do not contemplate extrinsic evidence such as statements or admissions made in the course of patent prosecution.⁴⁸⁴

The general rule is that extrinsic evidence is inadmissible for the purpose of construing a patent specification and this must necessarily extend to the testimony of the inventor pertaining to the proper construction of the specification.⁴⁸⁵

Likewise, if the direct testimony of the inventor is not admissible to assist in the construction of the patent, it follows that statements made elsewhere by the inventor would also not be admissible, as statements of the intention of the inventor.⁴⁸⁶

The inventor’s testimony may still be admissible to prove facts in the case other than the construction of the patent⁴⁸⁷ such as why a typical result was used instead of mean values.⁴⁸⁸

6.7.3.5 Other Patents of the Same Owner

The intention of the inventor is not to be assessed subjectively. The intention is derived from the wording of the claims read in context harmoniously with its purpose. In *Whirlpool* and *Free World*, the Supreme Court made it abundantly clear that the objective intention of the inventor is to be found within the four corners of the patent. Therefore, a later issued patent cannot be used to establish such intention or the meaning of a word.⁴⁸⁹

⁴⁸³ *Eli Lilly & Co. v. O’Hara Manufacturing Ltd.*, 1989 CarswellNat 504, 26 C.P.R. (3d) 1 (Fed. C.A.).

⁴⁸⁴ *Free World Trust c. Electro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at paras. 61 & 66.

⁴⁸⁵ *Apotex Inc. v. AstraZeneca Canada Inc.*, 2017 FCA 9, 2017 CarswellNat 40, 2017 CarswellNat 10632 (F.C.A.) per Gauthier J.A., Pelletier & Scott J.J.A. concurring at para. 47, leave to appeal refused 2017 CarswellNat 2529, 2017 CarswellNat 2530 (S.C.C.); *Nekoosa Packaging Corp. v. AMCA International Ltd.*, 1994 CarswellNat 2980, 56 C.P.R. (3d) 470 (Fed. C.A.) per Robertson J.A. at 479 [C.P.R.]; *Bourgault Industries Ltd. v. Flexi-Coil Ltd.*, 1998 CarswellNat 2125, 1998 CarswellNat 5284, [1998] F.C.J. No. 264, 141 F.T.R. 268, 80 C.P.R. (3d) 1 (Fed. T.D.), affirmed on reconsideration 1998 CarswellNat 5189, 1998 CarswellNat 554 (Fed. T.D.), affirmed 1999 CarswellNat 4756, 1999 CarswellNat 380 (Fed. C.A.), leave to appeal refused 2000 CarswellNat 393, 2000 CarswellNat 394 (S.C.C.).

⁴⁸⁶ *Pallmann Maschinenfabrik GmbH Co. KG v. CAE Machinery Ltd.*, 1995 CarswellNat 149, 62 C.P.R. (3d) 26 (Fed. T.D.) at 43 [C.P.R.].

⁴⁸⁷ *Bourgault Industries Ltd. v. Flexi-Coil Ltd.*, 1998 CarswellNat 2125, 1998 CarswellNat 5284, [1998] F.C.J. No. 264, 141 F.T.R. 268, 80 C.P.R. (3d) 1 (Fed. T.D.) at para. 26, affirmed on reconsideration 1998 CarswellNat 5189, 1998 CarswellNat 554 (Fed. T.D.), affirmed 1999 CarswellNat 4756, 1999 CarswellNat 380 (Fed. C.A.), leave to appeal refused 2000 CarswellNat 393, 2000 CarswellNat 394 (S.C.C.).

⁴⁸⁸ *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J. at para. 122.

⁴⁸⁹ *Apotex Inc. v. AstraZeneca Canada Inc.*, 2017 FCA 9, 2017 CarswellNat 40, 2017 CarswellNat 10632 (F.C.A.) per Gauthier J.A., Pelletier & Scott J.J.A. concurring at para. 47, leave to appeal

6.7.3.6 Other Canadian Decisions Construing the Same Patent

In respect of claim construction, inasmuch as it is an issue of law for the Court to decide, there should, in theory at least, be only one correct answer regardless of the expert evidence brought to bear upon it.⁴⁹⁰ The Court should be cautious and generally loathe to adopt an inconsistent construction of the same patent. The need for predictability and consistency dictates such an approach.⁴⁹¹

However, because claim construction is to be informed by what would have been understood by a person of ordinary skill in the art, the evidence of what that person may believe could differ in different cases.

In *Apotex Inc. v. Pfizer Canada Inc.*,⁴⁹² Justice O'Reilly determined that he was bound by the doctrine of stare decisis to accept the construction given to a patent by a judge of the Federal Court in a previous action. Even where the evidentiary record was different and where the earlier judge sat on the same court, a subsequent judge will be bound by the construction of a patent given by an earlier judge so long as there is no basis for concluding that the earlier judge was “manifestly wrong”.⁴⁹³

refused 2017 CarswellNat 2529, 2017 CarswellNat 2530 (S.C.C.); *Ductmate Industries Inc. v. Exanno Products Ltd.*, 1984 CarswellNat 603, 2 C.P.R. (3d) 289 (Fed. T.D.) per Reed J. at 299 [C.P.R.] (regarding sufficiency of disclosure); *Johnson & Johnson Inc. v. Boston Scientific Ltd. / Boston Scientifique Ltee*, 2008 FC 552, 2008 CarswellNat 3312, 2008 CarswellNat 1375 (F.C.) per Layden-Stevenson J. at para. 206, additional reasons 2008 CarswellNat 2118, 2008 CarswellNat 4560 (F.C.).

⁴⁹⁰ *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2007 FC 446, 2007 CarswellNat 976, 2007 CarswellNat 2196, 59 C.P.R. (4th) 166 (F.C.) per Barnes J., at para. 30, affirmed 2007 CarswellNat 2107, 2007 CarswellNat 2573 (F.C.A.). The same judge adopted the same construction of the same patent claims in subsequent litigation *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2010 FC 447, 2010 CarswellNat 1112, 2010 CarswellNat 2437 (F.C.) per Heneghan J. at para. 71, reversed 2011 CarswellNat 3227, 2011 CarswellNat 4446 (F.C.A.), leave to appeal refused 2012 CarswellNat 193, 2012 CarswellNat 194 (S.C.C.). On appeal, at para. 22, the Federal Court of Appeal held that Apotex, which was not a party to the previous proceeding, was not precluded from asserting a different construction of the patent based on an issue that was not previously raised.

⁴⁹¹ *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2007 FC 446, 2007 CarswellNat 976, 2007 CarswellNat 2196, 59 C.P.R. (4th) 166 (F.C.) per Barnes J. at para. 32, affirmed 2007 CarswellNat 2107, 2007 CarswellNat 2573 (F.C.A.). See also *Procter & Gamble Pharmaceuticals Canada Inc. v. Canada (Minister of Health)*, 2004 FC 204, 2004 CarswellNat 2894, 2004 CarswellNat 575, 32 C.P.R. (4th) 224, [2004] F.C.J. No. 374 (F.C.) per Snider J. at para. 19, affirmed 2004 CarswellNat 4223, 2004 CarswellNat 5423 (F.C.A.), leave to appeal refused 2005 CarswellNat 939, 2005 CarswellNat 940 (S.C.C.) and *Almecon Industries Ltd. v. Anchoortek Ltd.*, 2001 FCT 1404, 2001 CarswellNat 3428, 2001 CarswellNat 2949, 17 C.P.R. (4th) 74, [2001] F.C.J. No. 1956 (Fed. T.D.) per Gibson J. at para. 29, affirmed 2003 CarswellNat 975, 2003 CarswellNat 1744 (Fed. C.A.). See *Janssen Inc. v. Actavis Pharma Co.*, 2016 FC 1361, 2017 CarswellNat 33, 2017 CarswellNat 3014 (F.C.) per O'Reilly J. at para. 29 where the same claim construction as that by Justice Zinn in *Janssen-Ortho Inc. v. Canada (Minister of Health)*, 2010 FC 42, 2010 CarswellNat 1445, 2010 CarswellNat 199 (F.C.), additional reasons 2010 CarswellNat 2356, 2010 CarswellNat 442 (F.C.) was adopted.

⁴⁹² 2013 FC 493, 2013 CarswellNat 1543, 2013 CarswellNat 3153 (F.C.) per O'Reilly J., affirmed 2014 CarswellNat 4387, 2014 CarswellNat 413 (F.C.A.).

Decisions of the court on *PMNOC* proceedings are provisional only and do not bind another court however, where the construction issues were not to be resolved on the strength of much, if any, specialized knowledge, the unanimous views of the Federal Court of Appeal carry some persuasive weight.⁴⁹⁴

6.7.3.7 Foreign Decisions and Issue Estoppel

The Federal Court is not bound by decisions made in other jurisdictions,⁴⁹⁵ however, it will sometimes look to the corresponding US litigation for a consistent interpretation.⁴⁹⁶

Canadian patent cases often have foreign counterparts but, because the patent laws in other countries are different, and because the corresponding patents are also usually different, Canadian courts have not yet applied issue estoppel in a Canadian patent case. As stated by Justice Hughes in *Bayer Inc. v. Cobalt Pharmaceuticals Co.*:

None of these decisions is precedential in a Canadian Court. There may be many differences in the patents considered there, and here, that are critical. The evidence may have been different. There are differences in the law. I therefore note that different Courts and different judges can and do come to different results. These cases illustrate that. This is particularly so where the cases are vigorously contested and the decisions to be made could, in many cases, go either way; depending on the specifics of the patent, the evidence and the law with which each Court had to deal.⁴⁹⁷

Res judicata is a legal principle that provides that there should be finality to litigation and that no person should be subjected to action at the instance of the same individual more than once in relation to the same issue.⁴⁹⁸

⁴⁹³ *Apotex Inc. v. Pfizer Canada Inc.*, 2013 FC 493, 2013 CarswellNat 1543, 2013 CarswellNat 3153 (F.C.) per O'Reilly J. at para. 17, affirmed 2014 CarswellNat 4387, 2014 CarswellNat 413 (F.C.A.).

⁴⁹⁴ *AstraZeneca Canada Inc. v. Apotex Inc.*, 2015 FC 322, 2015 CarswellNat 7715, 2015 CarswellNat 656 (F.C.) per Barnes J. at para. 175, reversed in part 2017 CarswellNat 40, 2017 CarswellNat 10632 (F.C.A.), leave to appeal refused 2017 CarswellNat 2529, 2017 CarswellNat 2530 (S.C.C.).

⁴⁹⁵ *Lubrizol Corp. v. Imperial Oil Ltd.*, 1992 CarswellNat 1049, 45 C.P.R. (3d) 449 (Fed. C.A.), additional reasons 1993 CarswellNat 1964 (Fed. C.A.), leave to appeal refused 1993 CarswellNat 2472 (S.C.C.); *Kirin-Amgen Inc. v. Hoffmann-La Roche Ltd. / Hoffmann-La Roche Ltée*, 1999 CarswellNat 265, 1999 CarswellNat 4445, 87 C.P.R. (3d) 1 (Fed. T.D.), affirmed 2000 CarswellNat 3187, 2000 CarswellNat 4941 (Fed. C.A.); *Apotex Inc. v. Wellcome Foundation Ltd.*, 1998 CarswellNat 5160, 1998 CarswellNat 458, 79 C.P.R. (3d) 193 (Fed. T.D.), reversed in part 2000 CarswellNat 2643, 2000 CarswellNat 3414 (Fed. C.A.), affirmed 2002 CarswellNat 3436, 2002 CarswellNat 3437 (S.C.C.).

⁴⁹⁶ *Varco Canada Ltd. v. Pason Systems Corp.*, 2013 FC 750, 2013 CarswellNat 3356, 2013 CarswellNat 4866 (F.C.) per Phelan J. at para. 187.

⁴⁹⁷ *Bayer Inc. v. Cobalt Pharmaceuticals Co.*, 2013 FC 1061, 2013 CarswellNat 5342, 2013 CarswellNat 3789 (F.C.) per Hughes J. at para. 21, affirmed 2015 CarswellNat 1358, 2015 CarswellNat 4841 (F.C.A.).

⁴⁹⁸ *Connaught Laboratories Ltd. v. Medeva Pharma Ltd.*, 1999 CarswellNat 2809, 1999 CarswellNat 4416, 4 C.P.R. (4th) 508 (Fed. T.D.) at 515 [C.P.R.] per Sharlow J., affirmed 2000 CarswellNat

Issue estoppel is a sub-category of *res judicata* that provides that where an issue has been decided in one action between the parties, that decision is conclusive in a later action between the same parties.⁴⁹⁹

Three conditions are required for issue estoppel:

- (1) the same question has been decided;
- (2) the decision which is said to create the estoppel was final; and
- (3) the parties to the judicial decision or their privies were the same persons as the parties to the proceedings in which the estoppel is raised or their privies.⁵⁰⁰

Because claim construction is a question of law, the claim construction in another country would be determined under that country's law and the first criterion of issue estoppel is not met. The practice, procedure and jurisprudence are different.⁵⁰¹

It is open however to plead issue estoppel in respect of findings of fact⁵⁰² and law, so long as it is the same issue that arises in the foreign litigation.⁵⁰³

5394, 2000 CarswellNat 808 (Fed. C.A.) citing *Thomas v. Trinidad & Tobago (Attorney General)* (1990), 115 N.R. 313 (Trinidad & Tobago P.C.) at 316.

⁴⁹⁹ *Apotex Inc. v. Merck & Co.*, 2002 CarswellNat 1188, 2002 CarswellNat 2310, 19 C.P.R. (4th) 163 (Fed. C.A.) per Malone J.A. at 175, leave to appeal refused 2003 CarswellNat 280, 2003 CarswellNat 281 (S.C.C.); *Connaught Laboratories Ltd. v. Medeva Pharma Ltd.*, 1999 CarswellNat 2809, 1999 CarswellNat 4416, 4 C.P.R. (4th) 508 (Fed. T.D.) per Sharlow J. at 512-513 [C.P.R.], affirmed 2000 CarswellNat 5394, 2000 CarswellNat 808 (Fed. C.A.).

⁵⁰⁰ *Danyluk v. Ainsworth Technologies Inc.*, 2001 CarswellOnt 2434, 2001 CarswellOnt 2435, [2001] 2 S.C.R. 460 (S.C.C.) per Binnie J at 477 [S.C.R.], citing *Angle v. Minister of National Revenue*, 1974 CarswellNat 375, 1974 CarswellNat 375F, [1975] 2 S.C.R. 248 (S.C.C.) at 254 [S.C.R.].

⁵⁰¹ *Johnson & Johnson Inc. v. Boston Scientific Ltd. / Boston Scientifique Ltee*, 2008 FC 552, 2008 CarswellNat 3312, 2008 CarswellNat 1375, 71 C.P.R. (4th) 123 (F.C.) per Layden-Stevenson J. at para. 268, additional reasons 2008 CarswellNat 2118, 2008 CarswellNat 4560 (F.C.); *Apotex Inc. v. Wellcome Foundation Ltd.*, 1996 CarswellNat 691, 68 C.P.R. (3d) 23 (Fed. T.D.) per Tremblay-Lamer J. at 38 [C.P.R.]. Accordingly, it has not been permitted to be pleaded as it is not tenable in law: *Astrazeneca Canada Inc. v. Apotex Inc.*, 2011 CarswellNat 3372, 95 C.P.R. (4th) 414 (F.C.) per Lafreniere, Proth. at 417 [C.P.R.], para. 7, affirmed 2011 CarswellNat 3220 (F.C.), affirmed 2012 CarswellNat 475, 2012 CarswellNat 3783 (F.C.A.).

⁵⁰² In *Apotex Inc. v. Pfizer Ireland Pharmaceuticals*, 2011 FCA 77, 2011 CarswellNat 1788, 2011 CarswellNat 456, 93 C.P.R. (4th) 42 (F.C.A.), the Federal Court of Appeal referred to *Connaught* and recognized that: "it may be open to a judge to apply the doctrines of issue estoppel or abuse of process in the later proceeding to prevent a party from relitigating certain factual and legal issues decided in the earlier proceeding."; *Astrazeneca Canada Inc. v. Apotex Inc.*, 2011 CarswellNat 3372, 95 C.P.R. (4th) 414 (F.C.) per Lafreniere, Proth. at 417 [C.P.R.], para. 7, affirmed 2011 CarswellNat 3220 (F.C.), affirmed 2012 CarswellNat 475, 2012 CarswellNat 3783 (F.C.A.).

⁵⁰³ See, for example, *Kirin-Amgen Inc. v. Boehringer Mannheim GMBH* (1996), [1997] F.S.R. 289 (C.A.) at 314, per Aldous L.J.:

... I envisage cases where issue estoppel will arise in patent actions. For instance, the same issue can arise in different countries of the world, for example whether a particular scientific effect occurs when the invention or a manufacturing process is carried out, or how an infringing

However, an admission made in a foreign proceeding, which is expressly stated to be for the purpose of that proceeding only, cannot be relied upon to establish that very fact in another proceeding, in another jurisdiction.⁵⁰⁴

The Courts have declined to apply issues estoppel where new evidence is before the Court that was unavailable in the prior proceedings.⁵⁰⁵

Even if the conditions for issue estoppel are met, it is a matter of discretion for the judge as to whether it is an appropriate case to apply it⁵⁰⁶ to achieve fairness or and not work an injustice.⁵⁰⁷

6.7.4 Use of Language: Synecdoche or Metonymy

In *Improver*,⁵⁰⁸ Justice Hoffman restated the *Catnic* test to be one searching for the meaning of terms (rather than one permitting redrafting of the claims so as to ignore or vary claim elements):

If the issue was whether a feature embodied in an alleged infringement which fell outside the primary, literal or acontextual meaning of a descriptive word or phrase in the claim (“a variant”) was nevertheless within its language as properly interpreted, the court should ask itself the following three questions:

1. Does the variant have a material effect upon the way the invention works? If yes, then the variant is outside the claim. If no?
2. Would this (i.e. that the variant had no material effect) have been obvious at the date of publication of the patent to a reader of the patent skilled in the art? If no, the variant is outside the claim. If yes?

product is made, or the properties of a product or its composition. Thus, this judgment should not be taken as concluding that issue estoppel has no place in patent actions. To the contrary, I believe that it does in appropriate cases.

⁵⁰⁴ *Johnson & Johnson Inc. v. Boston Scientific Ltd. / Boston Scientifique Lte e*, 2008 FC 552, 2008 CarswellNat 3312, 2008 CarswellNat 1375, 71 C.P.R. (4th) 123 (F.C.) per Layden-Stevenson J. at para. 265, additional reasons 2008 CarswellNat 2118, 2008 CarswellNat 4560 (F.C.).

⁵⁰⁵ *Novartis Pharmaceuticals Canada Inc. v. RhoxalPharma Inc.*, 2001 CarswellNat 2087, 2001 CarswellNat 351, 11 C.P.R. (4th) 370 (Fed. T.D.) per Tremblay-Lamer J., affirmed 2001 CarswellNat 2722, 2001 CarswellNat 5100 (Fed. C.A.); *Novartis Pharmaceuticals Canada Inc. v. RhoxalPharma Inc.*, 2004 FC 474, 2004 CarswellNat 1312, 2004 CarswellNat 3918 (F.C.), per Lemieux J. reversed on other grounds 2005 FCA 11, 2005 CarswellNat 1327, 2005 CarswellNat 457 (F.C.A.).

⁵⁰⁶ *Johnson & Johnson Inc. v. Boston Scientific Ltd. / Boston Scientifique Lte e*, 2008 FC 552, 2008 CarswellNat 3312, 2008 CarswellNat 1375, 71 C.P.R. (4th) 123 (F.C.) per Layden-Stevenson J. at para. 263, additional reasons 2008 CarswellNat 2118, 2008 CarswellNat 4560 (F.C.).

⁵⁰⁷ *Danyluk v. Ainsworth Technologies Inc.*, 2001 CarswellOnt 2434, 2001 CarswellOnt 2435, [2001] 2 S.C.R. 460 (S.C.C.) per Binnie J. at 481, 492, 493 and 498 [S.C.R.].

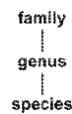
⁵⁰⁸ *Improver Corp. v. Remington Consumer Products Ltd.* (1989), [1990] F.S.R. 181 (Eng. Patents Ct.).

3. Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention? If yes, then the variant is outside the claim.⁵⁰⁹

On the other hand, a negative answer to the last question would lead to the conclusion that the patentee was intending the word or phrase to have not a literal but a figurative meaning (the figure being a form of synecdoche or metonymy) denoting a class of things which include the variant and the literal meaning, the latter being the most perfect, best-known or striking example of the class.”⁵¹⁰ [emphasis added]

It is ironic that in a judgment meant to assist one in knowing how to interpret words or phrases, one must resort to a dictionary to understand it:

- “Synecdoche” is defined⁵¹¹ as “a figure of speech in which a more inclusive term is used for a less inclusive one or vice versa, as a whole for a part or a part for a whole.” In this respect, a specie is used to refer to the genus, or vice versa.



For example, one could claim, as a claim element, a bolt. Obvious mechanical equivalents would include a nail and a rivet. These fasteners would be species of the genus “fastener” or “fastening means”.⁵¹²



⁵⁰⁹ *Improver Corp. v. Remington Consumer Products Ltd.* (1989), [1990] F.S.R. 181 (Eng. Patents Ct.) at 189.

⁵¹⁰ *Kirin-Amgen Inc. v. Transkaryotic Therapies Inc. (No. 2)* (2004), [2004] UKHL 46, [2005] 1 All E.R. 667 (U.K. H.L.) at 686 [All E.R.], para. 51.

⁵¹¹ *Shorter Oxford English Dictionary*, 5th ed. (Toronto: Oxford University Press, 2002).

⁵¹² For example, in *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2013 FC 947, 2013 CarswellNat 4788, 2013 CarswellNat 3398 (F.C.) per Barnes J. at paras. 44-47, additional reasons 2013 CarswellNat 3777, 2013 CarswellNat 4789 (F.C.), affirmed 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.), the Court held that the use of the more generic term “moveable switch contact element” was indicative of the intent to not limit the claims to only one type of switch; affirmed 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring.

- “Metonymy” is defined⁵¹³ as “(1) The substitution of a word denoting an attribute or adjunct of a thing denoting the thing itself; and instance of this. (2) A thing used or regarded as a substitute or symbol of something else.”

Hoffman J.’s characterization of the *Catnic* test changes it into one dealing with situations involving a variant from the literal or acontextual meaning of the word that is nevertheless within the language of the claim, as properly interpreted. It would appear to be a form of “all elements” test rather than one that allows the substitution or omission of a non-essential element, as *Catnic* expressly contemplated.

Hoffman, J.’s synecdoche/metonymy point appears to be a genus—species point. The way the patentee used that word or phrase, in that context, would make a reader understand that the word or phrase was referring to the genus and not the specific specie, the genus including those things which everyone would know, at the relevant time, could be substituted for the element at issue and which would have no material effect on the way the invention worked. Likewise, (although not dealt with by Hoffman J. in *Improver*) for a synecdoche, the reader might understand that although the patentee was using genus language, only a particular specie was meant. Either way, the focus was on determining how the term was being used in its context, not whether the term should be written out (by omission) or re-written.

A more succinct way Hoffman J. could have stated the test would have been to ask whether a term or phrase used in the patent claim would be understood by the reader of the patent to have a broader or narrower meaning than the meaning that word or phrase has ordinarily or acontextually. In other words: With what degree of precision was the patent using the word or phrase? Such a question would have been consistent with a “purposive construction”, reading the claim language in context.

Lord Hoffmann in *Kirin-Amgen* noted that it is unusual for a specific word to be interpreted as having a meaning broader than its normal meaning:

... the invention should normally be taken as having been claimed at the same level of generality as that at which it is defined in the claims. It would be unusual for the person skilled in the art to understand a specification to be claiming an invention at a higher level of generality than that chosen by the patentee.⁵¹⁴

Without reference to the *Improver* approach, the Federal Court of Appeal appears to have agreed with its approach, recognizing that the construction of the claim may lead to an expansion or limitation of the text of the claim.⁵¹⁵

⁵¹³ *Shorter Oxford English Dictionary*, 5th ed. (Toronto: Oxford University Press, 2002).

⁵¹⁴ *Kirin-Amgen Inc. v. Transkaryotic Therapies Inc. (No. 2)* (2004), [2004] UKHL 46, [2005] 1 All E.R. 667 (U.K. H.L.) at para. 70.

6.7.4.1 Examples of Synecdoche and Metonymy

Whirlpool appears to be an example of Hoffman’s synecdoche scenario where broad language was “read down” in context to mean something more specific.

In *Whirlpool*, Justice Binnie construed an earlier art patent containing a claim for a general element (“vanes”), in context, as being limited to a narrower subset of vanes, namely “rigid vanes” and did not including the subject matter of the patent in issue, namely “flexible vanes” (or render them obvious). Thus, a term that otherwise might have been construed broadly (and included both rigid and flexible vanes), was construed narrowly (a synecdoche in the form of the genus being used to refer to a particular specie: “vanes”, used in its context, meaning “rigid vanes”).

Whirlpool, the patent owner, had a first patent (the ‘803 patent) on a washing machine having an agitator with “outwardly extending substantially vertically oriented vanes”.⁵¹⁶

The patent described the device as having “vanes” but did not specify whether the vanes were rigid or flexible (they were, in fact, rigid). *Whirlpool* also had a second patent (the ‘734 patent) which explicitly stated that the vanes of the lower oscillator of a dual action agitator were flexible (rather than rigid).⁵¹⁷

Whirlpool argued that in the first patent (the ‘803 patent), the term “vanes” meant “rigid” only and did not include flexible vanes — otherwise its second patent (the ‘703 patent) may have been anticipated by the first patent.⁵¹⁸

In the present case, the appellants seek a broad interpretation of the word “vane” in the ‘803 patent claims. It is unusual, of course, to have accused infringers arguing for a broad interpretation of the patent claims under which they have been charged. It is equally unusual for a patent owner to be demanding a narrow interpretation. The unusual role reversal is dictated by the appellants’ desire to broaden the ‘803 patent to set up their argument for the invalidity of the later ‘734 patent. They contend that the plain unvarnished meaning of the word “vane” standing on its own in claims 1 and 2 of the ‘803 patent must, as a matter of language, include both flexible vanes

⁵¹⁵ *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2007 FCA 209, 2007 CarswellNat 1434, 2007 CarswellNat 4252, 60 C.P.R. (4th) 81 (F.C.A.) per Nadon J.A., Linden and Sexton J.J.A. concurring at para. 39, leave to appeal refused 2007 CarswellNat 3850, 2007 CarswellNat 3851 (S.C.C.).

⁵¹⁶ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 154 [C.P.R.], para. 54, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

⁵¹⁷ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 139 [C.P.R.], para. 20, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

⁴³⁷ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 137 [C.P.R.], para. 14, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

and rigid vanes and that there is no call or entitlement to supplement the verbal analysis by reference to “purpose” or anything else. They plead in aid the “nose of wax” metaphor offered in the last century by the U.S. Supreme Court:

Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. (*White v. Dunbar*, 119 U.S. 47 (1886) at 51—52, per Bradley J.)⁵¹⁹

One expert said “vanes” in the ‘803 patent meant rigid vanes. Others were equivocal.⁵²⁰ None of the experts interpreted the ‘803 patent as teaching the use of flexible vanes.⁵²¹

The Court concluded that a skilled reader would consider the term “vanes” in the ‘803 patent to mean “rigid vanes” and not to include “flexible vanes”. Thus, what otherwise looked like a word with a broad meaning, read in context, at the relevant time, had a more limited meaning.

The reverse situation occurred in *Biovail Pharmaceuticals Inc. v. Canada (Minister of National Health & Welfare)*⁵²² where the Court examined a claim element that was specific to determine whether it was meant to refer to the more general genus. Every claim referred to hydroxypropyl methylcellulose (“HPMC”) as a component of a controlled release tablet.⁵²³ The respondent Novopharm used hydroxypropyl cellulose (“HPC”) a different form of non-ionic, water-soluble cellulose ether useful as a hydrogelling polymer.⁵²⁴ Each would have been useful in a sustained release tablet.⁵²⁵ Justice Harrington

⁵¹⁹ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 152 [C.P.R.], para. 51, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

⁵²⁰ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 156 [C.P.R.], paras. 57-59, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

⁵²¹ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 156 [C.P.R.], para. 60, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

⁵²² *Biovail Pharmaceuticals Inc. v. Canada (Minister of National Health & Welfare)*, 2005 CarswellNat 65, 2005 CarswellNat 1993, 37 C.P.R. (4th) 487 (F.C.) per Harrington J.

⁵²³ *Biovail Pharmaceuticals Inc. v. Canada (Minister of National Health & Welfare)*, 2005 CarswellNat 65, 2005 CarswellNat 1993, 37 C.P.R. (4th) 487 (F.C.) per Harrington J. at 499 [C.P.R.], para. 28.

⁵²⁴ *Biovail Pharmaceuticals Inc. v. Canada (Minister of National Health & Welfare)*, 2005 CarswellNat 65, 2005 CarswellNat 1993, 37 C.P.R. (4th) 487 (F.C.) per Harrington J. at 499 [C.P.R.], para. 33.

⁵²⁵ *Biovail Pharmaceuticals Inc. v. Canada (Minister of National Health & Welfare)*, 2005

asked: “Did the inventors intend to claim HPMC as an example of the greater, i.e., hydrogelling polymers, or not?”,⁵²⁶ in effect asking whether the more specific was used in this case to include the more general. Without directly answering the question, the Court found the HPMC claim element to be essential,⁵²⁷ thereby indirectly finding that the specific was not being used to refer to the more general genus.

In *Bridgeview Manufacturing Inc. v. 931409 Alberta Ltd.*,⁵²⁸ the general term “manipulator”, which, outside the context of the patent could have included any of three types of manipulators, when used in the context of the patent at issue, was limited⁵²⁹ to the type described in the “Background of the Invention” section of the patent as a “typical machine” which had rollers as the invention of the patent was an improvement of that type of manipulator.⁵³⁰

In *Bombardier Recreational Products Inc. v. Arctic Cat Inc.*⁵³¹ the otherwise broad term “snowmobile” was construed to mean one for an adult and not one for a child.⁵³²

CarswellNat 65, 2005 CarswellNat 1993, 37 C.P.R. (4th) 487 (F.C.) per Harrington J. at 500 [C.P.R.], para. 35.

⁵²⁶ *Biovail Pharmaceuticals Inc. v. Canada (Minister of National Health & Welfare)*, 2005 CarswellNat 65, 2005 CarswellNat 1993, 37 C.P.R. (4th) 487 (F.C.) per Harrington J. at 500 [C.P.R.], para. 37.

⁵²⁷ *Biovail Pharmaceuticals Inc. v. Canada (Minister of National Health & Welfare)*, 2005 CarswellNat 65, 2005 CarswellNat 1993, 37 C.P.R. (4th) 487 (F.C.) per Harrington J. at 501 [C.P.R.], para. 40.

⁵²⁸ *Bridgeview Manufacturing Inc. v. 931409 Alberta Ltd.*, 2009 FC 50, 2009 CarswellNat 712, 2009 CarswellNat 155 (F.C.) per Campbell J., reversed in part 2010 FCA 188, 2010 CarswellNat 4009, 2010 CarswellNat 2314 (F.C.A.) per Sharlow J.A., Nadon & Trudel JJ.A. concurring, leave to appeal refused 2011 CarswellNat 1109, 2011 CarswellNat 1110 (S.C.C.).

⁵²⁹ Although Justice Campbell said he gave the term an “expanded interpretation” 2009 FC 50, 2009 CarswellNat 712, 2009 CarswellNat 155 (F.C.) at para. 31, reversed in part 2010 CarswellNat 4009, 2010 CarswellNat 2314 (F.C.A.), leave to appeal refused 2011 CarswellNat 1109, 2011 CarswellNat 1110 (S.C.C.), he actually read it narrowly, as confirmed by the Federal Court of Appeal 2010 FCA 188, 2010 CarswellNat 4009, 2010 CarswellNat 2314 (F.C.A.) at para. 24, leave to appeal refused 2011 CarswellNat 1109, 2011 CarswellNat 1110 (S.C.C.).

⁵³⁰ *Bridgeview Manufacturing Inc. v. 931409 Alberta Ltd.*, 2009 FC 50, 2009 CarswellNat 712, 2009 CarswellNat 155 (F.C.) per Campbell J. at paras. 16-17, 25-27, 29 and 31, reversed in part on other grounds 2010 FCA 188, 2010 CarswellNat 4009, 2010 CarswellNat 2314 (F.C.A.) per Sharlow J.A., Nadon & Trudel JJ.A. concurring at paras. 13, 29 and 32, leave to appeal refused 2011 CarswellNat 1109, 2011 CarswellNat 1110 (S.C.C.).

⁵³¹ *Bombardier Recreational Products Inc. v. Arctic Cat Inc.*, 2017 FC 207, 2017 CarswellNat 605, 2017 CarswellNat 10520 (F.C.) per Roy J., reversed in part 2018 CarswellNat 5338, 2018 CarswellNat 5339 (F.C.A.), leave to appeal refused 2019 CarswellNat 1959, 2019 CarswellNat 1960 (S.C.C.).

⁵³² *Bombardier Recreational Products Inc. v. Arctic Cat Inc.*, 2017 FC 207, 2017 CarswellNat 605, 2017 CarswellNat 10520 (F.C.) per Roy J. at paras. 308-309, reversed in part 2018 CarswellNat 5338, 2018 CarswellNat 5339 (F.C.A.), leave to appeal refused 2019 CarswellNat 1959, 2019 CarswellNat 1960 (S.C.C.). Similarly, at para. 348, the court held that an “engine cradle” meant a walled engine cradle.

6.8 STEP 2: IS A CLAIM ELEMENT “ESSENTIAL”?

With the first step complete, the Court has given a meaning to the word or phrase in the claim.

The second group of principles set out in *Free World* provided that the claim language will, on a purposive construction, show that some elements of the claimed invention are essential while others are non-essential:

The key to purposive construction is therefore the identification by the court, with the assistance of the skilled reader, of the particular words or phrases in the claims that describe what the inventor considered to be the “essential” elements of his invention.⁵³³

Trudel, J.A. of the Federal Court of Appeal rephrased the test this way:

When construing a patent claim, the task of a trial judge is to separate and to distinguish those elements of the claim that “are essential if the devices are to work as contemplated and claimed by the inventor” and the non-essential elements that “may be substituted or omitted without having a material effect on either the structure or the operation of the invention described in the claims” in order to define the boundaries of legal protection to which the patent is entitled (*Free World Trust v. E’lectro Sante’ Inc. et al.*, 2000 SCC 66 at paragraphs 15 and 20).⁵³⁴

This determination is relevant to the application of the claim construction to (at least) infringement: 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.⁵³⁵

⁵³³ *Free World Trust c. E’lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 183-184 [C.P.R.], para. 31(e). and *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 147 [C.P.R.], para. 45, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

⁵³⁴ *McKay v. Weatherford Canada Ltd.*, 2008 FCA 369, 2008 CarswellNat 5666, 2008 CarswellNat 4491 (F.C.A.) per Trudel J.A. at para. 17, leave to appeal refused 2009 CarswellNat 855, 2009 CarswellNat 856 (S.C.C.).

⁵³⁵ *Free World Trust c. E’lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 183-184 [C.P.R.], para. 31 and *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 147 [C.P.R.], para. 45, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.) following *J.K. Smit & Sons Inc. v. McClintock*, 1939 CarswellNat 64, [1940] S.C.R. 279 (S.C.C.) per Duff C.J. at 285 [S.C.R.] and *McPhar Engineering Co. v. Sharpe Instruments Ltd.*, 1960 CarswellNat 42, [1956-60] Ex. C.R. 467 (Can. Ex. Ct.) per Thorson P. at 525 [Ex. C.R.], *Marconi & Marconi’s Wireless Telegraph Co. v. British Radio Telegraph & Telephone Co.* (1911), 28 R.P.C. 181 (Unknown Court) at 217, *Birmingham Sound Reproducers Ltd. v. Collaro Ltd.*, [1956] R.P.C. 232 (C.A.) and *C. Van der Lely N.V. v. Bamfords Ltd.*, [1963] R.P.C. 61 (U.K. H.L.) per Lord Reid.

In essence, the purpose is to identify what it is in the claims that the inventor considered to be essential.⁵³⁶ Claim elements are presumed to be essential, and a party alleging otherwise bears the onus of establishing non-essentiality.⁵³⁷

This analysis presupposes that, at least in some cases, a claim will have a non-essential element, which element can be substituted or omitted.⁵³⁸ Thus, in this part of the *Free World* analysis, the Court is effectively re-writing the claim by replacing the non-essential element with something other than what it was (a substitute or “variant”) or deleting the word or phrase from the claim altogether (by declaring it non-essential and ignoring it).

After analogizing patent claims to “fences”, Mr. Justice Binnie stated:

In reality, the “fences” often consist of complex layers of definitions of different elements (or “components” or “features” or “integers”) of differing complexity, substitutability and ingenuity. A matrix of descriptive words and phrases defines the monopoly, warns the public and ensnares the infringer. In some instances, the precise elements of the “fence” may be crucial or “essential” to the working of the invention as claimed; in others the inventor may contemplate, and the reader skilled in the art appreciate, that variants could easily be used or substituted without making any material difference to the working of the invention. The interpretative task of the court in claims construction is to separate the one from the other, to distinguish the essential from the inessential, and to give to the “field” framed by the former the legal protection to which the holder of a valid patent is entitled.⁵³⁹ [emphasis added]

In *Free World*, Justice Binnie said:

- (e) ... The identification of elements as essential or non-essential is made:
...
 - (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

⁵³⁶ *Bristol-Myers Squibb Co. v. Apotex Inc.*, 2009 FC 137, 2009 CarswellNat 341, 2009 CarswellNat 6722 (F.C.) per Hughes J. at para. 37.

⁵³⁷ *MediaTube Corp. v. Bell Canada*, 2017 FC 6, 2017 CarswellNat 18, 2017 CarswellNat 3277 (F.C.) per Locke J. at para. 33, affirmed 2019 CarswellNat 2404, 2019 CarswellNat 14152 (F.C.A.), leave to appeal refused 2020 CarswellNat 826, 2020 CarswellNat 827 (S.C.C.). See also *Distrimedic Inc. v. Dispill Inc.*, 2013 FC 1043, 2013 CarswellNat 3663, 2013 CarswellNat 5722 (F.C.) at para. 201.

⁵³⁸ That may not always be the case. In *Weatherford Canada Ltd. v. Corlac Inc.*, 2011 FCA 228, 2011 CarswellNat 2835, 2011 CarswellNat 3714 (F.C.A.) per Layden-Stevenson J.A., Nadon & Evans JJ.A. concurring at para. 27, leave to appeal refused 2012 CarswellNat 846, 2012 CarswellNat 847 (S.C.C.), the court held that unless a party maintains that a claim element is not essential, it will be considered to be essential.

⁵³⁹ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 178-179 [C.P.R.], para. 15.

- (iv) according to the intent of the inventor, expressed or inferred from the claims, that a particular element is essential irrespective of its practical effect⁵⁴⁰

6.8.1 Judicial Readings of *Free World* and *Whirlpool* Consistent with *Catnic* and *Improver*

Some authors (including this one) have tried to give *Free World* and *Whirlpool* purposive constructions, assuming that Justice Binnie must have not intended to reformulate the *Catnic* and *Improver* questions as disjunctive “or” questions.

Because Justice Binnie agreed with *Catnic* and *Improver*, he must have intended to have his test be consistent with the two step questions of *Catnic* and *Whirlpool*.

In 2010, Justice Gauthier said, in addressing the second *Free World* or *Whirlpool* question, that this sentence cannot be construed as meaning that the Supreme Court found the third question in *Improver*⁵⁴¹ to be irrelevant.⁵⁴² Expressed as a positive: the Supreme Court still required the third question in *Improver* to be asked.

Mr. Justice Locke has politely noted that “the series of three questions from *Improver* does not appear to be entirely consistent with the two-part analysis” earlier in paragraph 55 of *Free World*⁵⁴³ which said the test for non-essentiality was a disjunctive (“or”). Justice Locke stated:

“... under the *Improver* test, the defendant need only be successful on one of the questions. In order for the patentee to establish that a claim element is not essential, it must succeed on all three questions. On the other hand, the SCC’s characterization of the analysis appears to indicate that the defendant must be successful on both parts of the analysis, and that the patentee can establish that a claim element is not essential by succeeding on just one part.

⁵⁴⁰ *Free World Trust c. Electro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 183-184 [C.P.R.], para. 31.

⁵⁴¹ See Chapter 6.3.3 above:

3. Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention? If yes, then the variant is outside the claim.

⁵⁴² *Bauer Hockey Corp. v. Easton Sports Canada Inc.*, 2010 FC 361, 2010 CarswellNat 3031, 2010 CarswellNat 796 (F.C.) per Gauthier J. at para. 144, affirmed 2011 CarswellNat 4827, 2011 CarswellNat 561 (F.C.A.). Although the inventor knew that the tendon guard could be attached in an overlapping fashion [substitutable, and therefore non-essential under the first *Improver* question], it was also evident that he chose to limit his monopoly to tendon guards attached in a side-by-side fashion [intention of the inventor as expressed in the claims and therefore essential under the second *Improver* question].

⁵⁴³ *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J. at para. 135.

It seems unlikely that the SCC intended this apparent difference. Its decision does not acknowledge any inconsistency between the *Improver* questions and its own test for determining essentiality. Nor does the SCC suggest any disapproval of the *Improver* questions. In fact, the SCC clearly relies in *Improver*.⁵⁴⁴

Justice Locke refers to the earlier analysis in this chapter at para. 142:

“More recently, Donald M. Cameron addressed this issue in *Canadian Patent Law Benchbook*, 2nd ed., D.M. Cameron ed., Carswell, 2014, at p. 375, making another attempt at reconciling the inconsistency which effectively reads the *Free World Trust* characterisation of the test as conjunctive.”⁵⁴⁵

6.8.2 Q. #1: The “Obviously Substitutable” Claim Element

The first question, in essence, asks: “Does the element really matter as to how the invention works?” If it matters, it is essential.

This question echoes the line of cases holding that the “pith and substance” of the invention is taken when a minor modification of the invention is made.

The first question set out in *Free World* by Justice Binnie as a way of determining whether a claim element was essential or non-essential was:

... 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.⁵⁴⁶

Presumably, if it would have been obvious that a variation or omission of a particular claim element would not make a difference to the way in which the invention works, then such element would be superfluous, or irrelevant, and it had to be obviously so.

This part of the question was derived from the language used in *Catnic* by Lord Diplock:

The question in each case is: whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used, would understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that any variant would fall outside the monopoly claimed, even though it could have no material effect upon the way the invention worked.

⁵⁴⁴ *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J. at paras. 135-136.

⁵⁴⁵ *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J. at para. 142.

⁵⁴⁶ *Free World Trust c. E' lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 193 [C.P.R.], para. 55(e)(iii).

The question, of course, does not arise where the variant would in fact have a material effect upon the way the invention worked. Nor does it arise unless at the date of publication of the specification it would be obvious to the informed reader that this was so. Where it is not obvious, in the light of then-existing knowledge, the reader is entitled to assume that the patentee thought at the time of the specification that he had good reason for limiting his monopoly so strictly and had intended to do so, even though subsequent work by him or others in the field of the invention might show the limitation to have been unnecessary.⁵⁴⁷ [emphasis added]

Although *Catnic* asked whether there was a “material” effect on the way the invention worked and *Free World* merely asked whether the variant made “a” difference, there probably needs to have been a material rather than an immaterial difference.

6.8.2.1 The Presence of a Variant

Somewhat illogically, this part of the analysis has as a precondition that the device or process under consideration varies from what is claimed.

So there is, at least, some preliminary construction given to the claim which is then compared with, perhaps, the infringing device, to determine “what is the difference”. The defendant’s device or process in the case of an action for infringement or a piece of prior art in the case of validity, lacks or has varied a particular element of the claimed invention to be “the variant” under consideration. This precondition of there being a variant underlines the observation made by Lord Hoffman in the *Kirin-Amgen* case, discussed in Chapter 6.10.1 below, that the *Catnic* test was not meant to be a test of general application but rather to be applied only in circumstances where there was a variant present.⁵⁴⁸

After already deciding that the variant is not within the claim language (by some form of initial construction), following in the footsteps of the *Catnic* test, the *Free World* test then asks the circular question as to whether the variant should be included in the claim.

As discussed above in Chapter 6.3.3, *Improver* specifically requires this initial construction to be done “acontextually”.⁵⁴⁹ No such restriction is imposed in *Catnic* or *Free World*.

⁵⁴⁷ *Catnic Components Ltd. v. Hill & Smith Ltd.* (1981), [1982] R.P.C. 183 (U.K. H.L.) per Lord Diplock at 242-243, affirmed (1982), [1983] F.S.R. 512 (U.K. H.L.).

⁵⁴⁸ *Kirin-Amgen Inc. v. Transkaryotic Therapies Inc. (No. 2)*, [2004] UKHL 46, [2005] 1 All E.R. 667 (U.K. H.L.) at paras. 52 and 71.

⁵⁴⁹ *Improver Corp. v. Remington Consumer Products Ltd.* (1989), [1990] F.S.R. 181 (Eng. Patents Ct.) at 189.

6.8.2.2 Does the Variant Affect the Way the Invention Works?

The first part of the *Free World* question requires a comparison to be made, by the notional person skilled in the art,⁵⁵⁰ between the way the invention works with the claim element and the way it works without the element or as replaced by the variant. According to Linden J.A. in *Janssen Pharmaceutica Inc. v. Apotex Inc.*:

... the question of equivalence supposes that the person skilled in the art is told of both the invention and the variant and asked whether the variant would obviously work in the same way⁵⁵¹

“Working in the same way” means the variant “... would perform substantially the same function in substantially the same way to obtain substantially the same result.”⁵⁵² The criterion is not whether the variant improves the performance of the invention but rather does it have a significant effect on how the device functions, be it positive or negative.⁵⁵³

a) The Way the Invention Works

How does one determine the way in which the invention works as a point to start the comparison? Presumably it is the invention as claimed that is considered — but that is what is trying to be determined in the first place, making the analysis circular.

As a starting point for the comparison, does one envisage a hypothetical product, made according to the preferred embodiment taught in the disclosure of the patent or does one examine the plaintiff’s product, determine whether it

⁵⁵⁰ In *Quadco Equipment Inc. v. Timberjack Inc.*, 2002 CarswellNat 233, 2002 CarswellNat 6151, 17 C.P.R. (4th) 224 (Fed. T.D.) per Heneghan J., at para. 23, Justice Heneghan expressed an unusual variant on the *Free World* test that assumed essentiality unless it was obvious that *the inventor knew* that the element was immaterial:

The fact remains however that strict compliance with a word or phrase will be considered an essential requirement by the courts unless it is obvious that *the inventor knew* that a failure to comply with that requirement would have no material effect on the way the invention worked. [emphasis added]

⁵⁵¹ 2001 CarswellNat 1631, 2001 CarswellNat 3174, 13 C.P.R. (4th) 410 (Fed. C.A.) per Linden J.A., Isaac and Malone JJ.A. concurring at 429-430 [C.P.R.], para. 48, citing *Improver*, at 192, *Free World Trust*, at para. 55 as authorities.

⁵⁵² *Free World Trust c. Electro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 193 [C.P.R.], para. 55, borrowing language from the U.S. decisions *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931 (Fed. Cir., 1987) and *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (Ohio S.C., 1997), per Thomas J., at 37; *Janssen Pharmaceutica Inc. v. Apotex Inc.*, 2001 FCA 247, 2001 CarswellNat 1631, 2001 CarswellNat 3174 (Fed. C.A.) per Linden J.A., Isaac C.J. and Malone JJ.A. concurring at para. 38.

⁵⁵³ *Hollick Solar Systems Ltd. v. Matrix Energy Inc.*, 2011 FC 1213, 2011 CarswellNat 4367, 2011 CarswellNat 5935 (F.C.) per Scott J. at para. 59, affirmed 2012 FCA 174, 2012 CarswellNat 1903, 2012 CarswellNat 3129 (F.C.A.) per L’Oudreau J.A., Blais C.J. and Pelletier J.A. concurring at para. 16.

is an embodiment of the invention and examine how it works? This is probably the case, because the patent must not be construed with an eye on the article allegedly made in compliance with the patent.⁵⁵⁴ It is suggested however, that if the plaintiff can establish that its device or process is made according to the patent, then the plaintiff's device or process would provide at least a "real life" example of the way the invention works which would be preferable to a hypothetical one⁵⁵⁵.

b) The Way (the Invention + the Variant) Works

Assuming one can determine how the invention works, to what does one compare it?

- (a) a hypothetical product or process that has the variant?;
- (b) a real product or method that has the variant (e.g., The defendant's product or process)?; or
- (c) the invention minus the purportedly non-essential element?

Some understanding of the operation of the allegedly infringing device is necessary to pinpoint the variants that are in contention.⁵⁵⁶

Assuming one knows how the invention works, if one compares that to how the defendant's product or method works, then claim construction is necessarily based in the reality of the defendant's device. Some case law has said the claims are to be construed without consideration of the defendant's device.⁵⁵⁷ In *Janssen Pharmaceutica Inc. v. Apotex Inc.*,⁵⁵⁸ the Federal Court of Appeal appears to have stated that the equivalence comparison can be made with the allegedly infringing product after an initial claim construction is done:

The Motions Judge was careful to construe the essentials of the claims without reference to the particular variants in the Torcan Process. Only after he had

⁵⁵⁴ *Janssen-Ortho Inc. v. Canada (Minister of Health)*, 2010 FC 42, 2010 CarswellNat 1445, 2010 CarswellNat 199 (F.C.) per Zinn J. at paras. 104-105, additional reasons 2010 CarswellNat 2356, 2010 CarswellNat 442 (F.C.).

⁵⁵⁵ See however *DuPont Canada Inc. v. Glopak Inc.*, 1998 CarswellNat 5077, 1998 CarswellNat 682, 81 C.P.R. (3d) 44 (Fed. T.D.) per Muldoon J. at paras. 27-28 holding that one does not compare the plaintiff's product to that of the defendant to determine infringement.

⁵⁵⁶ *Halford v. Seed Hawk Inc.*, 2006 FCA 275, 2006 CarswellNat 2397, 2006 CarswellNat 4150 (F.C.A.) per Sexton J.A., Sharlow & Malone JJ.A. concurring at para. 16.

⁵⁵⁷ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 148 [C.P.R.], para. 49, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.); *Janssen Pharmaceutica Inc. v. Apotex Inc.*, 2001 CarswellNat 1631, 2001 CarswellNat 3174, 13 C.P.R. (4th) 410 (Fed. C.A.) at 425 [C.P.R.], para. 36, affirming 2000 CarswellNat 182, 2000 CarswellNat 5136, 5 C.P.R. (4th) 53 (Fed. T.D.).

⁵⁵⁸ 2001 CarswellNat 1631, 2001 CarswellNat 3174, 13 C.P.R. (4th) 410 (Fed. C.A.), affirming 2000 CarswellNat 182, 2000 CarswellNat 5136, 5 C.P.R. (4th) 53 (Fed. T.D.).

completed his initial construction did he proceed to consider the issue of equivalence vis-a`-vis the Torcan [the respondent's] Process.⁵⁵⁹

In a later paragraph, the Federal Court of Appeal appears to approve using the allegedly infringing variant as a point of comparison:

He [the Motions Judge] was clearly aware of the main issue being whether Torcan's intramolecular reaction was materially different from Janssen's intermolecular acylation reaction.⁵⁶⁰

It is suggested that if the defendant's device or method has the variant or lacks the claim element at issue, it provides an empirical and realistic point of reference for determining equivalence as compared to some hypothetical device or method.

To determine whether a claim element is essential, one does not ask whether the element is novel and inventive (or presumably whether it is the element that differentiates it from the prior art).⁵⁶¹

6.8.2.3 Obvious Substitutability ... At the Time the Patent was Published

The second part of the *Free World* question also had its roots in *Catnic* where Lord Diplock phrased the question in this manner:

⁵⁵⁹ *Janssen Pharmaceutica Inc. v. Apotex Inc.*, 2001 CarswellNat 1631, 2001 CarswellNat 3174, 13 C.P.R. (4th) 410 (Fed. C.A.) at 427-428 [C.P.R.], para. 42, affirming 2000 CarswellNat 182, 2000 CarswellNat 5136, 5 C.P.R. (4th) 53 (Fed. T.D.). This case should be applied with caution as the claims at issue were "product by process" claims which, at the time, were permitted under subsection 41(1) of the Patent Act to prohibit claims for food or medicine except when prepared or produced by the methods or processes of manufacture particularly described and claimed or by their obvious chemical equivalents. Claim 1 claimed an intermolecular reaction whereas the Respondent's Torcan process used a more complicated process that involved and intramolecular reaction: "The Torcan process, therefore, attempted to add complexity to the process claimed in the Janssen Patent for the purpose of differentiating itself from the patented process." [at 420, para. 23]. Claim 5 in the *Janssen Pharmaceutica* case expressly claimed the compound "whenever prepared or produced by the process of claim 1 or by any obvious chemical equivalent thereof" [at 415, para. 11]. The Motions Judge held that the Apotex process was either within the scope of the claims or was an obvious chemical equivalent of the essential reaction described therein [at 414, para. 5]. The Court held that "...claim 1, by virtue of s-s. 41(1) of the *Patent Act*, already contemplates obvious chemical equivalents to the processes it specifically describes and claims." at 427-428 [para. 42].

⁵⁶⁰ *Janssen Pharmaceutica Inc. v. Apotex Inc.*, 2001 CarswellNat 1631, 2001 CarswellNat 3174, 13 C.P.R. (4th) 410 (Fed. C.A.) at 428 [C.P.R.], para. 44, affirming 2000 CarswellNat 182, 2000 CarswellNat 5136, 5 C.P.R. (4th) 53 (Fed. T.D.).

⁵⁶¹ *Norac Systems International Inc. v. Prairie Systems & Equipment Ltd.*, 2002 CarswellNat 4819, 2002 CarswellNat 642, 19 C.P.R. (4th) 360 (Fed. T.D.) at para. 16, reversed in part 2003 CarswellNat 938, 2003 CarswellNat 1593 (Fed. C.A.); *Halford v. Seed Hawk Inc.*, 2006 FCA 275, 2006 CarswellNat 2397, 2006 CarswellNat 4150 (F.C.A.) per Sexton J.A., Sharlow & Malone JJ.A. concurring at para. 14, reversing in part 2004 CarswellNat 342, 2004 CarswellNat 7412, 31 C.P.R. (4th) 434 (F.C.) per Pelletier J. at 465 [C.P.R.], para. 83.

Put in a nutshell the question to be answered is: Would the specification make it obvious to a builder familiar with ordinary building operations that the description of a lintel in the form of a weight-bearing box girder of which the back plate was referred to as “extending vertically” from one of the two horizontal plates to join the other, could not have been intended to exclude lintels in which the back plate although not positioned at precisely 90 degrees to both horizontal plates was close enough to 90 degrees to make no material difference to the way the lintel worked when used in building operations? No plausible reason has been advanced why any rational patentee should want to place so narrow a limitation on his invention. On the contrary, to do so would render his monopoly for practical purposes worthless, since any imitator could avoid it and take all the benefit of the invention by the simple expedient of positioning the back plate a degree or two from the exact vertical.⁵⁶² [emphasis added]

Elements are identified as essential or non-essential on the basis of the common knowledge of the person of ordinary skill in the art to which the patent relates, as of the date the patent (or patent application) is published⁵⁶³

The onus is on the patentee to establish known and obvious substitutability at the date of publication of the patent,⁵⁶⁴ or presumably, for old-Act patents, at the date the patent issued. If the patent holder fails to discharge the onus, the descriptive word or expression in the claim will be considered essential unless the context of the claims language otherwise dictates.⁵⁶⁵

⁵⁶² *Catnic Components Ltd. v. Hill & Smith Ltd.* (1981), [1982] R.P.C. 183 (U.K. H.L.) per Lord Diplock at 244, affirmed (1982), [1983] F.S.R. 512 (U.K. H.L.).

⁵⁶³ *Eurocopter c. Bell Helicopter Textron Canada Ltee*, 2012 FC 113, 2012 CarswellNat 164, 2012 CarswellNat 780, 100 C.P.R. (4th) 87 (F.C.) per Martineau J. at para. 46, additional reasons 2012 CarswellNat 2939, 2012 CarswellNat 4462 (F.C.), affirmed 2013 CarswellNat 6967, 2013 CarswellNat 3456 (F.C.A.), affirmed 2013 CarswellNat 6962, 2013 CarswellNat 3455 (F.C.A.), reconsideration / rehearing refused 2013 CarswellNat 4333, 2013 CarswellNat 4334 (F.C.A.), citing *Free World Trust c. E' lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at para. 31. A piece of public knowledge becomes common general knowledge when it is generally regarded as a good basis for further action by the bulk of those who are engaged in the particular art (*Eli Lilly & Co. v. Apotex Inc.*, 2009 FC 991, 2009 CarswellNat 3042, 2009 CarswellNat 6607, [2009] F.C.J. No. 1229 (F.C.) at para. 97, affirmed 2010 FCA 240, 2010 CarswellNat 5866, 2010 CarswellNat 3443 (F.C.A.), leave to appeal refused 2011 CarswellNat 1368, 2011 CarswellNat 1369 (S.C.C.), additional reasons 2011 CarswellNat 4151 (F.C.), quoting from *General Tire & Rubber Co. v. Firestone Tyre & Rubber Co.*, [1972] R.P.C. 457 (U.K. H.L.) at 482 and 483 (CA)).

⁵⁶⁴ *Free World Trust c. E' lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 194 [C.P.R.], para. 57, approving, in part *AT & T Technologies Inc. v. Mitel Corp.*, 1989 CarswellNat 552, 26 C.P.R. (3d) 238 (Fed. T.D.) per Reed J., at 257 [C.P.R.]; *Canamould Extrusions Ltd. v. Driangle Inc.*, 2004 CarswellNat 970, 2004 CarswellNat 386, 30 C.P.R. (4th) 129 (F.C.A.) at 143-144 [C.P.R.], para. 27, affirming 2003 CarswellNat 554, 2003 CarswellNat 1905, 25 C.P.R. (4th) 343 (Fed. T.D.) per Stone J.A.; *McKay v. Weatherford Canada Ltd.*, 2008 FCA 369, 2008 CarswellNat 5666, 2008 CarswellNat 4491 (F.C.A.) per Trudel J.A. at para. 18, leave to appeal refused 2009 CarswellNat 855, 2009 CarswellNat 856 (S.C.C.).

⁵⁶⁵ *Free World Trust c. E' lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 194 [C.P.R.], para. 57; *McKay v. Weatherford Canada Ltd.*, 2008 FCA 369, 2008 CarswellNat 5666, 2008 CarswellNat 4491 (F.C.A.) per Trudel J.A. at para. 18, leave to appeal refused 2009 CarswellNat 855, 2009 CarswellNat 856 (S.C.C.); *Eurocopter c.*

Unlike the test of obviousness when determining validity, in this context, the skilled person is permitted to know of the substitute's existence.⁵⁶⁶ Had the skilled worker at that time been told of both the element specified in the claim and the variant and "asked whether the variant would obviously work in the same way", the answer would be yes.⁵⁶⁷

a) At the Time the Patent Application is Published

In *Free World*, Justice Binnie reaffirmed that the substitutability of non-essential elements is to be determined as of the date of publication of the patent.⁵⁶⁸ His justification was that the scope of the patent would be broadened if the claim was to be able to encompass later developed equivalents:

... the effect would be that the ambit of the monopoly would grow over the life of the patent as new substitutes are developed and absorbed into the common knowledge of the skilled worker. The inventor cannot be thought to have the necessary "intent" in relation to after-created knowledge except in the irrelevant sense of intending to reap the benefit of the maximum coverage available. In my view, *Catnic, supra*, and *O'Hara, supra*, were correct to put the onus on the patentee to establish known and obvious substitutability at the date of publication of the patent. If the patentee fails to discharge that onus, the descriptive word or expression in the claim is to be considered essential unless the context of the claims language otherwise dictates.⁵⁶⁹

A corollary to the question as to whether it was obvious, as of the date the patent was published, that the variant would not make a difference to the way the invention works is that the variant must have existed at that time. If the variant did not exist at that time, then it could not have been obvious that it would not change the way the invention worked. Likewise, the inventor could not have intended to include a variant that did not exist.

The concept has been around since as early as 1912 in the context of infringement capturing something within the claim:

Bell Helicopter Textron Canada Ltée, 2013 FCA 219, 2013 CarswellNat 6962, 2013 CarswellNat 3455 (F.C.A.) (per Mainville J.A., Noë J. and Trudel J.J.A. concurring) at para. 84, reconsideration / rehearing refused 2013 CarswellNat 4333, 2013 CarswellNat 4334 (F.C.A.).

⁵⁶⁶ *Janssen Pharmaceutica Inc. v. Apotex Inc.*, 2001 FCA 247, 2001 CarswellNat 1631, 2001 CarswellNat 3174, 13 C.P.R. (4th) 410 (Fed. C.A.) at 429-430 [C.P.R.], para. 48, affirming 2000 CarswellNat 182, 2000 CarswellNat 5136, 5 C.P.R. (4th) 53 (Fed. T.D.).

⁵⁶⁷ *Janssen Pharmaceutica Inc. v. Apotex Inc.*, 2001 FCA 247, 2001 CarswellNat 1631, 2001 CarswellNat 3174 (Fed. C.A.) per Linden J.A., Isaac C.J. and Malone J.J.A. concurring at para. 38 citing *Improver Corp. v. Remington Consumer Products Ltd.* (1989), [1990] F.S.R. 181 (Eng. Patents Ct.) at 192.

⁵⁶⁸ *Free World Trust c. E`lectro SantO`Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 193-194 [C.P.R.], para. 55, quoted above.

⁵⁶⁹ *Free World Trust c. E`lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 194-195 [C.P.R.], para. 57.

... nothing is an infringement of the patent which the knowledge of the world on the publication of the specification would not have recognized as being an equivalent of the patented process.⁵⁷⁰

If no equivalent to a claim element existed as of the date of publication of the patent, the claim element under consideration was necessarily essential and therefore could not be varied. When the later developed equivalent was created, the element that was considered essential as of the date of publication of the patent became no longer de facto essential to the operation of the device. The device incorporating the variant of the essential feature would not be an infringement because the element that had been varied was essential as at the publication date.

If, however, there were obvious equivalents to the claim element at the date of publication, then the first question in *Free World* (Does it affect the way the invention works?), would not find the element to be essential.

Presumably for old-*Act* patents, these same considerations would be applicable at the date the patent issued.

6.8.3 Q. #2: *Is the Element Essential, According to the Intent of the Inventor as Expressed or Inferred from the Claims?*

Briefly, the second question in the *Free World* test requires that the patentee be limited to the language of the claims, as construed in the context of the patent. Arguably, the claim element is essential, in effect, simply “... because it’s there”.⁵⁷¹

This question echoes the comment by the Federal Court of Appeal in *O’Hara*:

A court must interpret the claims; it cannot redraft them. When an inventor has clearly stated in the claims that he considered a requirement as essential to his invention, a court cannot decide otherwise for the sole reason that he was mistaken.⁵⁷²

⁵⁷⁰ *Vidal Dyes Syndicate Ltd. v. Levinstein Ltd.* (1912), 29 R.P.C. 245 (C.A.) per Fletcher-Moulton L.J. at 277.

⁵⁷¹ Answer given by British mountaineer George Leigh Mallory in an interview with The New York Times in March 1923, when asked why he wanted to climb Mount Everest. He was lost on Everest a year later.

⁵⁷² *Eli Lilly & Co. v. O’Hara Manufacturing Ltd.*, 1989 CarswellNat 504, 26 C.P.R. (3d) 1 (Fed. C.A.) per Pratte J.A. at 7 [C.P.R.]. As discussed above, the claim never said the claim element was essential. The element was simply in the claim. See also *Glaston Services Ltd. Oy v. Horizon Glass & Mirrors Ltd.*, 2010 FC 1191, 2010 CarswellNat 5395, 2010 CarswellNat 4556 (F.C.) per Mandamin J. at para. 65: “Unlike the claim 7 of the ’257 Patent, an essential element of claim 3 of the ’628 patent is the requirement that the pneumatic spring on the upper rollers is provided by a pneumatic cylinder since it is specifically claimed in the ’628 Patent.” See also *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at para. 51 where, when a broad construction of a term in the claims was made, the “words may have mistakenly claimed too

Hoffman J. described the analog to this question, the third *Improver* question,⁵⁷³ as the real construction question, the earlier questions being factual precursors.⁵⁷⁴

This part of the test focuses on the primacy of the language of the claims:

The primacy of the claims language was already rooted in our jurisprudence and should, I think, be affirmed on this appeal.⁵⁷⁵

Courts can use the “primacy” language from *Free World* to hold the patentee to the words of the claim (purposely construed, of course).

The words chosen by the inventor will be read in the sense the inventor is presumed to have intended, and in a way that is sympathetic to accomplishment of the inventor’s purpose expressed or implicit in the text of the claims. However, if the inventor has misspoken or otherwise created an unnecessary or troublesome limitation in the claims, it is a self-inflicted wound. The public is entitled to rely on the words used provided the words used are interpreted fairly and knowledgeably.⁵⁷⁶

The facts of *O’Hara* have an echo in the facts of this case. Claim 1 of the ‘156 patent stipulates the “said magnetization coil being stationary” during treatment. Whether the magnetization is stationary may or may not affect the way the device works, but the inventor has explicitly so stipulated.⁵⁷⁷

much”: “Redrafting would undermine the public notice function of patents, which entitles readers to clear and definite guidance concerning the extent of the monopoly conferred (*Free World Trust*, at paragraphs 42-43.”

⁵⁷³ *Improver Corp. v. Remington Consumer Products Ltd.* (1989), [1990] F.S.R. 181 (Eng. Patents Ct.) at 189:

(3) Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention. If yes, the variant is outside the claim.

⁵⁷⁴ *Improver Corp. v. Remington Consumer Products Ltd.* (1989), [1990] F.S.R. 181 (Eng. Patents Ct.) at 190:

It is worth noticing that Lord Diplock’s first two questions, although they cannot sensibly be answered without reference to the patent, do not primarily involve questions of construction: whether the variant would make a material difference to the way the invention worked and whether this would have been obvious to the skilled reader are questions of fact. The answers are used to provide the factual background against which the specification must be construed. It is the third question which raises the question of construction ...

⁵⁷⁵ *Free World Trust c. E’ lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 188 [C.P.R.], para. 40.

⁵⁷⁶ *Free World Trust c. E’ lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 191 [C.P.R.], para. 51.

⁵⁷⁷ *Free World Trust c. E’ lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 196 [C.P.R.], para. 60. See also *Eli Lilly & Co. v. Apotex Inc.*, 2009 FC 991, 2009 CarswellNat 3042, 2009 CarswellNat 6607 (F.C.) per Gauthier J. at para. 139, affirmed 2010 CarswellNat 5866, 2010 CarswellNat 3443 (F.C.A.), leave to appeal refused 2011 CarswellNat 1368, 2011 CarswellNat 1369 (S.C.C.), additional reasons 2011 CarswellNat 4151 (F.C.) where the court refused to read out the only element in a dependent claim as to do so would render the claim as having no meaning.

Similarly, in *ABB v. Hyundai*, the trial judge characterized the inclusion of “cable grounding” as an element of claim 1, as making it an essential feature of the claims:

Here the inventor represented that cable grounding was required and included that component without reservation into Claim 1. If cable grounding was not an essential feature of Claim 1 there was no need to mention it. If it was intended to be an optional embodiment, it could have been described that way and included as a dependant claim. There is nothing in the claims or in the specification that would suggest to the skilled reader that including the cable grounding switch (ground conductor) in the [gas-insulated switchgear assemblies] compartment fulfilled some inventive purpose subordinate in importance to the circuit breaker isolator. Having included cable grounding as an essential feature of the claims, it is too late for ABB to resile from it.⁵⁷⁸

The language of the claims cannot be ignored. The care with which such language has been crafted has been stressed by the courts.⁵⁷⁹

The characterization in *Free World* of the language of the claim being (for the patentee) “a self inflicted wound” is harmonic with the old “literal infringement” test which forced the patent scope to be limited to the words chosen by the patentee.

It is suggested that the only difference between the old literal infringement test and the second part of the *Free World* test is that the words are to be interpreted “purposively” rather than “literally”, if, in fact, they ever were interpreted “literally”. Given the Supreme Court *dicta* in *Smith Incubator Co. v. Seiling*, perhaps the words of the claim were never meant to have been read “literally” and we may have merely returned to reading them, simply, “in context”:

It is now settled law that, for the purpose of ascertaining the meaning of the claims, the language in which they are expressed must be read in light of the specification as a whole, but it is by the effect of the language employed in the claims themselves, interpreted with such aid as may properly be derived from the other parts of the specification, that the scope of the monopoly is to be determined.⁵⁸⁰

⁵⁷⁸ *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2013 FC 947, 2013 CarswellNat 4788, 2013 CarswellNat 3398 (F.C.) per Barnes J. at para. 81, additional reasons 2013 CarswellNat 3777, 2013 CarswellNat 4789 (F.C.), affirmed 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.), as quoted in *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near J.J.A. concurring at para. 74.

⁵⁷⁹ *Canamould Extrusions Ltd. v. Driangle Inc.*, 2004 CarswellNat 970, 2004 CarswellNat 386, 30 C.P.R. (4th) 129 (F.C.A.) per Stone J.A., at 142 [C.P.R.], para. 25, affirming 2003 CarswellNat 554, 2003 CarswellNat 1905, 25 C.P.R. (4th) 343 (Fed. T.D.).

⁵⁸⁰ 1937 CarswellNat 46, [1937] S.C.R. 251 (S.C.C.) per Duff C. at 255 [S.C.R.].

6.8.3.1 Adherence to the Language of the Claims

“Purposive construction” is not an exercise divorced from the words used in the patent and the context in which they appear.⁵⁸¹ The first set of principles set out in *Free World*⁵⁸² stress the importance in claim construction of adhering to the language of the claim:

- (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.

Justice Binnie stressed the importance of claims having clear boundaries:

The scope of patent protection must not only be fair, it must be reasonably predictable. A patent is, after all, a public instrument issued under statutory authority which may result in severe financial consequences for its infringement. The scope of its prohibition should be made clear so that members of the public may know where they can go with impunity.⁵⁸³ [emphasis added]

The patent system is designed to advance research and development and to encourage broader economic activity. Achievement of these objectives is undermined however if competitors fear to tread in the vicinity of the patent because its scope lacks a reasonable measure of precision and certainty. A patent of uncertain scope becomes “a public nuisance” ... There is a high economic cost attached to uncertainty and it is the proper policy of patent law to keep it to a minimum.⁵⁸⁴

In applying this principle to the facts in the *Free World* case, Justice Binnie limited the invention to “circuit means”, as claimed and held it did not include a microcontroller (computer) which performed similar or even the same function:

⁵⁸¹ *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near JJ.A. concurring at para. 43.

⁵⁸² *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 184 [C.P.R.], para. 31(a) to (d).

⁵⁸³ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 188 [C.P.R.], para. 41.

⁵⁸⁴ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 188-189 [C.P.R.], para. 42.

The claims specify the presence of “circuit means” to control the electro-magnetotherapy. There is nothing in the context of the claims to suggest that the inventor considered circuit means to be non-essential. On the contrary, it is the core of the invention.⁵⁸⁵ [emphasis added]

The claims clearly require “circuit means”. As mentioned, a skilled reader in 1981 or 1983 would associate that descriptive phrase with specific technology and consider the use of such technology essential to the claimed invention. The fact that the *Electro-Sante* device uses a microcontroller to perform a similar or even the same function does not bring it within the claim. It performs the function in a very different way. Moreover, there is no reason to think the inventor didn’t mean what he said, or considered the use of “circuit means” a non-essential element of the claims, or intended to claim more broadly than “circuit means” and thereby put at risk for “covetous claiming” the validity of the patents.”⁵⁸⁶ [emphasis added]

The determination of which elements are essential and which are non-essential, should not be based on the inventive concept of the patent as such approach risks overlooking the language used in the claims.⁵⁸⁷

One judge may have characterized *Free World* too narrowly, omitting the essential/non-essential component of the test. In *Halford v. Seed Hawk Inc.*, Pelletier J. stated:

The question of whether patents protect only the literal meaning of the claims or whether patent protection extends to the “substance of the invention” was put to rest in *Free World Trust v. Electro Sante Inc. et al.* It is now clear that the patent protects only the invention described in the claims, as understood by a workman skilled in the trade, as of the date of the patent.⁵⁸⁸

Where the language of the claim and definitions in the disclosure make clear when the particle size is to be measured, a proffered purposive construction that is not supported by the language of the claims will not be followed. In *Eli Lilly Canada Inc. v. Mylan Pharmaceuticals ULC*,⁵⁸⁹ claim 1 said the compound [tadalafil] was provided as a free drug comprising particles. The disclosure defined “free drug” as “solid particles consisting essential of the compound of [tadalafil], as opposed to the compound intimately embedded in a polymeric

⁵⁸⁵ *Free World Trust c. Electro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 198 [C.P.R.], para. 68.

⁵⁸⁶ *Free World Trust c. Electro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 199 [C.P.R.], para. 73. Ironically, computers contain almost nothing but circuitry.

⁵⁸⁷ *Pollard Banknote Ltd. v. BABN Technologies Corp.*, 2016 FC 883, 2016 CarswellNat 3400, 2016 CarswellNat 10897 (F.C.) per Locke J. at para. 80, additional reasons 2016 CarswellNat 8063, 2016 CarswellNat 11587 (F.C.).

⁵⁸⁸ *Halford v. Seed Hawk Inc.*, 2001 CarswellNat 3884, 2001 CarswellNat 2519, 16 C.P.R. (4th) 189 (Fed. T.D.) at 196 [C.P.R.], para. 27.

⁵⁸⁹ 2015 FC 178, 2015 CarswellNat 477, 2015 CarswellNat 8773 (F.C.) per de Montigny J., affirmed 2015 CarswellNat 6951, 2015 CarswellNat 12238 (F.C.A.).

coprecipitate.”⁵⁹⁰ The court found that it could hardly be clearer that the particles to be measured were the tadalafil particles before they were combined with the excipients and not after formulation when bioavailability can be affected.⁵⁹¹

6.8.3.2 *The Inferred Intent of the Inventor*

The “intent of the inventor” does not refer to the actual intent of the inventor,⁵⁹² but rather what is determined from the patent itself. The Court is to embark upon an objective exercise as to what a skilled reader would have understood the inventor to mean:⁵⁹³

In my view, those references to the inventor’s intention refer to an objective manifestation of that intent in the patent claims, as interpreted by the person skilled in the art, and do not contemplate extrinsic evidence such as statements or admissions made in the course of patent prosecution.⁵⁹⁴ [emphasis added]

It should be noted that although *Free World* permits the entire patent to be examined to interpret the words of the claims,⁵⁹⁵ the language of the test appears to limit the search for the “intent of the inventor” to the claims themselves⁵⁹⁶ and the test has been applied as such.⁵⁹⁷ This may not have been the intention of the court in *Free World* as it did not indicate that it was departing from the

⁵⁹⁰ *Eli Lilly Canada Inc. v. Mylan Pharmaceuticals ULC*, 2015 FC 178, 2015 CarswellNat 477, 2015 CarswellNat 8773 (F.C.) per de Montigny J. at para. 103, affirmed 2015 CarswellNat 6951, 2015 CarswellNat 12238 (F.C.A.).

⁵⁹¹ *Eli Lilly Canada Inc. v. Mylan Pharmaceuticals ULC*, 2015 FC 178, 2015 CarswellNat 477, 2015 CarswellNat 8773 (F.C.) per de Montigny J. at paras. 102 & 103, affirmed 2015 CarswellNat 6951, 2015 CarswellNat 12238 (F.C.A.).

⁵⁹² *Axcan Pharma Inc. v. Pharmascience Inc.*, 2006 CarswellNat 1084, 2006 CarswellNat 2505, 50 C.P.R. (4th) 321 (F.C.) per Harrington J. at 329 [C.P.R.], para. 31.

⁵⁹³ *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2005 CarswellNat 4401, 2005 CarswellNat 7441, 46 C.P.R. (4th) 244 (F.C.) per Hughes J. at para. 39, affirmed 2007 CarswellNat 6, 2007 CarswellNat 1052 (F.C.A.) quoting with approval, Lord Hoffman in *Kirin-Amgen Inc. v. Hoechst Marion Roussel Ltd.* (2004), 331 N.R.1 (H.L.) at para. 32:

Construction is objective in the sense that it is concerned with what a reasonable person to whom the utterance was addressed would have understood the author to be using the words to mean.

⁵⁹⁴ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 197-198 [C.P.R.], para. 66.

⁵⁹⁵ *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 148-151 [C.P.R.], para. 49(f), reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.):

While the appellants express concern that “purposive construction” may open the door to extrinsic evidence of intent, as is the case with certain types of extrinsic evidence in the United States, neither *Catnic*, *supra*, nor *O’Hara*, *supra*, goes outside the four corners of the specification, and both properly limit themselves to the **words of the claims interpreted in the context of the specification as a whole**. [emphasis added]

⁵⁹⁶ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 184 [C.P.R.], para. 31:

(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. [emphasis added]

Catnic, *O'Hara* or *Smith Incubating*⁵⁹⁸ tests, quoted above, which entitled the Court to look to the entirety of the specification to determine whether the patentee intended to exclude a variant.⁵⁹⁹ Likewise, as in the *Eli Lilly Canada Inc. v. Mylan Pharmaceuticals ULC*⁶⁰⁰ [tadalafil] case discussed in the previous section, where the disclosure defines certain terms, those terms are to be used when construing the claims, even though such definitions do not occur in the claims themselves but are in their disclosure (see Section 4.7.2.2 above).

In *Fournier Pharma Inc. v. Canada (Minister of Health)*⁶⁰¹ the court inferred that a PK Profile set out in claims 1-3 that reflected a USFDA guideline was an essential feature of a claim given that the inventors were seeking bioequivalence, given that Canada requires that bioequivalence was established using the USFDA guideline, and given that the patent was for an invention to be marketed in Canada.⁶⁰²

6.8.3.3 Most Claims Contain Only Essential Elements

It is probably fair for a court to assume that, in most cases, all claim elements are essential.⁶⁰³ A party alleging otherwise bears the onus of proving non-essentiality.⁶⁰⁴

Section 34(2) of the *Patent Act*⁶⁰⁵ requires that a patent specification end with a claim or claims which “distinctly and in explicit terms” set out the scope of the monopoly claimed.⁶⁰⁶ This requirement suggests that a patentee should choose

⁵⁹⁷ In *Westaim Corp. v. Royal Canadian Mint*, 2002 CarswellNat 3380, 2002 CarswellNat 4776, 23 C.P.R. (4th) 9 (Fed. T.D.) at para. 75, the Court looked only to the claims for the inventor’s intent:

In my opinion there is nothing in the **language of the claims** to indicate that the inventors did not clearly intend that first layer 0.01 mm was a non-essential element. [emphasis added]

⁵⁹⁸ 1937 CarswellNat 46, [1937] S.C.R. 251 (S.C.C.) per Duff C. at 255 [S.C.R.].

⁵⁹⁹ *Catnic Components Ltd. v. Hill & Smith Ltd.* (1981), [1982] R.P.C. 183 (U.K. H.L.) per Lord Diplock at 244, affirmed (1982), [1983] F.S.R. 512 (U.K. H.L.).

⁶⁰⁰ 2015 FC 178, 2015 CarswellNat 477, 2015 CarswellNat 8773 (F.C.) per de Montigny J., affirmed 2015 CarswellNat 6951, 2015 CarswellNat 12238 (F.C.A.).

⁶⁰¹ 2012 FC 740, 2012 CarswellNat 2285, 2012 CarswellNat 3790, 103 C.P.R. (4th) 77 (F.C.) per Zinn J.

⁶⁰² *Fournier Pharma Inc. v. Canada (Minister of Health)*, 2012 FC 740, 2012 CarswellNat 2285, 2012 CarswellNat 3790, 103 C.P.R. (4th) 77 (F.C.) per Zinn J. at para. 74.

⁶⁰³ *Pollard Banknote Ltd. v. BABN Technologies Corp.*, 2016 FC 883, 2016 CarswellNat 3400, 2016 CarswellNat 10897 (F.C.) per Locke J. at 74, additional reasons 2016 CarswellNat 8063, 2016 CarswellNat 11587 (F.C.).

⁶⁰⁴ *Pollard Banknote Ltd. v. BABN Technologies Corp.*, 2016 FC 883, 2016 CarswellNat 3400, 2016 CarswellNat 10897 (F.C.) per Locke J. at 74, additional reasons 2016 CarswellNat 8063, 2016 CarswellNat 11587 (F.C.).

⁶⁰⁵ R.S., c. P-4.

⁶⁰⁶ As stated by Justice Snider in *Teva Canada Ltd. v. Novartis AG*, 2013 FC 141, 2013 CarswellNat 1556, 2013 CarswellNat 338 (F.C.) at para. 76:

... the claims — and not the disclosure — are the essence of a patent and it is the claims that must be interpreted. While the specification, as a whole, will describe the invention, the scope of the monopoly is defined by the claims.

as claim elements only those things that are essential to the working of the invention.

This concept is echoed in *Catnic*, where Lord Diplock quoted *Electrical & Musical Industries Ltd. v. Lissen Ltd.* at page 242—243, for an “all elements” test or “literal construction” of patent claims:

My Lords, a patent specification is a unilateral statement by the patentee, in words of his own choosing, addressed to those likely to have a practical interest in the subject matter of his invention (i.e., “skilled in the art”), by which he informs them what he claims to be the essential features of the new product or process for which the letters patent grant him a monopoly.⁶⁰⁷

Thus, if an inventor decides to include a certain element in his or her claim, why should the Court ignore or modify that element in construing that claim?⁶⁰⁸

In circumstances of dependant claims, where a dependent claim adds only one new limitation, that limitation must be an essential element of that dependent claim, otherwise that claim would be redundant with the parent claim and would “essentially [be] read out of the patent and [have] absolutely no meaning.”⁶⁰⁹

The difficulty for the patentee arises when the patentee has “underclaimed”⁶¹⁰ — that is, the claims are narrower than the invention the patentee could have claimed. The inventor realizes that the language used in the patent suggests that a particular element is essential when subsequent experience shows that it is not. When drafting the patent, the inventor considered a particular element important enough to include in the claim when, later on, the court and the inventor no longer consider it necessary.⁶¹¹

⁶⁰⁷ *Electrical & Musical Industries Ltd. v. Lissen Ltd.* (1938), 56 R.P.C. 23 (U.K. H.L.).

⁶⁰⁸ *Eli Lilly & Co. v. O'Hara Manufacturing Ltd.*, 1989 CarswellNat 504, 26 C.P.R. (3d) 1 (Fed. C.A.) per Pratte J.A. at 7 [C.P.R.]. See also *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2013 FC 947, 2013 CarswellNat 4788, 2013 CarswellNat 3398 (F.C.) per Barnes J. at para. 81, additional reasons 2013 CarswellNat 3777, 2013 CarswellNat 4789 (F.C.), affirmed 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near JJ.A. concurring at para. 74:

If cable grounding was not an essential feature if Claim 1 there was no need to mention it. If it was intended to be an optional embodiment, it could have been described that way and included as a dependent claim. “... Having included cable grounding as an essential feature of the claims, it is too late for ABB to resile from it.”

⁶⁰⁹ *Eli Lilly & Co. v. Apotex Inc.*, 2009 FC 991, 2009 CarswellNat 3042, 2009 CarswellNat 6607 (F.C.) per Gauthier J. at para. 140, affirmed 2010 CarswellNat 5866, 2010 CarswellNat 3443 (F.C.A.), leave to appeal refused 2011 CarswellNat 1368, 2011 CarswellNat 1369 (S.C.C.), additional reasons 2011 CarswellNat 4151 (F.C.).

⁶¹⁰ *Biovail Pharmaceuticals Inc. v. Canada (Minister of National Health & Welfare)*, 2005 CarswellNat 65, 2005 CarswellNat 1993, 37 C.P.R. (4th) 487 (F.C.) per Harrington J. at para. 15(8).

⁶¹¹ *Norac Systems International Inc. v. Prairie Systems & Equipment Ltd.*, 2002 CarswellNat 4819, 2002 CarswellNat 642, 19 C.P.R. (4th) 360 (Fed. T.D.) per Pelletier J. at para. 61, reversed in part 2003 CarswellNat 938, 2003 CarswellNat 1593 (Fed. C.A.) where the claim referred to a “tension

The prime example of “underclaiming” is *Eli Lilly & Co. v. O’Hara Manufacturing Ltd.*⁶¹² discussed in Chapter 6.3.1.1 above. The Federal Court of Appeal held that, because the O’Hara device lacked the feature of “flexibly biasing the plenum against the drum”, there was no infringement. The Court said that it could not rewrite the patent claim to omit the feature that was later discovered to be unnecessary:

A court must interpret the claims; it cannot redraft them. When an inventor has clearly stated in the claims that he considered a requirement as essential to his invention, a court cannot decide otherwise for the sole reason that he was mistaken.⁶¹³

In *Free World*, Justice Binnie approved this approach in these circumstances:

The words chosen by the inventor will be read in the sense the inventor is presumed to have intended, and in a way that is sympathetic to accomplishment of the inventor’s purpose expressed or implicit in the text of the claims. However, if the inventor has misspoken or otherwise created an unnecessary or troublesome limitation in the claims, it is a self-inflicted wound. The public is entitled to rely on the words used provided the words used are interpreted fairly and knowledgeably.⁶¹⁴

... there is no reason to think the inventor didn’t mean what he said⁶¹⁵

Mr. Justice Binnie stated⁶¹⁶ that the approach taken in the *O’Hara* case was the same as that of Duff C.J. in *J.K. Smit & Sons Inc. v. McClintock*.⁶¹⁷ The patent in the *Smit* case related to a method of setting diamonds in devices such as rotary drill bits for earth boring. Duff C.J., citing the earlier jurisprudence, put the focus on the inventor’s own identification of the “essential” parts of his invention:

Obviously, the invention, as described by the inventor himself, involves the use of air suction to hold the diamonds in place while the molten metal is being introduced into the mold. There can be no doubt, in my mind, that as the inventor puts it, that is an *essential* part of his process. That part of his process is clearly not taken by the appellants. Adapting the language of Lord Romer, it

load cell” instead of merely a load cell. This finding was undisturbed on the appeal: *Norac Systems International Inc. v. Prairie Systems & Equipment Ltd.*, 2003 CarswellNat 938, 2003 CarswellNat 1593, 25 C.P.R. (4th) 1 (Fed. C.A.).

⁶¹² *Eli Lilly & Co. v. O’Hara Manufacturing Ltd.*, 1989 CarswellNat 504, 26 C.P.R. (3d) 1 (Fed. C.A.) per Pratte J.A.

⁶¹³ *Eli Lilly & Co. v. O’Hara Manufacturing Ltd.*, 1989 CarswellNat 504, 26 C.P.R. (3d) 1 (Fed. C.A.) per Pratte J.A. at 7 [C.P.R.].

⁶¹⁴ *Free World Trust c. Électro Santé Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 191-192 [C.P.R.], para. 51.

⁶¹⁵ *Free World Trust c. Électro Santé Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 199 [C.P.R.], para. 73.

⁶¹⁶ *Free World Trust c. Électro Santé Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 195-196 [C.P.R.], para. 59.

⁶¹⁷ 1939 CarswellNat 64, [1940] S.C.R. 279 (S.C.C.) at 285 [S.C.R.].

is not the province of the court to guess what is and is not of the essence of the invention of the respondent. The patentee has clearly indicated that the use of air suction at that stage of the process is an essential, if not the essential, part of the invention described in the specification.⁶¹⁸ [emphasis added.]

It will be a rare instance for a patent to refer expressly to any element as being “essential”. Instead, the element will be merely one of many in the claim. For example, in the patent at issue in *J.K. Smits & Sons*, Canadian Letters Patent No. 368,042, the inventor never expressly identified any element as being “essential”. Of the nine claims in the patent, eight referred to “air-suction” or “suction of air” and the other claim referred to “means tending to form a vacuum in the vacuum chamber”. The disclosure of the Lilly patent in the *O’Hara* case stated “It is essential that the exhaust inlet be positioned adjacent to the leading lower quadrant of the drum where the tablets tumble”⁶¹⁹ but nowhere did the patent state that a plenum “flexibly biased against the drum” was essential to the invention. The claim merely included that claim element.

In *Free World*, Justice Binnie limited the scope of the claim to the exact language of the claim:

The facts of *O’Hara* have an echo in the facts of this case. Claim 1 of the ‘156 patent stipulates the “said magnetization coil being stationary” during treatment. Whether the magnetization is stationary may or may not affect the way the device works, but the inventor has explicitly so stipulated.⁶²⁰

6.8.3.4 Words of Precision and the Precision of Words

Because the words of the claims are supposed to be interpreted as they would be by a person skilled in the art (the notional addressee of the patent) and because different addressees give words meanings with different degrees of precision, it is suggested that the scope of the meaning of words could be easily found by answering the following question:

With what degree of precision are the words in question being used in the context of the claim?

Although he had the opportunity to decide the *Catnic* case on the similar reasoning, Lord Diplock, unfortunately, chose not to do so. He held that a rear wall slightly off vertical would be considered “vertical” for a builder.⁶²¹ In the

⁶¹⁸ 1939 CarswellNat 64, [1940] S.C.R. 279 (S.C.C.) at 285 [S.C.R.], also quoted in *Novartis AG v. Apotex Inc.*, 2001 CarswellNat 2297, 2001 CarswellNat 6172, 15 C.P.R. (4th) 417 (Fed. T.D.) at para. [90], affirmed (2002), 22 C.P.R. (4th) 450, 2002 CarswellNat 3179, 2002 CarswellNat 6014 (Fed. C.A.).

⁶¹⁹ Canadian Letters Patent No. 883,719, p. 4, l. 21-23.

⁶²⁰ *Free World Trust v. E. lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 196 [C.P.R.], para. 60.

case of tree harvesting “vertical processors” — something inclined 35 degrees off vertical — was considered to be substantially vertical and within the claims.⁶²²

One indication of the intention of the inventor is the degree of particularity of the description of the element in question. Where an inventor claims a particular subset of a class, then the court can assume that the inventor considered that degree of specificity to be required and the description does not extend to the class itself.⁶²³

Similarly, the use of the emphatic term “solely” indicated to one Court an intention that strict compliance with “solely” was required and that modification or additions were excluded.⁶²⁴

6.8.3.5 Numbers

Even when numbers are used to describe dimensions or quantities, they are described with a certain degree of precision.

In everyday measurement, numbers are rounded upwards from the half below and downwards from the half above. For example, something having a value of 6 could be any value between 5.5 and 6.49. On the other hand, when scientists describe something as having a weight of 6.002 grams, they mean that it is between 6.0015 and 6.00249 grams. Thus the number of significant digits expressed (the number of digits to the right side of the decimal point) is an indication of the precision of the value and the specificity of the description.

The following numerical ranges have been held to be essential elements of the claims of the patent in their respective cases:

⁶²¹ *Catnic Components Ltd. v. Hill & Smith Ltd.* (1981), [1982] R.P.C. 183 (U.K. H.L.) per Lord Diplock at 244, affirmed (1982), [1983] F.S.R. 512 (U.K. H.L.):

... it seems to me that the expression “extending vertically” as descriptive of the position of what in use will be the upright member of a trapezoid-shaped box girder, is perfectly capable of meaning positioned near enough to the exact geometrical vertical to enable it in actual use to perform satisfactorily all the functions that it could perform if it were precisely vertical; and having regard to those considerations to which I have just referred that is the sense in which in my opinion “extending vertically” would be understood by a builder familiar with ordinary building operation.

⁶²² *Nekoosa Packaging Corp. v. AMCA International Ltd.*, 1989 CarswellNat 556, 27 C.P.R. (3d) 153 (Fed. T.D.) at 165 [C.P.R.], additional reasons 1990 CarswellNat 1103 (Fed. T.D.), affirmed 1994 CarswellNat 2980 (Fed. C.A.).

⁶²³ *Norac Systems International Inc. v. Prairie Systems & Equipment Ltd.*, 2002 CarswellNat 4819, 2002 CarswellNat 642, 19 C.P.R. (4th) 360 (Fed. T.D.) per Pelletier J. at para. 61, reversed in part 2003 CarswellNat 938, 2003 CarswellNat 1593 (Fed. C.A.) where the claim referred to a “tension load cell” instead of merely a load cell. This finding was undisturbed on the appeal. *Norac Systems International Inc. v. Prairie Systems & Equipment Ltd.*, 2003 CarswellNat 938, 2003 CarswellNat 1593, 25 C.P.R. (4th) 1 (Fed. C.A.).

⁶²⁴ *Halford v. Seed Hawk Inc.*, 2004 CarswellNat 342, 2004 CarswellNat 7412, 31 C.P.R. (4th) 434 (F.C.) per Pelletier J. at 504 [C.P.R.], para. 194, reconsideration / rehearing refused 2004 CarswellNat 882, 2004 CarswellNat 4795 (F.C.), affirmed 2006 CarswellNat 2397, 2006 CarswellNat 4150 (F.C.A.).

- “at least 1.3”. The plain and ordinary meaning of a succination ratio of “at least 1.3” cannot include 1.25;⁶²⁵
- “a C4-C10 alpha-olefin having a density of from 0.916 to 0.930 g/cm³”. An alpha-olefin having a density below the “crisp value” was considered to be outside the scope of the claim;⁶²⁶ and
- A dosage of a pharmaceutical at “13-15 mg/kg/day”.⁶²⁷

6.8.3.6 “About”

The term “about” is usually used to modify a number: i.e., “about 5 mg”. The dictionary or ordinary meaning of “about” is “near” or “close”.⁶²⁸ Absent the disclosure specifically defining the word, the ordinary meaning applies.⁶²⁹

Justice Reed in the *Apotex Inc. v. Syntex Pharmaceuticals International Ltd.*⁶³⁰ case, considered that the use of the term “about” in the phrase “about 4-9 weight percentage” meant a flexibility no greater than half way to the next number (3.5 to 9.5). Such use of the term “about” clearly indicates that a number below or above the stated amount was to be considered included, whereas if the term “about” was not used, the Court would have to understand and accept the concept of significant digits, discussed above, to otherwise achieve the same effect.

⁶²⁵ *Lubrizol Corp. v. Imperial Oil Ltd.*, 1992 CarswellNat 1049, 45 C.P.R. (3d) 449 (Fed. C.A.) per Mahoney J.A., MacGuigan and Robertson JJ.A. concurring at 467 [C.P.R.], additional reasons 1993 CarswellNat 1964 (Fed. C.A.), leave to appeal refused 1993 CarswellNat 2472 (S.C.C.).

⁶²⁶ *DuPont Canada Inc. v. Glopak Inc.*, 1998 CarswellNat 5077, 1998 CarswellNat 682, 81 C.P.R. (3d) 44 (Fed. T.D.) per Muldoon J. at 57 [C.P.R.], para. 34.

⁶²⁷ *Axcan Pharma Inc. v. Pharmascience Inc.*, 2006 CarswellNat 1084, 2006 CarswellNat 2505, 50 C.P.R. (4th) 321 (F.C.) per Harrington J. at 330 [C.P.R.], paras. 34 and 35:

...when it comes to grammar, and simple arithmetic, the Court does not need the expert advice of a physician... The dosage portion thereof i.e., 13-15 mg/kg/day is an essential element. Otherwise what would be the point of mentioning dosage in a patent which asserts but one claim limited to a single sentence?

⁶²⁸ *The Canadian Oxford Dictionary*, (Toronto: Oxford University Press, 1998) defines “about” as, approximately; used to indicate understatement; here and there; at points nearby; all around; in every direction; on the move; in action. See also Ferance, Stephen J.; *Indefinite: The Use of Terms Such As “About” and “At Least About” in Patent Claims*; Canadian Intellectual Property Review; Patent and Trademark Institute of Canada; [1999], 185-187.

⁶²⁹ In *Shire Biochem Inc. v. Canada (Minister of Health)*, 2008 FC 538, 2008 CarswellNat 2815, 2008 CarswellNat 1240, 67 C.P.R. (4th) 94 (F.C.) per Hughes J. at para. 108. The patent defined the use of the term “about” in the context of particle size as meaning plus or minus approximately ten percent of the indicated value. The Court limited the definition of “about” to that particular context and not to all uses of the term “about” in the patent. In *Sanofi-Aventis Canada Inc. v. Ratiopharm Inc.*, 2010 FC 230, 2010 CarswellNat 2164, 2010 CarswellNat 1237 (F.C.) per Phelan J. at paras. 39-41, where the patent did not define the term “about”, the Court accepted the use of the term in the U.S. Pharmacopeia of “within 10%”.

⁶³⁰ *Apotex Inc. v. Syntex Pharmaceuticals International Ltd.*, 1999 CarswellNat 4895, 1999 CarswellNat 869, 1 C.P.R. (4th) 22 (Fed. T.D.) per Reed J. at 38 [C.P.R.], para. 45.

Everything depends on context. In *Sanofi-Aventis Canada Inc. v. Ratiopharm Inc.*⁶³¹ “about” was held to mean “within 10%” whereas in *Eli Lilly Canada Inc. v. Apotex Inc.* it was held to mean “approximately” and not plus or minus 10%.⁶³² In *Eli Lilly Canada Inc. v. Mylan Pharmaceuticals ULC*,⁶³³ “about” was held not to include 20% more.

In *Pfizer Canada Inc. v. Apotex Inc.*,⁶³⁴ the patent defined “about” two ways: (1) generally means within 10%, preferably within 5%, and more preferably within 1% of a given value or range; or (2) within an acceptable standard error of the mean, when considered by one of ordinary skill in the art. For the endotherms, the Court preferred the latter definition because the other definition resulted in the numerical margins of error it would be ± 13 , *i.e.*, a 268C variation, which was considered far too great a difference to have been intended by the inventors.⁶³⁵

In a case involving taps for maple tree sap collection,⁶³⁶ the dimension of the hole in the tree of 7/16th inch was expressed as a decimal measurement (0.4375 inches) and the size of the patented tap ranging from about 4.9/16th in. to 7/32nd in. in diameter was expressed in decimals as between about 0.30625 and 0.21875 in. Expressing dimensions in such manner normally implies a precision of 1/100,000th of an inch — a ridiculous precision for such a device. The issue was whether a 5/16th in. device fit within the claimed range. The Court wisely decided that the expression in decimal was merely a transposition from fractional to decimal and was not meant to be an expression of precision.⁶³⁷ The diameter difference of 1.4% outside the exact range was within the range covered by the term “about”.⁶³⁸

⁶³¹ 2010 FC 230, 2010 CarswellNat 2164, 2010 CarswellNat 1237 (F.C.) per Phelan J. at para. 41.

⁶³² *Eli Lilly Canada Inc. v. Apotex Inc.*, 2015 FC 1016, 2015 CarswellNat 4275, 2015 CarswellNat 10649 (F.C.) per Gleason J. at para. 57, additional reasons 2015 CarswellNat 4988, 2015 CarswellNat 8990 (F.C.).

⁶³³ 2015 FC 178, 2015 CarswellNat 477, 2015 CarswellNat 8773 (F.C.) per de Montigny J. at para. 83, affirmed 2015 FCA 286, 2015 CarswellNat 6951, 2015 CarswellNat 12238 (F.C.A.) per Dawson J.A., Near & Biovin JJ.A. concurring.

⁶³⁴ *Pfizer Canada Inc. v. Apotex Inc.*, 2017 FC 774, 2017 CarswellNat 5048, 2017 CarswellNat 8127 (F.C.) per Brown J. at para. 171, affirmed 2019 CarswellNat 14684, 2019 CarswellNat 259 (F.C.A.).

⁶³⁵ *Pfizer Canada Inc. v. Apotex Inc.*, 2017 FC 774, 2017 CarswellNat 5048, 2017 CarswellNat 8127 (F.C. per Brown J.) at para. 172, affirmed 2019 CarswellNat 14684, 2019 CarswellNat 259 (F.C.A.).

⁶³⁶ *Équipements d'érablie re C.D.L. inc. c. C o f e*, 2012 QCCS 1521, 2012 CarswellQue 3620 (C.S. Que.) per Michaud J.S.C.

⁶³⁷ *Équipements d'érablie re C.D.L. inc. c. C o f e*, 2012 QCCS 1521, 2012 CarswellQue 3620 (C.S. Que.) per Michaud J.S.C. at para. 77.

⁶³⁸ *Équipements d'érablie re C.D.L. inc. c. C o f e*, 2012 QCCS 1521 (C.S. Que.) per Michaud J.C.S. at para. 81.

6.8.3.7 “Substantially”

The term “substantially” is usually used in context to mean approximately or about the same as a reference item.

In *Shire Canada Inc. v. Apotex Inc.*,⁶³⁹ the court took guidance as to whether a composition had a “plasma concentration/time curve which is substantially the same as that of Figure 7” of the patent, by noting what the patent described Figure 7, and another figure (#8), as being “similar to” Figure 1 while the curve of Figure 7 was claimed but that of Figure 8 was not. A subjective (graphical, qualitative) consideration of the characteristics of the various curves was made.⁶⁴⁰ Allegedly unnecessary features of Figure 7 were said to operate against the patentee as a self-inflicted wound.⁶⁴¹

6.8.4 Problem/Solution Approach to Determine Essential Elements is Incorrect

Under Rule 42(1)(c) of the European Patent Convention, a patent application’s description shall “disclose the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state any advantageous effect of the invention with reference to the background art”. There is no such corresponding requirement under the Canadian *Patent Act*.

In *Choueifat v. Canada (Attorney General)*,⁶⁴² the Patent examiner and the Patent Appeal Board used a problem-solution approach to determine the essential elements of an invention to decide whether it was patentable subject matter under s. 2 of the *Patent Act*: The problem-solution approach, set out in CIPO’s Manual of Patent Office Practice (June 2015) [MOPOP], provides that the essential elements of a claim are those that are necessary to achieve the disclosed solution to an identified problem.⁶⁴³

13.05.02c 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*

⁶³⁹ *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J. at para.127.

⁶⁴⁰ *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J. at para.133.

⁶⁴¹ *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J. at para.133.

⁶⁴² *Choueifat v. Canada (Attorney General)*, 2020 FC 837, 2020 CarswellNat 3281, 2020 CarswellNat 6342 (F.C.) per Zinn J. at para. 39.

⁶⁴³ *Choueifat v. Canada (Attorney General)*, 2020 FC 837, 2020 CarswellNat 3281, 2020 CarswellNat 6342 (F.C.) per Zinn J. at para. 13.

without having first properly identified the proposed solution to the disclosed problem. 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 or omitted without affecting the working of the invention.⁶⁴⁴

Ultimately, some element or combination of elements defined in the claim must provide the solution. 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 to the solution. Some elements of a claim define the context or the environment of a specific working embodiment, but do not actually change the nature of the solution to the problem.⁶⁴⁵

...An element is essential if it is required to provide the solution to the problem, regardless of whether or not it is known.

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.

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 over breadth (i.e., lack of support) and/or for lack of utility.

...

An invention is an element or a combination of elements that provides a solution to a problem. Where a claim includes solutions to more than one problem it includes more than one invention.⁶⁴⁶

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

⁶⁴⁴ *Free World Trust c. E' lectro Sante Inc.*, 2000 SCC 66, 2000 CarswellQue 2728, 2000 CarswellQue 2731 (S.C.C.) at para. 55.

⁶⁴⁵ *Amazon.com Inc., Re*, 2011 FCA 328, 2011 CarswellNat 4865, 2011 CarswellNat 5990 (F.C.A.) at paras. 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.

⁶⁴⁶ 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).

the greatest emphasis by the inventors. If it becomes necessary to consider a different solution, the analysis should be undertaken anew.

... 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. [*emphasis added*]

The Commissioner of Patents is required to employ the purposive construction test set out in *Whirlpool* and *Free World Trust*.⁶⁴⁷ Using the problem-solution approach to claims construction is akin to using the “substance of the invention” approach discredited by the Supreme Court of Canada in *Free World Trust* at para 46.⁶⁴⁸ The problem-solution approach to claims construction focuses only on the second *Free World* question,⁶⁴⁹ it fails to respond, as taught in *Free World Trust*, to the issue of the inventor’s intention. It was an error for the Commissioner of Patents to determine the essential elements of the claimed invention by using the problem-solution approach, rather than the *Whirlpool* approach.⁶⁵⁰

6.9 An Inconsistency in *Free World*, or an Evolution of *Catnic/Improver*?

Free World and *Whirlpool* can be read two very different ways:

- Given a “plain reading”, as a significant departure from *Catnic* and *Improver* and a return to an approach whose outcomes are similar to the former “literal” and “pith and substance” approach; or
- Given a reading consistent with *Catnic* and *Improver*, as a mere restatement of them.

⁶⁴⁷ *Choueifaty v. Canada (Attorney General)*, 2020 FC 837, 2020 CarswellNat 3281, 2020 CarswellNat 6342 (F.C.) (per Zinn J.) at para. 34, citing *Amazon.com Inc., Re*, 2011 FCA 328, 2011 CarswellNat 4865, 2011 CarswellNat 5990 (F.C.A.) distinguishing *Genencor International Inc. v. Canada (Commissioner of Patents)*, 2008 FC 608, 2008 CarswellNat 2892, 2008 CarswellNat 1423 (F.C.) para. 62.

⁶⁴⁸ *Choueifaty v. Canada (Attorney General)*, 2020 FC 837, 2020 CarswellNat 3281, 2020 CarswellNat 6342 (F.C.) (per Zinn J.) at para. 37.

⁶⁴⁹ *Choueifaty v. Canada (Attorney General)*, 2020 FC 837, 2020 CarswellNat 3281, 2020 CarswellNat 6342 (F.C.) (per Zinn J.) at para. 38: “Is it the intention of the inventor, considering the express language of the claim, or inferred from it, that the element was intended to be essential? If so, then it is an essential element.”

⁶⁵⁰ *Choueifaty v. Canada (Attorney General)*, 2020 FC 837, 2020 CarswellNat 3281, 2020 CarswellNat 6342 (F.C.) (per Zinn J.) at para. 40.

	Q #1(a)	Q #1(b) (or Improver Q #2)	Q #2 (or Improver Q #3)	Process
<i>Free World/ Whirlpool (plain reading)</i>	Did a variant of a particular element make a material difference to the way in which the invention works?	Was that obvious at the time?	According to the intent of the inventor, expressed or inferred from the claims, was a particular element essential irrespective of its practical effect?	Ask either Q #1(a) & 1(b) or Q #2. If “No” to either Q, the element is non-essential and the variant is inside the claim.
<i>Free World/ Whirlpool (consistent with Cat-nic/Improver)</i>	Did a variant of a particular element make a material difference to the way in which the invention works?	Was that obvious at the time?	According to the intent of the inventor, expressed or inferred from the claims, was a particular element essential irrespective of its practical effect?	Ask Q #1(a): If “No”, ask Q #1(b). If “Yes”, the element is essential and the variant is outside the claim. Ask Q #1(b): If “Yes”, then ask Q #2. If “No”, the variant is outside the claim. Ask Q #2: If “No”, the element is non-essential and the variant is inside the claim. If “Yes”, the element is essential and the variant is outside the claim.

6.9.1 A Plain Reading of Whirlpool/Free World

Although Justice Binnie followed and endorsed *Catnic*, *Improver* and *O'Hara*, several portions of his reasons in *Free World* that are discordant⁶⁵¹ with the conjunctive two-step approach of the previous cases and, instead, suggest a return to a variant of the “literal” and “pith and substance” approaches to infringement.

The contrast in logic between these questions in *Free World* and those in *Catnic* and *Improver* is evident upon a comparison of the logic in *Catnic* and *Improver* and the interpretation of *Free World* given in Chapter 6.8.1 above,⁶⁵² as illustrated in Appendix “A” to this Chapter.

6.9.1.1 Para. 55: A Claim Element is Non-essential if its Variant Doesn't Affect the Working of the Invention

After expressly stating the test of essentiality or non-essentiality when setting out his “principles” of claim construction in paragraph 31,⁶⁵³ Justice Binnie restated his test as one of non-essentiality in paragraph 55:

It would be unfair to allow a patent monopoly to be breached with impunity by a copycat device that simply switched bells and whistles, to escape the literal claims of the patent. Thus the elements of the invention are identified as either essential elements (where substitution of another element or omission takes the device outside the monopoly), or non-essential elements (where substitution or omission is not necessarily fatal to an allegation of infringement). For an element to be considered non-essential and thus substitutable, it must be shown either (i) that on a purposive construction of the words of the claim it was clearly not intended to be essential, or (ii) that at the date of the publication of the patent, the skilled addressees would have appreciated that a particular element could be substituted without affecting the working of the invention, i.e., had the skilled worker at that time been told of both the element specified in the claim and the variant and “asked whether the variant would obviously work in the same way”, the answer would be yes: *Improver Corp. v. Remington*, *supra*, at p. 192. In *Improver Corp. v. Remington*, Hoffmann J. attempted to reduce the essence of the *Catnic* analysis to a series of concise questions, at p. 182:

- (i) Does the variant have a material effect upon the way the invention works? If yes, the variant is outside the claim. If no: —

⁶⁵¹ This section of this chapter was referenced in para. 142 of *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J

⁶⁵² Compare the logic of this test, illustrated in Figure 4 in Appendix “A” with the “purposive” interpretation of *Free World* given above in Chapter 6.9.3, Figure 3 in Appendix “A” and that of *Catnic* and *Improver* given in Figures 1 and 2 of Appendix “A” respectively.

⁶⁵³ *Free World Trust c. E' lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 184 [C.P.R.], para. 31.

- (ii) Would this (i.e., that the variant had no material effect) have been obvious at the date of publication of the patent to a reader skilled in the art? If no, the variant is outside the claim. If yes: –
- (iii) Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention? If yes, the variant is outside the claim.

[55] The three questions are not exhaustive but they encapsulate the heart of Lord Diplock’s analysis, and have been endorsed in subsequent English cases.”⁶⁵⁴ [emphasis added]

The first sentence of this quote echoes the older line of case law that held that infringement can occur by taking the “pith and substance” of the invention.

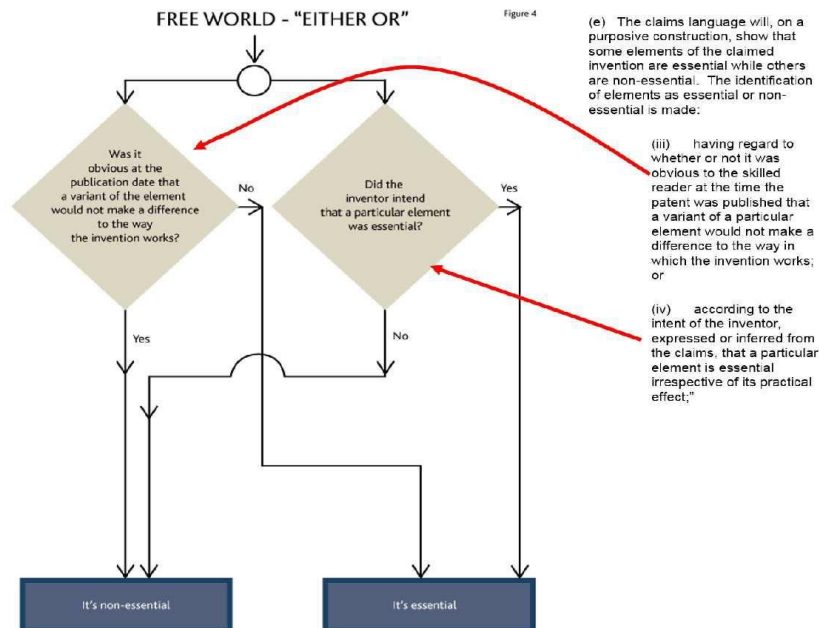
In the latter part of this quote, Justice Binnie quoted the three *Improver* questions, describing them as Hoffman J.’s attempt “to reduce the essence of the *Catnic* analysis to a series of concise questions”⁶⁵⁵ and “[t]he three questions are not exhaustive but they encapsulate the heart of Lord Diplock’s analysis, and have been endorsed in subsequent English cases.”⁶⁵⁶ He did not expressly agree with it and did not refer to *Improver* in *Whirlpool*.

Justice Binnie’s tests of non-essentiality in paragraph 55, if taken as expressed, make the *Catnic*, *Improver* and *O’Hara* questions mutually independent, either of which could establish that a claim element was non-essential. As shown in Figure 4 below, this is a significant departure from the logic of *Catnic* and *Improver*.

⁶⁵⁴ *Free World Trust c. E’ lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 193-194 [C.P.R.], paras. 55-56.

⁶⁵⁵ *Free World Trust c. E’ lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. para. 55.

⁶⁵⁶ *Free World Trust c. E’ lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. para. 56.



The first and second *Free World* questions correspond to the first and second *Catnic* questions. Each *Free World* question is addressed separately below.

Q#1: At the date of the publication of the patent, would the skilled addressees have appreciated that a particular element could be substituted without affecting the working of the invention?

This is analogous to the first question in *Catnic* (and first and second questions in *Improver*):⁶⁵⁷ does the variant change the way the invention works?

If this is an independent question to determine non-essentiality, then the claim element can be determined to be non-essential without any consideration of the second *Catnic* (or third *Improver*) question. All obviously substitutable equivalents known at the publication date would be variants included in the claim, regardless of the specificity of the claim language.⁶⁵⁸ Being an independent question, it would not matter whether a clear intention was

⁶⁵⁷ As noted in para. 135 of *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J

⁶⁵⁸ This would be analogous (in one respect) to the U.S. Doctrine of Equivalents in that the claims would cover that which is claimed and all equivalents of each element claimed: *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931 (Fed. Cir., 1987); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (Ohio S.C., 1997), per Thomas J., at 37. It would differ from the US doctrine that does not permit a claim element or its equivalent to be omitted.

expressed or inferred from the claim that the element was essential, or whether an express statement in the disclosure said that the element was essential. Under this interpretation, there could never be a “self-inflicted wound” as there was in *O’Hara*. The claim construction inquiry would be “... anchored in the language of the claims...”⁶⁵⁹ only to the extent that the claim element would be the starting point for determining its obviously functionally equivalent variants that performed the same function, in the same way, to achieve the same result.

6.9.1.2 “Irrespective of its Practical Effect”

When stating his principles of claim construction in paragraph 33(e) of *Free World*, Justice Binnie said:

The identification of elements as essential or non-essential is made: ...

(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;⁶⁶⁰

The first part of subparagraph 33(e)⁶⁶¹ echoes the second *Catnic* (and third *Improver*) question: did the patentee intend to exclude the variant? The second part of subparagraph 33(e)⁶⁶² is similar to the first *Catnic* and *Improver* questions: Does the variant change the way the invention works?⁶⁶³

In *Catnic* and *Improver*, the second *Catnic* (and third *Improver*) question was addressed only if the variant did not change the way the invention worked. If the variant changed the way the invention worked, then the claim element was deemed essential, it excluded the variant, and the second *Catnic* (and third *Improver*) question was never addressed.

Under *Catnic* and *Improver*, an element found to be essential because it changed the way the invention worked could never be found to be non-essential based upon a perceived intent of the inventor to include the variant.

Catnic and *Improver* held that a claim element could still be essential if the inventor meant it to be essential, even when the variant did not affect the way

⁶⁵⁹ “... failing which ”... the court may be heading into unknown waters without a chart”, *Whirlpool Corp. v. Camco Inc.*, 2000 CarswellNat 2846, 2000 CarswellNat 2861, 9 C.P.R. (4th) 129 (S.C.C.) per Binnie J. at 190 [C.P.R.], paras. 45 and 46, reconsideration / rehearing refused 2001 CarswellNat 283, 2001 CarswellNat 284 (S.C.C.).

⁶⁶⁰ *Free World Trust c. Electro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 184 [C.P.R.], para. 31(e)(iv).

⁶⁶¹ “according to the intent of the inventor, expressed or inferred from the claims, that a particular element is essential”

⁶⁶² “irrespective of its practical effect”

⁶⁶³ Presumably Justice Binnie was referring to the practical effect the element had on the way the invention worked.

the invention worked. In that sense, the *Catnic* and *Improver* claim element was essential irrespective of its (lack of) practical effect.

If Justice Binnie's test of essentiality in subparagraph 33(e) is truly "irrespective of" the "practical effect" of the variant, then the second *Catnic* (and third *Improver*) question is independent of the first *Catnic* question (or first and second *Improver* questions).

Such an interpretation of subparagraph 33(e) is consistent with Justice Binnie's test of non-essentiality in paragraph 55, taken as expressed: the first *Catnic* and *Improver* question (Does the variant change the way the invention works?) is to be considered independently of the second *Catnic* (and third *Improver*) question when determine whether a claim element is non-essential.

6.9.1.3 *Free World: Justice Binnie asked both questions to confirm that "circuit means" was an essential element*

In *Free World*, Justice Binnie decided that the claims clearly required "circuit means", finding that claim element to be "essential" under both *Free World* questions:

(1) At the claims construction stage, the wording of the claims was analysed to isolate the descriptive words and phrases which identify the elements of the invention. There is no need here to make heavy weather in the details. The claims specify the presence of "circuit means" to control the electro-magnetotherapy. There is nothing in the context of the claims to suggest that the inventor considered circuit means to be non-essential. On the contrary, it is the core of the invention. Equally, there was no evidence that at the date of publication of the patent the ordinary skilled worker would have appreciated that there were variants that could perform substantially the same function in substantially the same way to achieve substantially the same result as the circuit means specified in the patent.⁶⁶⁴ [emphasis added]

The first question failed for lack of evidence of obvious substitutability:

...there was no evidence that at the date of publication of the patent the ordinary skilled worker would have appreciated that there were variants that could perform substantially the same function in substantially the same way to achieve substantially the same result as the circuit means specified in the patent.⁶⁶⁵

...

⁶⁶⁴ *Free World Trust v. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at para. 68(1).

⁶⁶⁵ *Free World Trust v. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at para. 68(1).

The appellant however failed to establish that a skilled reader would have understood in 1981 and 1983, when these patents were published, that (i) the inventions as contemplated were intended to include departures (or variants) from the specified circuit technology, (ii) that it would have been obvious to such a skilled reader that substituting variants for the specified “circuit means” would perform substantially the same function in substantially the same way to produce substantially the same result ...⁶⁶⁶

Justice Binnie also held that although the defendant’s microcontroller performed “... a similar or even the same function ...” as the claimed “circuit means”, it “... performs the function in a very different way”.⁶⁶⁷

Given these findings, under the first *Catnic* question, the “circuit means” would be considered “essential” and that would be the end of the inquiry with no need to ask the second *Catnic* (or third *Improver*) question. Justice Binnie, however, addressed the second *Free World* question.

Likewise, under the second *Free World* question, the “circuit means” was considered “essential” because there was nothing in the context of the claims to suggest that the inventor considered circuit means to be non-essential:⁶⁶⁸

The appellant however failed to establish that a skilled reader would have understood in 1981 and 1983, when these patents were published, ... (iii) that when the inventor specified “circuit means” he didn’t really mean the description to be taken literally.⁶⁶⁹

Moreover, there is no reason to think the inventor didn’t mean what he said, or considered the use of “circuit means” a non-essential element of the claims, or intended to claim more broadly than “circuit means” and thereby put at risk for “covetous claiming” the validity of the patents.⁶⁷⁰

Justice Binnie held that the “circuit means” claim element was essential under both *Free World* questions, suggesting that either:

- he was following the *Catnic* and *Improver* tests, but being redundant in his findings; or

⁶⁶⁶ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at para. 72.

⁶⁶⁷ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at para. 73.

⁶⁶⁸ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at para. 68(1).

⁶⁶⁹ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at para. 72.

⁶⁷⁰ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at para. 73.

- under his *Free World* test, either question could determine whether an element was non-essential, and it was thus necessary for him to ask both *Free World* questions to confirm that the claim element was essential under both questions.

6.9.1.4 Para. 57: Element is Essential “Unless the Context of the Claim Otherwise Dictates”

The independent assessment of non-essentiality is reinforced in paragraph 57 of Justice Binnie’s Reasons where he discusses another situation: where a claim element is considered to be essential under the first question, unless “the context of the claims language otherwise dictates”:

[56] In my view, *Catnic, supra*, and *O’Hara, supra*, were correct to put the onus on the patentee to establish known and obvious substitutability at the date of publication of the patent. If the patentee fails to discharge that onus, the descriptive word or expression in the claim is to be considered essential unless the context of the claims language otherwise dictates.⁶⁷¹ [emphasis added]

The “unless” language suggests that the claim element can be found to be non-essential even if it is found to be essential under the first question (for lack of evidence of obvious substitutability. According to paragraph 55 (discussed above), a claim element can only be proven to be non-essential if, “on a purposive construction of the words of the claim it was clearly not intended to be essential.”⁶⁷²

An example of an application of this reading of *Free World* can be found in *Pfizer Canada Inc. v. Novopharm Ltd.*⁶⁷³ The claim referred only to “wet granulation” of tablets although the description indicated that tablet blends may be done by dry or wet granulation (but that wet granulation was preferred).⁶⁷⁴ A person skilled in the art would have known that these processes were substitutable without affecting the functioning of the invention.⁶⁷⁵ Based on asking only the first question in the *Free World* test (obvious substitutability), the Court concluded that the claim element “wet granulation” was not essential and, therefore,

⁶⁷¹ *Free World Trust c. E’ lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 194 [C.P.R.], para. 57.

⁶⁷² *Free World Trust c. E’ lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 193-194 [C.P.R.], para. 55.

⁶⁷³ *Pfizer Canada Inc. v. Novopharm Ltd.*, 2005 CarswellNat 5544, 2005 CarswellNat 31 14, 42 C.P.R. (4th) 502 (F.C.) per Blanchard J. at 523-524 [C.P.R.], para. 54.

⁶⁷⁴ *Pfizer Canada Inc. v. Novopharm Ltd.*, 2005 CarswellNat 5544, 2005 CarswellNat 31 14, 42 C.P.R. (4th) 502 (F.C.) per Blanchard J. at 531 [C.P.R.], para. 77.

⁶⁷⁵ *Pfizer Canada Inc. v. Novopharm Ltd.*, 2005 CarswellNat 5544, 2005 CarswellNat 31 14, 42 C.P.R. (4th) 502 (F.C.) per Blanchard J. at 531 [C.P.R.], para. 76.

that dry granulation was included in the claim.⁶⁷⁶ It appears that the Court considered it need only ask the first question in order to determine non-essentiality and never asked the second *Free World* question as to whether the inventor intended to limit the claim to “wet granulation” having used that specific term in the claim.

Q#2: (i) that on a purposive construction of the words of the claim it was clearly not intended to be essential

This is a version of the second question in *Catnic*, the third question in *Improver*⁶⁷⁷ and the analysis that resulted in the “self-inflicted wound” in *O’Hara*. If this was treated as an independent test, a variant could radically change the way the invention worked (i.e., be essential under the first *Catnic* and *Improver* questions) but if the Court considered that the inventor’s intention was to include the variant, then, under this test, the element would be found non-essential.

In contrast, in *Catnic*, *Improver* and *O’Hara*, the Courts effectively said “Even if the variant does not change the way the invention works, if the patentee clearly considered the claim element to be essential, then it is to be considered essential.”

In *Improver*, Hoffman J. stated that the second *Catnic* question (the third *Improver* question) the question that raised the question of construction (as compared to the factual background against which the claim is to be construed):

It is worth noticing that Lord Diplock’s first two [*Catnic*] questions, although they cannot sensibly be answered without reference to the patent, do not primarily involve questions of construction: whether the variant would make a material difference to the way the invention worked and whether this would have been obvious to the skilled reader are questions of fact. The answers are used to provide the factual background against which the specification must be construed. It is the third question which raises the question of construction and Lord Diplock’s formulation makes it clear that on this question the answers to the first two questions are not conclusive. Even a purposive construction of the language of the patent may lead to the conclusion that although the variant made no material difference and this would have been obvious at the time, the patentee for some reason was confining his claim to the primary meaning and excluding the variant. If this were not the case, there would be no point in asking the third [*Improver*] question at all.⁶⁷⁸ [parenthetical comments added]

⁶⁷⁶ *Pfizer Canada Inc. v. Novopharm Ltd.*, 2005 CarswellNat 5544, 2005 CarswellNat 3114, 42 C.P.R. (4th) 502 (F.C.) per Blanchard J. at 533 [C.P.R.], para. 81.

⁶⁷⁷ As noted in para. 135 of *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J

⁶⁷⁸ *Improver Corp. v. Remington Consumer Products Ltd.* (1989), [1990] F.S.R. 181 (Eng. Patents Ct.) at 190; *Canamould Extrusions Ltd. v. Driangle Inc.*, 2003 CarswellNat 554, 2003 CarswellNat

Justice Binnie appears to have repeated this apparent inconsistency in logic at another point of the decision. In dealing with the onus of proving that a variant was obvious at the publication date, Justice Binnie stated:

In my view, *Catnic*, *supra*, and *O'Hara, supra*, were correct to put the onus on the patentee to establish known and obvious substitutability at the date of publication of the patent. If the patentee fails to discharge that onus, the descriptive word or expression in the claim is to be considered essential unless the context of the claims language otherwise dictates.⁶⁷⁹ [emphasis added]

The first part of the quote above⁶⁸⁰ is consistent with *Catnic* and *Improver*. The latter part⁶⁸¹ is not.

Having found the claim element to be essential under the first question, the latter part of the sentence appears to be saying it is essential unless the context of the claims otherwise dictates (i.e., the element appears to be non-essential based on the wording of the claims — the paragraph (e)(iv) test). The test thus contemplates the possibility of the claim element being considered essential under the first question but non-essential under the second question, and the element therefore being non-essential. This is contrary to *Catnic* and *Improver* which asked the second question only after finding the element to be, at first blush, non-essential under the first question. [It is, however, consistent with the test for non-essentiality being satisfied by either the first OR second *Catnic* question.]

Free World further provides that the question as to whether a claim element was essential, according to the intent of the inventor, expressed or inferred from the claims, was to be determined “irrespective of its practical effect”.⁶⁸² Presumably Justice Binnie was referring to the practical effect the element had on the operation of the invention. Whereas the first questions in *Catnic* and *Improver* permitted claim elements whose variants had a material effect on the way the invention worked, to be immediately considered to be essential elements, Justice Binnie stated, for the purposes of the second test, this consideration is irrelevant to the second question, further suggesting that both questions are independent of one another.

Perhaps the unusual nature of the proposed scenario renders it of minimal concern: a situation where the patentee has claimed something that, if changed, materially changes the way the invention works, but is referred to expressly as a

1905, 25 C.P.R. (4th) 343 (Fed. T.D.), affirmed 2004 CarswellNat 970, 2004 CarswellNat 386, 30 C.P.R. (4th) 129 (F.C.A.) at 142 [C.P.R.], para. 25.

⁶⁷⁹ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 194 [C.P.R.], para. 57.

⁶⁸⁰ “If the patentee fails to discharge that onus [of proving substitutability], the descriptive word or expression in the claim is to be considered essential ...”

⁶⁸¹ “..... unless the context of the claims language otherwise dictates.”

⁶⁸² *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 184 [C.P.R.], para. 31(e)(iv).

claim element, yet the Court concludes that the inventor did not intend it to be essential, based on a determining such intent from the claim.

6.9.1.5 Cases Applying a Plain Reading of *Whirlpool/Free World*

Two cases decided within a few years after *Whirlpool* and *Free World* applied the two questions as alternatives for determining non-essential elements.

In *Westaim*,⁶⁸³ Hansen J. applied both parts of the *Whirlpool* test to the case at hand and determined, under one test, the one-step cladding was essential and under the other, that it was non-essential.⁶⁸⁴ The case turned on obviousness,⁶⁸⁵ and no findings of infringement were made so the construction did not affect the outcome of the case.

In *Pfizer Canada Inc. v. Novopharm Ltd.*⁶⁸⁶ the Court was faced with a claim that referred only to “wet granulation” of tablets although the description indicated that tablet blends may be dry or wet granulation (but that wet granulation was preferred).⁶⁸⁷ A person skilled in the art would have known that these processes were substitutable without affecting the working of the invention.⁶⁸⁸ Based on asking only the first question in the *Free World* test, the Court concluded that the claim element “wet granulation” was not essential and therefore that dry granulation was included in the claim.⁶⁸⁹ It appears that the Court considered it need only ask the first question in order to determine

⁶⁸³ *Westaim Corp. v. Royal Canadian Mint*, 2002 CarswellNat 3380, 2002 CarswellNat 4776, 23 C.P.R. (4th) 9 (Fed. T.D.) per Hansen J. at 30 [C.P.R.], para. 75.

⁶⁸⁴ In the *Westaim* case, the patent claim called for electroplating a metallic cladding onto steel cores for coins “... until a plating thickness of at least 0.01 mm has been deposited”. The issue was whether the claims included putting on the cladding in multiple layers having a total thickness of more than 0.01 mm, but where the first layer was less than 0.01 mm thick. In applying the two tests, Hansen J. held that it met one but not both tests:

1. In respect of the first test, it was not essential. The number of layers plated during the plating process did not make a functional difference to the process of the invention [para. 78]. A cladding consisting of multiple metallic layers would obtain “substantially the same result” as a cladding consisting of a single metallic layer: a coin blank with a cladding able to take an imprint, that is, a coin suitable for minting [para. 79]; and

2. In respect of the second test, the first layer thickness of 0.01 mm was essential [para. 75]. Three witnesses agreed that the language of the claims contemplated a cladding electroplated in a single continuous process. Although two other witnesses maintained that, in principle, the meaning of the word “cladding” could include multiple metallic layers, their opinions were not based on the use of the word within the context of specific language of the claims. Justice Hansen concluded with the rather awkward language of a triple-negative; “... there is nothing in the language of the claims to indicate that the inventors did not clearly intend that first layer 0.01 mm was a non-essential element.”

⁶⁸⁵ *Westaim Corp. v. Royal Canadian Mint*, 2002 CarswellNat 3380, 2002 CarswellNat 4776, 23 C.P.R. (4th) 9 (Fed. T.D.) per Hansen J. at 45-46 [C.P.R.], paras. 139 and 145.

⁶⁸⁶ *Pfizer Canada Inc. v. Novopharm Ltd.*, 2005 CarswellNat 5544, 2005 CarswellNat 3114, 42 C.P.R. (4th) 502 (F.C.) per Blanchard J. at 523-524 [C.P.R.], para. 54.

⁶⁸⁷ *Pfizer Canada Inc. v. Novopharm Ltd.*, 2005 CarswellNat 5544, 2005 CarswellNat 3114, 42 C.P.R. (4th) 502 (F.C.) per Blanchard J. at 531 [C.P.R.], para. 77.

⁶⁸⁸ *Pfizer Canada Inc. v. Novopharm Ltd.*, 2005 CarswellNat 5544, 2005 CarswellNat 3114, 42 C.P.R. (4th) 502 (F.C.) per Blanchard J. at 531 [C.P.R.], para. 76.

non-essentiality and never asked the second *Free World* question as to whether the inventor intended to limit the claim to “wet granulation”, having used that specific term in the claim.

6.9.2 Back to *Catnic* and *Improver*

Although Justice Binnie agreed with the tests in *Catnic*, *Improver* and *Free World*, he expressed his non-essentiality test as two disjunctive questions (“or”), resulting in logic inconsistent with *Catnic*, *Improver* and *O’Hara*.

Some judges of the Federal Court and Federal Court of Appeal have reverted to the conjunctive *Catnic* and *Improver* tests: if the element is functionally non-essential (it does not change the way the invention works, and that would have been obvious at the relevant time), it may still be essential according to the intent of the inventor.

In 2004, Justice Shore, after citing *Free World*, reverted expressly to the *Improver* questions and held that the claim element in question was essential under both the first and third *Improver* questions.⁶⁹⁰

In 2005 in *Biovail*,⁶⁹¹ Justice Harrington used the first and second *Improver* questions of obvious substitutability to find the elements at issue to be non-essential, but held the elements to be essential based on the third *Improver* question:

In following Lord Hoffmann’s guidelines in *Improver Corp.*, *supra*, the tentative answer to the first question is that the variant (HPC) does not have a material effect on the way the invention works. I say tentative because it is not clear how much experimentation would have to be done to get the ratios between HPC and bupropion hydrochloride right in order to achieve an appropriate sustained release. To answer the second question, subject to the above, it would have been obvious at the date of publication that a reader skilled in the art would have known that the variant had no material effect. Nevertheless, a reader skilled in the art would have understood from the language of the claim that the patentees intended that strict compliance with the claims language was an essential requirement of the invention. Consequently, the variant is outside the claims.⁶⁹²

In 2006, in *Axcan Pharma Inc. v. Pharmascience Inc.*,⁶⁹³ Justice Harrington quoted paragraph 31(e)(iii) and (iv) of *Free World* and noted:

⁶⁸⁹ *Pfizer Canada Inc. v. Novopharm Ltd.*, 2005 CarswellNat 5544, 2005 CarswellNat 31 14, 42 C.P.R. (4th) 502 (F.C.) per Blanchard J. at 533 [C.P.R.], para. 81.

⁶⁹⁰ *Stonehouse v. Batco Manufacturing Ltd.*, 2004 CarswellNat 4874, 2004 CarswellNat 7436, 38 C.P.R. (4th) 105 (F.C.) per Shore J. at paras. 65-66.

⁶⁹¹ *Biovail Pharmaceuticals Inc. v. Canada (Minister of National Health & Welfare)*, 2005 FC 9, 2005 CarswellNat 65, 2005 CarswellNat 1993, 37 C.P.R. (4th) 487 (F.C.) per Harrington J.

⁶⁹² *Biovail Pharmaceuticals Inc. v. Canada (Minister of National Health & Welfare)*, 2005 FC 9, 2005 CarswellNat 65, 2005 CarswellNat 1993, 37 C.P.R. (4th) 487 (F.C.) per Harrington J. at para. 44.

Notice the use of the word “or” between a variant and the intent of the inventor. Objectively speaking, an element of the claimed invention may not be essential but nevertheless is essential according to the intent of the inventor. The inventor will not get more than he asked for.

Justice Harrington held that the specificity of the claim language (a dosage portion of 13-15 mg/kg/day) was an essential element (“Otherwise, what would be the point of mentioning dosage in a patent which asserts but one claim limited to a single sentence?”).⁶⁹⁴ He did not expressly address the first *Free World* question nor address the test of non-essentiality expressed in paragraph 55 of *Free World*. He thus applied *Free World* in a manner consistent with *Catnic* and *Improver*.

In *Halford v. Seed Hawk Inc.*,⁶⁹⁵ the Federal Court of Appeal asked both *Free World* questions, requiring either question to be answered in the affirmative to result in a finding that the element was essential:

An element may be found to be essential on the basis of the intent of the inventor as expressed or inferred from the claims, or on the basis of evidence as to whether it would have been obvious to a skilled worker at the time the patent was published that a variant of a particular element would make a difference to the way in which the invention works (*Free World* at paragraphs 31 and 55).⁶⁹⁶

...

While infringement may result from the hypothetical situation described in the quoted paragraph, if it was not obvious at the date of patent publication that the substituted member had no material effect upon the way the invention works, then there is no infringement. Alternatively, if the functional equivalence was obvious, but the patentee intended strict compliance with the claim, then there is also no infringement (*Free World* at paragraph 55).⁶⁹⁷

⁶⁹³ *Axcan Pharma Inc. v. Pharmascience Inc.*, 2006 FC 527, 2006 CarswellNat 1084, 2006 CarswellNat 2505, 50 C.P.R. (4th) 321 (F.C.) per Harrington J. at 327 [C.P.R.], para. 22.

⁶⁹⁴ *Axcan Pharma Inc. v. Pharmascience Inc.*, 2006 FC 527, 2006 CarswellNat 1084, 2006 CarswellNat 2505, 50 C.P.R. (4th) 321 (F.C.) per Harrington J. at 327 [C.P.R.], para. 28.

⁶⁹⁵ 2006 FCA 275, 2006 CarswellNat 2397, 2006 CarswellNat 4150 (F.C.A.) per Sexton J.A., Sharlow & Malone JJ.A. concurring; referred with approval in *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J. at para. 142.

⁶⁹⁶ 2006 FCA 275, 2006 CarswellNat 2397, 2006 CarswellNat 4150 (F.C.A.) per Sexton J.A., Sharlow & Malone JJ.A. concurring at para. 13.

⁶⁹⁷ *Halford v. Seed Hawk Inc.*, 2006 FCA 275, 2006 CarswellNat 2397, 2006 CarswellNat 4150 (F.C.A.) at para. 15. Although the Court skipped making an express determination of essentiality, it did so implicitly as explained in the table below where the Court’s statement is found in the left hand column and its logic explained in the right hand column.

Quote from the judgment:	Logic
... if it was not obvious at the date of patent publication that the substituted member had no material effect on the way the invention works,	If it was obvious that the variant materially affected the way the invention works

In 2010, after apparently finding obvious substitutability (non-essential under the first *Catnic* question), Justice Gauthier,⁶⁹⁸ said that *Free World* paras. 55-57, but more specifically para. 57, cannot be construed as meaning that the Supreme Court found the third question in *Improver* (the second *Free World* and *Catnic* questions) to be irrelevant.⁶⁹⁹

In 2013, the Federal Court of Appeal, after quoting the disjunctive “or” test from *Whirlpool* and *Free World* said:

The *Improver* questions are used for determining whether an element is essential.⁷⁰⁰

In *Astrazeneca Canada Inc. et al. v. Apotex Inc. et al.*, Justice Rennie⁷⁰¹ explained the test for essentiality in terms of how to determine when an element is essential:

An “essential element” of a patent is either: an element which, if varied, would make a difference to the way in which the invention works, or an element which is essential irrespective of its practical effect according to the intent of the inventor, expressed or inferred from the claims: *Free World Trust*, at para. 31.⁷⁰²

The converse – how to determine whether an element is non-essential – was stated expressly, in *Shire Canada Inc. v. Apotex Inc.*⁷⁰³ by Justice Locke with reference to the *Free World* decision:

then there is no infringement.	then the element was essential and the variant was therefore outside the claim and not infringing.
Alternately, if the functional equivalence was obvious,	On the other hand, if there was an obvious equivalent,
but the patentee intended strict compliance with the claim,	but the patentee’s intention from reading the claim was that the claim element was essential
then there is also no infringement.	then the element was essential and the variant was therefore outside the claim and not infringing.

⁶⁹⁸ then of the Federal Court, now of the Federal Court of Appeal.

⁶⁹⁹ *Bauer Hockey Corp. v. Easton Sports Canada Inc.*, 2010 FC 361, 2010 CarswellNat 3031, 2010 CarswellNat 796 (F.C.) per Gauthier J. at para. 144, affirmed 2011 CarswellNat 4827, 2011 CarswellNat 561 (F.C.A.). Although the inventor knew that the tendon guard could be attached in an overlapping fashion [substitutable, and therefore non-essential under the first *Improver* question], it was also evident that he chose to limit his monopoly to tendon guards attached in a side-by-side fashion [intention of the inventor as expressed in the claims, and therefore essential under the second *Improver* question]. See also *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J. at para. 143.

⁷⁰⁰ *Eurocopter c. Bell Helicopter Textron Canada Ltée*, 2013 FCA 219, 2013 CarswellNat 6962, 2013 CarswellNat 3455 (F.C.A.) (per Mainville J.A., Noe J. and Trudel J.J.A. concurring) at para. 86, reconsideration / rehearing refused 2013 CarswellNat 4333, 2013 CarswellNat 4334 (F.C.A.).

⁷⁰¹ Then of the Federal Court (but now of the Federal Court of Appeal)

⁷⁰² *Astrazeneca Canada Inc. et al. v. Apotex Inc. et al.*, 2014 FC 638 (F.C. per Rennie J.) at para. 72; aff’d *Astrazeneca Canada Inc. et al. v. Apotex Inc. et al.*, 2015 FCA 158 (F.C.A. per Dawson J.A., Ryer & Webb J.J.A., concurring) at para. 11, reversed 2017 CarswellNat 2988, 2017 CarswellNat 2989 (S.C.C.).

⁷⁰³ 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J

In my view, the SCC likely intended that, in order for a patentee to establish that a claim element is non-essential, it must show both (i) that on a purposive construction of the words of the claim it was clearly not intended to be essential, and (ii) that at the date of publication of the patent, the skilled addressees would have appreciated that a particular element could be substituted without affecting the working of the invention.”⁷⁰⁴ [emphasis in original]

and in *MediaTube Corp. v. Bell Canada*:⁷⁰⁵

The foregoing questions are sometimes referred to as the *Improver* questions. It is understood that a party seeking to establish that a claim element is not essential (*i.e.*, that the variant falls within the scope of the claim) must be successful on all three questions.

Shire was followed in *Choueifaty v. Canada (Attorney General)*.⁷⁰⁶

Ironically, by reading the *Free World* questions as being consistent with those in *Catnic* and *Improver*, the courts are avoiding at least a “literal” construction of *Free World* para. 55 and, at most, ignoring what Justice Binnie appears to have expressly intended (disjunctive questions), and thereby applying their own “purposive” construction.

If the courts are to follow the *Catnic* and *Improver* tests then, until such time as the *Free World* test is clarified either by the Supreme Court of Canada, or by statutory amendment, it is respectfully suggested that the test as expressed by Justice Locke in *Shire* (or by the Federal Court of Appeal in *Halford*, or by the Federal Court in *Astrazeneca*) should be followed by subsequent courts.

6.9.3 A Purposive Construction of Free World

The *Free World* test is explicitly disjunctive,⁷⁰⁷ whereas *Catnic* and *Improver* asked questions sequentially and dependently. In addition, unlike Justice Hoffman in *Improver*, Justice Binnie did not provide specific questions, answers and directions as to how essentiality or non-essentiality were to be determined in applying the *Free World* test.

⁷⁰⁴ *Shire Canada Inc. v. Apotex Inc.*, 2016 FC 382, 2016 CarswellNat 951, 2016 CarswellNat 2105 (F.C.) per Locke J. at para. 137.

⁷⁰⁵ *MediaTube Corp. v. Bell Canada*, 2017 FC 6, 2017 CarswellNat 18, 2017 CarswellNat 3277 (F.C.) per Locke J. at para. 34, affirmed 2019 CarswellNat 2404, 2019 CarswellNat 14152 (F.C.A.), leave to appeal refused 2020 CarswellNat 826, 2020 CarswellNat 827 (S.C.C.).

⁷⁰⁶ *Choueifaty v. Canada (Attorney General)*, 2020 FC 837, 2020 CarswellNat 3281, 2020 CarswellNat 6342 (F.C.) per Zinn J. at para. 39.

⁷⁰⁷ *Free World Trust c. E lectro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 183-184 [C.P.R.], para. 31. The disjunctive “or” was noted by Harrington J. in *Biovail Pharmaceuticals Inc. v. Canada (Minister of National Health & Welfare)*, 2005 CarswellNat 65, 2005 CarswellNat 1993, 37 C.P.R. (4th) 487 (F.C.) per Harrington J. at 503 [C.P.R.], para. 46 while he applied the *Improver* questions in para. 44.

In order for the disjunctive questions in *Free World* to be consistent with the conjunctive questions asked in *Catnic* and *Improver* (both of which Binnie J. approved) the questions for determining essentiality must be:

1. Was it 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? If modifying or omitting the element changes the way the invention works, and that was obvious at the relevant date, then the element is essential; or
2. According to the intent of the inventor, expressed or inferred from the claims, was a particular element essential irrespective of its practical effect? If the element appears to have been intended to be essential, then the element is essential.

If Binnie J. intended his test to be consistent with *Catnic* and *O'Hara*, it should have been expressed as a test for essentiality (rather than non-essentiality) and the negatives turned to positives, as follows:

For an element to be considered essential and thus non-substitutable, it must be shown either:

- (i) that on a purposive construction of the words of the claim it was clearly intended to be essential, or
- (ii) that at the date of the publication of the patent, the skilled addressees would have appreciated that a particular element could not be substituted without affecting the working of the invention ...

Such test would be consistent with *Catnic* and *O'Hara* in that if either question found the element to be essential, then it would be essential and if both questions found the element not to be essential, then the element would be non-essential.

Thus, if either Question 1 or Question 2 established that the claim element is essential, then it is essential. In order to be non-essential, it must be found not to be essential under both questions.⁷⁰⁸ This interpretation is consistent with the approach taken by the decisions in the previous section.

Although the *Free World* test permits departing from the wording of the claims, Justice Binnie suggested that it be done sparingly:

The patent owner, competitors, potential infringers and the public generally are thus entitled to clear and definite rules as to the extent of the monopoly conferred. This in turn requires that the subjective or discretionary element of claims interpretation

⁷⁰⁸ See Appendix "A" for a comparison of the logic in *Catnic*, *Improver* and *Free World*.

(e.g., the elusive quest for “the spirit of the invention”) be kept to the minimum, consistent with giving “the inventor protection for that which he has actually in good faith invented” (*Western Electric Co. v. Baldwin International Radio of Canada*, [1934] S.C.R. 570, at p. 574). Predictability is achieved by tying the patentee to its claims; fairness is achieved by interpreting those claims in an informed and purposive way.⁷⁰⁹ [emphasis added]⁷¹⁰

Where patent language can bear more than one equally plausible meaning, one must adopt a “reasonable view” of patent language to “afford the inventor protection for that which he has in good faith invented”⁷¹¹ but this principle does not mean that in all cases it must adopt “any arguable interpretation that would uphold the patent”.⁷¹² Claim construction is supposed to be objective, not result-oriented.

6.10. DEVELOPMENTS IN CLAIM CONSTRUCTION SINCE FREE WORLD AND WHIRLPOOL

6.10.1 *The 2004 Kirin-Amgen Decision*

Ironically, only a few years after the Supreme Court of Canada embraced *Catnic*’s principles in *Free World* and *Whirlpool*, the U.K. House of Lords in the *Kirin-Amgen* decision⁷¹³ took a fresh look at claim construction. Lord Hoffman, who decided the *Improver* case, distinguished *Catnic* stating that its double-negative test should not be used as a rule of general application in claim construction. Apparently therefore, the Supreme Court of Canada adopted as a general test in *Free World* one similar to *Catnic* which, a few years later, the House of Lords said should not be considered as a general test.

The patent in issue in *Kirin-Amgen* was granted after 1977 and had to be interpreted under the newer U.K. *Patent Act* which had to take into consideration Article 69 of the European Patent Convention (“EPC”). For patents granted after 1977, the UK *Patent Act* gave effect to article 69 of the

⁷⁰⁹ *Free World Trust c. Électro Santé Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 189 [C.P.R.], para. 43.

⁷¹⁰ *Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd.*, 1981 CarswellNat 582F, 1981 CarswellNat 582, [1981] 1 S.C.R. 504 (S.C.C.) at 521 [S.C.R.].

⁷¹¹ *Lubrizol Corp. v. Imperial Oil Ltd.*, 1992 CarswellNat 1049, 45 C.P.R. (3d) 449, 98 D.L.R. (4th) 1 (Fed. C.A.), additional reasons 1993 CarswellNat 1964 (Fed. C.A.), leave to appeal refused 1993 CarswellNat 2472 (S.C.C.); *Western Electric Co. v. Baldwin International Radio of Canada Ltd.*, 1934 CarswellNat 38, [1934] S.C.R. 570, [1934] 4 D.L.R. 129 (S.C.C.); *Unilever PLC v. Procter & Gamble Inc.*, 1995 CarswellNat 375, [1995] F.C.J. No. 1005, 61 C.P.R. (3d) 499 (Fed. C.A.) at para. 23.

⁷¹² *ABB Technology AG v. Hyundai Heavy Industries Co.*, 2015 FCA 181, 2015 CarswellNat 9234, 2015 CarswellNat 3718 (F.C.A.) per Stratas J.A., Webb & Near JJ.A. concurring at para. 45.

⁷¹³ *Kirin-Amgen Inc. v. Transkaryotic Therapies Inc. (No. 2)*, [2004] UKHL 46, [2005] 1 All E.R. 667 (U.K. H.L.).

EPC which applies to infringement proceedings in the domestic courts of all Contracting States:

The extent of protection conferred by a European patent or a European patent application shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.

Article 2 added to the Protocol by the *Munich Act* revising the EPC, dated November 29, 2000 (and not yet in force) provides:

For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of any element which is equivalent to an element specified in the claims.

The Protocol on the Interpretation of Article 69 provides that Article 69 is to be interpreted at a position between the extremes of applying a strict, literal meaning of the wording used in the claims on the one hand and extend to what the patentee had contemplated: namely, to combine a fair protection for the patentee with a reasonable degree of certainty for third parties.⁷¹⁴ Thus, neither extreme is to be used.

Under U.K. law, construction of the claims is not to be concerned with what the author meant to say, rather, it is concerned with what a reasonable person reading the patent would understand the author to mean using those words. The language chosen by the patentee is thus of critical importance.

Lord Hoffman reviewed the history of the U.K. infringement of the “pith and marrow” versus “literal infringement” and the U.S. “doctrine of equivalents”, the effect of the latter of which it considered to “extend protection to something outside the claims which performs substantially the same function in substantially the same way to obtain the same result.”⁷¹⁵ The Court said that the U.S. “doctrine of equivalents” was a way to adhere to literalism yet evolve a doctrine which supplements the claims by extending protection to equivalents. On the other hand, Lord Hoffman said that *Catnic* had abandoned literalism to adopt an approach that gave effect to what the person skilled in the art would have understood the patentee to be claiming.⁷¹⁶

According to Lord Hoffman, Article 69 “firmly shuts the door on any doctrine which extends protection outside the claims.”⁷¹⁷ In his view, *Catnic* was differentiating between different meanings of the words in the claim:

⁷¹⁴ *Kirin-Amgen Inc. v. Transkaryotic Therapies Inc. (No. 2)*, [2004] UKHL 46, [2005] 1 All E.R. 667 (U.K. H.L.) at para. 25.

⁷¹⁵ *Kirin-Amgen Inc. v. Transkaryotic Therapies Inc. (No. 2)*, [2004] UKHL 46, [2005] 1 All E.R. 667 (U.K. H.L.) at para. 38.

⁷¹⁶ *Kirin-Amgen Inc. v. Transkaryotic Therapies Inc. (No. 2)*, [2004] UKHL 46, [2005] 1 All E.R. 667 (U.K. H.L.) at para. 43.

If Lord Diplock did not invent the expression [“purposive construction”], he certainly gave it wide currency in the law. But there is, I think, a tendency to regard it as a vague description of some kind of divination which mysteriously penetrates beneath the language of the specification. Lord Diplock was in my opinion being much more specific and his intention was to point out that a person may be taken to mean something different when he uses words for one purpose from what he would be taken to mean if he was using them for another. The example in the *Catnic* case was the difference between what a person would reasonably be taken to mean by using the word “vertical” in a mathematical theorem and by using it in a claimed definition in the building trade.

Here, Lord Hoffman appears to be creatively applying “revisionist history” to say what Lord Diplock should have said in *Catnic*: that words should be read in their technological context and be given the scope or precision with which they are used in that technology or industry. This is exactly what Lord Diplock said in his “near enough” statement, immediately prior to going on to divide the claim into essential and non-essential elements:

... it seems to me that the expression “extending vertically” as descriptive of the position of what in use will be the upright member of a trapezoid-shaped box girder, is perfectly capable of meaning positioned near enough to the exact geometrical vertical to enable it in actual use to perform satisfactorily all the functions that it could perform if it were precisely vertical ...⁷¹⁷ [emphasis added]

In *Kirin-Amgen*, Lord Hoffman described his own rephrasing of the *Catnic* test in the *Improver* case, as follows:

Does the feature fall outside the primary, literary or acontextual meaning of a descriptive word or phrase in the claim (“the variant”). If it does, is it nevertheless within the language as properly interpreted? — the latter question answered by asking the following:

1. Does the variant have a material effect upon the way the invention works? If yes, then the variant is outside the claim. If not,
2. Would the fact that the variant had no material effect have been obvious, at the date of publication of the patent, to a reader of the patent skilled in the art? If no, the variant is outside the claim. If yes,
3. Would the reader have understood from the language of the claim that the patentee intended that strict compliance with the primary

⁷¹⁷ *Kirin-Amgen Inc. v. Transkaryotic Therapies Inc. (No. 2)*, [2004] UKHL 46, [2005] 1 All E.R. 667 (U.K. H.L.) at para. 44.

⁷¹⁸ *Catnic Components Ltd. v. Hill & Smith Ltd.* (1981), [1982] R.P.C. 183 (U.K. H.L.) per Lord Diplock at 244, affirmed (1982), [1983] F.S.R. 512 (U.K. H.L.).

meaning was an essential requirement of the invention? If yes, then the variant is outside the claim. If no, it is within the claim.

A negative answer would lead to the conclusion that the patentee was intending the word or phrase to have not a literal but a figurative meaning denoting a class of things which include the variant and the literal meaning, the latter being the most perfect, best-known or striking example of the class.⁷¹⁹

In *Kirin-Amgen*, Lord Hoffman held that *Catnic* questions (which he referred to as “the Protocol questions”) had erroneously been used as a general rule: namely “... as a framework for deciding whether equivalents fall within the scope of the claims”. In contrast, the “*Catnic* principle”, namely that of purposive construction, which gives effect to the requirements of the Protocol, is the “bedrock of patent construction” and is universally applicable. The Protocol questions are merely a guideline, more useful in some cases than in others.⁷²⁰

I am bound to say that the cases show a tendency for counsel to treat the Protocol questions as legal rules rather than guides which will in appropriate cases help to decide what the skilled man would have understood the patentee to mean.⁷²¹

The determination of the extent of protection conferred by a European patent is an examination in which there is only one compulsory question, namely that set out in article 69 and its Protocol: what would a person skilled in the art have understood the patentee to have used the language of the claim to mean? Everything else, including the Protocol questions, is only guidance to a judge trying to answer that question. But there is no point in going through the motions of answering the Protocol questions when you cannot sensibly do so until you have construed the claim. In such a case — and the present is in my opinion such a case — they simply provide a formal justification for a conclusion which has already been reached on other grounds.⁷²² [emphasis added]

No doubt there will be patent lawyers who are dismayed at the notion that the Protocol questions do not provide an answer in every case. They may feel cast adrift on a sea of uncertainty. But that is the fate of all who have to understand what people mean by using language. The Protocol questions are useful in many cases, but they are not a substitute for trying to understand what the person skilled in the art would have understood the patentee to mean by the language of the claims.⁷²³

⁷¹⁹ *Kirin-Amgen Inc. v. Transkaryotic Therapies Inc. (No. 2)*, [2004] UKHL 46, [2005] 1 All E.R. 667 (U.K. H.L.) at para. 51.

⁷²⁰ *Kirin-Amgen Inc. v. Transkaryotic Therapies Inc. (No. 2)*, [2004] UKHL 46, [2005] 1 All E.R. 667 (U.K. H.L.) at para. 52.

⁷²¹ *Kirin-Amgen Inc. v. Transkaryotic Therapies Inc. (No. 2)*, [2004] UKHL 46, [2005] 1 All E.R. 667 (U.K. H.L.) at para. 52.

⁷²² *Kirin-Amgen Inc. v. Transkaryotic Therapies Inc. (No. 2)*, [2004] UKHL 46, [2005] 1 All E.R. 667 (U.K. H.L.) at para. 69.

The current U.K. test would appear to be a simple one: Applying a purposive construction to the patent, what would a person skilled in the art have understood the patentee to have used the language of the claim to mean?

Construction, whether of a patent or any other document, is of course not directly concerned with what the author meant to say. There is no window into the mind of the patentee or the author off any other document. Construction is objective in the sense that it is concerned with what a reasonable person to whom the utterance was addressed would have understood the author to be using the words to mean. Notice, however, that it is not, as is sometimes said, “the meaning of the words the author used”, but rather what the notional addressee would have understood the author to mean by using those words. The meaning of words is a matter of convention, governed by rules, which can be found in dictionaries and grammars. What the author would have been understood to mean by using those words is not simply a matter of rules. It is highly sensitive to the context of and the background to the particular utterance. It depends not only upon the words the author has chosen but also upon the identity of the audience he is taken to have been addressing and the knowledge and assumptions which one attributes to that audience.⁷²⁴

Kirin-Amgen was quoted in great detail by Justice Hughes in *Pfizer Canada Inc. v. Canada (Minister of Health)*⁷²⁵ and, although quoted to a lesser extent or cited by other judges,⁷²⁶ none have yet noted its marginalization of *Catnic*.

6.10.2 The 2017 Actavis Decision

Article 69 of the European Patent Convention provides:

The extent of the protection conferred by a European patent or a European patent application shall be determined by the claims. Nevertheless, the description and drawings shall be used to interpret the claims.⁷²⁷

⁷²³ *Kirin-Amgen Inc. v. Transkaryotic Therapies Inc. (No. 2)*, [2004] UKHL 46, [2005] 1 All E.R. 667 (U.K. H.L.) at para. 71.

⁷²⁴ *Kirin-Amgen Inc. v. Transkaryotic Therapies Inc. (No. 2)*, [2004] UKHL 46, [2005] 1 All E.R. 667 (U.K. H.L.) at para. 64 quoted in *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at para. 64.

⁷²⁵ *Pfizer Canada Inc. v. Canada (Minister of Health)*, 2005 CarswellNat 4401, 2005 CarswellNat 7441, 46 C.P.R. (4th) 244 (F.C.) at para. 26, affirmed 2007 CarswellNat 6, 2007 CarswellNat 1052 (F.C.A.) and in *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at paras. 63-64.

⁷²⁶ See also *Letourneau v. Clearbrook Iron Works Ltd.*, 2005 CarswellNat 5521, 2005 CarswellNat 3008, 44 C.P.R. (4th) 345 (F.C.) at 354 [C.P.R.], para. 28, affirmed 2006 CarswellNat 1465, 2006 CarswellNat 240, 46 C.P.R. (4th) 241 (F.C.A.); *Stonehouse v. Batco Manufacturing Ltd.*, 2004 CarswellNat 4874, 2004 CarswellNat 7436, 38 C.P.R. (4th) 105 (F.C.) at 119-120 [C.P.R.], para. 71; *Biovail Pharmaceuticals Inc. v. Canada (Minister of National Health & Welfare)*, 2005 CarswellNat 65, 2005 CarswellNat 1993, 37 C.P.R. (4th) 487 (F.C.) at 501 [C.P.R.], para. 39.

⁷²⁷ <https://www.epo.org/law-practice/legal-texts/html/epc/2016/e/ar69.html>

The Protocol on the Interpretation of Article 69⁷²⁸ as revised by the Act revising the EPC of 29 November 2000, provides:

Article 1 - General principles

Article 69 should not be interpreted as meaning that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Nor should it be taken to mean that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties.

Article 2 - Equivalents

For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of any element which is equivalent to an element specified in the claims.

Article 1

In *Eli Lilly v. Actavis UK Ltd. & Others*⁷²⁹ the UK Supreme Court said it “expressed in our own words our reformulated version” of the Improver questions (emphasizing that they are guidelines, not strict rules:

- i) Notwithstanding that it is not within the literal meaning of the relevant claim(s) of the patent, does the variant achieve substantially the same result in substantially the same way as the invention, i.e., the inventive concept revealed by the patent?
- ii) Would it be obvious to the person skilled in the art, reading the patent at the priority date, but knowing that the variant achieves substantially the same result as the invention, that it does so in substantially the same way as the invention?
- iii) Would such a reader of the patent have concluded that the patentee nonetheless intended that strict compliance with the literal meaning of the relevant claim(s) of the patent was an essential requirement of the invention?

In order to establish infringement in a case where there is no literal infringement, a patentee would have to establish that the answer to the first two questions was “yes” and that the answer to the third question was “no”.⁷³⁰

⁷²⁸ <https://www.epo.org/law-practice/legal-texts/html/epc/2016/e/ma2a.html>

⁷²⁹ [2017] UKSC 48 (U.K. S.C.) (per Lord Neuberger, President).

At first blush, the questions look very similar to *Improver*, but they and the other *dicta* in *Actavis* contain significant departures from *Catnic*, *Improver* and *Kirin-Amgen*:

1. Lord Neuberger differentiates between the meaning of the claims and the scope of protection afforded to a patentee, the latter not being limited to the former.

... two points appear to be clear from the Protocol. The first, which can be deduced from article 1, is that the scope of protection afforded to a patentee is not to be limited by the literal meaning of the claims. However, it is not at all clear how far a court is permitted to move away from the literal meaning. ... it is very hard to be confident how far they were intended to permit a court to go beyond the actual language of a claim when interpreting a claim. Secondly, it is apparent from article 2 that there is at least potentially a difference between interpreting a claim and the extent of the protection afforded by a claim, and, when considering the extent of such protection, equivalents must be taken into account, but no guidance is given as to precisely what constitutes an equivalent or how equivalents are to be taken into account with the need for a competitive market. In my view, issue (i) self-evidently raises a question of interpretation, whereas issue (ii) raises a question which would normally have to be answered by reference to the facts and expert evidence.⁷³¹

2. Lord Neuberger characterized Lord Hoffman's approach in *Kirin-Amgen* as conflating the two issues:

In *Kirin-Amgen* [2005] RPC 9, Lord Hoffmann, following his approach in *Improver*, [1990] FSR 181 (which itself had followed Lord Diplock's analysis in *Catnic*, [1982] RPC 183) effectively conflated the two issues, and indicated that the conflated issue involved a question of interpretation. I have considerable difficulties with the notion that there is a single conflated, or compound, issue, and, even if that notion is correct, that that issue raises a question of interpretation. Indeed, in my view, to characterise the issue as a single question of interpretation is wrong in principle, and unsurprisingly, therefore, can lead to error.⁷³²

3. Before embarking on an analysis of past UK jurisprudence and that of other Convention states, Lord Neuberger tellingly asked:

⁷³⁰ *Eli Lilly v. Actavis UK Ltd. & Others*, [2017] UKSC 48 (U.K. S.C.) (per Lord Neuberger, President) at para. 66.

⁷³¹ *Eli Lilly v. Actavis UK Ltd. & Others*, [2017] UKSC 48 (U.K. S.C.) (per Lord Neuberger, President) at para. 33.

⁷³² *Eli Lilly v. Actavis UK Ltd. & Others*, [2017] UKSC 48 (U.K. S.C.) (per Lord Neuberger, President) at para. 55.

The question of how far one can go outside the wording of a claim to enable the patentee to enjoy protection against products or processes which are not within the ambit of the actual language, construed in accordance with ordinary principles of interpretation, ...

4. Lord Neuberger flips the order of the *Catnic/Improver* questions to first ask what is the scope of the claims as a matter of normal interpretation and then ask what scope of protection is afforded to such claim by including equivalents that are immaterial variants:

In my view, notwithstanding what Lord Diplock said in *Catnic* [1982] RPC 183, 242, a problem of infringement is best approached by addressing two issues, each of which is to be considered through the eyes of the notional addressee of the patent in suit, ie the person skilled in the relevant art. Those issues are: (i) does the variant infringe any of the claims as a matter of normal interpretation; and, if not, (ii) does the variant nonetheless infringe because it varies from the invention in a way or ways which is or are immaterial? If the answer to either issue is “yes”, there is an infringement; otherwise, there is not. Such an approach complies with article 2 of the Protocol, as issue (ii) squarely raises the principle of equivalents, but limits its ambit to those variants which contain immaterial variations from the invention. It is also apparent that the two issues comply with article 1 of the Protocol in that they involve balancing the competing interests of the patentee and of clarity, just as much as they seek to balance the encouragement of inventions and their disclosure.⁷³³

5. In reformulating the three *Improver* questions, Lord Neuberger said:

a.....the question as framed by Hoffmann J., with its emphasis on how “the invention” works, should correctly involve the court focussing on the “the problem underlying the invention”, “the inventive core”, or “the inventive concept” as it has been variously termed in other jurisdictions. In effect, the question is whether the variant achieves the same result in substantially the same way as the invention. If the answer to that question is no, then it would plainly be inappropriate to conclude that it could infringe. If, by contrast, the answer is yes, then it provides a sound initial basis for concluding that the variant may infringe, but the answer should not be the end of the matter.⁷³⁴ [emphasis added]

b. The second *Improver* question is more problematic. In my view, it imposes too high a burden on the patentee⁷³⁵ ...the second question is

⁷³³ *Eli Lilly v. Actavis UK Ltd. & Others*, [2017] UKSC 48 (U.K. S.C.) (per Lord Neuberger, President) at para. 54.

⁷³⁴ *Eli Lilly v. Actavis UK Ltd. & Others*, [2017] UKSC 48 (U.K. S.C.) (per Lord Neuberger, President) at para. 60.

⁷³⁵ *Eli Lilly v. Actavis UK Ltd. & Others*, [2017] UKSC 48 (U.K. S.C.) (per Lord Neuberger, President) at para. 61.

better expressed as asking whether, on being told what the variant does, the notional addressee would consider it obvious that it achieved substantially the same result in substantially the same way as the invention. In other words, it seems to me that the second *Improver* question should be asked on the assumption that the notional addressee knows that the variant works to the extent that it actually does work.⁷³⁶ ... This reformulated second question should also apply to variants which rely on, or are based on, developments which have occurred since the priority date, even though the notional addressee is treated as considering the second question as at the priority date.⁷³⁷ [emphasis added]

Lord Neuberger's greatest departure with *Improver* and *Catnic* occurs in his handling of the third *Improver* question:

c. The third *Improver* question as expressed by Hoffmann J. is whether the notional addressee would have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention. That is in my view an acceptable test, provided that it is properly applied.

... the fact that the language of the claim does not on any sensible reading cover the variant is certainly not enough to justify holding that the patentee does not satisfy the third question. Hence, the fact that the rubber rod in *Improver* [1990] FSR 181 could not possibly be said to be "an approximation to a helical spring" (to quote from p. 197) was not the end of the infringement issue even in Hoffmann J's view: indeed, as I have already pointed out, it was because the rubber rod could not possibly be said to be a helical spring that the allegedly infringing product was a variant and the patentee needed to invoke the three *Improver* questions.

Lord Neuberger seems to disregard the specificity of the term in question (e.g. "helical spring") and does not ask (as was asked in *Catnic* and *Improver* respectively) whether the inventor intended to exclude the variant or whether the term was being used to mean something more or less than its acontextual meaning.

In the *Actavis* case, Lord Neuberger held that the claim for the "pemetrexed disodium" extended to include the Actavis products: (a) pemetrexed diacid, (b) pemetrexed ditromethamine, and (c) pemetrexed dipotassiumdiacid⁷³⁸ effectively ignoring the specific language of the claim:

⁷³⁶ *Eli Lilly v. Actavis UK Ltd. & Others*, [2017] UKSC 48 (U.K. S.C.) (per Lord Neuberger, President) at para. 62.

⁷³⁷ *Eli Lilly v. Actavis UK Ltd. & Others*, [2017] UKSC 48 (U.K. S.C.) (per Lord Neuberger, President) at para. 63.

⁷³⁸ *Eli Lilly v. Actavis UK Ltd. & Others*, [2017] UKSC 48 (U.K. S.C.) (per Lord Neuberger, President) at paras. 8 & 75.

In my opinion, the Court of Appeal adopted an approach which places too much weight on the words of the claim and not enough weight on article 2 of the Protocol (and it is only right to add that, in doing so, they were, like Arnold J. at first instance, following Lord Hoffmann's guidance in *Kirin-Amgen* [2005] RPC 9). If one cannot depart from the language of the claim when considering those questions, what is the point of the questions in the first place?⁷³⁹

Lord Neuberger, borrowing from *Catnic*, decided that “No plausible reason has been advanced why any rational patentee should want to place so narrow a limitation on his invention” as to limit the scope of protection afforded by the Patent to pemetrexed disodium⁷⁴⁰. Note however that the patentee did not, but could have, claimed more broadly to define the claim in terms of a genus that included the specie of pemetrexed disodium and its equivalents, but chose not to do so.

Actavis appears to have introduced a doctrine of equivalents to the scope of protection of UK patent claims: construe the claim and then include under its scope of protection, its equivalents.

Canadian courts have not yet commented on the *Actavis* decision. The Court of Appeal of Singapore declined to follow the *Actavis* case.⁷⁴¹

6.11 “SWISS” TYPE CLAIMS

A “Swiss” type claim is one drafted in the following form:

The use of [an old compound] in the manufacture of a medicament for the treatment of [a new disorder].⁷⁴²

At one time, claims directed to medicines were not permitted, so claims were phrased to indirectly cover them. When a new use for an old medicine could not be claimed, the Swiss developed a way around this issue by claiming the use of a medicine for the manufacture of a pill for a new use, thus making it statutory subject matter as being “susceptible of industrial application”.⁷⁴³

⁷³⁹ *Eli Lilly v. Actavis UK Ltd. & Others*, [2017] UKSC 48 (U.K. S.C.) (per Lord Neuberger, President) at para. 71.

⁷⁴⁰ *Eli Lilly v. Actavis UK Ltd. & Others*, [2017] UKSC 48 (U.K. S.C.) (per Lord Neuberger, President) at para. 73.

⁷⁴¹ *Lee Tat Cheng v. Maka GPS Technologies Pte Ltd.*, [2018] SGCA 18.

⁷⁴² *Eli Lilly Canada Inc. v. Apotex Inc.*, 2008 FC 142, 2008 CarswellNat 1821, 2008 CarswellNat 308, 63 C.P.R. (4th) 406 (F.C.) per Hughes J. at para. 18, affirmed 2009 CarswellNat 833, 2009 CarswellNat 3956 (F.C.A.), leave to appeal refused 2009 CarswellNat 3235, 2009 CarswellNat 3236 (S.C.C.), quoted in *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at para. 87.

⁷⁴³ *Deprenyl Research Ltd. v. Apotex Inc.*, 1994 CarswellNat 1861, 55 C.P.R. (3d) 171 (Fed. T.D.) at 175 [C.P.R.], affirmed 1995 CarswellNat 3024, 1995 CarswellNat 3025, 60 C.P.R. (3d) 501 (Fed. C.A.), quoted in *Eli Lilly Canada Inc. v. Apotex Inc.*, 2008 FC 142, 2008 CarswellNat 1821, 2008 CarswellNat 308, 63 C.P.R. (4th) 406 (F.C.) per Hughes J. at para. 20, affirmed 2009 CarswellNat 833, 2009 CarswellNat 3956 (F.C.A.), leave to appeal refused 2009 CarswellNat 3235, 2009

The authorities on how to interpret such claims are divided. In *Abbott Laboratories v. Canada (Minister of Health)*,⁷⁴⁴ the court held that a “Swiss” type claim was a claim for the use of a substance to make another substance and, therefore, was not an eligible claim under the NOC Regulations because it was not “... a claim for the use of a medicine for the diagnosis, treatment, mitigation or prevention of a disease, disorder or abnormal physical state, or the symptoms thereof”. However in *Pfizer Canada Inc. v. Apotex Inc.*⁷⁴⁵ Justice Mosley appears to have considered several “Swiss” type claims as being for the use of a medicine to treat ED “... and the manufacture of a medicament or the adaptation for oral treatment are merely secondary aspects to the essential claimed use.”⁷⁴⁶ In *Merck & Co. v. Pharmascience Inc.*,⁷⁴⁷ Hughes J. limited his construction of a “Swiss” type claim to what had been alleged in Pharmascience’s Notice of Allegation: to the use of a particular dosage of a medicine to treat baldness.⁷⁴⁸

6.12 CONCLUSIONS

The test set out in *Free World* inherits the legacy of an inherently self-contradictory test that, on the one hand, considers the claim language to be paramount yet, on the other hand, permits claim elements to be considered non-essential and capable of variation or omission from consideration. A resolution of this situation can be made only through future jurisprudence at the level of the Supreme Court of Canada or by Parliament rendering all claim elements to be considered essential.

It is possible to apply a “purposive construction” to the claim construction test expressed in *Free World* which is consistent with prior cases approved by the Supreme Court (*Catnic*, *Improver* and *O’Hara*), however a lack of specificity in expressing what is to follow in answering the *Free World* questions has resulted in diverse applications of the test. Until the *Free World* test is clarified by the

CarswellNat 3236 (S.C.C.) and *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at para. 87.

⁷⁴⁴ 2007 CarswellNat 3022, 2007 CarswellNat 1216, 59 C.P.R. (4th) 1 (F.C.A.) per Noe” I.J.A.

⁷⁴⁵ *Pfizer Canada Inc. v. Apotex Inc.*, 2007 CarswellNat 3145, 2007 CarswellNat 4965, 61 C.P.R. (4th) 305 (F.C.) per Mosley J., affirmed 2009 CarswellNat 1151, 2009 CarswellNat 176 (F.C.A.).

⁷⁴⁶ *Pfizer Canada Inc. v. Apotex Inc.*, 2007 CarswellNat 3145, 2007 CarswellNat 4965, 61 C.P.R. (4th) 305 (F.C.) per Mosley J. at para. 153, affirmed 2009 CarswellNat 1151, 2009 CarswellNat 176 (F.C.A.) quoted in *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at para. 90. This approach mirrors the older U.K. approach at construing such claims by ignoring their form and considering them to be claiming a new use; otherwise such claims will lack novelty and inventiveness if all that is being considered is the making of the tablet.

⁷⁴⁷ *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J.

⁷⁴⁸ *Merck & Co. v. Pharmascience Inc.*, 2010 FC 510, 2010 CarswellNat 2923, 2010 CarswellNat 1335 (F.C.) per Hughes J. at paras. 94-99.

Supreme Court of Canada, there will likely continue to be unpredictable and inconsistent outcomes — a result that will frustrate litigants and fuel what Mr. Justice Binnie described as “the already overheated engines of patent litigation”⁷⁴⁹ for years to come.

6.13 APPENDIX A

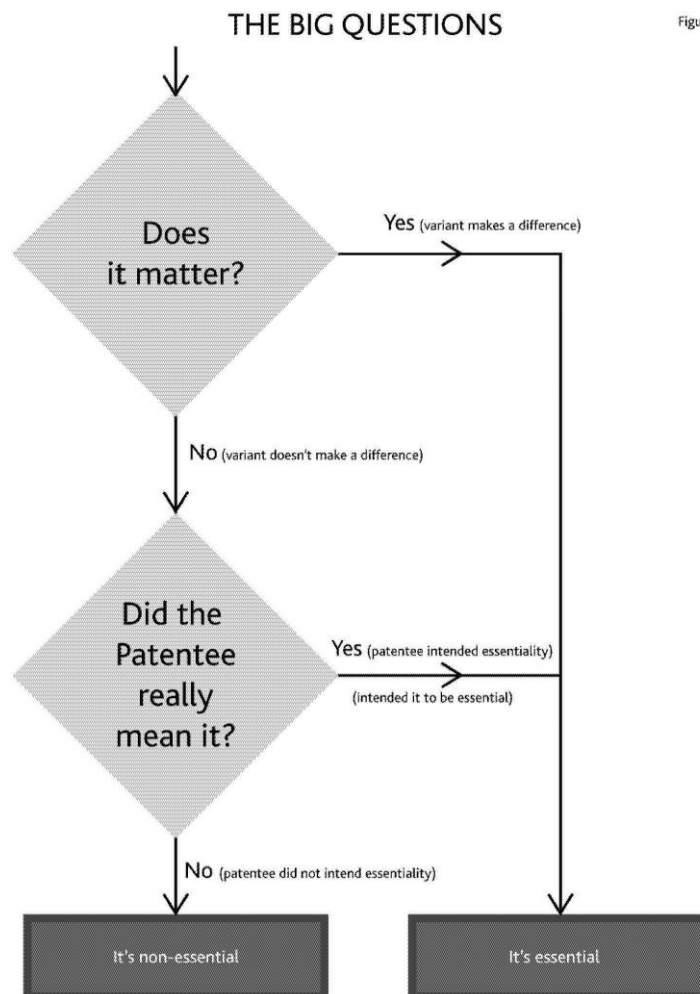


Figure 3 The big questions to be asked to determine whether a claim element is essential are:

Does varying or removing the claim element in question change the way the invention works?

and

Does it appear from the patent that the inventor intended the element to be essential?

⁷⁴⁹ *Free World Trust v. Electro Sante Inc.*, 2000 CarswellQue 2728, 2000 CarswellQue 2731, 9 C.P.R. (4th) 168 (S.C.C.) per Binnie J. at 197-198 [C.P.R.], para. 66.

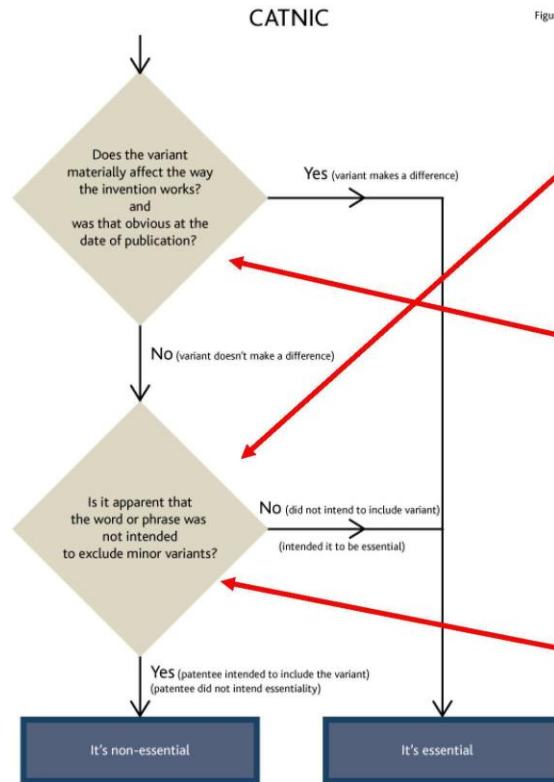
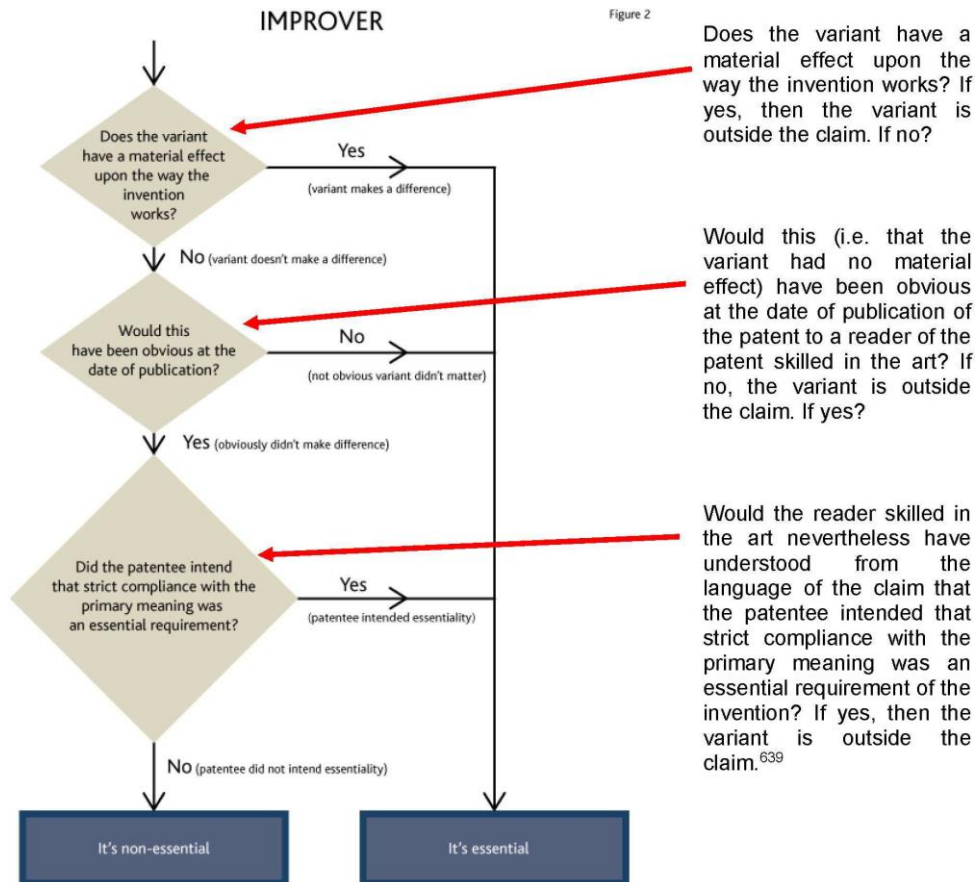


Figure 1

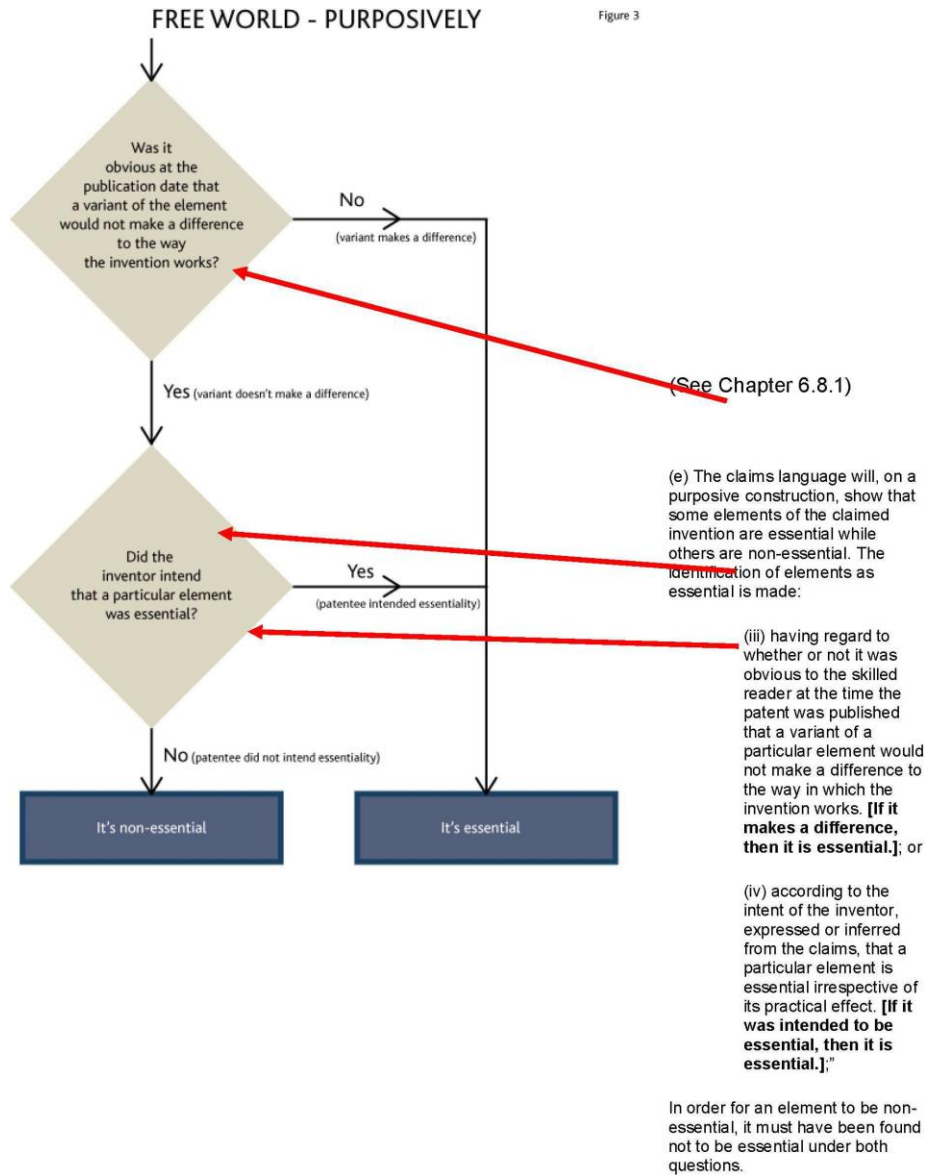
The question in each case is: whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used, would understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that any variant would fall outside the monopoly claimed, even though it could have no material effect upon the way the invention worked.

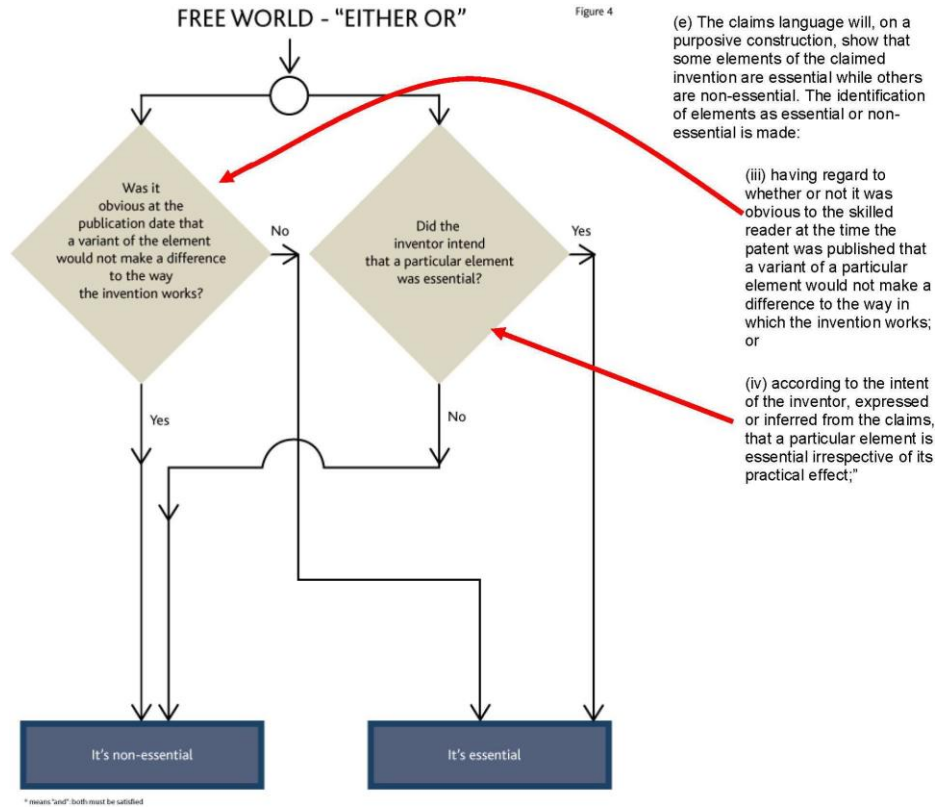
The question, of course, does not arise where the variant would in fact have a material effect upon the way the invention worked. Nor does it arise unless at the date of publication of the specification it would be obvious to the informed reader that this was so. Where it is not obvious, in the light of then-existing knowledge, the reader is entitled to assume that the patentee thought at the time of the specification that he had good reason for limiting his monopoly so strictly and had intended to do so, even though subsequent work by him or others in the field of the invention might show the limitation to have been unnecessary. It is to be answered in the negative only when it would be apparent to any reader skilled in the art that a particular descriptive word or phrase used in a claim cannot have been intended by the patentee, who was also skilled in the art, to exclude minor variants which, to the knowledge of both him and the readers to whom the patent was addressed, could have no material effect upon the way in which the invention worked.⁶³⁸

⁶³⁸ *Catnic Components Ltd. v. Hill & Smith Ltd.* (1981), [1982] R.P.C. 183 (U.K. H.L.) per Lord Diplock at 242—243, affirmed (1982), [1983] F.S.R. 512 (U.K. H.L.).



⁶³⁹ *Improver Corp. v. Remington Consumer Products Ltd.* (1989), [1990] F.S.R. 181 (Eng. Patents Ct.) at 189.





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