



Chapter 6 Anticipation

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Executive Summary:

The statutory definition of “invention” requires that it be “new”.

An invention is not “new” if the same thing has been done before or described before, publicly. The invention, if not new, is said to have been “anticipated” by the prior art reference.

In order to be anticipatory, a single piece of prior art must both:

- (a) disclose the invention of the patent in question; and
- (b) enable a skilled reader to make the invention using the prior art reference and common knowledge, allowing for some trial and error (non-inventive) experimentation to make it work.

6.1 Anticipation – the invention must be “new”

As discussed in greater detail below, an invention is not “new” if the same thing has been done before or described before, publicly. The invention, if not new, is said to have been “anticipated” by the prior art reference.

The invention, as claimed, must be found in a single, prior art reference or public use. As an Australian judge said:

“Anticipation is deadly but requires the accuracy of a sniper, not the firing of a 12 gauge shotgun.”¹

In *Sanofi*,² Justice Rothstein endorsed a two part test for anticipation.³ In order to be anticipatory, a single piece of prior art must both:

- (a) disclose the invention of the patent in question; and
- (b) enable a skilled reader to make the invention using the prior art reference and common knowledge, allowing for some trial and error (non-inventive) experimentation to make it work.⁴

Justice Rothstein stated that the following (non-exhaustive) factors should normally be considered, in accordance with the evidence in each case:

“1. Enablement is to be assessed having regard to the prior patent as a whole including the specification and the claims. There is no reason to limit what the skilled person may consider in the prior patent in order to discover how to perform or make the invention of the subsequent patent. The entire prior patent constitutes prior art.

¹ *Apotex Pty Ltd (formerly GenRx Pty Ltd) v Sanofi-Aventis* [2008] FCA 1194 per Gyles J.

² *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.*, [2008 SCC 61](#) at para. 28.

³ adopted from *Synthon B.V. v. SmithKline Beecham plc*, [2006] 1 All E.R. 685, [2005] UKHL 59 per Hoffmann L.J.

⁴ Rothstein J. suggested that the second of these requirements is “a refinement” of the *Beloit* case (*Beloit Canada Ltd. v. Valmet OY* (1986), 8 C.P.R. (3d) 289 (F.C.A. per Hugessen J.A.)) – which only expressly dealt with the “disclosure” portion of the test.⁴ However, the *Beloit* case mentioned both enablement and disclosure, but did not expressly state that both factors had to be met in each case at p. 297:

“One must, in effect, be able to look at a prior, single publication and find in it all the information which, for practical purposes, is needed to produce the claimed invention without the exercise of any inventive skill. The prior publication must contain so clear a direction that a skilled person reading and following it would in every case and without possibility of error be led to the claimed invention.”

2. The skilled person may use his or her common general knowledge to supplement information contained in the prior patent. Common general knowledge means knowledge generally known by persons skilled in the relevant art at the relevant time.

3. The prior patent must provide enough information to allow the subsequently claimed invention to be performed without undue burden. When considering whether there is undue burden, the nature of the invention must be taken into account. For example, if the invention takes place in a field of technology in which trials and experiments are generally carried out, the threshold for undue burden will tend to be higher than in circumstances in which less effort is normal. If inventive steps are required, the prior art will not be considered as enabling. However, routine trials are acceptable and would not be considered undue burden. But experiments or trials and errors are not to be prolonged even in fields of technology in which trials and experiments are generally carried out. No time limits on exercises of energy can be laid down; however, prolonged or arduous trial and error would not be considered routine.

4. Obvious errors or omissions in the prior patent will not prevent enablement if reasonable skill and knowledge in the art could readily correct the error or find what was omitted.⁵

6.2 The Legislative Basis

A patent is valid in the absence of evidence to the contrary. Under the statutory presumption⁶, the party attacking the patent has the onus of proving that the patent is invalid, no matter what the ground of attack may be, on the balance of probabilities.

The attributes of novelty, utility and inventive ingenuity or lack of obviousness are all presumed to be present in an invention for which a patent has been granted until the contrary has been shown.⁷

6.2.1 Onus & Burden of Proof

The pre-1988 *Patent Act* provided that a patent is *prima facie* valid.⁸ The presumption was redrafted in the 1985 version of the *Patent Act* (which came into effect on December

⁵ *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.*, [2008 SCC 61](#) at para. 37.

⁶ s. 45, *Patent Act* R.S. 1985, c. P-4 (Every patent granted under this Act shall be issued under the signature of the Commissioner and the seal of the Patent Office, shall bear on its face the date on which it is granted and issued and shall thereafter, in the absence of any evidence to the contrary, be valid and avail the grantee and his legal representatives for the term mentioned therein.)

⁷ *Ernest Scragg & Sons v. Leesona Corp.*, [1964] Ex. C.R. 649, 45 C.P.R. 1 (Ex. Ct. per Thorson, P.) [at p. 76](#).

⁸ as first established in *The King v. Uhlemann Optical Co.*, 11 C.P.R. 26 at p. 45, [1950] Ex. C.R. 142 at p. 161. s. 47, *Patent Act* R.S.C. 1970, c. P-4 (Every patent granted under this Act shall be issued under the signature of the Commissioner and the seal of

12, 1988) to provide that, "in the absence of any evidence to the contrary", the patent shall be considered valid. It was merely a stylistic change and did not change the substance of the presumption.⁹ As with its English counterpart, this section "deals only with the incidence of proof, not with the standard of proof. It shows on whom the burden lies to satisfy the court, and to the degree of proof which he must attain".¹⁰ The presumption applies to all forms of attack on the validity of a patent.¹¹

The burden of proving invalidity rests upon the party alleging invalidity.¹² The statutory "presumption" adds little to the onus already resting, in the usual way, on the attacking party.¹³ In the context of PM(NOC) proceedings however, the presumption the applicant would otherwise have to prove that its patent is not invalid may shift, due to the statutory presumption, to the respondent to prove that the patent is invalid.¹⁴

Once the party attacking the patent has introduced evidence, the Court, in considering this evidence and in determining whether it establishes the invalidity of the patent, must not take the presumption into account.¹⁵

the Patent Office; the patent shall bear on its face the date on which it is granted and issued and it shall thereafter be prima facie valid and avail the grantee and his legal representatives for the term mentioned therein, which term shall be as provided in and by sections 48 and 49.)

⁹ *Diversified Products Corp. v. Tye-Sil Corp.* (1991) 35 C.P.R. (3d) 350 (F.C.A. per Decary J.A.) at [pp. 357-358](#).

¹⁰ *Blyth v. Blyth*, [1966] 1 All E.R. 524 at p.535, per Lord Denning; quoted in *Rubbermaid (Canada) Ltd. v. Tucker Plastic Products Ltd.* (1972) 8 C.P.R. (2d) 6 (F.C.T.D. per Pratte J.) at p.14.

¹¹ *McPhar Engineering Co. of Canada Ltd. v. Sharpe Instruments Ltd.* (1960), 35 C.P.R. 105 (Ex. Ct. per Thorsen P.) at p. 129; *Unipak Cartons Ltd. v. Crown Zellerback Canada Ltd.* (1960), 33 C.P.R. 1 (Ex. Ct. per Thorsen P.); *Lovell Manufacturing 60 v. Beatty Bros. Ltd.* (1962) 41 C.P.R. 18 (Ex. Ct. per Thorsen P.) at p. 44; quoted with approval in *Diversified Products Corp. v. Tye-Sil Corp. Ltd.* (1987), 16 C.P.R. (3d) 207 at para. 42, p. 229 (F.C.T.D.), affirmed (1991), 35 C.P.R. (3d) 350 (F.C.A.).

¹² *McPhar Co. v. Sharpe Instruments* (1960), 21 Fox Pat. C. 1 at [p. 28](#);

Beecham Canada Ltd. v. Procter & Gamble Co. (1982) 61 C.P.R. (2d) 1 (F.C.A. per Urie J.A.) at [p. 24](#); *Wellcome Foundation Ltd. v. Apotex Inc.* (1991) 39 C.P.R. (3d) 289 (F.C.T.D. per McKay J.) at [p. 336](#).

¹³ *Apotex Inc. v. Wellcome Foundation Ltd.*, 2002 SCC 77, [2002] 4 S.C.R. 153 at para. 43.

¹⁴ *Merck Frosst Canada Inc. v. Canada (Minister of National Health and Welfare)* (1994), 55 C.P.R. (3d) 302 (F.C.A. per Hugessen J.A.) at p. 319.

¹⁵ *Diversified Products Corp. v. Tye-Sil Corp.* (1991), 35 C.P.R. (3d) 350 (F.C.A.) at 359 quoting *Rubbermaid (Canada) Ltd. v. Tucker Plastic Products Ltd.* (1972) 8 C.P.R. (2d) 6 (F.C.T.D. per Pratte J.) at p.14.

The threshold of proof of invalidity is on “the balance of probabilities”.¹⁶ It is not the “clear and convincing standard” as it is under US law.

The onus is on the party attacking the patent to put such facts into evidence from which the Court might conclude on the balance of probabilities that the patent is invalid.

Some Courts have said it is not an easy burden to discharge¹⁷, or that the evidence must be very clear.¹⁸ It cannot be said that the statutory presumption of validity is, as a rule, either easy or difficult to overcome; in some cases, the circumstances may be such that the presumption will be easily rebutted, while, in other cases the same result may be very difficult or even impossible to obtain.¹⁹ The more correct statement of the burden of proof is that it depends on the strength of the evidence in each case.²⁰ If the evidence proves on a balance of probabilities that the patent is invalid, the presumption is rebutted and is no longer relevant.²¹

¹⁶ *Bayer Inc. et al v. Apotex Inc. et al* [A-518-98 April 7, 1998](#), (FCA per Sharlow J.A., Létourneau and Rothstein JJ.A. concurring) at para. 9; *Diversified Products Corp. v. Tye-Sil Corp.* (1997), 125 N.R. 218, 35 C.P.R. (3d) 350 (F.C.A. per Decary J.A.) at para. 17; *Pfizer Canada v. Apotex*, 2007 FCA 209, 60 C.P.R. (4th) 81 at para. 105-111.

¹⁷ *DeFrees and Betts Machine Co. v. Dominion Auto Accessories Ltd.* 25 Fox Pat. C. 58 (Exchequer Court of Canada per Noel J.) at [p. 79](#); *Windsurfing Int'l Inc. v. Les Entreprises Hermano Ltée* (1982), 69 C.P.R. (2d) 176 (F.C.T.D.) at [p. 181](#).

¹⁸ *Diversified Products Corp. v. Tye-Sil Companies Ltd.* (1987), 16 C.P.R. (3d) 207 per (F.C.T.D. Cullen J.) at [p. 229](#); *Diversified Products Corp. v. Tye-Sil Corp.* (1991) 35 C.P.R. (3d) 350 (F.C.A. per Decary J.A.) at [p. 359](#).

Windsurfing Int'l Inc. v. Les Entreprises Hermano Ltée (1982), 69 C.P.R. (2d) 176 (F.C.T.D.) at [p. 181](#); *Hy Kramer Canada Ltd. et al. v. Lindsay Specialty Products Ltd.* (1986) 9 C.P.R. (3d) 297 (F.C.T.D. per Rouleau J.) at [p. 303](#).

¹⁹ *Diversified Products Corp. v. Tye-Sil Corp.* (1991), 35 C.P.R. (3d) 350 (F.C.A.) at [p. 359](#) quoting *Rubbermaid (Canada) Ltd. v. Tucker Plastic Products Ltd.* (1972) 8 C.P.R. (2d) 6 (F.C.T.D. per Pratte J.) at p.14.

²⁰ *DeFrees and Betts Machine Co. v. Dominion Auto Accessories Ltd.* 25 Fox Pat. C. 58 (per Noel J.) at [p.79](#) (Exchequer Court of Canada)

Diversified Products Corp. v. Tye-Sil Companies Ltd. (1987), 16 C.P.R. (3d) 207 per (F.C.T.D. Cullen J.) at [p. 229](#).

Diversified Products Corp. v. Tye-Sil Corp. (1991) 35 C.P.R. (3d) 350 (F.C.A. per Decary J.A.) at [p. 359](#).

Bayer Inc. et al v. Apotex Inc. et al [A-518-98 April 7, 1998](#), (FCA per Sharlow J.A., Létourneau and Rothstein JJ.A. concurring) at para. 9 citing *Diversified Products Corp. v. Tye-Sil Corp.* (1991), 35 C.P.R. (3d) 350 (F.C.A.) at [p. 359](#).

²¹ *Bayer Inc. et al v. Apotex Inc. et al* [A-518-98 April 7, 1998](#), (FCA per Sharlow J.A., Létourneau and Rothstein JJ.A. concurring) at para. 9 citing *Diversified Products Corp. v. Tye-Sil Corp.* (1991), 35 C.P.R. (3d) 350 (F.C.A.) at [p. 359](#).

The question of anticipation is one of fact.²²

6.3 Prior Knowledge And Use: Anticipation

In *Beloit Canada Ltd. v. Valmet Oy*²³, Hugessen J.A. set out the test for anticipation by publication:

It will be recalled that anticipation, or lack of novelty, asserts that the invention has been made known to the public prior to the relevant time. The inquiry is directed to the very invention in suit and not, as in the case of obviousness, to the state of the art and to common general knowledge. Also, as appears from the passage of the statute quoted above, anticipation must be found in a specific patent or other published document; it is not enough to pick bits and pieces from a variety of prior publications and to meld them together so as to come up with the claimed invention. One must, in effect, be able to look at a prior, single publication and find in it all the information which, for practical purposes, is needed to produce the claimed invention without the exercise of any inventive skill. The prior publication must contain so clear a direction that a skilled person reading and following it would in every case and without the possibility of error be led to the claimed invention.

The test for anticipation by publication in *Beloit*, was cited with approval by the Supreme Court of Canada in *Free World Trust v. Électro Santé Inc.*²⁴

6.3.1 The Legislative Basis

There are two different tests for anticipation, depending upon which *Patent Act* governs: the pre October 1, 1989 Act or the post-October 1, 1989 Act.

6.3.1.1 Pre 89:

Q1a: Was someone else the first to know of and use the invention?²⁵
and

Q1b Did that someone else make the invention available to the public before the patent application in question was filed or did that other person apply for a patent for the same invention before the patent at issue, issued?²⁶

²² *Xerox of Canada Ltd. et al v. IBM Canada Ltd.* (1977) 33 C.P.R. (2d) 24 (per Collier, J.) at p. 24.

²³ (1986), 8 C.P.R. (3d) 289 (F.C.A.) at pp. 298-299.

²⁴ [2000] 2 S.C.R. 1024, at para. 26.

²⁵ Pre-1989 Patent Act, s. 27(1)(a).

²⁶ Pre-1989 Patent Act, s. 61(1).

OR

Q2 Did the inventor wait too long to file the Canadian patent application?

Q2a Had the invention been in the public domain (in a Canadian patent or printed publication,²⁷ or public use or sale anywhere,²⁸ more than two years before the Canadian patent application was filed?

OR

Q2b If the inventor filed a patent application in another country first, for the same invention, did a patent issue in that other country prior to the filing of the Canadian application?²⁹

OR

Q2c If a patent issued in that other country, did the inventor file the Canadian application more than 12 months after the first application filed anywhere?³⁰

6.3.1.2 Post October 1, 1989 (and pre October 1, 1996):

Q1a Was someone else the first to file a patent application for the invention?

For applications filed after October 1, 1989, you cannot patent your invention if someone else filed a patent application for the same invention before you (either by filing a Canadian patent application before you or by having an earlier convention priority date for the Canadian application).

There are two scenarios where you will be entitled to a patent where someone else has also filed for a patent for the same invention in Canada:

1. If you are claiming convention priority, you will be entitled to a patent unless someone else filed a patent application in Canada either:

²⁷ Pre-1989 Patent Act, s. 27(1)(b).

²⁸ Pre-1989 Patent Act, s. 27(1)(c).

²⁹ Pre-1989 Patent Act, s. 27(2)(a).

³⁰ Pre-1989 Patent Act, s. 27(2)(b).

- (a) prior to your priority date³¹. In other words, they filed in Canada before you filed anywhere, or;
 - (b) that had a priority date earlier than your priority date.³² In other words, they filed first elsewhere.
2. If you are not claiming convention priority (s. 28 does not apply) then you are entitled to a patent unless someone else filed a patent application in Canada:
- (a) prior to your filing date.³³ [first-to-file wins]
 - (b) that had a priority date earlier than your filing date.³⁴ [first-to-file wins]

OR

Q2 Did the inventor wait too long to file the Canadian patent application?

Q2a Did you disclose (directly or indirectly) the invention to the public more than 1 year before the applicant's actual Canadian filing date?³⁵ [limited grace period]

Q2b Did an independent third party inventor disclose the invention prior to the earlier of your Canadian filing date or your priority date?³⁶ [Absolute novelty required with respect to other "inventors"]

6.3.1.3 *Post October 1, 1996:*

In the 1996 amendments, the concept of "claim date" was introduced. The claim date of a claim in a patent is either the:

- 1. filing date of the patent³⁷ ; or

³¹ Post-Oct. 1, 1989 Patent Act, s. 27(1)(a)(i).

³² Post-Oct. 1, 1989 Patent Act, s. 27(1)(a)(ii).

³³ Post-Oct. 1, 1989 Patent Act, s. 27(1)(b)(i).

³⁴ Post-Oct. 1, 1989 Patent Act, s. 27(1)(b)(ii).

³⁵ Post-Oct. 1, 1989 Patent Act, s. 27(1)(d).

³⁶ Post-Oct. 1, 1989 Patent Act, s. 27(1)(c).

³⁷ Post-Oct. 1, 1996 Patent Act, s. 28.1(1).

2. the filing date of a previously regularly filed application³⁸ where priority has been properly claimed.³⁹

A patent application will fail for anticipation under one of two scenarios: the inventor waited too long to file in that someone else made the invention public or; someone else has a co-pending patent application that has an earlier claim date.⁴⁰

³⁸ Post-Oct. 1, 1996 Patent Act, s. 28.1(2).

³⁹ Post-Oct. 1, 1996 Patent Act, s. 28.1(1)(a) –(c).

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

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

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

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

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

(i) the co-pending application is filed by

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

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

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

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

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

Q1a Was someone else's claim date earlier than your claim date on a patent application that claims the same subject-matter? In other words, did they file somewhere first? [first-to-file wins]

For applications filed after October 1, 1996, you cannot patent your invention if someone else filed, before you, a co-pending patent application claiming the same subject-matter. This done either by that other person filing his or her application in Canada:

1. prior to your claim date;⁴¹ or
2. on or after your claim date but based upon an application that was filed by someone who previously regularly filed his or her application:
 - a. in or for Canada⁴²; or
 - b. in another country which, by treaty or convention, extends similar protection to Canadians⁴³

and the co-pending application:

1. was filed:
 - a. before your claim date⁴⁴; and
 - b. within 12 months of his or her previously filed application;⁴⁵ and
2. claims priority on the basis of his or her previously regularly filed application⁴⁶

OR

Q2 Did the inventor wait too long to file the Canadian patent application?

⁴¹ Post-Oct. 1, 1996 Patent Act, s. 28.2(c).

⁴² Post-Oct. 1, 1996 Patent Act, s. 28.2(d)(i)(A).

⁴³ Post-Oct. 1, 1996 Patent Act, s. 28.2(d)(i)(B).

⁴⁴ Post-Oct. 1, 1996 Patent Act, s. 28.2(d)(i)(B)(i)

⁴⁵ Post-Oct. 1, 1996 Patent Act, s. 28.2(d)(i)(B)(iii)

⁴⁶ Post-Oct. 1, 1996 Patent Act, s. 28.2(d)(i)(B)(iv)

Q2a Did you (or someone who learned of the invention directly or indirectly from you) disclose the invention to the public more than 1 year before your actual Canadian filing date, in such a manner that the subject-matter became available to the public in Canada or elsewhere?⁴⁷ [limited grace period]

Q2b Did an independent third party inventor disclose the subject-matter prior to the claim date in such a manner that the subject-matter became available to the public in Canada or elsewhere?⁴⁸ [Absolute novelty required with respect to other "inventors"]

6.3.2 What is the invention?

For anticipation of the invention, one must first determine what really is the invention. Although the claims add light to the invention, the invention is described in the disclosure of the specification.⁴⁹

6.3.3 Date of Invention - Pre October 1, 1989 Act

Under the first-to-invent system, the Patent Office or the Court had to determine who was the first to invent.

The first question under Section 27(1)(a) is: What was the date of invention of the invention of the patent in suit? The date is the earlier of the actual filing date of the application in Canada, the priority date or the "invention date" itself as proven by evidence at trial.

The burden on the patentee to prove a date of invention earlier than the date of application which appears on the patent (to which he would otherwise be entitled) is a very serious and heavy onus of proof. He must establish and prove the earlier date by cogent evidence. The prima facie validity of a patent does not go beyond the application date.⁵⁰

⁴⁷ Post-Oct. 1, 1996 Patent Act, s. 28.2(a).

⁴⁸ Post-Oct. 1, 1996 Patent Act, s. 28.2(b).

⁴⁹ [Baldwin Int'l Radio Co. of Canada Ltd. v. Western Electric Co. Inc. et al, \(1934\) S.C.R. 94 at p. 100.](#)

[Windsurfing International Inc. v. Trilantic Corp., \(1985\) 8 C.P.R. \(3d\) 241 \(F.C.A. per Urie J.A.\) at p. 254.](#)

⁵⁰ *Omark Industries v. Gouger Saw Chain* (1964), 45 C.P.R. 169 (Ex. Ct. per Noel, J.) at p. 206-210.

[Atlas Copco Aktiebolag v. CIL Inc. \(1986\), 10 C.P.R. \(3d\) 145 \(F.C.T.D. per Cullen, J.\) at p. 159-161.](#)

To establish a date of invention prior to the filing date of an application, it is necessary for the inventor to be able to show that, on that date, the invention was reduced to a practical and definite shape either by a written or oral description of it or in the case of a product, by the product actually having been made and used. The making of an invention is more than merely formulating the idea.⁵¹

Some Judges have said that if it is possible for the patentee to get the inventor into the witness box, it is incumbent upon him to do so to prove a date of invention earlier than the application date. It is the accepted practice in this Court today to call the inventor, if he is available to testify, to prove a date of invention.⁵² However, in the Unilever⁵³ case, neither co-inventor was called as a witness. Lab book entries were admitted as business records to prove the invention date.

6.3.4 Prior Knowledge or use before invention date- Pre October 1, 1989 Act

See section C.1 Q1a and Q1b above.

6.3.5 Prior Printed Publication - Pre October 1, 1989 Act

The prior publication must, for the purposes of practical utility, be equal to that given by the patent in question. It cannot be merely a foreshadowing of the invention or the nucleus of the idea behind the invention. It must clearly show the whole of the invention with all the directions necessary to instruct the public how to put it to use.⁵⁴

[*Apotex Inc. v. Hoffman La-Roche Ltd.*](#) (1987), 15 C.P.R. (3d) 217 (F.C.T.D. per Reed. J.) at p. 239-241, affirmed (1989), 24 C.P.R. (3d) 289 (F.C.A.).

⁵¹ [*Christiani & Nielsen v. Rice*](#), [1930] S.C.R. 443 (S.C.C.) at p. 456.

⁵² [*Omark Industries v. Gouger Saw Chain*](#) (1964), 45 C.P.R. 169 (Ex. Ct. per Noel, J.) at p. 209.

⁵³ [*Unilever PLC v. Procter & Gamble Inc.*](#) (1995), 61 C.P.R. (3d) 499 (F.C.A. per Stone J.A.)

[*Marzone Chemicals Ltd. v. Eli Lilly and Co.*](#) (1978), 37 C.P.R. (2d) 37 per Pratte, J.A. at p. 39. also 37 C.P.R. (2d) 3 per Gibson, J. p. 36-37.

[*Koehring Canada Ltd. v. Owens-Illinois Inc.*](#) (1980), 52 C.P.R. (2d) 1, (F.C.A. per Le Dain, J.) at p. 11.

[*Hammond Organ Co. v. Stinson Jr.*](#) (1970), 65 C.P.R. 62, per Walsh, J. p. 70-75 (Ex. Ct.);

[*AT&T v. Mitel*](#) (1989) 26 C.P.R. (3d) 238, (F.C.T.D. per Reed, J.) at p. 265.

⁵⁴ [*The King v. Uhlemann Optical Company*](#), [1950] Ex. C.R. 142 at 157.

In considering whether a prior patent anticipates an invention, the prior patent must be read in light of the common knowledge which a person skilled in the art would have just before the alleged invention was made.⁵⁵

The publication must be "printed". The offset process is not printing; photocopying may be printing.

6.3.5.1 Reeves Brothers test

The tests for anticipation were summarized by Mr. Justice Gibson in the *Reeves Brothers*⁵⁶ case. This summary has become known as "the Reeves Brothers"⁵⁷ test and has been followed in virtually every case since then.⁵⁸

An alleged prior publication or prior patent, to invalidate a patent under Section 28, must meet the vigorous tests of anticipation. It must:

a) give an exact prior description;⁵⁹

A prior inventor must be shown to have planted his flag at the precise destination before the patentee.⁶⁰

⁵⁵ [The King v. Uhlemann Optical Company](#), [1950] 10 Fox Pat. C. 24 (per Thorson P.) at p. 39.

⁵⁶ [Xerox of Canada Ltd. v. IBM Canada Ltd.](#), (1977) 33 C.P.R. (2d) 24 (F.C.T.D. per Collier J.) at p. 85.

⁵⁷ [Reeves Brothers Inc. v. Toronto Quilting & Embroidery Ltd.](#) (1978), 43 C.P.R. (2d) 145 (F.C.T.D. per Gibson J.) at p. 157.

⁵⁸ [Lubrizol Corp. et al v. Imperial Oil Ltd.](#) (1990), 33 C.P.R. (3d) 1 at p. 24 (F.C.T.D.).

Hy Kramer Canada Ltd. et al v. Lindsay Specialty Products Ltd. et al (1986), 9 C.P.R. (3d) 297 at p. 305; [Windsurfing International Inc. v. Trilantic Corporation](#) (1985), 8 C.P.R. (3d) 241 at p. 255.

Corning Glass Works v. Canada Wire & Cable Ltd. (1984), 81 C.P.R. (2d) 39 at p. 63-70, (F.C.T.D.).

⁵⁹ [Eli Lilly & Co. v. Marzone Chemicals Ltd.](#), (1977), 37 C.P.R. (2d) 3 (F.C.T.D. per Gibson J.) at p. 32.

⁶⁰ [The General Tire & Rubber Company v. The Firestone Tyre and Rubber Company Limited and Others](#) [1972] R.P.C. 457 at p. 486.

b) give directions which will inevitably result in something within the claims (“the infringement test”);⁶¹

The "infringement test" for anticipation can be briefly stated as: What infringes if later, anticipates if earlier.⁶²

If the prior publication contains a clear description of or clear instructions to do or make something that would infringe the patentee's claims if carried out after the grant of the patentee's patent, the patentee's claim will have been shown to lack the necessary novelty, that is to say, it will have been anticipated. If, on the other hand, the prior publication contains a direction which is capable of being carried out in a manner which would infringe the patentee's claim, but would be at least as likely to be carried out in a way which would not infringe the patentee's claim, the patentee's claim will not have been anticipated.⁶³

The prior publication must be so clear as to lead the skilled workman to the invention claimed in the patent.⁶⁴ Anticipation is shown where following the instructions of a prior publication inevitably produces a result which falls within the plaintiffs claim even if that result is not as in fact described.⁶⁵

What if the claims describe the prior art, but the prior art is not, for the purpose of practical utility, equal to that given by the patent in suit? In that case the "infringement test" is improper with respect to anticipation.⁶⁶

⁶¹ [The General Tire & Rubber Company v. The Firestone Tyre and Rubber Company Limited and Others](#) [1972] R.P.C. 457 at p. 485-486.

[Eli Lilly & Co. v. Marzone Chemicals Ltd.](#), (1977), 37 C.P.R. (2d) 3 (F.C.T.D. per Gibson J.) at p. 32.

⁶² [Lightening Fastener Company, Limited v. Colonial Fastener Company, Limited et al](#) [1933] S.C.R. 377 (Ex. Ct. per Rinfret, J.) at p. 381; quoted in [J.M. Voith GMBH v. Beloit Corp.](#) 26 C.I.P.R. (F.C.T.D. per Rouleau J.) 22 at p. 59

[General Tire & Rubber Company v. Firestone Tyre & Rubber Company Limited](#) [1971] F.S.R. at p. 443.

⁶³ [General Tire & Rubber Company v. Firestone Tyre & Rubber Company Limited](#) [1972] R.P.C. 457 at 485-486.

⁶⁴ [Sakharam D. Mahurkar v. Vas-cath of Canada Limited et al](#) (1988) 18 C.P.R. (3d) 417 (F.C.T.D. per Strayer J.) at p. 430.

⁶⁵ [General Tire & Rubber Company v. Firestone Tyre & Rubber Company Limited and Others](#), [1971] R.P.C. 173 (per Graham, J.) at p. 232 quoting from [Flour Oxidising Co. v. Carr & Co.](#) (1908) 25 R.P.C. 428 (H.L. per Lord Parker) at p. 457, line 34.

⁶⁶ [Consolboard Inc. v. MacMillan Bloedel \(Sask\) Ltd.](#) (1981) 56 C.P.R. (2d) 145 (S.C.C. per Dickson J.) at 167-168.

[Procter & Gamble Co. v. Kimberly-Clark of Canada Ltd.](#) (1991), 40 C.P.R. (3d) 1 at p. 34.

The "infringement test" can also be characterized as a circumstance where the patent claims more than the inventor invented: which is sometimes called "[covetous claiming](#)" – it claims something that is not new.

c) give clear and unmistakable directions;

The prior publication must not only describe an apparatus that anticipates the invention, it must also contain clear and unmistakable directions so to use it.⁶⁷

Where the stated purpose of the prior art reference is different and the difference in purpose of the two devices is so material then the prior art reference cannot be seen as a source of clear direction.⁶⁸

"Inevitable" anticipates, 50/50 does not. If the direction given in the prior art, when carried out, is at least as likely not to infringe a patent claim, then it doesn't anticipate the claim.⁶⁹

d) give information which for the purpose of practical utility is equal to that given by the subject patent;⁷⁰

Whatever is necessary to the invention for the purposes of its practical working and utility must be found in the prior publication.⁷¹ An invention that is practically useless is not an anticipation of a subsequent invention which achieves success, even if the two are very similar.⁷² A publication that discloses an inoperable device can not be an anticipation of a subsequent invention, for how could one reading that say, "this gives

⁶⁷ [Flour Oxidising Co. v. Carr & Co.](#) (1908) 25 R.P.C. 428 (H.L. per Lord Parker) at p. 457, line 34; quoted with approval in [Electrolier Manufacturing Company Ltd. v. Dominion Manufacturers Limited](#) [1934] S.C.R. 436 (per Rinfret, J.) at p. 441.

[CGE Co. Ltd. v. Fada Radio Ltd.](#), [1927] 2 D.L.R. 911 at p. 917.

⁶⁸ *Sakharam D. Mahurkar v. Vas-cath of Canada Limited et al* (1988) 18 C.P.R. (3d) 417 (F.C.T.D. per Strayer J.) at p. 430.

⁶⁹ [General Tire & Rubber Co. v. Firestone Tyre & Rubber Co. Ltd.](#) [1972] R.P.C. 457 at 485 (Eng. C. of A.); followed in [Quantel Ltd. v. Spaceward Microsystems Ltd.](#) [1990] R.P.C. 83 (Patents Court per Falconer J.) at p. 112.

⁷⁰ [Hill v. Evans](#) (1862), 45 E.R. 1195 per Lord Westbury. [CGE Co. Ltd. v. Fada Radio Ltd.](#), [1927] 2 D.L.R. 911 at p. 917.

[The King v. Uhlemann Optical Company](#) [1950] 10 Fox Pat. C. 24 (per Thorson P.) at pp. 38-39.

[Eli Lilly & Co. v. Marzone Chemicals Ltd.](#), (1977), 37 C.P.R. (2d) 3 (F.C.T.D. per Gibson J.) at p. 32.

⁷¹ [The King v. Uhlemann Optical Co.](#) (1951), 15 C.P.R. 99 (S.C.C.) at p. 104.

⁷² [Farwell, L.J. in Re Andrews' Patent](#) (1907), 24 R.P.C. 349 at p. 371.

me what I wish"?⁷³ Anticipation is not shown where the prior device was impractical and inoperable when used in the manner of the patented invention.⁷⁴

If specific details are necessary for the practical working and utility of the invention, they must be found substantially in the prior publication.⁷⁵

A prior specification is not an anticipation unless it discloses a practicable method of producing the result which is the subject of the invention.⁷⁶

Under the current U.K. Patent Act, for the prior use to constitute anticipation it must have made available to the public an enabling disclosure of the invention.⁷⁷ But see contrary in Asahi KKK's Application.

- e) **convey information so that a person grappling with the same problem must be able to say "that gives me what I wish";**⁷⁸
- f) **give information to a person of ordinary knowledge so that he must at once perceive the invention [without experimentation];**⁷⁹
- g) **in the absence of explicit directions, teach an "inevitable result" which "can only be proved by experiments";**⁸⁰

The result must necessarily always be obtained.⁸¹

⁷³ [Lovell Manufacturing Co. v. Beatty Bros. Ltd.](#) (1962), 41 C.P.R. 18 (Ex.Ct) Per Thomson P. at p. 47.

⁷⁴ [Tye-Sil Corp. v. Diversified Products Corp. et al](#), (1991), 35 C.P.R. (3d) 350 (F.C.A.) at p. 363.

⁷⁵ [Hill v. Evans](#) (1862), 45 E.R. 1195 per Lord Westbury.

[Beloit Canada Ltd. v. Valmet Oy](#), (1986) 8 C.P.R. (3d) 289 at 297 (F.C.A. per Hugessen J.A.) at p. 298-299.

⁷⁶ [Betts v. Menzies](#) (1862), 10 H.L.C. 117 at p. 153.

⁷⁷ [Quantel Ltd. v. Spaceward Microsystems Ltd.](#) [1990] R.P.C. 83 (Patents Court per Falconer J.) at p. 129, I. 20-23.

⁷⁸ [Pope Appliance Corp. v. Spanish River Pulp & Paper Mills Ltd.](#), (1929) 46, R.P.C. 23, (Judicial Committee of the Privy Council) per Viscount Dunedin at p. 52.

[Eli Lilly & Co. v. Marzone Chemicals Ltd.](#), (1977), 37 C.P.R. (2d) 3 (F.C.T.D. per Gibson J.) at p. 32.

⁷⁹ [Hill v. Evans](#) (1862), 45 E.R. 1195.

[Eli Lilly & Co. v. Marzone Chemicals Ltd.](#), (1977), 37 C.P.R. (2d) 3 (F.C.T.D. per Gibson J.) at p. 32.

⁸⁰ [Letraset International Ltd. v. Dymo Ltd.](#), [1976] R.P.C. 65 at p. 75 (Eng. C.A.).

h) satisfy all these tests in a single document without making a mosaic.

The Federal Court of Appeal clarified the *Reeves Brothers* test in that the eighth element provides that only one of the first seven *Reeves Brothers* “tests” need be satisfied for there to be anticipation.⁸²

When determining anticipation, you cannot “mosaic” prior art documents.⁸³ It is not enough that the prior document makes suggestions, which taken with suggestions from other and independent documents, may be shown to foreshadow the invention or important steps in it.⁸⁴ Anticipation is not established by what may be qualified the ‘imaginary assemblage of separate elements gathered from glosses selected here and there in several and distinct anterior specifications.’⁸⁵ If one must compile and combine previous unconnected publications in an attempt to show anticipation, then it follows that no one has previously done so, and therefore there has been no anticipation.⁸⁶

6.4 Prior Public Use or Sale

The public use of an embodiment of the claimed invention, as opposed to secret use, is making the invention available to the public.⁸⁷

⁸¹ [Letraset International Ltd. v. Dymo Ltd.](#), [1976] R.P.C. 65 at p. 75 (Eng. C.A.).

[Beloit Canada Ltd. v. Valmet Oy](#), (1986) 8 C.P.R. (3d) 289 at 297 (F.C.A. per Hugessen J.A.) at p. 298-299.

⁸² [Tye-Sil Corp. Ltd. v. Diversified Products Corp. et al](#) (1991), 35 C.P.R. (3d) 350 at p. 361 (F.C.A.).

[Procter & Gamble Co. et al. v. Kimberly Clark of Canada Ltd.](#) (1991), 40 C.P.R. (3d) 1 at p. 33.

⁸³ [Eli Lilly & Co. v. Marzone Chemicals Ltd.](#), (1977), 37 C.P.R. (2d) 3 (F.C.T.D. per Gibson J.) at p. 32.

[Beloit Canada Ltd. v. Valmet Oy](#), (1986) 8 C.P.R. (3d) 289 at 297 (F.C.A. per Hugessen J.A.) at p. 298-299.

⁸⁴ [British Ore Concentration Syndicate Ltd. v. Minerals Separation Ltd.](#) (1909), 26 R.P.C. per Lord Moulton at p. 147.

⁸⁵ [His Majesty the King v. Uhlemann Optical Company](#), [1952] 1 S.C.R. 143 (per Rinfret, C.J.) at p. 150.

⁸⁶ [The General Tire & Rubber Company v. The Firestone Tyre and Rubber Company Limited and Others](#) [1972] R.P.C. 457 at p. 486.

⁸⁷ [Gibney v. Ford Motor Company of Canada Ltd.](#), [1967] 2 Ex. C.R. 279, per Joel, J. at p. 298.

Under the 1949 U.K. Patent Act, knowledge as to the identity or composition of the article or means of knowledge were not relevant. Any commercial sale would constitute use unless it was secret.⁸⁸

6.4.1 Anticipation under the “new” Patent Act

Although the *Patent Act* was amended in 1989 it was not until 2002 when the Federal Court of Appeal examined the novelty requirements under the post 1989 *Patent Act* in *Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd.*⁸⁹

The Federal Court of Appeal remarked that, due to the similarities between section 2 of the United Kingdom *Patents Act* 1977 (U.K.), 1977, c. 37 and s. 28.2(1)(a) of the 1996 Canadian *Patent Act*, the United Kingdom jurisprudence will be instructive in assisting in the interpretation of s. 28.2(1)(a) of the Canadian Act.⁹⁰ Likewise for the European Patent Convention.⁹¹ The court saw no difference between the English term "made available" and the Canadian term "became available".⁹²

The Federal Court summarized eight principles of anticipation from the UK and EPC jurisprudence:

1. Sale to the public or use by the public alone is insufficient to prove anticipation. Disclosure of the invention is required to constitute anticipation under paragraph 28.2(1)(a). The disclosure must make the necessary invention available.⁹³

⁸⁸ [Quantel Ltd. v. Spaceward Microsystems Ltd.](#) [1990] R.P.C. 83 (Patents Court per Falconer J.) at p. 129, l. 15-20.

⁸⁹ (2002), 17 C.P.R. (4th) 478 (F.C.A. per Strayer, J.A., Rothstein and Evans JJ.A. concurring).

⁹⁰ *Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd* (2002), 17 C.P.R. (4th) 478 (F.C.A. per Strayer, J.A., Rothstein and Evans JJ.A. concurring) at para. 36.

⁹¹ Convention on the Grant of European Patents (European Patent Convention), October 5, 1973; *Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd* (2002), 17 C.P.R. (4th) 478 (F.C.A. per Strayer, J.A., Rothstein and Evans JJ.A. concurring) at para. 37.

⁹² Convention on the Grant of European Patents (European Patent Convention), October 5, 1973; *Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd* (2002), 17 C.P.R. (4th) 478 (F.C.A. per Strayer, J.A., Rothstein and Evans JJ.A. concurring) at para. 41.

⁹³ *Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd* (2002), 17 C.P.R. (4th) 478 (F.C.A. per Strayer, J.A., Rothstein and Evans JJ.A. concurring) at para. 42[1] quoting *Merrell Dow Pharmaceuticals Inc. and Anr. v. H. N. Norton & Co. Ltd.*, [1996] R.P.C. 76 (H.L. per Lord Hoffman), at p. 86.

2. For a prior sale or use to anticipate an invention, it must amount to "enabling disclosure" so as to make available information as to its contents and its methods of manufacture⁹⁴ or to be enabled to make or obtain the invention.⁹⁵
3. The prior sale or use of a chemical product will constitute enabling disclosure to the public if its composition can be discovered through analysis of the product because direct and unambiguous access to information concerning the composition or internal structure of a prior used product is possible.⁹⁶
4. The analysis must be able to be performed by a person skilled in the art in accordance with known analytical techniques available at the relevant time to find the invention without the use of inventive skill.⁹⁷
5. When reverse engineering is necessary and capable of discovering the invention, an invention becomes available to the public if a product containing the invention is sold to any member of the public who is free to use it as she or he pleases.⁹⁸ Communicating the invention to a single member of the public without inhibiting fetter is enough to amount to a making available to the public.⁹⁹ The grant of a patent depends on the inventor giving to the public something it did not have before. If the public already has it, then the

⁹⁴ *Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd* (2002), 17 C.P.R. (4th) 478 (F.C.A. per Strayer, J.A., Rothstein and Evans JJ.A. concurring) at para. 42[2] citing *Merrell Dow Pharmaceuticals Inc. and Anr. v. H. N. Norton & Co. Ltd.*, [1996] R.P.C. 76 (H.L. per Lord Hoffman), at pp. 86-87 and quoting *PLG Research Ltd. v. Ardon International Ltd.*, [1993] F.S.R. 197 per Aldous J. at page 225.

⁹⁵ *Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd* (2002), 17 C.P.R. (4th) 478 (F.C.A. per Strayer, J.A., Rothstein and Evans JJ.A. concurring) at para. 42[2] quoting *Lux Traffic Controls Ltd. v. Pike Signals Ltd. and Faronwise Ltd.*, [1993] R.P.C. 107 per Aldous J. at page 133.

⁹⁶ *Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd* (2002), 17 C.P.R. (4th) 478 (F.C.A. per Strayer, J.A., Rothstein and Evans JJ.A. concurring) at para. 42[3] quoting *FISONS plc v. Packard Instrument B.V.*, E.P.O. case number T 0952/92 - 3.4.1, August 17, 1994, at page 21.

⁹⁷ *Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd* (2002), 17 C.P.R. (4th) 478 (F.C.A. per Strayer, J.A., Rothstein and Evans JJ.A. concurring) at para. 42[4] quoting *FISONS plc v. Packard Instrument B.V.*, E.P.O. case number T 0952/92 - 3.4.1, August 17, 1994, at page 21.

⁹⁸ *Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd* (2002), 17 C.P.R. (4th) 478 (F.C.A. per Strayer, J.A., Rothstein and Evans JJ.A. concurring) at para. 42[4] quoting *Bristol-Myers Co.'s Application*, [1969] R.P.C. 146 (Q.B.D. per Lord Parker C.J.) at page 155 and *Lux Traffic Controls Ltd. v. Pike Signals Ltd. and Faronwise Ltd.*, [1993] R.P.C. 107 per Aldous J. at page 133.

⁹⁹ *Bristol-Myers Co.'s Application*, [1969] R.P.C. 146 (Q.B.D. per Lord Parker C.J.) at page 155 quoted in *Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd* (2002), 17 C.P.R. (4th) 478 (F.C.A. per Strayer, J.A., Rothstein and Evans JJ.A. concurring) at para. 42[5].

inventor gives nothing and is not entitled to anything in return, i.e. a monopoly for a period of years.¹⁰⁰

6. It is not necessary to demonstrate that a member of the public actually analysed the product that was sold in the case or prior use nor read the book or whether it was situated in a dark and dusty corner of the library.¹⁰¹
7. The amount of time and work involved in conducting the analysis is not determinative of whether a skilled person could discover the invention. The relevant consideration, in this respect, is only whether inventive skill was required.¹⁰²
8. It is not necessary that the product that is the subject of the analysis be capable of exact reproduction. It is the subject-matter of the patent claims (the invention) that must be disclosed through the analysis. Novelty of the claimed invention is destroyed if there is disclosure of an embodiment which falls within the claim.¹⁰³ A complete analysis of a prior used product so as to enable an exact reproduction of such product is not necessary in order to destroy the novelty of the claimed product.¹⁰⁴

6.5 Weight of the Evidence

Where a patent has achieved commercial success, evidence of prior use requires very careful scrutiny.¹⁰⁵

¹⁰⁰ *Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd* (2002), 17 C.P.R. (4th) 478 (F.C.A. per Strayer, J.A., Rothstein and Evans JJ.A. concurring) at para. 42[5] referring to *Free World Trust* at para. 13.

¹⁰¹ *Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd* (2002), 17 C.P.R. (4th) 478 (F.C.A. per Strayer, J.A., Rothstein and Evans JJ.A. concurring) at para. 42[6] quoting *Lux Traffic Controls Ltd. v. Pike Signals Ltd. and Faronwise Ltd.*, [1993] R.P.C. 107 per Aldous J. at page 133.

¹⁰² *Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd* (2002), 17 C.P.R. (4th) 478 (F.C.A. per Strayer, J.A., Rothstein and Evans JJ.A. concurring) at para. 42[4] quoting *FISONS plc v. Packard Instrument B.V.*, E.P.O. case number T 0952/92 - 3.4.1, August 17, 1994, at pp. 21-22.

¹⁰³ *Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd* (2002), 17 C.P.R. (4th) 478 (F.C.A. per Strayer, J.A., Rothstein and Evans JJ.A. concurring) at para. 42[8] quoting *FISONS plc v. Packard Instrument B.V.*, E.P.O. case number T 0952/92 - 3.4.1, August 17, 1994, at p. 23.

¹⁰⁴ *FISONS plc v. Packard Instrument B.V.*, E.P.O. case number T 0952/92 - 3.4.1, August 17, 1994, at p. 23 quoted in *Baker Petrolite Corp. v. Canwell Enviro-Industries Ltd* (2002), 17 C.P.R. (4th) 478 (F.C.A. per Strayer, J.A., Rothstein and Evans JJ.A. concurring) at para. 42[8].

¹⁰⁵ [Boyce v. Morriss Motors Lts.](#) (1927) 44 R.P.C. 105 at 135; approved in [Quantel Ltd. v. Spaceward Microsystems Ltd.](#) [1990] R.P.C. 83 (Patents Court per Falconer J.) at p. 122.

6.5.1 Paper patents will be viewed very strictly

"Paper" anticipations must be viewed very strictly. Paper patents (inventions that were patented but never commercialized) will not have the same weight as evidence based on patents whose concepts have been put into use.¹⁰⁶ The fact the prior document, which pre-dates the invention by a number of years, was never realized in practise makes it hard to believe that it anticipates the alleged invention.¹⁰⁷

The court looks poorly upon an attempt to deprive a meritorious inventor of a useful patent by dredging up some forgotten still-born patent from the limbo of forgotten things.¹⁰⁸

The prior anticipation of some useful thing by a document which was never put into useful practice must involve more than the nucleus of the inventive idea. It must be that the public has been presented with the invention such that no one else could claim it as their own.¹⁰⁹

6.6 Covetous Claiming

A claim is invalid if it monopolizes more than the inventor:

- a. actually invented (an inventor may not validly claim what he or she has not invented); or
- b. described in the patent (an inventor may not validly claim what he or she has not described).

If the breadth of coverage of the claim goes beyond the bounds of what reasonably can be considered to be an inventor's fair reward, then the claim will be declared invalid.¹¹⁰

6.6.1 broader than the invention made

Claims that are broader than the invention made may include:

¹⁰⁶ [Creations 2000 Inc. v. Canper Industrial Products Ltd.](#) (1991), 34 C.P.R. (3d) 178, (F.C.A. per Hugessen J.A.) at p. 181.

¹⁰⁷ *Sakharam D. Mahurkar v. Vas-cath of Canada Limited et al* (1988) 18 C.P.R. (3d) 417 (F.C.T.D. per Strayer J.) at p. 432.

¹⁰⁸ [Pirrie v. York Street Flax Spinning Co.](#) (1894), 11 R.P.C. 429 at p. 445.

See also [Creations 2000 Inc. v. Canper Industrial Products Ltd.](#) (1991), 34 C.P.R. (3d) 178, (F.C.A. per Hugessen J.A.) at p. 181.

¹⁰⁹ [Sir W.G. Armstrong, Whitworth & Co. v. Hardcastle](#), (1925), 42 R.P.C. 543 (Lord Dunedin) at p. 555

¹¹⁰ [Leitheiser et al v. Pengo Hydra-Pull of Canada Ltd.](#) (1974), 17 C.P.R. (2d) 110 (F.C.A. per Thurlow, J.) at 118.

- a. prior art, and be invalid (See "the [infringement test](#)" above);
- b. someone else's simultaneous work or invention, and therefore include more than what was invented;
- c. all solutions to the problem and not merely the one invented;

6.6.1.1 *all solutions*

Claims that are limited by reference to a result can easily go beyond the bounds of what can be considered to be an inventor's fair reward. An objection that the claimed invention is merely functional often really means simply that the claim is broader than the invention made.¹¹¹

One is not entitled to claim all ways of reaching an obviously desirable result merely because one has become the first to find a way to reach that result. This is because the result itself is well-known and obvious. Where the result concerned is so obviously advantageous, a claim to any means of attaining it could not possibly be legitimate and so is "not an invention". A patent covering generally any and every means or method for producing a given result cannot be upheld.¹¹²

It is clear that the discoverer of a new principle is entitled to claim all devices making use of it: all modes of carrying it into effect. For in such a case, the new principle itself will be a part of his invention. If, however, the principle itself is old, such a claim will be too wide; for then the inventor has contributed nothing new except any special method of carrying it out, and his claims must consequently be confined to such special methods.¹¹³

This distinction applies in particular where the "principle" concerned is the advantageous character of a particular result. If the result is in itself new and not obvious, the inventor may, in theory at least, claim all methods (including methods in themselves obvious) of attaining it. But if the result is known, either in the sense that it has been attained before or in the sense that it was an obviously desirable result if it could be attained, then a claim to any method of attaining it will be too wide.¹¹⁴

¹¹¹ [R.C.A. Photophone v. Gaumont-British](#) (1936), 53 R.P.C. 167 (C.A.) at 195.

¹¹² [Paul Bergeon v. De Kermor Electric Heating Co., Ltd.](#) [1927] Ex. C.R. 181 at 195.

See also: [Bataafsche Petroleum Maatschappij \(N.V.\)'s Application](#), [1956] R.P.C. 254 (C.A.) [Denning Wire and Fence Co. v. American Steel and Wire Co.](#)

[Patterson v. Gas Light and Coke Company](#) L.R. 2 C.D. 812.

¹¹³ [R.C.A. Photophone v. Gaumont-British](#) (1936), 53 R.P.C. 167 (C.A.) at 195.

¹¹⁴ [British United Shoe Machinery v. Simon Collier](#) (1909), 26 R.P.C. 21 at p. 49.

One cannot claim the solution to a problem as an invention. You can not obtain a monopoly over all methods of remedying a known defect.¹¹⁵

The idea of getting rid of a nuisance is not an invention. In fact its the most obvious thing to do. The difficult (and patentable) part is discovering how to do it.¹¹⁶

It is covetous to attempt to monopolize all methods of achieving a particular end by claiming the end rather than the method of achieving it.¹¹⁷ In the claims one can describe a class of substances or compounds by their characteristics, thereby covering all the substances which would work for that purpose.¹¹⁸

A patentee can cast his or her claim in language which allows the skilled addressee reading the claim to employ a substance such that it achieves a particular function. For instance, the patent can direct the addressee to choose a suitable liquid with the following characteristics, such that it behaves in a certain manner or performs a certain function.¹¹⁹

6.6.1.2 broader than the invention described

The disclosure must support the claims: there must be a description of how to make that which is claimed. The inventor cannot claim more than he or she has described.¹²⁰

The Court will not limit claims by reading them in context with the disclosure and limiting their scope based on the description of the invention given in the disclosure. If the claims are broader than the disclosure, they are invalid.¹²¹

An inventor can describe how to use one example of a class and then claim the entire class so long as it is predictable that the rest of the class will behave as does the example. The patentee must not claim beyond what is specifically described in the

¹¹⁵ [Crabtree v. Hoe](#) (1936), 53 R.P.C. 443 (C.A.) at p. 450.

¹¹⁶ [Mullard v. Philco](#) (1935), 52 R.P.C. 261 at p. 274

¹¹⁷ [Procter & Gamble Inc. and The Procter & Gamble Company v. Unilever PLC, and Lever Brothers Limited](#) (1995), 61 C.P.R. (3d) 499 (F.C.A. per Stone J.A.) at p. 515.

¹¹⁸ [Procter & Gamble Inc. and The Procter & Gamble Company v. Unilever PLC, and Lever Brothers Limited](#) (1995), 61 C.P.R. (3d) 499 (F.C.A. per Stone J.A.) at p. 517-518.

¹¹⁹ [Procter & Gamble Inc. and The Procter & Gamble Company v. Unilever PLC, and Lever Brothers Limited](#) (1995), 61 C.P.R. (3d) 499 (F.C.A. per Stone J.A.) at p. 518-519.

¹²⁰ [Radio Corporation of America v. Raytheon Mfg. Co.](#), (1957) 16 Fox Pat. C. 122 (per President Thorson) at p. 133.

[Beecham Canada Ltd. v. The Procter & Gamble Co.](#), (1982) 61 C.P.R. (2d) 1 (F.C.A.) at p. 19-21.

¹²¹ [Beecham Canada Ltd. v. The Procter & Gamble Co.](#), (1982) 61 C.P.R. (2d) (F.C.A.) at p. 19-21.

disclosure where it is not reasonably predictable or cannot be extrapolated but is merely speculation.¹²²

If an article is new, useful, and has subject-matter, it is patentable. But the claim may be for something new, useful and which has subject-matter, yet it may be too wide because it extends beyond the subject-matter of the invention. A claim may be too wide if it claims protection for something the patentee isn't entitled to protect. An inventor is not allowed to claim part of a combination where the invention is in the combination. If the inventive concept is that an article will attain a certain object when in a particular orientation, then the claim cannot be for the article at large apart from the orientation.¹²³

a) the object clause

The validity of the claims may be determined by the result promised by the invention at the beginning of the patent.

Some patents make promises in the region of the "statement of the invention", that the patented invention has certain characteristics or objects. These promises or "object clauses" are not mandatory. An invention may have certain advantages, but the advantages need not be part of the invention which must be recited in the claims.¹²⁴ A patentee is under no obligation to make promises in respect of the inventions abilities, but where he does and it is fair as a matter of construction to view that promise as material, then when assessing the validity of the claims the ability of the invention described to fulfil that promise is a factor.¹²⁵ The invention described in the disclosure may be limited to have certain features. If the claims do not contain these features, then the claims are broader than the invention disclosed or made.¹²⁶

In examining validity as to whether the claims are broader than the invention, you should read the disclosure first, to see what it is the inventor thinks is the invention. Then, having read that, read the claims and see whether it appears the inventor claims more than has been declared to be the invention.¹²⁷

¹²² [*Hoescht Pharmaceuticals of Canada Ltd. v. Gilbert & Co.*](#) [1966] S.C.R. 189

¹²³ [*The Mullard Radio Valve Co., Ltd. v. Philco Radio and Television Corporation of Great Britain, Ltd. and Others*](#), [1936] 53 R.P.C. 323 at p. 347.

¹²⁴ [*Northern Telecom Limited v. Reliance Electric Industrial Company et al.*](#) (1992), 44 C.P.R. (3d) 161 (F.C.A.)

¹²⁵ [*American Cyanamid Company v. Ethicon Limited*](#), [1979] R.P.C. 215 (per Graham, J.) at p. 261

¹²⁶ [*Mullard Radio Valve Co. Ltd. v. Philco Radio and Television Corporation of Great Britain, Ltd. and Others*](#), (1936) 53 R.P.C. 323 (H.L. per Lord MacMillan) at p. 345-346.

¹²⁷ [*The Edison Bell Phonograph Corporation, Limited v. Smith and Young*](#), [1894] 11 R.P.C. 389 at pp. 395-396.

The "object clause" can be used indirectly to limit the protectable invention to something that includes the stated object. If the claims do not contain the limitation of the stated object then they are broader than the invention described.¹²⁸

¹²⁸ [Amfac Foods Inc. et al v. Irving Pulp & Paper, Ltd.](#), (1987) 12 C.P.R. (3d) 193 (F.C.A. per Urie J.).