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**CANADIAN PATENT ACT ANNOTATED
Second Edition**

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The *Canadian Patent Act Annotated*, Second Edition, is your one-stop source, bringing together commentary and current case law interpreting patent legislation. This includes all of the relevant statutes, regulations and rules you need to provide your client with the best patent advice available.

What's New in this Update:

This release features the addition of case law annotations under the *Patent Act*. This release also features the addition of the Practice Notice on Special Characters, August 1, 2018 to the Practice Notices tab.

This release also features amendments to the *Patent Act* brought about by the *Budget Implementation Act, 2018, No. 2*, S.C. 2018, c. 27, as well as

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the addition of selected sections of Canada United States Mexico Agreement (CUSMA) including the Preamble, and Chapter 20 Intellectual Property Rights under a new “Current Developments” tab.

- **Patent Act — Section 27(3) — “correctly and fully describe the invention” — Need for Further Testing or Experimentation** — The fact that some non-inventive trial and error experiments may be required to practice a properly disclosed invention will not per se invalidate a patent on the basis that it fails to meet the requirements of s. 27(3) of the Act. Thus, it was incorrect for the Federal Court to say that the strict test applicable to the description of the invention applied to the question of whether the disclosure was sufficient to teach the POSITA how to practice the invention. A disclosure will still be enabling if it does not require undue efforts. However, the Federal Court also took into account the less stringent approach: “If a person skilled in the art can arrive at the same results only through chance or further long experiments, the disclosure is insufficient and the patent is void”. It would have been more complete to add that even short experiments will be objectionable if they involve an inventive step, since the nature of the efforts required is also important. The acceptable extent of the efforts that may be required from the POSITA will depend on the nature of the invention and the field to which it pertains: *Bombardier Recreational Products Inc. v. Arctic Cat, Inc.*, 2018 FCA 172.
- **Patent Act — Section 52** — It is well-established that the Court lacks jurisdiction to entertain a claim under s. 52 of the *Patent Act* where the issue to be decided is the proper owner of a particular patent, and the determination of ownership depends on the interpretation of various contract documents between the parties and the application and interpretation of contract law principles. The issuance of the section 52 order sought was secondary and dependant on a prior interpretation of the Agreements which, according to the Amended Counterclaim, made it the owner of the '742 Patent. When the Amended Counterclaim is assessed independently as a separate action, as required, it is not about infringement of a patent. It is about the ownership of the '742 patent, and a contractual dispute regarding whether certain agreements establish that the Defendant was the owner of the '742 Patent. The impugned portions of the Amended Statement of Defence were within the jurisdiction of this Court because they differed in nature and purpose from the Amended Counterclaim. Unlike the Amended Counterclaim, the Amended Statement of Defence formed part of the main action. The subject matter of the main action primarily concerned a patent. That some

issues of contract raised in the Amended Statement of Defence may be reviewed by the Court in its overall consideration of the issues raised in the main action does not displace that jurisdiction. The Court can interpret and apply provincial law to proceedings that are otherwise founded upon federal law and are within the Court's jurisdiction. In the Amended Statement of Defence, the allegations regarding the Agreements were being used as a shield against the claim of patent infringement. That claim could be decided on the basis of the Statement of Claim and the Amended Statement of Defence, and incidental to that determination, the agreements might need to be considered. In the Amended Counterclaim, the agreements were being used as a sword, as a basis for obtaining a declaration of ownership. While it may be that this result would lead to inconvenience, since the issues raised in the impugned portions of the Amended Counterclaim must be adjudicated in a different court, the Federal Court of Appeal held in *Innotech Pty* that such inconvenience "is not, of itself, a basis for this Court assuming jurisdiction": *Farmobile, LLC. v. Farmers Edge Inc.*, 2018 FC 915.

- **Budget Implementation Act, 2018, No. 2, S.C. 2018, c. 27** — The Act is amended to (a) provide a regulation-making authority for the establishment of requirements for written demands relating to patents; (b) specify that an act committed for the purpose of experimentation relating to the subject matter of a patent is not an infringement of the patent and that licencing commitments that bind the owner of a standard-essential patent or the holder of a certificate of supplementary protection that sets out such a patent bind any subsequent owners or holders; (c) expand the rights of a person in respect of a claim in a patent who meets the requirements to be considered a prior user; (d) ensure that patent prosecution histories may be admissible into evidence for certain purposes; (e) clarify when a late fee must be paid in respect of divisional applications as well as when the confidentiality period begins in the case where a request for priority is deemed never to have been made.

