

Publisher's Note

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Fox on the Canadian Law of Patents, Fifth Edition

Fox on the Canadian Law of Patents, Fifth Edition is the pre-eminent text for patent lawyers and agents in Canada. The fourth edition was repeatedly cited by courts including the Supreme Court of Canada. However, since its publication in 1969, there have been significant changes in Canadian patent law, including major statutory revisions in 1989 and 1996. The new edition brings the statement of the law up to date while retaining the jurisprudence as compiled by Dr. Fox to the extent that it remains relevant. Topics covered in this edition include: Invention, Subject Matter of Patents, Obviousness, Novelty, Utility, Application for a Patent, International Patent Protection, Dedication and Re-Examination, and Infringement and Remedies for Infringement.

This release features updates and additions to the commentary and case law in Chapters 1 (Introduction), 3 (The Subject Matter of Patents), 4 (Obviousness), 5 (Novelty), 7 (The Specification), 8 (Construction of a Patent), 11 (The Patent Grant and Validity of a Patent), 12 (Reissue, Disclaimer, Correction, Re-examination and Dedication) and 13 (Infringement).

Legislation Highlights

As discussed in overview in chapter 1, the *Budget Implementation Act, 2018, No. 2*, which was enacted, given royal assent and largely brought into force all in December

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2018 made significant amendments to Canadian patent law. The most significant are:

- New provisions that written communications in the patent prosecution file may be admissible in evidence as to the construction of a claim of a patent or a certificate of supplementary protection, effectively reversing the leading decision of the Supreme Court on this issue. [also discussed in chapter 8]
- Introduction of a wholly new and complex s. 56 relating to use before the claim date [also discussed in chapter 13]
- Amendment of the provisions re exemption from infringement of non-commercial and experimental use. Regulations regarding these provisions have not yet been promulgated. [also discussed in chapter 13]
- New provisions relating to standard essential patents. Regulations regarding these provisions have not yet been promulgated.
- New provisions prescribing requirements for written demands relating to an invention that is patented in Canada or elsewhere or that is protected by a certificate of supplementary protection in Canada or by analogous rights granted elsewhere and establishing liability to the recipient for such written demands which do not comply with the prescribed requirements. Regulations regarding these requirements have not yet been promulgated.
- Enactment of the *College of Patent Agents and Trade-mark Agents Act* (“*College Act*”) which establishes the College of Patent Agents and Trade-mark Agents, but most of the provisions of the *College Act* have yet to come into force and the related regulations have not yet been promulgated.

Chapter 1 also includes discussion of the *Comprehensive and Progressive Agreement for Trans-Pacific Partnership Act*, the Canada-United States-Mexico Agreement, and brief reference to the proposed new *Patent Rules*.

Case Law Highlights

Patentable Subject Matter

Recent decisions of the Patent Appeal Board and the Commissioner of Patents relating to the patentability of computer implemented inventions.

Obviousness

Obviousness issues in relation to three patents were considered by Locke J. in *Teva Canada Limited v. Janssen Inc. et al*, 2018 FC 754.

In *AFD Petroleum Ltd. v. Frac Shack Inc. et al*, 2018 FCA 140, the Federal Court of Appeal remitted the issue of obviousness to the trial judge in view of its assessment of the common general knowledge. In *Frac Shack Inc. et al v. AFD Petroleum Ltd.*,

2018 FC 1047, the decision on the remitted issues the trial judge's conclusion was the same.

Obviousness issues were also considered in *Safe Gaming System Inc. v. Atlantic Lottery Corporation et al*, 2018 FC 542 and in *Eli Lilly Canada Inc. et al v. Apotex Inc. et al*, 2018 FC 736.

Reference is also made to two UK decisions: *Jushi Group Co. Ltd. v. OVC Intellectual Capital LLC*, [2018] EWCA Civ 1416 and *Clearswift Limited v. Glasswall (IP) Limited*, [2018] EWHC 2442 (Pat).

The Specification

In *Eli Lilly Canada Inc. et al v. Apotex Inc. et al*, 2018 FC 736, Manson J. rejected an argument that a patent relating to the use of prasugrel with aspirin was insufficient. However, in *Safe Gaming System Inc. v. Atlantic Lottery Corporation et al*, 2018 FC 542, McVeigh J. found several terms in the claims to be ambiguous or indefinite.

Chugai Seiyaku and Kabushiki Kaisha's Patent application (2018) C.D.1398 is a significant decision as to the sufficiency of disclosure of an invention relating to a humanized antibody.

Warner-Lambert LLC v. Generics (UK) Ltd. (t/a Mylan), [2018] UKSC 56 is a decision of the UK Supreme Court as to the disclosure requirement for a new use of a known product. The court held that there must be a disclosure which makes the claimed utility plausible across the full scope of the claim in issue. While Canadian courts have not applied a plausibility test, the result is similar to the Canadian requirement of sound prediction of utility and the rationale of the UK Supreme Court may be relevant to this issue.

Construction of a Patent

The most significant development relating to construction of a patent was the dramatic change in Canadian law made by the *Budget Implementation Act, 2018, No. 2* permitting the admission of evidence for this issue from the prosecution file of the application leading to the patent.

In the UK, similar evidence has been considered and these authorities, such as the recent decision in *Icecape Limited v. Ice-World International BV & Ors*, [2018] EWCA Civ 2219 may be helpful.

The *Icecape* decision also provides recent commentary by the English Court of Appeal on the decision of the UK Supreme Court in *Actavis UK Limited v. Eli Lilly and Company*, [2017] UKSC 48.

Re-examination

There are very few decisions relating to re-examination. In *Usinage Pro-24 Inc. et al c. 9125-6651 Québec Inc. et al*, (July 11, 2018) unreported FC File No. T-1481-16, in an action to impeach the validity of three patents, Lafrenière J. dismissed a motion

motion to stay a re-examination in respect of one of the patents based on the prior filing of another of the patents.

Infringement

The most significant developments relating to patent infringement were the statutory amendments to introduce a wholly new provision, s. 56, relating to use before the claim date and amending the provision relating to non-commercial and experimental use, both of which are noted above.

The UK decision *Parainen Pearl Shipping Ltd. et al v. Kristian Gerhard Jebsen Skipsrederi AS et al*, [2018] EWHC 2628 (Pat) addresses the issue of non-infringing repair vs infringing manufacture in the context of a cement discharge system installed on a ship which ran aground and was extensively damaged.