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Annotated Patent Act

This publication examines the provisions of Canada's *Patent Act* to explain the history, purpose and importance of each provision within the broader scheme of the legislation as a whole. Each section of the Act is examined and the following information included: the current section is reproduced in full; related sections and related rules are gathered for ease of reference, a legislative history of the provision is discussed as it relates to the development of the law of patents as a whole, and upon the specific issues dealt with by the provision, and commentary upon the section (and its subsections) is provided in terms of the purpose and function of the section within the context of the act as a whole, specific issues in respect of both the obtaining and enforcement of patent rights, and relevant, specific facts of case law are summarized.

This release features the addition of case law annotations under the Annotated *Patent Act* tab. 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 the addition of Subdivision D College of Patent Agents and Trademark agents, sections 247-253 under a new "Related Legislation" tab. This release also features the addition of

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selected sections of United States-Mexico-Canada Agreement (USMCA) including the Preamble, and Chapter 20 Intellectual Property Rights.

Highlights

- ***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 subsection 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 CarswellNat 5338, 2018 CarswellNat 5339, 2018 CAF 172, 2018 FCA 172 (F.C.A.).

- ***Patent Act* — Section 28.3 — Case Law —** There was little doubt that Millennium's Velcade product had experienced tremendous commercial success both in Canada and around the world. There was also evidence of many awards and accolades associated with the success of Velcade. But it also appeared that such success required the inventions of all three patents in suit. No single one of these patents could have given rise to the commercial success. The parties had not cited any jurisprudence in which a series of patents were necessary to commercial success. In Justice Locke's view, the Court must consider the issue of commercial success separately for each patent, just as the Court must consider the broader issue of obviousness separately for each patent. The issue of commercial success could not save the claims of the 936 Patent from obviousness. There was little doubt that the 936 Patent was not sufficient to create a commercially successful product. Bortezomib alone was too unstable to be commercially

practical. This was evidenced by the long time period between the filing of the application for the 936 Patent in 1995, and the introduction of Velcade to the market in 2005. As with the 936 Patent, the commercial success of Velcade could not save the claims in issue of the 146 Patent from obviousness. Even though the bortezomib mannitol ester that was claimed in the 146 Patent was necessary to the success of Velcade, it was not sufficient. The improved properties of solubility and dissolution rate, which made an important contribution to Velcade being a practical commercial product, were the result of a large excess of mannitol in the formulation. The inventive concept of the claims in issue of the 146 Patent did not contemplate such an excess of mannitol. Accordingly, the inventive concept of the 146 Patent lacked the required causal link with the commercial success: *Teva Canada Limited v. Janssen Inc.*, 2018 CarswellNat 4521, 2018 CarswellNat 5461, 2018 FC 754, 2018 CF 754, 157 C.P.R. (4th) 391, 295 A.C.W.S. (3d) 839 (F.C.).