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## CIPO's New Draft Guidelines Could Result in Higher Disclosure Standards for Canadian Patents

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The Canadian Intellectual Property Office (CIPO) has released a further update to the Manual of Patent Office Practice (MOPOP), an administrative document of CIPO that examiners refer to during the patent examination process. The latest update is a draft version of Chapter 9: Descriptions, and is now available for public comment. Chapter 9 sets out CIPO's views on the description requirements of Canadian patent applications. While the MOPOP does not carry the force of law, it reflects CIPO's interpretation of the patent statute and surrounding jurisprudence and the administrative position that CIPO is likely to take when examining an application.

The new Chapter 9 is expected to overhaul the current edition in use at CIPO, which was relatively brief in reciting the technical requirements of a patent description and contained only two short paragraphs discussing the requirement that the description be sufficient to support the claimed invention. In the newly proposed guidance, there is an expansion on the disclosure requirements necessary to identify, enable and establish the utility of an invention. The new guidance would have examiners analyzing the description to determine whether the application provides sufficient disclosure of a solution to a practical problem that is reflected in the claims.

Additionally, new Chapter 9 indicates that for an invention to be enabled, a person skilled in the art must be able to practise the invention without "undue burden or the need to exercise their inventive ingenuity." The new chapter also provides a detailed discussion of obviousness for examiners to verify properties of the claimed invention. Examiners are now likely to look for literal support for the invention as claimed, which would be a very rigid and restrictive interpretation of the support requirements under the Canadian *Patent Act*. This approach is, however, not explicitly stated in the chapter.

Further, the new Chapter 9 describes how examiners will determine which aspects of an invention are "essential elements," – that is, elements necessary to provide a solution to the practical problem at hand. Under the doctrine set forth by the Supreme Court of Canada,<sup>1</sup> claim construction requires a purposive analysis of which elements are considered to be essential or non-essential by a person skilled in the art. However, Chapter 9 now directs examiners to take a different perspective in determining essential elements of the description/invention than the courts take in determining essential elements of the claims. The new Chapter 9 indicates that "[w]here the description requires that an invention comprise a given element, that element must appear in each claim to that invention in order that the claim not be broader than the

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<sup>1</sup> *Free World Trust v. Électro Santé Inc.* [2000] SCC 66.

description,” and that an element may be essential even if a person of ordinary skill would not view the same element to be essential. It is unclear why examiners are to ignore the views of the notional person of ordinary skill or why they are to take a different approach to defining essential elements of a description/invention – an approach that appears to be a different requirement to the purposive construction principle for construing claims as set out by the Supreme Court.

Patent applicants in Canada are required to demonstrate the utility of the claimed invention as of the filing date, either by demonstration or by “sound prediction.” The new Chapter 9 cites recent case law from the Federal Court that may raise the bar for disclosure requirements in the context of soundly predicting the usefulness of a claimed invention. We expect there to be more calls for supporting data to satisfy examiners of demonstrated utility.

Overall, new Chapter 9 would be problematic if ultimately adopted, especially for applicants with international patent programs as it appears to elevate the disclosure requirements for a Canadian patent description to a standard that is much higher than in other jurisdictions. Subsection 27(1) of the *Patent Act* directs the Commissioner of Patents to grant a patent if an application “is filed in accordance with th[e] Act and all other requirements for the issuance of a patent under th[e] Act are met,” and the draft guidance, if read as going beyond the explicit requirements set out in the statute and rules, might be considered outside the legal authority of CIPO. However, in practice the examiners are the gatekeepers of the patent process, and if these proposed examination methods are adopted, applicants will nonetheless be faced with these new standards during the examination process.

The period for public comment runs until December 30, 2009, and stakeholders are invited to provide comments to CIPO on the new Chapter 9. A copy of the chapter can be accessed at [www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr00758.html](http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr00758.html). 