

Inputs from Member States and Regional Patent Offices to the Thirty-Eighth Session of the Standing Committee on the Law of Patents

Respondent Information

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Disclaimer:

The information provided in response to this questionnaire is understood to be submitted on behalf of the Member State or regional organization concerned, through its competent authority and in accordance with its applicable official internal procedures.

It is assumed that the person completing and submitting the questionnaire is duly authorized to do so and that the information reflects the official position or practice of the Member State or organization, to the extent possible.

I confirm that I have read and understood the statement above and that I agree with its contents.

A. Prior Art

1. How is prior art defined under the applicable national or regional law?

The term prior art is not explicitly defined in the Patent Act or in the Patent Rules. A disclosure in any form (written, oral, public use, sale, display, etc.) and made anywhere in the world is considered to be prior art. The prior art typically applied in patent examination consists of printed publications.

Subsections 34.1(1) and 48.1(1) of the Patent Act, both relating to information that can be submitted to the patent office, inform that prior art consists of patents, applications for patents open to public inspection and printed publications.

2. Against which date is prior art assessed under the applicable law?

The date against which the prior art is assessed is the claim date which is defined in Section 28.1 of the Patent Act. The claim date is generally the filing date of the application, or an earlier priority date if a valid priority claim is made under section 28.4 of the Patent Act.

3. Which types of information may constitute prior art under the applicable law, and how is it determined whether such information is considered to form part of the prior art?

Information in any form can constitute prior art if it was made available to the public in Canada or elsewhere before the claim date.

In the case of non-printed publications (e.g. oral, public use, sale, display, etc.), the question of what it means for information to be made "available to the public" may be fact specific.

In Canada, the form or source of a disclosure is irrelevant for determining whether it qualifies as prior art. Any information that is made available to the public in Canada or elsewhere before the claim date may constitute prior art, regardless of its form.

Information that is made available to the public excludes information disclosed on a confidential basis or in circumstances giving rise to an implicit duty of confidentiality. For public use, the law is concerned with whether the public had an unrestricted opportunity to access information that would enable a person skilled in the art to perform the invention before the claim date. The level of difficulty to access the invention and actual access by any person is not required (Federal Court of Appeal in *Wenzel Downhole Tools Ltd. v. National-Oilwell Canada Ltd.*, 2012 FCA 333).

For a written publication, the determination if it is prior art is usually established through the date of the publication or other reliable timestamps related to the publication. For information related to oral disclosures, public uses, or sales, documentary evidence is generally required to establish that the information is prior art.

Canada has a grace period that excludes certain disclosures from being considered prior art. Please see the section titled "Grace Period Mechanisms and Pre-Filing Disclosures" for further information.

4. Does the applicable law provide for any category of prior art that is taken into account for patentability purposes notwithstanding that it was not publicly available before the relevant filing or priority date (sometimes referred to as "secret prior art")?

Yes

If yes, please indicate, where applicable, the types of information or documents concerned (for example, earlier-filed patent applications), the relevant date(s) for determining such prior art, as well as any limitations, exclusions, or special rules applicable to such prior art. : Under paragraphs 28.2(1)(c) and 28.2(1)(d) of the Patent Act, certain earlier-filed Canadian patent applications by a third party can be cited as prior art for the purposes of assessing novelty even if the earlier-filed patent applications were not published before the claim date of the application being examined.

5. Please provide any additional information that may be relevant to the understanding or application of prior art under the applicable law, including where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

A general reference is made to Chapter 18 "Anticipation, Obviousness and Double-Patenting" in the Manual of Patent Office Practice (MOPOP).

In regards to secret prior art referenced in question 5, a PCT international application will only become secret prior art in Canada, for the purposes of paragraphs 28.2(1)(c) and (d) of the Patent Act, if it enters into the national phase in Canada.

Please upload any document that may be relevant to the understanding or application of prior art under the applicable law.

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

B. Novelty

1. How is the requirement of novelty defined under the applicable national or regional law?

Subsection 28.2(1) of the Patent Act states that the subject-matter of a claim must not have been disclosed:

(a) before the one-year period immediately preceding the filing date or, if the claim date is before that period, before the claim 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 but where the co-pending application has a priority date that precedes the claim date.

Canada applies an absolute worldwide novelty standard. Any disclosure that makes the subject-matter available to the public anywhere in the world before the claim date destroys novelty, subject to the one-year grace period in paragraph 28.2(1)(a) of the Patent Act.

2. For the purposes of assessing novelty under the applicable law, are there any novelty-specific considerations regarding the relevant date or the scope of information taken into account, beyond those addressed in the Prior Art section of this survey?

The relevant date against which the prior art is assessed for the purpose of assessing novelty is the claim date which is defined in Section 28.1 of the Patent Act. The claim date is generally the filing date of the application, or an earlier priority date if a valid priority claim is made under section 28.4 of the Patent Act.

The claim date is assessed on a claim by claim basis. When an earlier priority date is claimed under section 28.4 of the Patent Act, the priority document must provide full support for the claim (i.e., the subject-matter of the claim must be disclosed in the priority document). If the priority claim is invalid or the subject matter of the claim is only partially supported by the priority document, the claim date is the Canadian filing date for novelty purposes.

An application which claims priority from two or more prior applications may have multiple claim dates. The claim date accorded to a claim is the earliest possible claim date for subject-matter claimed in the pending application based on the content of the earliest corresponding priority document.

When assessing novelty, all elements of the claim must be found in a single prior art reference. Multiple documents cannot be combined to destroy novelty. (Federal Court of Appeal in *Beloit Canada Ltd. v. Valmet OY* (1986), 8 C.P.R. (3d) 289)

3. Does the applicable law apply an absolute novelty requirement, or does it provide for any limitations or qualifications to novelty (for example, relative novelty or other restricted approaches), apart from any grace period mechanisms addressed separately in this survey?

Canada applies an absolute worldwide novelty standard.

4. Apart from the approach described in question 3, are there any specific rules or contextual factors that affect what is taken into account as prior art for the purposes of assessing novelty under the applicable law?

In regards to secret prior art which can only apply in the assessment of novelty in Canada, a PCT international application will only become secret prior art in Canada, for the purposes of paragraphs 28.2(1)(c) and (d) of the Patent Act, if it enters into the national phase in Canada.

5. Please provide any additional information relevant to the requirement of novelty under the applicable law, to the extent not already addressed in questions 1 to 4, including, where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or other interested parties, captured by patent office practice.

The test for anticipation under Canadian law, as established by the Supreme Court in *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.*, 2008 SCC 61, requires that a single prior disclosure both disclose and enable the claimed invention. The person skilled in the art is assumed to read the prior art purposively, seeking to understand what the author meant, in the same manner as the patent specification itself. The disclosure does not need to be an exact description; it is sufficient if it clearly conveys the invention such that carrying out the prior art would inevitably result in something falling within the scope of the claim.

If the prior art discloses the claimed subject-matter, the second part of the test examines whether it is enabling. At this stage, the skilled person is willing to undertake routine trial and error experiments to make the invention work, but must not be required to exercise inventive effort or face undue burden.

The "reverse infringement" principle is often applied to assess anticipation. If practising the prior art would infringe the later claim, then the prior art anticipates the claimed invention. In assessing anticipation, it may also be determined that a claim encompasses many different operating embodiments. The claim will be anticipated if any one working embodiment is disclosed and enabled by the prior art.

A general reference is made to Chapter 18 "Anticipation, Obviousness and Double-Patenting" in the Manual of Patent Office Practice (MOPOP).

C. Inventive Step

1. How is the criterion of inventive step or non-obviousness defined under the applicable national or regional law?

Subsection 28.3 of the Patent Act states that the subject-matter defined by a claim in an application for a patent in Canada must be subject-matter that would not have been obvious on the claim date to a person skilled in the art or science to which it pertains, having regard to

(a) information disclosed before the one-year period immediately preceding the filing date or, if the claim date is before that period, before the claim date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant in such a manner that the information became available to the public in Canada or elsewhere; and

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

2. For the purposes of assessing inventive step or non-obviousness under the applicable law, what is the relevant date and what prior art or information is taken into account?

The relevant date against which the prior art is assessed for the purpose of assessing novelty is the claim date which is defined in Section 28.1 of the Patent Act. The claim date is generally the filing date of the application, or an earlier priority date if a valid priority claim is made under section 28.4 of the Patent Act.

The claim date is assessed on a claim by claim basis. When an earlier priority date is claimed under section 28.4 of the Patent Act, the priority document must provide full support for the claim (i.e., the subject-matter of the claim must be disclosed in the priority document). If the priority claim is invalid or the subject matter of the claim is only partially supported by the priority document, the claim date is the Canadian filing date for novelty purposes.

An application which claims priority from two or more prior applications may have multiple claim dates. The claim date accorded to a claim is the earliest possible claim date for subject-matter claimed in the pending application based on the content of the earliest corresponding priority document. An application which claims priority from two or more prior applications may have multiple claim dates. The claim date accorded to a claim is the earliest possible claim date for subject-matter claimed in the pending application based on the content of the earliest corresponding priority document.

3. What is the standard applied under the applicable law to determine whether an invention involves an inventive step or is non-obvious, in particular as reflected in the concept of the “person skilled in the art”, focusing on how the standard is understood or applied, rather than its formal legal definition?

Obviousness is assessed from the viewpoint of the person skilled in the art, in light of their common general knowledge and the state of the art as it was on the claim date. For a claimed invention to satisfy the requirement of section 28.3 of the Patent Act there must be present that "characteristic or quality" (i.e. that "scintilla of invention necessary to support the patent") which serves to elevate the matter of the claims from mere workshop improvement to real invention.

The Supreme Court of Canada (Apotex Inc. v. Sanofi Synthelabo Canada Inc., [2008] 3 S.C.R. 265, 2008 SCC 61) has endorsed a four-step analysis for the assessment of obviousness, wherein the first three steps frame the inquiry and the fourth step is to ask the pertinent question. The four steps in the analysis are as follows:

- (1) Identify the notional "person skilled in the art" and identify the relevant common general knowledge of that person;
- (2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
- (3) Identify what, if any, difference exists between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;
- (4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

4. Are there any specific rules, limitations, or contextual factors that apply to the assessment of inventive step or non-obviousness under the applicable law?

Yes

Please indicate, where relevant, whether such rules or factors include geographic or territorial considerations affecting the relevance of prior art (for example, distinctions between domestic and foreign disclosures, uses, or publications, or territorial conditions applicable to particular categories of prior art) or any other particular considerations relevant to the assessment.

Responses should be limited to such contextual factors as they relate to the assessment of inventive step or non-obviousness, without restating general rules on what constitutes prior art. When assessing obviousness, multiple prior art references may be combined, along with the common general knowledge of the person skilled in the art. Determining whether a claimed invention is obvious at step 4 of the obviousness inquiry (see question 3) may involve asking whether the claimed subject-matter is obvious because the route to the invention would have been obvious to try. When considering an obvious to try analysis, the following non-exhaustive list of factors is relevant: a) Is it more or less self-evident that what is being tried ought to work? Are there a finite number of identified predictable solutions known to the person skilled in the art? b) What is the extent, nature and amount of effort required to achieve the invention? Are routine trials carried out or is the experimentation prolonged and arduous, such that the trials would not be considered routine? c) Is there a motive provided in the prior art to find the solution the patent addresses?

5. Please provide any additional information relevant to the requirement of inventive step or non-obviousness under the applicable law, to the extent not already addressed in questions 1 to 4, including, where applicable, any guidance (for example, patent office manuals or guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

A general reference is made to Chapter 18 "Anticipation, Obviousness and Double-Patenting" in the Manual of Patent Office Practice (MOPOP).

Please upload any document relevant to the requirement of inventive step or non-obviousness under the applicable law.

6. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

D. Grace Period Mechanisms and Pre-Filing Disclosures

1. Does the applicable law provide for any mechanism under which certain disclosures made before the filing or priority date do not prejudice the patentability of an invention, in particular with respect to novelty and/or the legal effect on prior art?

Yes

If yes, please identify the relevant legal provisions (in primary and/or secondary legislation) and describe their operation.: Canada has a grace period that excludes certain disclosures from being considered prior art. In the assessment of novelty, paragraph 28.2(1)(a) of the Patent Act excludes from the prior art disclosures by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant, if they were made in the one-year period immediately preceding the filing date or, if the claim date is before that period, before the claim date. In the assessment of obviousness, paragraph 28.3(a) of the Patent Act excludes from the prior art disclosures by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant, if they were made in the one-year period immediately preceding the filing date or, if the claim date is before that period, before the claim date.

2. What is the duration of the mechanism referred to in question 1, during which the covered disclosures do not prejudice the patentability of the invention?

The duration is one year immediately preceding the filing date of the Canadian patent application.

When an earlier priority date is claimed under section 28.4 and where there is a restoration of the right of priority, the grace period could have a duration of up to 14 months immediately preceding the filing date of the Canadian patent application (i.e. it could grace disclosures on or after the claim date which is a date that is earlier than the date that is one year immediately preceding the filing date).

When an earlier priority date is claimed under section 28.4 of the Patent Act and where there is an extension of time that results in the filing date of the Canadian patent application to be more than one-year after the priority date (e.g. office closures, force majeure), the grace period could be longer than one-year (i.e. it could grace disclosures on or after the claim date which is a date that is earlier than the date that is one year immediately preceding the filing date).

3. Where such a mechanism exists, which categories of disclosures are covered by it?

All disclosures by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant. The applicant is defined in Section 2 of the Patent Act and includes an inventor and the legal representatives of an applicant or inventor.

4. Are there any formalities or procedural requirements that must be fulfilled in order to rely on the mechanism identified in question 1?

No

Please describe any such requirements, where applicable, including, for example, the need to file statements, declarations or notices, to submit certificates or other supporting evidence, or to comply with any timing or notification requirements or any information relating to the burden of proof. :

5. Does the applicable law provide for prior user rights or other protections for third parties who may be affected by an invention that has benefited from a graced pre-filing disclosure?

Yes

If yes, identify the relevant legal provisions (including any provisions in primary and/or secondary legislation), and describe the conditions under which such rights or protections arise (for example, good-faith use of the invention prior to the filing or priority date), as well as how such rights or protections operate. : Under subsection 56(1) of the Patent Act, a person who, in good faith, before the claim date of a claim in a patent committed an act that would otherwise constitute infringement (e.g., made, constructed, used or sold the invention in Canada), or made serious and effective preparations to do so, is entitled to continue to perform the same act after the claim date without liability for infringement. There is an important limitation in subsection 56(5) of the Patent Act. These prior user rights do not apply if the person was only able to commit the act or make the preparations because they obtained knowledge of the subject-matter of the claim, directly or indirectly, from the applicant, or someone who obtained it from the applicant, and they knew that the applicant was the source of that knowledge. This provision is particularly relevant in the context of the one-year grace period: it could prevent a third party who learned of the invention through the applicant's pre-filing disclosure from relying on prior user rights if they knew the information came from the applicant.

6. Please provide any additional information that may be relevant, including, where applicable, any guidance (e.g. patent office manual/guidelines) or key judicial decisions in your jurisdiction with general relevance to applicants or interested parties, captured by patent office practice.

Please upload any document that may be relevant to grace period mechanisms and/or pre-filing disclosures.

7. Please indicate whether any legal provisions, including those applicable to utility models or any other similar system (where different from those applicable to patents of invention), are relevant to the subject matter of this section and, if so, kindly provide the relevant information and references.

Final review before submission

Confirmation of submission

I am aware that by clicking "Submit" below, my responses will be sent to the SCP Secretariat.