In recent years, attacks on the lack of sound prediction and failure to meet the promise of the patent have proven to be a crushing hammer in the hands of those who challenge patents. This article considers the Canadian patent utility requirements that extend beyond mere usefulness.

**Promise of the Patent**

The utility of each claim is assessed against what has been called "the promise of the patent." Traditionally, utility requirements were easily met. Although courts indicated that, where no specific promise is made, the threshold required for utility is low, much ink has been spilled construing patents for specific promises that will void a patent if not met by the claimed invention.

What constitutes a promise is a question of law that courts determine at the Canadian filing date of the patent. The judge is to purposively construe the patent and its context, assisted by factual evidence and expert testimony as to the state of the art and the research conducted until the Canadian filing date, informed by objective and subjective considerations. Advantages described in support of inventive ingenuity have also been considered promises of utility (even though utility and advantages are clearly different). Construing a promise is different from claim construction but may introduce language into the claim, adding limitations.

Patents can now fail as a result of inutility where the patent promises a specific result, but does not deliver. Such attacks have become commonplace. Patents are scrutinized for words and
phrases that inflate the promise of a specific result for which the utility has not been demonstrated or soundly predicted. For example, a compound claim can be transformed into a use claim as a result of construing a promise that the compound has a particular utility.

A patentee should not over-promise by suggesting utility for the claimed invention that is not inferable in interpreting the promise from the context of the research and development work that was done prior to the Canadian filing date, even where that research was done to show the claimed invention was inventive over prior art. Caution should be applied when disclosing lists of potential uses for which there is no specific support. Exclusion of such lists, however, may prejudice the patent in other jurisdictions so caution is warranted.

**Demonstrated Utility**

There were two lines of cases in the Courts with respect to whether or not a patentee must disclose the utility that is demonstrated. In the *Viagra* decision of late last year, the Supreme Court affirmed there is no requirement to disclose what is demonstrated. One also need not prove the utility conclusively; a strong suggestion of utility by the Canadian filing date is sufficient. However, one cannot rely on post-filing data for demonstrated utility.

**Soundly Predicted Utility**

It is also possible to have a sound prediction of utility. A sound prediction requires a prima facie reasonable inference of utility. Courts have required patentees to support predictions of utility (and advantages) with a factual basis: a line of reasoning by which predictions of that the claimed invention will meet the promise of utility and a proper disclosure. The Supreme Court of Canada in the *AZT* case indicated only that one needed the elements of a factual basis, sound line of reasoning and proper disclosure without explaining these requirements. Subsequent cases have interpreted this to mean the factual basis and line of reasoning needs to be disclosed, at least in part, in the patent.

Although the Supreme Court dealt with disclosure requirements for sufficiency in the *Viagra* case, the Court did not deal with enhanced disclosure requirements for sound prediction. Some have nonetheless argued that heightened disclosure is required. Patent drafters should consider including support for a factual basis and a sound line of reasoning by which the inventors predicted the utility of a claimed invention.

Post-filing data cannot be used to prove a prediction was soundly made or was, in fact, correct.
However, a prediction need not be correct if it was soundly made as of the Canadian filing date and the claimed invention has the promised utility. If the reason for utility was subsequently discovered to be different from that disclosed in the line of reasoning, this should not be fatal to the patent since one need not explain why an invention works, only what it is and how to practice it. Hence an enhanced disclosure requirement for sound predictions of utility seems at odds with Canadian law on sufficiency. Hopefully, the Supreme Court will take the opportunity to make the law consistent on this point and indicate that disclosure requirements for sufficiency and utility are the same and no enhanced disclosure requirement exists for utility regardless of whether utility is demonstrated or soundly predicted.

What this Means for Patentees

The following are four tips for patentees:

1. To support a sound prediction of utility, consider including as much information in any application for the factual basis and line of reasoning, e.g. reference to the state of the art, hypotheses, descriptions of work done, tests and results.

2. Add additional information to the patent specification learned during the period between priority filing and the Canadian filing date. Note, however, the Canadian filing date for PCT applications is the PCT filing date and it is too late to supplement the disclosure upon National Entry in Canada.

3. Consider each claim individually and what support exists in the disclosure for it.

When claiming a broad genus, claim various preferred sub-genera and preferred species disclosed which are especially relevant to the work done. Where one is claiming new uses, have claims that mirror the actual commercial use as separate independent claims, distinct from potential uses inferable from initial research.

1. Be aware of how statements of advantage, or discussion of potential applications may be argued to be promises of the patent.

Utility in Canada is a fertile ground for invalidity attacks compared with Europe or the United States. However, where one promises more than one’s claimed invention can deliver, a patentee may face jeopardy in numerous jurisdictions, not just Canada. Therefore, before including a statement of advantage or a statement of utility about the claimed invention, one must think about how that statement can be supported, either with information in the patent or with information that would be understood at the filing date of the patent.

Patentees may either draft applications specific to Canada or ensure applications are drafted in
such a manner that there is support in the disclosure for any advantages described, or promises made, and subject matter claimed. Because this analysis begins and ends with the claimed invention, it is wise to review the scope of claims to ensure, where possible, narrow claims are available that cover the key aspects of the invention that are the most critical to the commercial product.

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