Applying for a patent

What are the criteria for patentability in your jurisdiction?

In Canada, in order to be patentable an invention must be novel, useful and unobvious. In other words, the invention must:

- not have been previously disclosed anywhere in the world;
- be functional and operative;
- show inventive ingenuity; and
- not be obvious to someone skilled in the art (Sections 2, 28.2 and 28.3 of the Patent Act, RSC 1985, c P-4).

What are the limits on patentability?

Statutory limits on inventions

Similar to other jurisdictions (eg, the United States), Section 27(8) of the Patent Act provides that "no patent shall issue for any mere scientific principle or abstract theorem". The purpose of this preclusion is to separate disembodied inventions that attempt to monopolise natural phenomena or scientific laws from practical applications of such principles (David Vaver, Intellectual Property Law: Copyright, Patents, Trademarks, 2nd ed (Toronto: Irwin Law, 2011) at 308. Also see Canadian Intellectual Property Office, Practice Guidance Following the Amazon FCA Decision (Ottawa: Industry Canada, 2013)). Section 27(8) of the Patent Act encompasses, among other things:
merely discoveries of nature;
mathematical formulas;
laws of nature; and
purely mental operations (Vaver at 308. Also see Canadian Intellectual Property Office (CIPO), Manual of Patent Office Practice, December 2009 update (Ottawa: Industry Canada, 1998) at 12.05.01)).

The difficulty in distinguishing between patentable and non-patentable subject matter using Section 27(8) is illustrated by the courts' hesitation in many instances to invoke its use (Bruce Stratton, Annotated Patent Act (Toronto: Carswell, 2009) at Section 27(8)).

Time limits on granted patents

In Canada, patents are granted for a 20-year period from the date of filing (Section 44 of the Patent Act). Although patent term extensions do not exist in Canada, the Canada and European Union Comprehensive Economic and Trade Agreement is expected to introduce two-year extensions for drug patents, subject to government delays in approving drugs for patient use (John Norman and Monique M Couture, "CETA: Impact on Canada's IP Regime").

To what extent can inventions covering software be patented?

The Patent Act does not include the terms 'computer' or 'software' (or any equivalent wording); as such, as with any other invention, software must meet the general requirements for patentability outlined in Sections 2, 28.2 and 28.3 of the Patent Act. The issue of software patentability in Canada was recently examined in Canada (Attorney General) v Amazon.com Inc (2011 FCA 328, 2 FCR 459). Amazon had been refused a patent for software that stored customer information to expedite future purchases (Amazon.com at Paragraph 14). Although the Federal Court ruled that the claims constituted patentable subject matter, the Federal Court of Appeal did not affirm this ruling. On re-examination, the commissioner of patents allowed the claims and granted the patent (Method and System for Placing a Purchase Order via a Communications Network, Patent 2246933, (September 11 1998)).

Following Amazon.com, the Patent Office issued new patent examination guidelines for computer-implemented inventions. Specifically, the office stated that a purposive
construction is needed to determine whether a computer is an essential element of the claims, thus distinguishing legitimate claims from disembodied inventions prohibited by Section 27(8) of the Patent Act (Canadian Intellectual Property Office, "Examination Practice Respecting Computer-Implemented Inventions" (Ottawa: Industry, 2013). Also see Canadian Intellectual Property Office, "Examination Practice Respecting Purposive Construction" (Ottawa: Industry Canada, 2013)).

Hundreds of patents pertaining to computer-implemented inventions have been issued by the Patent Office since Amazon.com. Nonetheless, no bright-line test exists for determining whether a claim directed at software or a computer-implemented business method will be found to constitute patentable subject matter.

To what extent can inventions covering business methods be patented?

Traditionally, business methods did not constitute patentable subject matter in Canada (Vaver at 309). In Amazon.com the court held that the commissioner should undertake a purposive construction of the claims at issue "with a mind open to the possibility that a novel business method may be an essential element of a valid patent claim" (Amazon.com at Paragraph 63). The court confirmed that no conclusive Canadian jurisprudence dictates that business methods cannot be patented.

Prospectively, for a business method to be patentable, it must comprise a practical application. Methods which rely solely on the presence of a computer program to implement the methodology in order to provide the necessary practical application may not be patentable. Instead, it is more likely that a business method that will be found patentable when it is "not the whole invention but only one of a number of essential elements in a novel combination" (Amazon.com at Paragraph 63).

To what extent can inventions relating to stem cells be patented?

The Patent Office takes the position that stem cells with limited developmental potential are patentable under Section 2 of the Patent Act. This category can include embryonic, multipotent and pluripotent stem cells. Totipotent stem cells - which have the potential to differentiate into a complete organism - are not patentable (Canadian Intellectual Property Office, "Office Practice Regarding Fertilized Eggs, Stem Cells, Organs and Tissues"
Are there restrictions on any other kinds of invention?

In addition to the statutory bar on patenting scientific principles and abstract theorems, common law restrictions on patentability also exist (Canadian Intellectual Property Office, "Examination Practice Respecting Computer-Implemented Inventions" (Ottawa: Industry, 2013). Also see Canadian Intellectual Property Office, "Examination Practice Respecting Purposive Construction" (Ottawa: Industry Canada, 2013)). These restrictions have all been found to fall outside the Patent Act's definition of 'invention' and include the following:

- methods of medical treatment (Tennessee Eastman Co v Commissioner of Patents (1972), [1974] SCR 111);
- professional skills (Lawson v Canada (Commissioner of Patents), [1970] Ex CJ 13, 62 CPR 101).
- fine arts (things "inventive only in an artistic or aesthetic sense") (Amazon.com);
- disembodied inventions lacking a method of practical application (Shell Oil Co v Commissioner of Patents, [1982] 2 SCR 536, 67 CPR (2d) 1 at 554); and
- higher life forms (Harvard College v Canada (Commissioner of Patents), 2002 SCC 76).

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