

# Index

## ABANDONMENT

- Generally, **9:72 to 9:77**
- Circumstances, **9:72**
- Good faith reply, **9:73**
- Timely completion of application, **9:74**
- Timely payment of fees, **9:77**
- Timely payment of maintenance feeds, **9:75**
- Timely request for examination, **9:76**

## ACCOUNT OF PROFITS

- Generally, **14:47 to 14:59**
- Apportionment, **14:56**
- Condonation, **14:59**
- Expenses, **14:55**
- Indirect profits, **14:57**
- Interest, **14:58**
- Measure of profits, **14:49**
  - differential cost approach, **14:51**
  - differential profits approach, **14:52**
  - full cost approach, **14:50**
- Multiple parties, **14:48**
- Proof of the expenses, **14:54**

## AGENT

- See PATENT AGENT

## APPLICATION FOR A PATENT

- Generally, **9:1 et seq.**
- Additional term, **9:85.20 to 9:85.40**
- Applications filed before October 1, 1989
  - “Old Act applications”
- amendments, **9:103**
  - supplementary disclosure, **9:103**
- conflicting applications, **9:104 to 9:106**
  - conflict exists, **9:104**
  - federal court, **9:106**
  - patent office, **9:105**
- due care, **9:78.50**
- examination, **9:102**
- priority date, **9:94**
  - convention priority, **9:94**
  - earliest corresponding foreign application, **9:94**
  - foreign application, **9:94**

## APPLICATION FOR A PATENT

### —Cont’d

- Applications filed before October 1, 1989
  - “Old Act applications”—Cont’d
- priority date, **9:94**—Cont’d
  - same invention, **9:94**
  - significance of, **9:94**
- public inspection, not open to, **9:95 to 9:100**
  - substances intended for food, **9:101**
- Applications filed on or after October 1, 1989
  - abandonment, **9:72 to 9:77**
    - circumstances, **9:72**
    - good faith reply, **9:73**
    - timely completion of application, **9:74**
    - timely payment of fees, **9:77**
    - timely payment of maintenance fees, **9:75**
    - timely request for examination, **9:76**
  - allowance of an application, **9:83**
  - amendments, **9:61 to 9:65**
    - after allowance, **9:65**
    - application, **9:61**
    - include sequence listings, **9:63**
    - limitation after rejection, **9:64**
    - new matter, **9:62**
  - appeal from decision of commissions, **9:86 to 9:90**
    - appeal decisions, **9:90**
    - appeal to federal court, **9:86**
    - powers of the federal court, **9:89**
    - procedure on appeals, **9:87**
    - standard of review, **9:88**
  - appeal to the patent appeal board, **9:82**
  - application, **9:31 to 9:36**
    - abstract, **9:33**
    - petition, **9:32**
    - specification, **9:34**
  - appointment of patent agents, **9:22**
  - appointment of representative, **9:23**
  - claim date, **9:38 to 9:45**
    - applicant, request for priority by, **9:44**

## APPLICATION FOR A PATENT

### —Cont'd

Applications filed on or after October 1, 1989—Cont'd

- claim date, **9:38 to 9:45**—Cont'd
- disclosure of subject matter, **9:42**
- filing date, **9:43**
- multiple priorities, effect of, **9:45**
- prior application, **9:41**
- prior Canadian application, **9:39**
- prior convention or Treaty application, **9:40**
- requirements, **9:38**
- completing the application, **9:52**
- conflicting applications, **9:81**
- corrections, **9:66**
- divisional applications, **9:68**
- examination, **9:57 to 9:60**
  - accelerated examination, **9:58**
  - prosecution of application, **9:59**
  - request for examination, **9:57**
  - timely response in good faith, **9:60**
- fees, **9:25 to 9:30**
  - current status, **9:28**
  - fees for “small entity” applicants, **9:26 to 9:28**
  - legislative correction, **9:27**
  - maintenance fees, **9:29**
  - reduced fees, **9:26**
- filing date, **9:37**
- filing prior art, third party, **9:80**
- good faith, issues of, **9:69 to 9:71**
- granting patent, **9:67**
- grant of a patent, **9:84**
- inventor, application by, **9:9**
- inventor’s legal representative, application by, **9:9**
- joint inventors and applications, **9:12 to 9:21**
  - appeal from decision of commission, **9:18**
  - changing inventors named in patent, **9:21**
  - consequences of misnaming inventors, **9:20**
  - effect of refusal, **9:13**
  - joining persons, **9:15**
  - joint applicant had no part in invention, **9:14**
  - joint investors, ownership rights of, **9:19**

## APPLICATION FOR A PATENT

### —Cont'd

Applications filed on or after October 1, 1989—Cont'd

- joint inventors and applications, **9:12 to 9:21**—Cont'd
  - power of commissioner, **9:16, 9:17**
  - section 31 appeal, **9:18**
- judicial review, **9:91**
- misrepresentation, **9:79**
- postal services interruption relief, **9:92**
- publication of the application, **9:53**
  - confidentiality period, **9:54**
  - secret applications and patents, **9:56**
  - significance of the publication date, **9:55**
- refusal to grant patents, **9:85**
- reinstatement, **9:78**
- requesting priority, **9:46 to 9:51**
  - withdrawal of request, **9:47**
- third party filing, **9:80**
- time, **9:24**
- Commission of patents, **9:2 to 9:4**
- Patent agents, **9:5**
  - new patent agent privilege, **9:5**
  - solicitor-client privilege, **9:5**
- Patent office, **9:2 to 9:4**
  - communications with the patent office, **9:4**
  - manual of patent office practice (MOPOP), **9:3**

## BIOTECHNOLOGY

- Generally, **3:40 to 3:45**
- Animals, **3:44**
- Higher life forms, **3:42**
- Inventions
  - biochemical, **3:40**
  - biological, **3:40**
- Lower life forms, **3:41**
- Plants, **3:45**

## CLAIM DATE

- Generally, **9:38 to 9:45**
- Applicant, request for priority by, **9:44**
- Disclosure of subject matter, **9:42**
- Filing date, **9:43**
- Multiple priorities, effect of, **9:45**
- Prior application, **9:41**
- Prior Canadian application, **9:39**

## INDEX

### **CLAIM DATE—Cont'd**

Prior convention or Treaty application,  
**9:40**

Requirements, **9:38**

### **COLLEGE OF PATENT AGENTS AND TRADEMARK AGENTS**

Generally, **16:1 et seq.**

### **COMMON GENERAL KNOWLEDGE IN THE ART**

Construction of a patent

consideration of the common general  
knowledge of a person skilled in  
the art, **8:15**

Obviousness

determination of obviousness, **4:46 to  
4:56**

relevance of the common general  
knowledge in the art, **4:37**

The specification

common general knowledge in the art  
re the specification, **7:6**

What is the common general knowledge  
in the art, **4:38**

### **CONSTRUCTION OF THE PATENT**

Generally, **8:1 et seq.**

Claims, types of, **8:48 to 8:52**

“Jepson” claims, **8:51**

“Markush” claims, **8:52**

product by process claims, **8:49**

product claims, **8:48**

“Swiss Form” claims, **8:50**

“for,” **8:50**

Consideration, **8:64**

Experts, role of, **8:63**

First duty of court, **8:1**

interpretation, **8:1**

General principles, **8:7 to 8:10**

abstract, **8:9**

approach, **8:7**

description, role of, **8:8**

drawings, role of, **8:8**

function of the claims, **8:10**

Historical developments, **8:4 to 8:6**

Canadian rules, **8:6**

rules prior to 1981, **8:4**

U.K. rules, **8:5**

Issue of law, **8:2**

Prior decision, **8:65**

### **CONSTRUCTION OF THE PATENT**

#### **—Cont'd**

Rules of construction, **8:11 to 8:37**

claims language, **8:31 to 8:35**

consideration of variants, **8:32**

determination of essential elements,  
**8:34**

essential elements, **8:33**

purposive construction, **8:31**

U.K. law, **8:35**

consider whole claim, **8:28**

construed as a whole, **8:20**

plain and ambiguous language, **8:20**

construed objectively, **8:21**

construed to avoid unreasonable result,  
**8:27**

context, **8:26**

date of publication, **8:12**

disclaimed, **8:37**

extrinsic evidence, **8:22**

factual matrix, **8:19**

meaning of term, **8:19**

interpretation, consistency in, **8:30**

interpreted in its context, **8:26**

language, interpretation of, **8:29**

language of patent specification, **8:26**

person of ordinary skill in the art, **8:13  
to 8:18**

application, **8:17**

common general knowledge, **8:15**

expert evidence, **8:16**

person skilled in art, **8:14**

separate claims, **8:14**

purposive construction, **8:24**

read fairly, **8:25**

redraft, should not, **8:36**

Specification, construction of, **8:38 to  
8:47**

Specification, issues concerning, **8:38 to  
8:47**

alternatives, **8:41**

dependence claims, **8:43, 8:44**

antecedent claims, **8:43**

element, included or additional, **8:44**

inventions, single or multiple, **8:40**

new result or method, **8:39**

new technology, **8:47**

numerical limitations, **8:46**

promise of patent — old law, **8:38**

reference numbers, **8:42**

## **CONSTRUCTION OF THE PATENT**

### **—Cont'd**

- Specification, issues concerning, **8:38 to 8:47**—Cont'd
  - reference to another claim, **8:45**
- Terms, **8:53 to 8:62**
  - “about,” **8:53**
  - “approximately,” **8:54**
  - “comprising,” **8:55**
  - “contain,” **8:56**
  - “for,” **8:57**
  - functional claims, **8:58**
  - “obvious chemical equivalent,” **8:59**
  - pharmaceutical preparation, **8:60**
  - relative terms, **8:62**
  - “treatment,” **8:61**
- Types of claims, **8:48 to 8:52**
  - “Jepson” claims, **8:51**
  - “Markush” claims, **8:52**
  - product by process claims, **8:49**
  - product claims, **8:48**
  - “Swiss Form” claims, **8:50**
- Written instruments, **8:3**
  - Interpretation Act, **8:3**

## **CORRECTION**

- Certificate of correction for clerical errors, **12:28 to 12:30**
- Correction by the court, **12:31**

## **DAMAGES**

- Generally, **14:17 to 14:45**
- Absence of licences, **14:27**
- Aggravated damages, **14:45**
- Alternatives, **14:43**
- Damages from use, **14:28**
- Effect of licences, **14:26**
- Loss due to price reduction, **14:37 to 14:39**
  - market disruption, **14:38**
  - post infringement losses, **14:39**
- Loss of profit, **14:29 to 14:36**
- Lost sales, **14:29 to 14:36**
- Measure of damages, **14:18**
- Mitigation, **14:42**
- Plaintiff's loss, **14:19**
- Profits of infringer, **14:19**
- Reasonable royalty, **14:41**
- Recovery of plaintiff's damages, **14:44**
- Sales patentee, **14:40**

## **DEDICATION TO THE PUBLIC**

- Generally, **12:40 to 12:42**
- Dedication, **12:40**
- Effect of dedication, **12:42**
- Reasons for dedication, **12:41**

## **DESCRIPTION OF INVENTION**

- Generally, **7:9 to 7:25**
- Clarity, **7:18**
  - ambiguity, **7:19**
  - definition of materials, **7:21**
  - errors and inaccuracies, **7:20**
  - proportions of ingredients, **7:22**
- Failure to meet disclosure requirements, **7:25**
- Good faith, **7:23**
- Misleading matter, **7:24**
- Nature of the invention, **7:10**
- Necessity for experiments, **7:16**
- Operation and use, **7:11**
- Reference to previous documents, **7:17**
- Standards for disclosure, **7:12 to 7:15**
  - contemplated by the inventor, **7:13**
  - general points, **7:12**

## **DISCLAIMER**

- Generally, **12:18 to 12:27**
- British authorities, **12:23**
- Effect, **12:27**
- Extent, **12:24**
- Form, **12:26**
- Function, **12:25**
- History
  - Canada, **12:20**
  - U.K., **12:18**
  - U.S., **12:19**
- Statutory provisions for disclaimer, **12:21**
- United States authorities, **12:22**

## **DISCLOSURE**

- Generally, **5:1 et seq.**
- Applicant, **5:50**
- Filing date, **5:49 to 5:52**
- General considerations, **5:15**
- Infringe, **5:17**
- Patent or publication, disclosure by, **5:32 to 5:48**
  - claimed subject matter, **5:43**
  - construction, **5:36**
  - directions, **5:43**
  - drawing, **5:37**

**DISCLOSURE—Cont'd**

- Patent or publication, disclosure by, **5:32 to 5:48**—Cont'd
  - enabling disclosure, **5:44**
  - evidence of obviousness, **5:48**
  - exact prior description, **5:42**
  - experiments, **5:41**
  - language, **5:35**
  - no mosaic of documents, **5:34**
  - oral disclosure, **5:38**
  - paper anticipation, **5:47**
  - photograph, **5:37**
  - prior description, **5:32**
  - public accessibility, **5:33**
  - same invention, **5:39**
  - similarity of language, **5:45**
  - sufficiency of description, **5:40**
  - use unnecessary, **5:46**
- Person skilled in the art, **5:18**
- Public, **5:12 to 5:14**
  - art cited in the patent, **5:13**
  - available to the public, **5:12**
  - enabling disclosure, **5:14**
- Public use or sale, **5:22 to 5:31**
  - accidental use, **5:31**
  - analogous use, **5:25**
  - enabling disclosure, **5:26**
  - experimental use, **5:29**
  - impractical device, **5:27**
  - inoperable device, **5:27**
  - method or result, **5:30**
  - same invention, **5:24**
  - secret use, **5:28**
- Same invention, **5:16**
- Without experimentation, **5:19**
- Without invention, **5:20**

**DOUBLE PATENTING**

- Generally, **11:13 to 11:18**

**EXAMINATION**

- Generally, **9:57 to 9:60**
- Accelerated examination, **9:58**
- Prosecution of application, **9:59**
- Request for examination, **9:57**
- Timely response in good faith, **9:60**

**EXPERT EVIDENCE**

- Expert evidence as to the prior art, **4:32**
- Expert evidence as to the qualities and capabilities of the person skilled in the art, **4:35**

**EXPERT EVIDENCE—Cont'd**

- Expert evidence to assist construction of the patent, **8:2, 8:16, 8:26**
- Proof of infringement, **13:14**

**FILING APPLICATIONS, OLD ACT**

- Generally, **9:93**
- Benefit, **9:94**
- Conflicting applications, **9:104 to 9:106**
  - conflict exists, **9:104**
  - federal court, **9:106**
  - patent office, **9:105**
- Convention priority, **9:94**
- Earliest corresponding foreign application, **9:94**
- Examination, **9:102**
- Foreign application, **9:94**
- No new matter, **9:103**
- Priority date, **9:94**
  - significance of, **9:94**
- Public inspection, not open to, **9:95 to 9:100**
- Same invention, **9:94**
- Substances intended for food, **9:101**
- Supplementary disclosure, **9:103**

**INFRINGEMENT**

- Generally, **13:1 et seq.**
- Assignee, **13:69**
- Burden of proof, **13:8**
- Canada, must occur in, **13:47**
- Cause of action, **13:72**
- Constructing, **13:38 to 13:46**
- Construction of patent, **13:10**
- Construed infringement, **13:11 to 13:16**
  - approach, **13:11**
  - combinations, **13:13**
  - common law, **13:16**
  - intention, **13:12**
  - new product, **13:15**
  - presumption, **13:15**
  - proof of infringement, **13:14**
- Crown right to use, **13:66**
- Exclusive right of patentee, **13:6 to 13:8**
- Expiry, effect of, **13:35**
- “Gillette defence,” **13:17**
- Historical, **13:2, 13:3**
- Inducing infringement, **13:49**
  - affiliated companies, **13:52**
  - aiding and abetting, **13:54**
  - common design, **13:53**

## **INFRINGEMENT—Cont'd**

- Inducing infringement, **13:49**—Cont'd
  - good faith belief in invalidity, **13:49**
  - supplying product, **13:50**
  - vicarious liability, **13:55**
- Infringement by officers and directors, **13:56**
- Infringing Acts, **13:19**
- Liability for patent infringement, **13:67**
- Liability, partners, **13:55.50**
- Liability, partnerships, **13:55.50**
- Licensee, **13:70**
- Making, **13:38 to 13:46**
- Non-infringement defences, **13:57 to 13:65**
  - experimental and developmental, **13:57**
  - foreign vehicle entering Canada temporarily, **13:61**
  - laches and acquiescence, **13:63**
  - licence, **13:59**
  - limitation period, **13:62**
  - manufacture, **13:58**
  - patent misuse, **13:64**
  - use and sale, **13:60**
- Old Act patents, **13:4, 13:5**
- Patentee, **13:68**
- Patentee, persons claiming under, **13:71**
- Patent term, activity during, **13:20 to 13:37**
  - articles acquired prior to filing, **13:21 to 13:28**
  - correction, **13:32**
  - dedication, **13:34**
  - disclaimer, **13:31**
  - re-examination, **13:33**
  - reissue, **13:30**
- Purposive construction, **13:2**
- Selling, **13:38 to 13:46, 13:48**
- Statutory grant, **13:18**
- Three aspects of patent infringement, **13:7**
- U.K. law, **13:3**
- Using, **13:38 to 13:46, 13:48**

## **INTERNATIONAL PATENT PROTECTION**

- Generally, **10:1 et seq.**
- Canada-European Union, Comprehensive Economic and Trade Agreement (CETA), **10:20**
- North America Free Trade Agreement (NAFTA), **10:14**

## **INTERNATIONAL PATENT PROTECTION—Cont'd**

- Paris convention, **10:2**
- Patent Cooperation Treaty (PCT), **10:3**
  - amendment of the claims, **10:7**
  - examination, **10:9**
  - international application, **10:4**
  - international publication, **10:8**
  - international search, **10:5**
  - national phase entry, **10:12, 10:13**
  - right to practice, **10:10**
  - third party observations, **10:6**
  - time limits, **10:11**
- Patent Law Treaty (PLT), **10:18**
- Strasbourg Agreement, **10:19**
- Trade-Related aspects of Intellectual Property Rights (TRIPS), **10:15**
- TRIPS and patents, **10:16**
- TRIPS disputes, **10:17**

## **INVENTION**

- Generally, **2:1 et seq.**
- Accidental discovery, **2:8**
- Date of invention, **2:10**
- Definition in Patent Act, **2:3**
- Discovery, **2:7**
- Idea, **2:6**
- Inventive ingenuity, **2:4**
- Inventor: CITE2:11
  - historical background, **2:12**
  - Patent Act, **2:13**
- Making an invention, **2:9**
- Patent granted, **2:1**

## **JOINT INVENTORS AND APPLICATIONS**

- Generally, **9:12 to 9:21**
- Appeal from decision of commission, **9:18**
- Appeal under section 31, **9:18**
- Changing inventors named in patent, **9:21**
- Consequences of misnaming inventors, **9:20**
- Effect of refusal, **9:13**
- Joining persons, **9:15**
- Joint applicant had no part in invention, **9:14**
- Joint investors, ownership rights of, **9:19**
- Power of commissioner, **9:16, 9:17**



## INDEX

### **LICENSEE**

Right of action for patent infringement,  
**13:70**

### **MAINTENANCE FEES**

Generally, **9:29, 11:20**

### **NOVELTY**

Generally, **5:1 et seq.**

Anticipation of novelty, **5:2**

Common general knowledge, **5:11**

Consideration of novelty, **5:54 to 5:65**

chemical product, **5:56**

claims made by a particular process,  
**5:57**

combinations, **5:54**

confidential communications, **5:64**

enantiomers, **5:60**

new use, **5:58**

novelty in part, **5:62**

process, **5:55**

product for a new use, **5:59**

rediscovery, **5:63**

selection patents, **5:61**

Co-pending patent applications, section

28.2(1)(c),(d), **5:53**

Description in patent or publication, **5:75**

anticipation under sections 27(1)(b) and  
28(2), **5:77**

printed publication, **5:76**

Development of requirements, **5:3, 5:4**

Canadian laws, **5:4**

U.K. laws, **5:3**

Disclosure

anticipate, **5:17**

filing date, **5:49 to 5:52**

applicant, **5:50**

one year before filing date, **5:51**

general considerations, **5:15**

infringe, **5:17**

Enablement, **5:21**

Essential nature, **5:1**

Evidence of novelty, **5:66**

Lack of novelty, **5:2**

Novelty applications, **5:80**

Old Act, **5:67**

Patent or publication, **5:32 to 5:48**

claimed subject matter, **5:43**

construction, **5:36**

directions, **5:43**

drawing, **5:37**

### **NOVELTY—Cont'd**

Patent or publication, **5:32 to 5:48**

—Cont'd

enabling disclosure, **5:44**

evidence of obviousness, **5:48**

exact prior description, **5:42**

experiments, **5:41**

language, **5:35**

no mosaic of documents, **5:34**

oral disclosure, **5:38**

paper anticipation, **5:47**

person skilled in the art, **5:18**

photograph, **5:37**

prior description, **5:32**

public accessibility, **5:33**

same invention, **5:39**

similarity of language, **5:45**

sufficiency of description, **5:40**

use unnecessary, **5:46**

Person skilled in the art, **5:10**

Prior foreign grant, section 27(2), **5:79**

Prior to invention, knowledge or use, Old

Act, **5:68 to 5:74**

conflict, **5:73**

disclosure to public before filing date,  
**5:72**

invention date, **5:69**

section 61, **5:71**

section 61(3), **5:74**

Public, **5:12 to 5:14**

art cited in the patent, **5:13**

available to the public, **5:12**

enabling disclosure, **5:14**

Public use or sale, **5:22 to 5:31**

accidental use, **5:31**

analogous use, **5:25**

before filing date, **5:78**

enabling disclosure, **5:26**

experimental use, **5:29**

impractical device, **5:27**

inoperable device, **5:27**

method or result, **5:30**

same invention, **5:16, 5:24**

every essential element claimed,  
**5:24**

secret use, **5:28**

without experimentation, **5:19**

without invention, **5:20**

Relevant dates, **5:9**

Requirement of novelty, **5:1**

## **NOVELTY—Cont'd**

- Statutory requirements, current Act, **5:6**
- Subject matter defined by claim, **5:8**
- Test for anticipation, **5:5**
  - Beloit test, **5:5**

## **OBVIOUSNESS**

- Generally, **4:1 et seq.**
- Age of the prior art, **4:27**
- Anticipation, **4:2**
- Application of test for, **4:72 to 4:84**
- Cited art, **4:23**
- Claim, **4:39 to 4:45**
- Climate in the art, **4:63**
- Combination of factors, **4:69**
- Combinations, **4:72**
- Commercial success, **4:65**
- Common general knowledge in art, **4:37, 4:38**
  - relevance, **4:37**
- Composition, **4:82**
- Constructive date of invention, **4:14**
- Current Act
  - information disclosed, **4:18, 4:19**
- Date of invention, **4:12 to 4:14**
  - filing date, **4:14**
- Determination of, **4:46 to 4:56**
  - directly and without difficulty, **4:50**
  - relevant date, **4:54**
- Disclosure, **4:21**
- Effort required to achieve invention, **4:60**
- Expert evidence, prior art, **4:32**
- Factors for determining, **4:57 to 4:69**
  - activities of others, **4:66**
- File record, relevance of, **4:70**
- File wrapper, relevance of, **4:70**
- Hindsight, caution concerning, **4:55**
- Idea, **4:80**
- Industry praise, **4:67**
- Information outside the field, **4:26**
- Invention, **4:48**
  - inventive ingenuity, **4:48**
- Inventive concept, **4:39 to 4:44**
  - general principles, **4:42**
  - U.K. law, **4:40**
- Issues to consider, **4:21 to 4:31**
- Locating art, **4:30**
- Manner of making the invention, **4:59**
- Material, **4:81**
- Mechanical skill, **4:53**

## **OBVIOUSNESS—Cont'd**

- Meritorious awards, **4:67**
- Motive to find the solution, **4:58**
- New use for old product or process, **4:77**
- Non-obviousness requirement, **4:3 to 4:6**
  - Canadian law, **4:6**
  - U.K. law, **4:4**
  - U.S. law, **4:5**
- Omission, **4:80**
- Overview, **4:1**
- Patent Act, section 28.3, **4:9**
- Patents, **4:68**
- Post-art, **4:25**
- Prior art
  - expert evidence as to, **4:32**
  - Old Act, **4:16**
  - Patent Act, **4:17 to 4:20**
- Priority date, **4:14**
- Product for a new use, **4:78**
- Proof of actual date of invention, **4:13**
- Proportions, **4:81**
- Prosecution of patent application, **4:24**
- Question of fact, **4:52**
- Recently disclosed technology, **4:75**
- Reception of invention, **4:66**
- Relevance of a diligent search, **4:29**
- Relevant art, **4:22**
- Relevant date for obviousness
  - Old Act, **4:12 to 4:14**
  - Patent Act section 28.3, **4:15**
- Selection, **4:79**
  - broad class, **4:73**
- Shape, **4:81**
- Simplicity, **4:61**
  - utility, **4:62**
- Size, **4:81**
- Skilled in the art, person, **4:33 to 4:36**
  - identify the person, **4:33**
  - notional person, **4:34**
  - qualities and capabilities, **4:35**
    - expert evidence as to, **4:36**
    - admissibility of expert evidence, **4:36**
  - other, **4:35**
- State of the art, **4:45**
- Statutory test for obviousness, **4:9, 4:10**
- Subject-matter defined by the claim, **4:11**
- Test for obviousness
  - Current Act, **4:9, 4:10**
  - Old Act, **4:7, 4:8**



## INDEX

### **OBVIOUSNESS—Cont'd**

Tests concerning prior art, **4:31**  
repetition, **4:31**

### **PATENT AGENT**

College of Patent and Trademark Agents,  
**16:1 et seq.**  
Patent Agents, **9:5**  
Appointment of Patent Agents, **9:23**  
Patent Agent Privilege, **9:8**  
Representation by a Patent Agent, **9:6**  
Retainer of a Patent Agent, **9:7**

### **PATENT GRANT AND VALIDITY OF PATENTS**

Generally, **11:1 et seq.**  
Conditions, **11:19**  
Double patenting, **11:13 to 11:18**  
Evidence, relevant, **11:9 to 11:12**  
commercial success, **11:12**  
proof of patents, **11:10**  
record file, **11:11**  
Grant, **11:1**  
Grant subject to adjudication, **11:4**  
Grounds of invalidity, **11:8**  
Invalid claims, **11:7**  
Maintenance fees, **11:20**  
Marking of patented articles, **11:21 to 11:24**  
benefit, **11:22**  
Canadian law, **11:21**  
false representations, **11:24**  
offences for false marking, **11:23**  
Nature of a challenge, **11:6**  
Nature of the grant, **11:2**  
Presumption of validity, **11:5**  
Prior grant, **11:13 to 11:18**  
Term of the grant, **11:3**

### **PATENTS**

Generally, **1:1 et seq.**  
Certificate of Supplementary Protection,  
**1:55**  
English law, **1:6 to 1:12**  
book of bounty, **1:9**  
British patents Acts, **1:12**  
law courts, **1:7**  
monopolies, **1:6**  
patents, **1:6**  
Governed, **1:5**  
Jurisdiction, limited by, **1:4**  
Monopoly, patent, **1:3**

### **PATENTS—Cont'd**

Obtaining by application, **1:4**  
Patent Act, **1:5, 1:13 to 1:28**  
history, **1:29 to 1:53**  
since 1989, **1:29 to 1:42**  
transition provisions, **1:43 to 1:53**  
which Patent Act applies, **1:43 to 1:53**  
Patented Medicines (Notice of Compliance) Regulations, **1:56**  
Patented Medicines Process Review  
Board, **1:57**  
Patented Medicines Regulation, **1:55**  
Patent Rules, **1:54**  
Purpose, **1:2**  
Statute of Monopolies, **1:58**

### **PERSON SKILLED IN THE ART**

Construction of a patent  
consideration of the understanding of a  
person skilled in the art, **8:1, 8:2,**  
**8:13 to 8:18**  
appropriate approach, **8:16**  
meaning of technical terms, **8:26**  
purposive construction, **8:24**  
purposive construction, essential and  
non-essential elements, **8:31 to 8:35, 13:10**

Double patenting, **11:14**

Novelty

construction of a written description,  
**5:34**  
disclosure as understood by a person  
skilled in the art, **5:18**  
enablement, **5:21, 5:44**  
interpretation of a photograph or drawing,  
**5:37**

Obvious to a person skilled in the art  
disclosure as understood by a person  
skilled in the art, **4:21**  
information outside the field of the  
person skilled in the art, **4:26**  
test for obviousness, Current Act, **4:9,**  
**4:10**

test for obviousness, Old Act, **4:7, 4:8**

The person skilled in the art

a notional person, **4:34**  
expert evidence as to the qualities and  
capabilities of the person skilled in  
the art, **4:35**  
qualities and capabilities of the person  
skilled in the art, **4:35**

## **PERSON SKILLED IN THE ART**

### **—Cont'd**

The specification, **7:1 et seq.**  
 patent specification addressed to  
 persons skilled in the art, **7:5, 7:6,**  
**7:9, 7:11 to 7:16, 7:18, 7:37, 7:39**  
**to 7:44**

### **Utility**

construction of a promise of utility,  
**6:10**  
 sound prediction of utility, **6:15**  
 utility as specified when put into  
 practice by a competent person,  
**6:9**

## **PRIVILEGE**

Patent Agent Privilege, **9:8**  
 Privilege in Dealing with College of  
 Patent Agents and Trademark  
 Agents, **16:51**  
 Privilege in Threats Action, **15:32**

## **RE-EXAMINATION**

Generally, **12:32 to 12:39**  
 Advantages, **12:39**  
 Disadvantages, **12:39**  
 Question of patentability, **12:35**  
 Re-examination proceeding, **12:36**  
 Request, **12:33**

## **REISSUE**

Generally, **12:1 to 12:17**  
 Accident, **12:11**  
 Application for reissue, **12:14**  
 Deemed, **12:7**  
 Defective, **12:8**  
 Effect of reissue, **12:15**  
 Error, **12:10**  
 History  
     Canada, **12:3**  
     U.K., **12:1**  
     U.S., **12:2**  
 Inadvertence, **12:11**  
 Inoperative, **12:8**  
 Invalid patent, **12:9**  
 Jurisdiction of commission, **12:6**  
 Litigation involving reissued patent  
     infringement of reissued patent, **12:16**  
     validity of reissue, **12:17**  
 Mistake, **12:11**  
 No new matter, **12:13**  
 Purpose and nature, **12:5**

## **REISSUE—Cont'd**

Same invention, **12:12**  
 Statutory provisions, **12:4**  
 Valid patent, **12:9**

## **REMEDIES**

Generally, **14:1 et seq.**  
 Account of profits, **14:47 to 14:59**  
     apportionment, **14:56**  
     condonation, **14:59**  
     expenses, **14:55**  
     indirect profits, **14:57**  
     interest, **14:58**  
     measure of profits, **14:49**  
         differential cost approach, **14:51**  
         differential profits approach, **14:52**  
         full cost approach, **14:50**  
     multiple plaintiffs, **14:48**  
     proof of the expenses, **14:54**  
 Appeals, **14:75**  
 Claims of particular parties, **14:7 to 14:9**  
     licensee, **14:8**  
     parent for, **14:9**  
     patentee, **14:7**  
 Compensation for damages, **14:46**  
 Compensatory remedies, **14:3**  
 Costs, **14:6**  
 Currency conversion, **14:64**  
 Damages, **14:17 to 14:45**  
     absence of licences, **14:27**  
     alternatives, **14:43**  
     damages from use, **14:28**  
     effect of licences, **14:26**  
     infringer's profits, **14:19**  
     loss due to price reduction, **14:37 to**  
         **14:39**  
         market disruption, **14:38**  
         post infringement losses, **14:39**  
     loss of profit, **14:29 to 14:36**  
     lost sales, **14:29 to 14:36**  
     measure of damages, **14:18**  
     mitigation, **14:42**  
     plaintiff's loss, **14:19**  
     reasonable royalty, **14:41**  
     recovery of plaintiff's damages, **14:44**  
     relevance of a non-infringing alterna-  
         tive, **14:20 to 14:25**  
     lost profits on lost sales, **14:21**  
         Apotex v. Merck, **14:23**

**REMEDIES—Cont'd**

- Damages, **14:17 to 14:45**—Cont'd
  - relevance of a non-infringing alternative, **14:20 to 14:25**—Cont'd
  - lost profits on lost sales, **14:21**—Cont'd
  - pre-2015 Canadian jurisprudence, **14:22**
  - reasonable royalty, **14:25**
  - sale of non-infringing alternative, **14:24**
  - sales patentee, **14:40**
- Declaration, **14:4, 14:68**
- Destruction on oath, **14:67**
- Effect of income tax, **14:65**
- Election of Damages or Account of Profits, **14:10 to 14:16**
  - choosing the remedy, **14:15**
  - damages and account of profits compared, **14:11**
  - causation, **14:12**
  - damages, **14:13**
  - discretion of court, **14:14**
- Exemplary damages, **14:60**
- Injunction, **14:66**
- Interest, **14:61**
  - post-judgment interest, **14:63**
  - prejudgment interest, **14:62**
  - preventive remedies, **14:2**
- Procedural considerations, **14:69 to 14:75**
  - asserting a claim as to other types of alleged infringement, **14:72**
  - compensation phase, **14:71**
  - effect of judgment in a subsequent case revoking the patent, **14:73**
  - liability judgment, **14:70**
- Punitive damages, **14:60**
- Punitive remedies, **14:5**

**SPECIFICATION**

- Generally, **7:1 et seq.**
- Claims, **7:36 to 7:44**
  - broader than the invention, **7:40**
  - general principle, **7:39**
  - clarity of language, **7:37**
  - definition of the ambit of the monopoly, **7:38**
  - nature and function of the claims, **7:36**
- Common general knowledge in the art, **7:6**

**SPECIFICATION—Cont'd**

- Construction of, see SPECIFICATION, CONSTRUCTION OF
- Description of invention, **7:9 to 7:25**
  - clarity, **7:18**
  - ambiguity, **7:19**
  - definition of materials, **7:21**
  - errors and inaccuracies, **7:20**
  - proportions of ingredients, **7:22**
  - failure to meet disclosure requirements, **7:25**
  - good faith, **7:23**
  - misleading matter, **7:24**
  - nature of the invention, **7:10**
  - necessity for experiments, **7:16**
  - operation and use, **7:11**
  - reference to previous documents, **7:17**
    - disclosure, **7:11**
  - standards for disclosure, **7:12 to 7:15**
    - contemplated by the inventor, **7:13**
    - general points, **7:12**
- Description requirements in specific situations, **7:26 to 7:34**
  - biological material, **7:32**
  - description of known matter, **7:26**
  - distinction between old and new matter, **7:33**
  - matter necessarily implied, **7:27**
  - principle, **7:34**
  - selection patents, **7:31**
  - size or shape, **7:28**
  - sound prediction of utility, **7:30**
  - utility, **7:29**
- Drawings, **7:35**
- Historical, **7:2, 7:3**
  - development in the U.K., **7:2**
  - evolution of Canadian laws, **7:3**
- Person skilled in the art, **7:5**
- Relevant date, **7:7**
- Statutory provisions, **7:4**

**SPECIFICATION, CONSTRUCTION OF**

- Generally, **8:38 to 8:47**
- Alternatives, **8:41**
- Dependence claims, **8:43, 8:44**
  - antecedent claims, **8:43**
  - element, included or additional, **8:44**
- Inventions, single or multiple, **8:40**
- New result or method, **8:39**
- New technology, **8:47**

## **SPECIFICATION, CONSTRUCTION OF—Cont'd**

Numerical limitations, **8:46**  
 Promise of patent — old law, **8:38**  
 Reference numbers, **8:42**  
 Reference to another claim, **8:45**

## **SUBJECT-MATTER OF PATENTS**

Generally, **3:1 et seq.**  
 Biotechnology, **3:40 to 3:45**  
     animals, **3:44**  
     higher life forms, **3:42**  
         biochemical inventions, **3:40**  
         biological inventions, **3:40**  
     lower life forms, **3:41**  
     plants, **3:45**  
 Business methods, **3:48**  
 Business plans, **3:48**  
 Business systems, **3:48**  
 Combinations, **3:17 to 3:22**  
     aggregation, **3:19**  
     arrangement of parts, **3:22**  
     common result essential, **3:18**  
     novelty of elements, **3:20**  
     omission and addition, **3:21**  
 Computer programs, **3:46**  
 Copyright, **3:53**  
 Data processing systems, **3:46**  
 Definitions, **3:9 to 3:14**  
     art, **3:10**  
     composition of matter, **3:14**  
     machine, **3:12**  
     manufacture, **3:13**  
     process, **3:11**  
 Development of requirements, **3:5 to 3:8**  
     Canadian requirements, **3:8**  
     U.K. requirements, **3:6**  
     U.S. requirements, **3:7**  
 Improvements, **3:50**  
 Industrial designs, **3:52**  
 Integrated circuit topographies, **3:54**  
 Inventions  
     dangerous, **3:57**  
     ethically questionable, **3:57**  
     immoral objects, **3:57**  
 Mathematical formulas, other, **3:47**  
 Patentability of claimed subject-matter, **3:4**  
 Patentable subject-matter, **3:2**

## **SUBJECT-MATTER OF PATENTS —Cont'd**

Principles and theorems, **3:15, 3:16**  
     knowledge of scientific principle, **3:16**  
     patentability, **3:15**  
 Process, **3:23 to 3:35**  
     addition, **3:25**  
     analogous purposes, **3:27**  
     biological, **3:28**  
     chemical, **3:28**  
     general statement, **3:23**  
     medical treatment of animals, **3:33**  
     mental steps, **3:29**  
     methods of medical treatment, **3:31**  
     methods of surgical treatment, **3:31**  
     new result, **3:24**  
     non-medical treatment, **3:32**  
     old result, **3:24**  
     omission, **3:25**  
     professional skills, **3:30**  
     variation, **3:25**  
 Products and substances, **3:36 to 3:39**  
     food, **3:38**  
     medicine, **3:38**  
     non-obviousness, **3:37**  
     novelty, **3:37**  
     signals, **3:39**  
     utility, **3:37**  
 Selection, **3:49**  
 Statutory provisions, **3:3**  
 Trade-marks, **3:55**  
 Unpatentable matter, **3:51**

## **THREATS OF PATENT INFRINGEMENT**

Actions for Threats of Patent Infringement, **15:1 et seq.**  
     Civil Code of Quebec, **15:15**  
     Common Law Action for Trade Libel or Injurious Falsehood, **15:9 to 15:14**  
     Competition Act, ss. 52 and 36, **15:31**  
     Consumer Protection Legislation, **15:32**  
     Patent Act, ss. 76.2 and 76.3, **15:33**  
     Trademarks Act, s. 7(a), **15:16 to 15:30**

## **TRADEMARK AGENT**

College of Patent Agents and Trademark Agents, **16:1 et seq.**

## INDEX

### UTILITY

- Generally, **6:1 et seq.**
- As described and claimed, **6:3**
  - inutility, **6:3**
- Assessed at filing date, **6:4**
- As specified, **6:9**
- Claim inutility, **6:16**
  - broad class, **6:18**
  - not useful products or processes, **6:17**
  - omits an essential element, **6:19**
- Dangerous result or disadvantages, **6:7**
- Evidence as to utility, **6:22 to 6:24**
  - commercial success, **6:24**
  - infringement, **6:23**
- Filing date, **6:13**
  - demonstrated utility, **6:14**

### UTILITY—Cont'd

- Filing date, **6:13**—Cont'd
  - sound prediction of utility, **6:15**
- Historical, **6:2**
- Immoral objects, **6:8**
- Improvement patents, **6:20**
  - invalidity, **6:13**
- In part, **6:12**
- Promised results, **6:10**
- Quantum, **6:6**
- Selection patents, **6:21**
- Statements of advantages, **6:11**

### VALIDITY OF PATENTS

- See PATENT GRANT AND VALIDITY  
OF PATENTS