

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 directors and by officers and other employees, **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**
- World Intellectual Property Organization (WIPO) Treaty, **10:21**

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