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### **FOX ON THE CANADIAN LAW OF PATENTS, FIFTH EDITION**

**Donald H. MacOdrum**  
**Release No. 2, April 2024**

**Fox on the Canadian Law of Patents, Fifth Edition** is the pre-eminent text for patent lawyers and agents in Canada. The fourth edition was repeatedly cited by courts including the Supreme Court of Canada. However, since its publication in 1969, there have been significant changes in Canadian patent law, including major statutory revisions in 1989 and 1996. The new edition brings the statement of the law up to date while retaining the jurisprudence as compiled by Dr. Fox to the extent that it remains relevant. Topics covered in this edition include: Invention, Subject Matter of Patents, Obviousness, Novelty, Utility, Application for a Patent, International Patent Protection, Dedication and Re-Examination, and Infringement and Remedies for Infringement.

This release features updates and additions to the commentary and case law in Chapters 1 (Introduction), 2 (Invention), 3 (Patentable Subject Matter), 4 (Obviousness), 5 (Novelty), 6 (Utility), 7 (The Specification), 8 (Construction of a Patent), 9 (Application for a Patent), 11 (Patent Grant and Validity), 13 (Infringement) and 15 (Actions for Threats of Patent Infringement).

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## Highlights

### *Invention*

The UK Supreme Court in, *Thaler v. Comptroller-General*, [2023] UKSC 49, affirmed that an inventor must be a natural person and hence a machine (artificial intelligence) could not be an inventor.

### *Patentable Subject Matter*

Issues as to whether claims relating to dosages of a pharmaceutical were an unpatentable method of medical treatment were considered by the Federal Court in *AbbVie v. JAMP*, 2023 FC 1520. The patentability of computer-implemented inventions was considered by the Patent Appeal Board and the Commissioner in *Landmark Graphics' Application*, 2023 CACP 25 and by the Australian Federal Court in *UbiPark v. TMA Capital*, [2023] FCA 885. Also, in relation to the patentability of computer-implemented inventions, a discussion has been included of the UK law, including reference to the English High Court decision in *Emotional Perception v. Comptroller-General*, [2023] EWHC 2948.

### *Obviousness*

Issues as to obviousness were considered by the Federal Court in *AbbVie v. JAMP*, 2023 FC 1520, *Steelhead v. ARC*, 2023 FC 1684, *Allergan v. Juno*, 2023 FC 1686, by the Federal Court of Appeal in *dTechs v. B.C. Hydro*, 2023 FCA 115, and by the UK Patents Court in *Abbott v. Dexcom*, [2024] EWHC 36 (Pat), *Safestand v. Weston*, [2023] EWHC 3250 (Pat).

### *Novelty*

Anticipation issues were addressed by the Federal Court in *AbbVie v. JAMP* 2023 FC 1520, *Steelhead v. ARC*, 2023 FC 1684, by the Federal Court of Appeal in *Eli Lilly v. Apotex*, 2023 FCA 125, by the UK Patents Court in *Abbott v. Dexcom*, [2024] EWHC 36 (Pat) and by the Australian Federal Court in *Hanwha Solutions v. REC Solar*, [2023] FCA 1017.

### *Utility*

Utility issues were by the Patent Appeal Board and the Commissioner in *Astellas Institute's Application*, 2023 CACP 26.

### *The Specification*

Issues as to the specification were considered by the Federal Court in *Allergan v. Juno*, 2023 FC 1686, by the Federal Court of Appeal in *Greenblue v. Deeproot*, 2024 FCA 19, and by the U.S. Court of Appeals, Federal Circuit in *Baxalta v. Genentech*, 81 F. 4th 1362 (2023) and by the U.S. Supreme Court in *Amgen v. Sanofi*, 598 U.S. 594 (2023).

### *Construction of A Patent*

Issues as to construction of a patent were considered by the Federal Court in *AbbVie v. JAMP*, 2023 FC 1520, *Steelhead v. ARC*, 2023 FC 1684, by the Federal Court of Appeal in *dTechs v. B.C. Hydro*, 2023 FCA 115, by the UK Patents Court in *Abbott v. Dexcom*, [2024] EWHC 36 (Pat), *Safestand v. Weston*, [2023] EWHC 3250 (Pat).

### *Application for a Patent*

Issues relating to patent applications were considered by the Patent Appeal Board and the Commissioner in *Ackley Machine's Application*, 2023 CACP 3, *Uniquire IP's Application*, 2023 CACP 24, and by the Federal Court in *AbbVie v. JAMP*, 2023 FC 1520.

### *Validity*

Other validity issues were considered by the Federal Court in *ProSlide Technology v. Whitewater West Industries*, 2023 FC 1591. Double patenting was considered by the Patent Appeal Board and the Commissioner in *Uniquire IP's Application*, 2023 CACP 24, and by the Federal Court in *AbbVie v. JAMP*, 2023 FC 1520, *NCS Multistage v. Kobold*, 2023 FC 1486.

### *Infringement*

Infringement issues including inducing infringement were addressed by the Federal Court in *NCS Multistage v. Kobold*, 2023 FC 1486, *Steelhead v. ARC*, 2023 FC 1684 and by the Federal Court of Appeal in *Greenblue v. Deeproot*, 2023 FCA 184, *Apotex v. Janssen*, 2024 FCA 9, *Pharmascience v. Janssen*, 2024 FCA 10.

### *Threats of Patent Infringement*

Issues as to threats of patent infringement were considered by the B.C. Supreme Court in *Keezio Group v. The Shrunk's Family Toy Company*, 2024 BCSC 64 (a trademark and copyright case).

## **ProView Developments**

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