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ANNOTATED PATENT ACT

Bruce Stratton

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This publication examines the provisions of Canada's *Patent Act* to explain the history, purpose and importance of each provision within the broader scheme of the legislation as a whole. Each section of the Act is examined and the following information included: the current section is reproduced in full; related sections and related rules are gathered for ease of reference, a legislative history of the provision is discussed as it relates to the development of the law of patents as a whole, and upon the specific issues dealt with by the provision, and commentary upon the section (and its subsections) is provided in terms of the purpose and function of the section within the context of the act as a whole, specific issues in respect of both the obtaining and enforcement of patent rights, and relevant, specific facts of case law are summarized.

Current to 2023–5. This release features updates to Appendix A. Patent Act, Appendix IF. Issues in Focus, and Appendix WP. Words and Phrases Judicially Considered.

Highlights

- **Appendix IF. Issues In Focus—Identifying Inventorship In Patent Law And The Rights Of Joint Inventors And Joint Owners—**
The research into this issue has been updated to August 1, 2023. Under section 53(1) of the *Patent Act*, failure to name co-inventors may amount

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to a misrepresentation, rendering the patent invalid, if the omission to name the inventor was “wilfully made for the purpose of misleading”. Finally, establishing inventorship is important for the purposes of conducting due diligence. This memorandum outlines the limited guidance given regarding inventorship under the *Patent Act*, as well as how the Act deals with disputes between joint inventors. It further discusses how the Courts have determined inventorship, and the rights and responsibilities that arise from co-inventorship and co-ownership.

- **Appendix IF. Issues In Focus—Correcting A Clerical Error In An Issued Patent**—The research into this issue has been updated to August 1, 2023. Rules 107-109 of the *Patent Rules* are remedial provisions that authorize the Commissioner of Patents to correct clerical errors in any instrument of record in the Patent Office. Correction in this manner is differentiated from correction by way of re-issuance of the patent, in that the former is available as a remedy at any time during the life of the patent while the latter is only available for a period of 12 months from the date that the patent was originally issued. The decision of the Commissioner is subject to judicial review, and the Federal Court may set aside the decision and remit the matter back to the Patent Office.
- **Appendix WP. Words and Phrases Judicially Considered—Non-Infringing Option**—“A “non-infringing option” is any product that helps courts isolate the profits causally attributable to the invention from the profits which arose at the same time the infringing product was used or sold, but which are not causally attributable to the invention...it can be understood that a non-infringing option is any product that helps courts isolate the profits causally attributable to the invention from the profits which arose at the same time the infringing product was used or sold, but which are not causally attributable to the invention. ...In sum, a non-infringing option is any product that helps courts isolate the profits causally attributable to the invention from the profits which arose at the same time the infringing product was used or sold, but which are not causally attributable to the invention. A non-infringing option is not, as [the infringing party] and my colleague contend, an infringer’s “most profitable” alternative sales product that it “would have” and “could have” sold had it not infringed.” (*Nova Chemicals Corp. v. Dow Chemical Co.*, 2022 CarswellNat 4832 (S.C.C.)).
- **Appendix WP. Words And Phrases—Springboard Profits**—Springboard profits are profits that arise post-patent-expiry but that are causally attributable to infringement of the invention during the period of patent protection ... Springboard profits are an extension of the fundamental principle that, in calculating an accounting of profits, the infringer must disgorge all profits causally attributable to infringement of the invention. It is irrelevant when the profits arise, provided they are causally connected to infringement. (*Nova Chemicals Corp. v. Dow Chemical Co.*, 2022 CarswellNat 4832 (S.C.C.)).

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