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<p style="text-align: center;">FOX ON THE CANADIAN LAW OF PATENTS, FIFTH EDITION Donald H. MacOdrum Release No. 5, September 2022</p>
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Publisher's Special Release Note 2021

The pages in this work were reissued in December 2021 and updated to reflect that date in the release line. Please note that we did not review the content on every page of this work in the December 2021 release. We will continue to review and update the content according to the work's publication schedule. This will ensure that subscribers are reading commentary that incorporates developments in the law as soon as possible after they have happened or as the author deems them significant.

Changes to chapter and heading numbering may have occurred. Please refer to the Correlation Table in the front matter if you wish to confirm references.

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, Nov-

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elty, 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 7 (The Specification), 8 (Construction of a Patent), 9 (Application for a Patent), 10 (International Patent Protection), 11 (Grant and Validity of Patents), 13 (Infringement), 14 (Remedies) and 15 (Actions for Threats of Patent Infringement), 16 (College of Patent Agents and Trademark Agents).

Legislation Highlights

Patent Rules

The *Patent Rules* were amended June 2, 2022. The rules as to sequence listings came into force on July 1, 2022. All other provisions will come into force on October 3, 2022. These amendments are incorporated in Chapter 9.

In addition to the changes relating to the form of sequence listings required by amendments to the Patent Cooperation Treaty (PCT), fees will now be required for “excess claims” over 20 claims and for specifications exceeding specified page limits and for continued prosecution of an application after a certain stage. A new procedure of conditional allowance has also been introduced.

The amendments to the *Patent Rules* also related to national entry in Canada of a PCT application, referred to in Chapter 10, and correction of errors by the Commissioner, referred to in Chapter 12.

College of Patent Agents and Trademark Agents Act

The *College of Patent Agents and Trademark Agents Act* (“*College Act*”) was amended by the *Budget Implementation Act, 2022*, which was given royal assent on June 23, 2022. These amendments are incorporated in Chapter 16.

The summary of the act states that it amends the *College Act* to, among other things: (a) ensure that the College has sufficient independence and flexibility to exercise its corporate functions; (b) provide statutory immunity to certain persons involved in the regulatory activities of the College; and (c) grant powers to the Registrar and Investigations Committee that will allow for improved efficiency in the complaints and discipline process.

Case Law Highlights

The Specification

Issues as to the specification were considered by the Federal Court in *Merck Sharp & Dohme v. Pharmascience*, 2022 FC 417 (F.C.) and *Angelcare Canada v. Munchkin*, 2022 FC 507 and by the English Patents Court in *Sandoz v. Bristol-Myers Squibb*, [2022] EWHC 822 (Pat).

Construction of A Patent

Issues as to construction of a patent were considered by the Federal Court in *Angelcare Canada v. Munchkin*, 2022 FC 507 and by the English Patents Court in *Optis Cellular Technology v. Apple Retail UK*, [2022] EWHC 561 (Pat) and *Saint-Gobain v. 3M Innovative Properties*, [2022] EWHC 1018 (Pat).

Application for a Patent

As referred to above, amendments to the Patent Rules have been incorporated in Chapter 9.

Issues as to amendments of patent applications were considered by the Federal Court in *Rovi Guides v. BCE*, 2022 FC 979. Issues as to whether a claim set contains claims for separate inventions were considered by the Patent Appeal Board and the Commissioner of Patents in *Ipsen Pharma S.A.S.'s Patent Application*, 2022 CACP 10, C.D. 1617.

As discussed in § 9:78, the section relating to patents of the Canadian Intellectual Property Office (“CIPO”) has a subsection providing a list of determinations relating to due care.

Grant and Validity of Patents

Issues as to double patenting were considered by the Federal Court in *Angelcare Canada v. Munchkin*, 2022 FC 507.

Correction

A section has been added to Chapter 12 relating to the jurisdiction of provincial courts and other forums to determine issues as to ownership of patents.

Infringement

Issues as to infringement were considered by the Federal Court in *Allergan v. Apotex*, 2022 FC 260, *Biofert Manufacturing v. Agrisol Manufacturing*, 2020 FC 379 (F.C.) (copyright and trademark case), *Angelcare Canada v. Munchkin*, 2022 FC 507 and *Rovi Guides v. BCE*, 2022 FC 979, and by the Federal Court of Appeal in *Pharmascience v. Teva Canada Innovation*, 2022 FCA 2, *Swist. v. MEG Energy*, 2022 FCA 118. Issues addressed included inducing infringement and common design.

A section has been added to Chapter 13 relating to appeal of infringement issues.

Remedies

Issues as to remedies were considered by the Federal Court in *Deeproot Green Infrastructure v. Greenblue Urban*, 2022 FC 709 and *Rovi Guides v. BCE*, 2022 FC 979. *Farmobile v. Farmer's Edge*, 2022 FC 22, which addressed the grant of an injunction was affirmed 2022 FCA 116, but that point was not in issue on appeal.

Threats of Patent Infringement

Issues as to threats were considered by the Federal Court in *Milano Pizza v. 6034799 Canada*, 2022 FC 425 (trademark case).

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