Index

ABANDONMENT (OF APPLICATION)

Generally, § 21:1, § 21:2 Of PCT application, § 5:5, § 21:2 Patent not invalid, § 21:3

ABSTRACT

Not part of the specification, § 12:102 Required to be published in English and French, § 15:8

ABSTRACT THEOREM NOT PATENTABLE Generally, § 12:120

ABUSE OF PATENT RIGHTS Generally, § 20:14 to § 20:26 As defence to infringement action, § 19:32 Repealed provision re, § 26:44

ACCOUNTING OF PROFITS

See Action for infringement

ACTION FOR INFRINGEMENT Generally, § 19:1 to § 19:27 Accounting of profits, § 19:29 Appeal, § 19:47, § 19:49, § 19:150 Assignment of patent as affecting, § 17:4, § 19:30, § 19:36 Burden of proof in, § 19:35 reverse burden, § 19:52, § 19:53 repealed provision re, § 26:38 Damages, § 19:43 reference into, post-trial, § 19:44 repealed provision re, § 26:37 Defences to generally, § 19:36 abuse of patent rights, § 19:36

ACTION FOR INFRINGEMENT -Cont'd Defences to—Cont'd accidental or innocent use. § 19:19 acquiescence and laches, § 19:36, § 19:153 Competition Act, breach of by plaintiff, § 1:8, § 19:36 experimental use, § 19:146 "Gillette defence," § 12:118, § 19:37 inequitable conduct by plaintiff, § 19:36 invalidity of patent as, § 19:36, § 19:157 licence, defendant's, § 19:36 limitation defence, § 19:51 prior acquisition of invention (prior user's right), § 19:148, § 19:149 repealed provision re, § 26:41 Estoppel, as to issue or cause of action, § 19:36 Evidence in, § 19:38 Exemptions from infringement, § 19:5 Injunction, § 19:46, § 19:150, § 19:151 interlocutory, § 19:152 Interest, award of, § 19:45 Interlocutory proceedings in, § 19:40 Judgment in, § 19:150 stay of execution of, § 19:47 summary judgment, § 19:39 Jurisdiction of courts, § 19:1, § 19:28 stay of duplicative proceedings, § 19:28

ACTION FOR INFRINGEMENT -Cont'd Limitation of, § 19:50, § 19:51 Lovastatin, § 19:138 Mootness, dismissal of action for, § 19:39 No action for infringement act committed after period or transfer, § 19:54 act committed during period. **§ 19:54** subsequent acquisition, § 19:54 Omeprazole, § 19:138 Order of court in, § 19:150 Parties to, § 19:30 defendant in, officer or director of corporation, § 19:31 defendants acting in concert, § 19:20, § 19:31 mise-en-cause, § 19:33 plaintiff in. § 19:30 assignment as affecting, § 17:4, § 19:35 licensee as, § 19:30 "persons claiming under the patentee," § 19:30 Presumption, product infringes process, § 19:52, § 19:53 Question of law, separate trial of issue. § 19:39 Quia timet action, threatened infringement, § 19:25, § 19:29 "Reasonable compensation" for pre-grant use of invention, § 19:48 Remedies generally, § 19:27, § 19:41, § 19:150 accounting of profits, § 19:44 damages, § 19:43 delivery up, § 19:46 injunction, § 19:46, § 19:150, § 19:151 interlocutory, § 19:152 stay of, § 19:47

ACTION FOR INFRINGEMENT -Cont'd Remedies-Cont'd interest, § 19:45 TRIPS, effect of on, § 19:42 Stay of execution, § 19:47 Third party rights, § 19:54 **ADVANTAGE (OF AN INVENTION**) Normally need not be claimed, § 12:115 Normally need not be disclosed in the specification, § 2:41, § 12:58 Selection patent for compound, need to be disclosed in. § 2:29 Undisclosed, as justifying insufficiency attack, § 12:88 Unexpected, may justify selection patent, § 2:25 AGENT See Patent agent AGGREGATIONS Generally, § 2:16 AMBIGUITY Generally, § 12:62, § 12:74, § 12:77, § 12:100 About, § 12:83 And insufficiency compared, § 12:74 Comprising, § 12:82 Contra proferentem, § 12:78 Multiple meanings not fatal, § 12:79 Obvious chemical equivalent, § 12:84 Obvious error not fatal, § 12:80 Substantially, § 12:85 AMENDMENT OF PATENT APPLICATION

Generally, § 14:7 New matter in, § 14:8 ANTICIPATION See also Novelty See also Overclaiming Generally, § 2:34, § 12:116, § 12:138, § 12:139, § 12:155, § 12:164 Generaly, § 12:132, § 12:138 Acts constituting, § 12:147 Analysis of requires two-step approach, § 12:155 Anticipation as clarified in Sanofi, § 12:155 enabling publication, § 12:155 further criteria and legal requirement, § 12:157 "necessarily result," § 12:155 overclaiming test, § 12:155 prior disclosure test, § 12:155 prior publication, § 12:155 trial and error, § 12:156 two-pronged approach to anticipation analysis, § 12:155 undue burden, § 12:157 Availability to public, § 12:137, § 12:154, § 12:158 inherency, § 12:160 recipe cases, § 12:159 Burden of proof, § 12:143 Claim date, § 12:154 Claims, tested relative to, § 12:134, § 12:154 Combination, of, § 12:147 Concept of, contrasted with novelty, § 12:136 Criteria for, § 12:155 Dichotomy of anticipation/ overclaiming, § 12:139 Difficult to make out, § 12:144 Enabling disclosure, § 12:138, § 12:139, § 12:149 to § 12:151, § 12:154, § 12:156 Evidence of, § 12:144 Experiments by inventor and others, § 12:161

ANTICIPATION—Cont'd First to file, § 12:154 First to invent, § 12:154 Foreign case law, resort to, § 12:167 General principles of, § 12:142 "Infringes if later, anticipates if earlier," § 12:137, § 12:158, § 12:160, § 12:164 Inherency of result in following known process, § 12:160 Introduction, § 12:137 Negating a finding that patented invention has been made available to the public, § 12:154 New use of old article, § 2:24, § 12:165 Obviousness, and, § 12:162 "Old Act" and "new Act" tests for, § 12:140, § 12:142, § 12:149, § 12:153 "Paper patents," § 12:145, § 12:160 Patent office, § 12:165 Prior disclosure Generally, § 12:132, § 12:141, § 12:147, § 12:154, § 12:159 person-skilled-in-the-art test, § 12:150, § 12:152, § 12:156 practice of must be normal, not contrived, § 12:151 "that gives me what I wish," § 12:151 Prior enabling public disclosure, § 12:138 Prior publication, § 12:150 evidence of date of, § 12:149, § 12:161 mosaic of documents not permitted, § 12:150, § 12:152 need not have been read by anyone, § 12:154 one disclosure may be enough, § 12:153 purposive construction applies to, § 12:148

ANTICIPATION—Cont'd Prior public use, § 12:138, § 12:151, § 12:161 by user unknowing that the invention is being used, § 12:138, § 12:157 experimental. § 12:161 Prior sale, § 12:161 Process-dependent product claims, of, § 12:165 Ouestion of fact or mixed question of law and fact, § 12:142 Reasonable man test, § 12:154 "Recipe" cases, § 12:159 "Reeves Brothers test," § 12:149 Repealed provisions re, § 26:12, § 26:16 § 26:42 Selection patent criteria, § 12:153 Selection patents, of, § 12:166 Swiss-style claims may avoid. § 12:154, § 12:160 Tests for, § 12:148

APPEAL

Commissioner, from, procedure, § 8:1 to § 8:3 Commissioner, from, refusal to grant patent, § 15:3 intervention in. § 8:3 standard of review of Commissioner's decision, § 1:7, § 8:3 Commissioner's decision or order in compulsory licence cases, from, § 9:5, § 20:26 Impeachment action, from trial judgment, § 20:11 Infringement action, from trial judgment, § 19:49 duty of appellate tribunal in reviewing trial decision and testimony in, § 19:49 order in, § 19:150 Standard of review in, s. 55.2 cases, § 1:7, § 19.90

APPLICANT, FOR PATENT Generally, § 2:3 Defined, § 2:1, § 2:2 Joint, § 12:370 Non-resident, § 12:369 **APPLICATION FOR PATENT** See Patent application ART Generally, § 2:12 ASSIGNMENT Of patent or application for patent, § 17:1, § 17:3, § 17:5 action for infringement as affecting, § 17:4 bona fide purchaser, § 17:4 priority of rights as between competing assignees, § 17:5, § 17:6 foreign patent rights, § 17:6 provincial law applicable to, § 17:2 Registration of, APPA § A:59, § 17:4 Repealed provisions re, § 26:36 Right to sue when patent assigned, § 17:4 Void against subsequent assignee unless registered, § 17:5 ASSISTANT COMMISSIONER OF PATENTS Generally, § 4:4 **ATOMIC ENERGY, INVENTIONS** RE

See Nuclear energy, patents relating to Generally, § 11:1

ATOMIC ENERGY CONTROL ACT (RENAMED NUCLEAR ENERGY ACT) Generally, § 26:9

BEST MODE

See Disclosure, § 12:56 to § 12:89

BIOTECHNOLOGICAL SUBJECT-MATTER

Generally, § 2:20 Adequate disclosure of, § 12:88, § 14:5, § 14:6 regulations re see Rules 103, 159 and 183 sequence listings see Rule 111 Deposit of biological material, § 14:5

BURDEN OF PROOF

Of infringement, § 19:35 of patent for process for making a new product, § 19:52, § 19:53 Of invalidity, § 15:7, § 15:9

BUSINESS METHODS, PATENTABILITY OF Generally, § 2:17

CAVEAT (REPEALED) Generally, § 26:46

CERTIFICATE OF CORRECTION OF CLERICAL ERROR

Generally, **§ 4:8** Standard of review of Commissioner's decision, **§ 1:7, § 4:9**

CERTIFIED COPY OF PATENT Generally, § 4:14

CHEMICAL AND PHARMACEUTICAL INVENTIONS, CLAIMS FOR Generally, § 12:116, § 12:117, § 26:26

CLAIM, CLAIMS

See also Specification Generally, § 12:90 to § 12:118 benevolent, § 12:98 comes first, § 12:92 CLAIM, CLAIMS—Cont'd Generally, § 12:90 to § 12:118 -Cont'd comparison with other claims, § 12:98 file histories permitted, uses of, § 12:109 construing claims, § 12:94 contra proferentem doctrine, § 12:97, § 12:99 dictionaries, use of, § 12:97 disclosure (description, specification) as aid to, § 12:105 duty of, in infringement action, § 19:2 equivalents doctrine of, see also Infringement of patent, Purposive construction. § 19:9 non-essential limitations, of, § 12:102 "reverse equivalence," § 19:15 essential to see where the shoe pinches, § 12:93 extrinsic evidence in aid of. § 12:107 fencing of invention, § 12:95 file history as aid to, § 12:107 foreign patent, comparison of claims with, § 12:109 Interpretation Act, applicability of, § 1:5, § 12:52 inventor's intention, evidence of inadmissible, § 12:48, § 12:102 "Markman hearing," § 12:39 meaning clear, if, § 12:105 prior art, relative to, § 12:38 purposive, § 12:102 essential elements, determining, § 12:102 variants, substitution of, § 12:102 re-examination proceedings, in, § 12:96

CLAIM, CLAIMS—Cont'd Generally, § 12:90 to § 12:118 -Cont'd rules of, § 12:90 Advantage, need to claim, § 12:113, § 12:115 Alternatives treated separately, § 12:112, § 12:119 multiply dependent claims, § 12:120 Ambiguity of, § 12:62, § 12:74, § 12:77, § 12:100 Apparatus, § 12:114 Breadth of, § 12:115, § 12:116 Chemical and pharmaceutical inventions, for, § 12:116, § 12:117, § 26:26 Composition of matter, § 2:13 Conjunctive and disjunctive limitations in, § 19:8 Context, as limiting, § 12:116 Date of see Claim date Dependent, meaning separate from but consistent with meaning of claim from which it depends, § 12:106 Desired result, not permitted to claim, § 12:116, § 12:164 Differentiation between claims, two claims must not mean the same thing, § 12:106 Disclosure, § 2:29, § 2:32, § 2:46 Disclosure, support by and conformity with, § 12:115 "fairly based," **§ 12:115** Distinguish old matter from new, need not. § 12:110 Environmental elements in. § 12:115 Errors of wording in, § 12:80 Essential element of determination of what is, § 12:102 need to include, § 2:36, § 12:115 substitutability of, § 12:102

CLAIM. CLAIMS—Cont'd Essential element of-Cont'd variants of, affecting the working of the invention, § 12:102 "Fairly based" on disclosure, § 12:115 File history, use of in construction of claims, § 12:108, § 12:109, § 15:6, § 15:9 Indefinite terms in, § 12:80 Invalidity of some, does not imply entire patent invalid, § 19:155 Jepson claims, § 12:110 Markush claims, § 2:41, § 12:112, § 12:119 Overclaiming see Overclaiming Person skilled in the art, § 12:37, § 12:40 Preamble of, in construing, § 12:101, § 12:110 Product claims, § 12:113 process-dependent, § 12:113, § 12:165 selection patent, in, § 12:113 Purpose of. § 12:29 Pyramid or hierarchical claims, § 12:116 Ranges of variables, for, § 12:80, § 12:81 Redundant, as basis for invalidity attack, § 12:106 Scope family of claims having varying, § 12:116 limitation of, by wording of description, § 12:104, § 12:116 Selection patent, in, § 12:113 Statutory basis for, § 12:1 Style of, § 12:98, § 12:110 Support for in disclosure (description), § 12:115 Swiss-style, § 12:111, § 12:165 Unusual meaning of word in, § 12:105

CLAIM, CLAIMS—Cont'd Utility of claimed subject-matter, § 12:81, § 12:112 Words in, § 12:52, § 12:81

CLAIM DATE

Generally, § 2:112 Anticipation tested relative to, § 12:132, § 12:133 Defined, § 12:45, § 12:129

CLERICAL ERRORS

Correction of, § 23:16 In claims, § 12:80 Standard of review of Commissioner's decision, § 1:7, § 4:9

COMBINATIONS

Generally, § 2:16

COMMERCIAL SUCCESS, OBVIOUSNESS AND Generally, § 12:221

COMMISSIONER OF PATENTS

Abuse of patent rights, jurisdiction over, § 20:14 Action against, for refusal of patent, § 15:4 Action against, re processing of patent application, § 8:3, § 15:2 Annual report of, § 11:6, § 11:7 Appeal from decision of, § 8:1, § 8:2, § 9:5, § 15:3 standard of review of Commissioner's decision, § 8:3 Appointment, powers and duties, § 4:2 Assistant Commissioner, § 4:4 Compensation for infringement, § 9:10 Compulsory licence, power to grant, § 20:16 appeal from decision or order, § 20:26 repealed provisions re, § 26:45 Costs, in court proceedings, § 11:5

COMMISSIONER OF PATENTS -Cont'd Defence contracts, setting patents use, § 9:2 Discretion permitted, § 15:2 Duties, remedy if failure to perform, § 4:3 Government use of patents, order for, § 9:1 Commissioner's exercise of jurisdiction appeal from, § 9:5 prerequisites for, § 9:3 Judicial review of decision of, § 15:6 Mandamus against, § 4:3 Public servants' defence-related inventions fixing compensation for, § 9:10 Refusal of patent application by, § 15:2, § 15:4 appeal from, § 15:3 Reports of, § 11:6, § 11:7 Seal of. § 6:1

COMMON GENERAL KNOWLEDGE Generally, § 12:44, § 12:188

COMPENSATION

Defence-related patents and inventions, § 9:10 Fixed by Commissioner see Commissioner of Patents Pre-grant use of patented invention, for, § 19:48

COMPETITION LAW, APPLICABILITY TO PATENTS-RELATED ACTS Generally, § 1:8

Competition Act excerpt relating to patents, § 1:8

COMPLETION OF PATENT APPLICATION Generally, APP B § B:28

COMPOSITION OF MATTER Generally, § 2:13 Claims to, coexisting with compound claims, § 2:24 Commissioner may require specimen of, § 14:3 COMPULSORY LICENCE Appeal from decision or order, § 20:26 semiconductor technology, § 9:3, § 9:4 Export of pharmaceutical products to developing countries, for, § 10:1 General, § 20:14 application for, requirements of, § 20:21 procedure, § 20:21 Pharmaceutical patents, for (repealed), § 14:10, § 26:26 continuation of previously granted licences, § 23:2 Public health in developing countries, to promote, § 10:1 **COMPUTER PROGRAMS,** PATENTABILITY OF Generally, § 2:18 **CONFIDENTIALITY PERIOD** FOR PATENT APPLICATIONS Generally, § 4:15 CONFLICT Generally, § 22:3 Proceedings "should have been directed," § 26:42 Repealed provisions re, § 26:28, § 26:42 cases subsequent to repeal, § 26:30 Transitional provisions re, § 22:6, § 22:18 CONSISTORY CLAUSE IN SPECIFICATION, UNNECESSARY Generally, § 12:118, § 26:20

CONSTRUCTION Of claims see Claim, claims Of specification see Specification **CONTRA PROFERENTEM DOCTRINE, AS** APPLICABLE TO CONSTRUCTION Generally, § 12:97, § 12:99 **CONVENTION, PARIS** See also Priority, Treaties Generally, § 12:129, § 12:130, § 12:366, § 12:368 Compliance of Canadian law with. § 12:368 Improper claim to priority under, § 18:3 COSTS Commissioner's, in court proceedings, § 11:5 Security for, in impeachment action, § 20:1, § 20:7 COURTS HAVING PATENT JURISDICTION Generally, § 1:2 **CRIMINAL OFFENCES** Generally, § 21:5 **CROWN CORPORATION, USE OF PATENT BY** Generally, § 9:1, § 9:2 DAMAGES See Action for Infringement; DATE

> Anticipation, for testing as of claim date, § 12:125, § 12:133 Assessing utility, § 2:37, § 2:38, § 2:51 Claim, of see Claim date

DATE—Cont'd Construction of specification, of, § 12:45 Filing, of see Filing date Invention, of, § 12:175 Obviousness, for testing, § 12:169, § 12:173 DEDICATION TO PUBLIC OF PATENT Generally, § 12:19, § 16:7, § 23:9 **DEFENCE (I.E., FOR MILITARY** PURPOSES) Foreign government agreement with re defence-related invention, § 9:11 Inventions re, ownership and use of, § 9:10 Patents for national defence, § 9:1, § 9:10 Defence Production Act, § 9:2 **DEFENCES, TO ACTION FOR INFRINGEMENT** See Action for infringement **DEPOSIT OF BIOLOGICAL** MATERIAL Generally, § 14:5, § 14:6 DESCRIPTION See Disclosure DIES NON Generally, § 21:13 DISCLAIMER Generally, § 16:1 Commissioner may not refuse, § 16:4 Court, review of by, § 16:4 Dedication to public, as alternative to, § 16:7 Good faith required of applicant for, § 16:4

Parts of claims may be disclaimed, § 16:3 DISCLAIMER—Cont'd Patentee may not resile from, § 16:3 Pending action, as affecting, § 16:5 Repealed provision, § 26:34 Validity of, § 16:4 DISCLOSURE See also Insufficiency See also Specification Advantages of invention, no need to disclose, § 12:58 Best mode, § 12:56 to § 12:89 Biotechnological subject-matter, of, § 12:67, § 12:88 deposit of biological material, § 14:5, § 14:6 Computer software to implement invention, program listing not required, § 12:67 Consistory clause in, § 12:118. § 26:20 Construction of, § 12:48 Content of, required, § 12:1 Deposit of biological material, § 14:5, § 14:6 Duty of, on applicant, § 12:20 assessed relative to claim(s) in issue, § 12:57 Erroneous statements in, § 12:80 Insufficiency of see also insufficiency generally, 12:61 Novelty of invention, no need for, but see also Selection Patents, § 12:58 Prior art, distinctions over, no need for, § 12:58 Purpose of, § 12:10 Selection patents, extent of required in, § 12:72, § 12:88 Sound prediction, of, § 12:70 Statutory requirement for, § 12:1 Trials or experiments required to interpret, § 12:66 Unintelligible, renders patent invalid, § 12:76

DISCLOSURE—Cont'd

Utility of invention, of, § 2:34, § 12:59 Variants and improvements, § 12:73

DISCONFORMITY ATTACK ON VALIDITY Generally, § 14:8, § 20:6

DISCOVERY

Generally, **§ 2:10** Accidental, is not a bar to patentability, **§ 12:204** Invention, distinguished from, **§ 2:10**

DIVISION (OF PATENT APPLICATION)

Generally, § 13:9, § 13:10 Prosecution is procedural not substantive, § 13:10

DIVISIONAL PATENT APPLICATION

See also Double Patenting Generally, § 13:9 Must claim inventively relative to parent, § 13:10 Overlapping claims in, § 13:10

DOCUMENTS

Electronic filing of, in Patent Office, § 4:10, § 4:11
Electronic recordal of, in Patent Office, § 4:12, § 4:13
Public inspection of, in Patent Office, § 4:15, § 4:16

DOUBLE PATENTING

Generally, § 12:6, § 12:18 Coterminous ("same invention") and obviousness bases for, § 12:13, § 12:15 Dedication to avoid, § 12:20 Dedication to public may not avoid, § 12:19, § 16:7

DOUBLE PATENTING—Cont'd

Division directed by Patent Office does not generate, § 12:12 does not necessarily avoid. § 12:11, § 12:20, § 16:7 Divisional applications, § 12:12 Obviousness-type, § 12:7, § 12:22 On the claims, focus, § 12:16 Patent Office treatment of, § 12:24 Reissue may cure, § 15:17 Repealed provision affecting, § 26:42 Same-type, § 12:7 Single invention or composite generic invention, § 12:20 Take-away points, § 12:23

DRAWINGS

Addition to patent application, § 12:128 As aid to construe specification, § 12:53, § 14:2 Patent application, § 12:1, § 12:53 Requirement for, in patent application, § 14:1

EFFICACY Generally, § 2:45

ELECTRONIC FILING, RECORDAL OF DOCUMENTS IN PATENT OFFICE Generally, § 4:10 to § 4:13

ERROR, MATERIAL IN PETITION

Generally, § 18:1, § 18:2 As to inventorship, effect of on validity of patent, § 12:371, § 18:3 correction of inventorship or ownership in patent, § 17:8

ERRORS, CLERICAL Correction of, § 23:16

In claims, § 12:80

ESSENTIAL ELEMENT

Omission of in claim, invalidates for overclaiming, § 2:36, § 12:115

ESTOPPEL, AS TO ISSUE OR CAUSE OF ACTION Generally, § 19:36

ETHICS, OBLIGATIONS OF APPLICANT AND PATENT AGENT

Generally, § 4:9, § 12:56

"EVERGREENING" Generally, § 12:15, § 12:19

EVIDENCE

Expert see Expert Patent in court proceedings, of, § 6:2

EXAMINATION OF PATENT APPLICATION Generally, § 13:8

Duty of applicant, § 13:8 final action, § 13:8, § 15:4 Judicial interference with, § 13:8 Process of examination, § 13:8 Prosecution see Prosecution (of application) Re-examination see Re-examination of patent Role of Manual of Patent Office Practice (MOPOP), § 13:8

EXAMINERS Appointment of, § 4:5

EXHAUSTION OF PATENT RIGHTS

Generally, § 19:24

EXPERT

Evidence of, to construe specification, § 12:37 Patent agent as, for construing claims, § 12:38 EXPERT—Cont'd Ultimate issue, evidence re, § 12:38

FALSE MARKING OR REPRESENTATION Generally, § 21:5, § 21:7

FALSE PROMISE Generally, 19:114

FEDERAL COURT

Appeals from Commissioner, § 8:1, § 8:2

FEDERAL GOVERNMENT See Government

See Government

FEES

Patent, maintenance of, § 15:14 Patent application filing of, § 12:1, § 12:125 late payment of, § 12:127 maintenance of, § 12:123 reinstatement of abandoned, § 12:9, § 21:1, § 21:2 Remedying improper payment of, § 22:19

FILE HISTORY

As evidence for other purposes, § 12:109 As pertinent to presumption of validity, § 15:9 Construing claims, use of for, § 12:107, § 13:3

FILING

Of documents in Patent Office, electronic, § 23:16 Of patent application, requirements for, § 12:1 withdrawal of patent application, § 12:132

FILING DATE (OF PATENT APPLICATION)

Generally, § 2:1, § 12:126 Retroactive granting of earlier, § 12:127

FILING DATE (OF PATENT APPLICATION)—Cont'd Transitional provisions, § 22:1 outstanding documents and information, § 12:127 FIRST TO FILE Generally, § 12:133 FOREIGN GOVERNMENT Agreement re defence-related invention, § 9:11 FORFEITURE Generally, § 21:2, § 26:47 FRAUD ON PATENT OFFICE Generally, § 18:1, § 18:2 GATT (GENERAL AGREEMENT **ON TARIFFS AND TRADE**) Generally, § 1:5, § 9:4 **GENUS, SPECIES, ESPECIALLY** IN CHEMICAL/PHARMACEUTICAL GRACE PERIOD CASES Generally, § 2:25, § 12:5, § 12:8, § 12:21 "GILLETTE DEFENCE" Generally, § 12:117, § 19:37, § 19:39 **GOOD FAITH** Duty of disclosure invention, of, § 12:56 prior art, of, § 13:8 Infringement of defence-related patent, § 9:15 Required Generally of applicant, § 12:31, § 12:56, § 12:75 Response to Examiner, must be made in, § 18:3, § 21:1 Specification construed to protect what was invented in, § 12:51, § 15:6

Specification contrived to permit varying interpretations,

GOOD FAITH—Cont'd § 12:75, § 12:87

GOVERNMENT

Commissioner's jurisdiction to order use of patented invention by, § 9:1 appeal from, § 9:5 prerequisites for, § 9:3 Contractor to, use of patents by, § 9:2 Crown corporation, use by, § 9:2 Defence purposes, use of patents for see Defence Foreign, agreement re defence-related invention, § 9:11 Ownership of patents, § 9:10 Patent Act binds federal and provincial, § 3:1, § 3:2 Use of patents by, § 9:1, § 9:2 repealed provision, § 26:8

GRANT OF PATENT(S) Generally, § 15:5, § 15:7 Annual report re, § 11:7 Appealable final decision, is, § 15:6 Conclusive as to compliance with the Act and Rules, § 14:8, § 15:6 Exclusive right, § 15:6 Issuance distinguished, § 15:8 Issue date and formalities, § 15:8 Policy underlying, § 1:4 Presumption of validity, § 15:9 Repealed provisions, re, § 26:32 Royal prerogative, formerly, § 9:2 "Use," meaning of in s. 42, § 15:6

Generally, § 12:132, § 12:168

HEALTH, PUBLIC See Compulsory Licence

HISTORY Patent Act, of, § 1:4 HISTORY—Cont'd Requirements of specification and claims, of, § 12:29

HOLIDAYS Generally, § 21:13

HUMANITARIAN PURPOSES, USE OF PATENTS FOR Generally, § 10:1

IMPEACHMENT OF PATENT

Generally, § 20:1 Anticipation, on basis of, repealed provisions re, § 26:14, § 26:42 Grounds for, § 20:5 Interested person may bring action for. § 20:3 Mootness, dismissal of action, § 20:2 Obligation to impeach, repealed provisions re, § 26:42 Re-examination does not foreclose, § 20:2 Reissue, action re parent must include, § 15:17 Security for costs in action for, § 20:7

IMPROVEMENT

Generally, **§ 13:1** Infringement not avoided by, **§ 13:2, § 19:16** Invention need not be, **§ 2:11**, **§ 2:34**

INDEPENDENT CONTRACTOR Infringement by, § 19:32 With government, acquires no right to infringe patent, § 9:2 With licensee, acquires no right to

infringe patent, § 17:4

INFRINGEMENT OF PATENT Accidental, § 11:3 Action for see Action for infringement

INFRINGEMENT OF PATENT -Cont'd Advantage of the invention, taking constitutes, § 19:2, § 19:3 Aircraft temporarily in Canada, by, § 11:3 Article acquired, manufactured before filing of application, post-grant sale of is not, § 19:148 Article acquired from patentee, resale of is not, § 19:24 Biotech patent, of, § 19:36 Burden of proof of, § 19:35 of patent for process for making a new product, § 19:52, § 19:53 Business interest, use of invention by defendant to advance constitutes, § 19:2 Claims, see also Claim, claims, construction of conjunctive and disjunctive phrases in, § 19:8 construction is antecedent to determination of, § 19:2 differences between as affecting, 19:9 essential and non-essential elements of, § 19:11 limitation of scope to recited elements, § 19:13, § 19:16 purposive construction of, § 19:3, § 19:7 Combination, sale of elements of is not, § 19:6, § 19:20 kit of parts infringes, § 19:21 Commercial embodiment, comparing, § 19:7, § 19:16 Compensation for, before grant, § 19:48 Conflict-of-laws principles applicable, § 19:6 Construction of claims, duty of court to perform, § 19:2 Contributory, § 19:20

INFRINGEMENT OF PATENT —Cont'd

Damages for see Action for Infringement Defence-related patent, or, § 9:10 Defences to see Action for infringement Defendants acting in concert, § 19:20, § 19:31 Defendant's article, analysis of, § 19:16 Defendant's intention irrelevant. § 19:19 Defined, § 19:2 Doctrine of equivalents defined. § 19:14 equivalents, by, § 19:9, § 19:14 reverse equivalence, § 19:15 rules applicable to, § 19:9 Drug patents see Patented Medicines (Notice of Compliance) Regulations (PMNOC Regulations) Essential elements of valid claim, taking of, § 19:8, § 19:11 Evidence of foreign counterpart lawsuit, § 19:38 Exemptions from, § 19:5, § 19:57 General. § 19:2 Government, by see Government Importation of product of process, § 19:22 Importation of product satisfying claims of patent, § 19:21 Improvement by infringer does not avoid, § 13:1, § 13:2, § 19:16 Improver tests, the, § 12:103 Independent contractor, by, § 9:2, § 17:4, § 19:32 Inducing or procuring, § 19:20 Inessential element of claim, variant or omission of, § 19:11 Inferiority of impugned article does not avoid, § 19:16

INFRINGEMENT OF PATENT -Cont'd Intention of defendant irrelevant to. § 19:19 Intermediate, use or sale of may constitute, § 19:22, § 19:96 Inventor's view of what was invented irrelevant to. § **19:12** Kit of parts, by, § 19:21 Limitation of action for, § 19:50, § 19:51 Mechanical equivalents see equivalents Mixed question of law and fact, § 19:2, § 19:8 New principle, patent for, § 19:8 New product, presumption re process, § 19:52, § 19:53 Offer to sell. § 19:23 Patent granted to infringer does not avoid, § 13:1, § 19:9 Pecuniary benefit to infringer not required, § 19:23 Pharmaceutical patents see Notice of Compliance Regulations Pioneer patent. § 19:9 "Pith and marrow," see also equivalents, § 19:9 Place of, § 19:6 Prior user of invention, by, § 19:148 Process claim, sale of product of infringes, § 19:22, § 19:52, § 19:53 presumption re, § 19:53 Purposive construction and, § 19:7, § 19:9, § 19:10 Question of law and fact, § 19:2 Remedies for see Action for Infringement Repair and reconstruction, § 19:21 Resale of article purchased from patentee is not, § 19:24 Reverse equivalence, § 19:15

INFRINGEMENT OF PATENT -Cont'd Sale of article FOB foreign country is not, § 19:6 Secret patent, of, § 9:10 Ship or vessel temporarily in Canada, by, § 11:3 Spare parts, sale of for installation in patented article, § 19:21 Statutory tort, a species of, § 19:2 Subsidiary, by, does not make parent liable, § 19:32 Substance of invention, taking of, § 19:9 Temporary vehicle or vessel in Canada, by, § 11:3 Territorial ambit of. § 19:6 Testing required to determine, § 12:67, § 12:103, § 19:8 Textual, § 19:2 Threat of, as justifying quia timet action, § 19:25, § 19:29 Use, by, § 19:17 as an intermediate, § 19:18 Variant of claimed element as affecting, § 19:12 Vehicle temporarily in Canada, by, § 11:3 Vicarious liability for, § 19:32

INJUNCTION See Action for Infringement

INOPERABLE SPECIES Generally, § 2:36

INSPECTION OF DOCUMENTS IN PATENT OFFICE Generally, § 4:15, § 4:16

INSUFFICIENCY (OF DISCLOSURE)

Generally, **\$ 12:61** Ambiguity and, **\$ 12:74** Biotechnological subject-matter, of, **\$ 12:67, \$ 12:88** Claim by claim, **\$ 12:64** **INSUFFICIENCY (OF** DISCLOSURE)-Cont'd Computer software to implement invention, program listing not required for sufficient specification, § 12:67 Data to support invention, insufficiency of, distinguished, § 12:72 Date for determination, § 12:63 Erroneous statements in disclosure. § 12:80 Experiments, trials required by reader of specification, § 12:66, § 12:86 General knowledge, inferred, § 12:65 How it works not why it works, § 12:68 Test for sufficiency, § 12:62 Undisclosed advantage or activity, as supporting, § 12:88 What is the invention?, § 12:62

INTELLECTUAL PROPERTY, PATENT A SPECIES OF Generally, § 1:4 Coexistence of patents with other species thereof, § 1:4

INTERESTED PERSON, IN IMPEACHMENT ACTION Generally, § 20:3

INTERNATIONAL HUMANITARIAN PURPOSES, USE OF PATENTS FOR Generally, § 10:1

INTERPRETATION

Of claims see Claim, claims, construction of Of NOC Regulations, **§ 19:84** Of Patent Act Generally, **§ 1:5** with reference to foreign law, **§ 1:5**

INTERPRETATION—Cont'd

Of Patent Act Generally, § 1:5 -Cont'd with reference to treaties, § 1:5 Of regulations under the Act, § 5:2 Of specification see Specification INTERPRETATION ACT. APPLIES TO THE PATENT ACT AND TO PATENT **SPECIFICATIONS** Generally, § 1:5, § 12:52 **INVALIDITY** Burden of proof of, § 15:7, § 15:9 Claims, of some, does not imply entire patent invalid, § 19:155 Declaration of, by court, § 20:1, § 20:2 certificate of, § 20:9, § 20:10 within jurisdiction of provincial courts, § 20:2 Defence to infringement action, § 19:157 Grounds for finding of, § 20:5 failure to meet selection patent criteria, not, § 2:25 technical attacks given little weight, § 20:5 Holistic approach to analysis of, § 1:2, § 20:5 In rem and inter partes finding distinguished, § 19:158 INVENTION See also Obviousness Abstract theorem is not, § 12:120 Acquisition of before filing of someone else's patent application, § 19:148 Art, § 2:12 Complete, must be, with adequate testing, § 2:6 Compound and composition, § 12:9, § 12:111, § 12:115, § 12:117 composition of matter, a species

of invention, § 2:13

INVENTION—Cont'd Conception, and, § 2:4, § 2:6 Date of, § 12:175 Discovery distinguished, § 2:10 Genus/species description/claiming issues, § 12:8, § 12:21, § 12:72, § 12:112, § 12:116, § 12:119 Inventive concept, inventive step see Obviousness Laws of physics, must not violate, § 14:4 Manufacture, a species of invention, § 2:13 Meanings, different, § 12:119 New use of old article or product, § 2:24 Patentable, § 2:16 "Same," § 4:17, § 12:13 to § 12:15, § 12:21, § 15:16, § 15:17, § 16:6, § 22:6, § 26:16 Scintilla of, sufficient to support patent, § 12:205 Separate single or composite generic, § 12:20, § 12:73 Speculative see Sound prediction Unity of, § 12:5, § 13:10 Verification and testing do not constitute, § 2:7, § 2:30 What constitutes, different in different circumstances, § 12:119 **INVENTIVE CONCEPT** See Obviousness, inventive concept **INVENTIVE STEP** See Obviousness, inventive step **INVENTOR, INVENTORSHIP** Generaly, § 12:26 Combination invention, of, § 2:16 Correction of, in patent, § 2:4 Defined, who qualifies as, what acts qualify as invention, § 2:4,

§ 2:13

INVENTOR, INVENTORSHIP -Cont'd Employee, § 17:8 Erroneous naming of, effect on validity, § 12:26, § 12:371, § 18:3 Joint, joint application, § 12:370, § 12:371 **ISSUE OF PATENTS** See Grant of patent(s) JEAN CHRETIEN PLEDGE TO AFRICA Generally, § 10:2 JOINT APPLICATION FOR PATENT Generally, § 12:370 JUDGMENT Action for infringement, in, § 19:150 stay of, § 19:47 Appeal from see Appeal Default judgment, motion for, § 19:39 Registration of, in Patent Office, § 20:9 Stay of execution of, § 19:47 Summary judgment, § 19:39 JUDICIAL REVIEW Generally, § 1:7 Commissioner's decision, of, § 15:9 competitor lacks standing to bring, re grant, § 15:6 Minister's decision re patent register, of, § 19:90 **JURISDICTION** Impeachment, action for, § 20:1 Infringement, action for, § 19:1, § 19:28

Of Federal Court, **§ 17:7, § 19:1** Commissioner's decisions, judicial review of, **§ 8:3** .IURISDICTION—Cont'd Of Federal Court, § 17:7, § 19:1 -Cont'd contractual matters respecting patents, § 17:8 impeachment actions, § 20:1 infringement actions, § 19:1, § 19:28 Patent Office records, § 17:7, § 17:8 provincial courts, concurrent, stay of proceedings where duplicative proceedings commenced, § 19:28 Of provinces over property in patents, § 1:4, § 17:2, § 17:8 Validity issues, over, § 19:158 LAWS OF NATURE, NOT PATENTABLE Generally, § 12:120 LEGAL REPRESENTATIVES Generally, § 2:117 Defined, § 2:1 LEGISLATIVE JURISDICTION, **PROVINCIAL AND** FEDERAL Generally, § 1:4, § 17:2, § 17:8 LICENCES, LICENSING See also Assignment, Compulsory Licence Generally, § 20:14 application for, requirements, § 20:21 Exclusive, recordal of, § 17:3, § 17:4 Recordal of, effect of failure to record, § 17:6 Refusal to grant, may constitute abuse. § 20:14 Restrictions on, enforceable against subsequent purchaser, § 19:24 LICENSEE Contractual relations with licensor, § 17:4

LICENSEE—Cont'd Estoppel, inability to impeach patent, § 20:4 Plaintiff in infringement action, § 19:30

LIFE FORMS See Subject-matter LIMITATION OF ACTIONS FOR

INFRINGEMENT Generally, § 19:50, § 19:51

LIVING MATTER See Subject-matter

MAINTENANCE FEES

Generally, § 12:123, § 15:14 Late fee and notice, § 12:2, § 15:14 Late payment of, § 15:15 Patent not invalid, § 12:123, § 22:15 Powers of Federal Court. § 15:14 Prescribed fee deemed paid on prescribed date, § 12:123, § 15:14 Term limit deemed expired on prescribed date, § 15:14 Unauthorized person paying, § 15:15

MANUFACTURE AS A SPECIES **OF INVENTION** Generally, § 11:1, § 11:2

MANUFACTURING AND DESIGN OF PATENTED MEDICINES REGULATIONS Generally, § 19:58

MARKING

False, § 21:5 Repealed provisions re, § 26:10, § 26:48

"MARKMAN HEARING" Generally, § 12:39

MATERIAL MISSTATEMENT IN PETITION Generally, § 18:1, § 18:2

MEDICAL TREATMENT, **METHODS OF.** PATENTABILITY OF Generally, § 2:19

MEDICINE

See Patented medicine; Medical treatment, methods of, patentability of; Claim, claimschemical and pharmaceutical inventions, for

MENTAL STEPS, PATENTABILITY OF. CLAIMS INCLUDING Generally, § 2:5

MICROORGANISMS, PATENTABILITY OF Generally, § 2:20

"MIND WILLING TO UNDERSTAND," SPECIFICATION TO BE **READ WITH** Generally, § 12:41, § 12:50,

§ 12:95, § 12:99

MISREPRESENTATION, AS TO PATENTED ARTICLE Generally, § 21:5

MISSTATEMENTS IN PATENT **PETITION ETC.. CONSEQUENCES OF** Generally, § 18:2

MISUSE OF PATENT RIGHTS See Abuse of patent rights

MODELS, TO BE FURNISHED IN SUPPORT OF PATENT APPLICATION Generally, § 14:3

MONOPOLY, MEANING OF IN PATENT LAW Generally, § 1:4

NATIONAL DEFENCE See Defence

NATURAL PHENOMENA, NOT PATENTABLE Generally, § 12:120

NEW DRUG SUBMISSION

See Patented Medicines (Notice of Compliance) Regulations (PMNOC Regulations)

NEW USE OF OLD ARTICLE OR PRODUCT

Generally, **§ 2:24, § 12:165** Must be recited in the claims, **§ 12:110**

NORTH AMERICAN FREE TRADE AGREEMENT (NAFTA)

Generally, § 1:5 Regulations to implement, § 9:7

NOTICE OF ALLEGATION

See Patented Medicines (Notice of Compliance) Regulations (PMNOC Regulations)

NOTICE OF ALLOWANCE

Failure to pay fees due for, a deemed abandonment, **§ 21:1** Not an appealable decision of the Commissioner, **§ 8:3**

NOTICE OF COMPLIANCE REGULATIONS

See Patented Medicines (Notice of Compliance) Regulations (PMNOC Regulations)

NOVELTY

See also Anticipation Generally, § 2:9, § 12:132 NOVELTY—Cont'd Changes to the law effected by s. 28.2, § 12:154 modifications in the law of novelty effected by s. 28.2, § 12:154 Concept of, contrasted with anticipation, § 12:136 Dichotomy of anticipation/ overclaiming explained. § 12:139 Disclosure of point of, not required in specification or claims, § 2:41, § 12:58 First to file, see also First to file, § 12:154 First to invent, § 12:154 Grace period, § 12:168, § 12:368 Introduction, § 12:137 Lack of see Anticipation New use of old article, process, etc., § 2:24, § 12:165 Novelty-destroying, § 12:154 Overclaiming, § 12:116, § 12:138, § 12:139, § 12:155, § 12:164 Prior disclosure, § 12:154 Repealed provisions re, § 26:12, § 26:42

NUCLEAR ENERGY, PATENTS RELATING TO Generally, § 11:1

OBVIOUSNESS

Generally, § 12:169, § 12:170 Anticipation, § 12:233 Applicant, § 12:170 Assessing, § 12:233 Burden of proof, § 12:234 Claim date, § 12:170 "Classic" Beloit test, § 12:180 Commercial acquiescence, § 12:223 Commercial success, § 12:221 Common general knowledge, § 12:188 proof of existence, § 12:189

OBVIOUSNESS—Cont'd "Cripps question," § 12:179 Date, relevant, § 12:172 Date of invention, § 12:175 absent proof, § 12:175 "first to file" system, § 12:175 priority date, § 12:175 proof requirement, § 12:175 Evidence expert, § 12:231 inventor, § 12:232 obviousness, § 12:231 unobviousness, § 12:225 Experts, § 12:185 Failure by others, § 12:226 Foreign jurisdictions, prior art from, § 12:191 Foreign tests, § 12:237 Australian test, § 12:239 British test, § 12:238 Comparison between tests, § 12:240 European test, § 12:237 Highly skilled persons, evidence against, § 12:225 Imitation by others, § 12:224 Invention analogous use of a well-known principle, § 12:209 application, § 12:202 different stages of, § 12:201 idea, § 12:202 new compound, § 12:210 routine effort, § 12:204 scintilla or spark, mere, § 12:205 selection-patent criteria, § 12:208 simplicity of implementation, § 12:206 simultaneous, § 12:230 unexpected utility, § 12:207 what constitutes, § 12:200 Inventive concept, § 12:199 Inventiveness, § 12:170 Inventive step, § 12:202 Inventors, § 12:185

OBVIOUSNESS—Cont'd Mosaicing, § 12:190 Motivation, § 12:219 New Act patents, § 12:171 Non-obviousness, § 12:170 Non-technical factors, § 12:222 Objective approach, § 12:181 "Obvious to try," **§ 12:211** inapplicability, § 12:218 test, § 12:216 US law, § 12:215 Old Act patents, § 12:171 Person skilled in the art, § 12:183 Canada. § 12:186 common general knowledge, § 12:188 curious onlooker, § 12:184 England, § 12:186 evidence against, § 12:225 experts, § 12:185 following a well-charted route, § 12:228 inventors, § 12:185 long felt need, § 12:227 qualities of the posita, § 12:184 Post-relevant date publications, § 12:196 Prejudice, § 12:195 Prior art, § 12:191 "lion in the path," § 12:194 not static, § 12:194 search, § 12:198 "teaching away" from the invention, § 12:229 Prior public use, evidence of. § 12:193 Publications, post-relevant date, § 12:196 Question of fact, § 12:176 mixed question, § 12:176 objective test, § 12:176 subjective test, § 12:176 Receipt of award, § 12:226 Sanofi-Synthelabo, § 12:182 Secondary considerations, § 12:220

INDEX

OBVIOUSNESS—Cont'd Subject-matter, § 12:170 Technical considerations, § 12:233 Test, § 12:177 evolution of, § 12:178 Tracking advances in the art, § 12:197 Unpublished work, § 12:192 "Worth a try," § 12:211 experimentation, § 12:213 UK law, § 12:215 untested hypotheses, § 12:214 Wrong tests, § 12:233 dissection of combinations, § 12:236 ex post facto analysis, § 12:235

OFFENCES, INDICTABLE Generally, § 21:5

OFFERS TO SELL, AS CONSTITUTING INFRINGEMENT Generally, § 19:23

OFFICIAL LANGUAGES ACT, APPLICABILITY TO SPECIFICATIONS Generally, § 15:8

OFFICIAL SECRETS ACT Generally, § 9:10

"OLD ACT"

Generally, § 1:6 Anticipation re patents granted under, § 12:2 Obviousness re patents granted under, § 12:174

OLD ARTICLE OR PRODUCT, NEW USE OF Generally, § 12:165

Claim styles for, § 2:25

ORDER

See Judgment

OVERCLAIMING Claiming desired result, § 12:164 Dichotomy of anticipation/ overclaiming explained, § 12:139 Novelty, and, § 12:116, § 12:138, § 12:139, § 12:155, § 12:164 Relative to scope of invention disclosed, § 12:116 Relative to scope of invention made, § 12:116, § 12:164 Technical, literal approach to question not to be taken, § 12:116 Utility, and, § 2:41, § 12:115, § 12:164

OWNERSHIP OF PATENTS

Assignment see Assignment Co-ownership, § 12:372 Correction of, § 17:7 Employee vs. employer, § 17:8 Government, by defence-related inventions, § 9:10 Joint ownership, § 12:372 Trust, in, § 12:26, § 17:8

"PAPER PATENT", "PAPER REFERENCE" Novelty relative to prior, § 12:160 Obviousness relative to prior, § 12:193

PARIS CONVENTION See Convention, Paris

PARTIES TO ACTION

Action for impeachment, § 20:1 "interested person," § 20:3 Action for infringement, § 19:27 parties defendant, § 19:31 parties plaintiff, § 19:30

PATENT

Assignment of, see also Assignment, § 17:1, § 17:3, § 17:5 Bargain, § 12:30

PATENT—Cont'd Certified copy of, § 4:14 Chose in action, is a species of, **§ 1:4** Coexistence with other intellectual property rights, § 1:4 Definition of, § 2:118 Double see Double patenting Evidence (proof) of, in court, § 6:2 Grant, issue see Grant of patent(s) Intellectual property, is a species of, **§ 1:4** Invalidity of see Invalidity Invention, one patent for one, § 12:4 Multiple inventions in one, § 12:4 Personal property, is a species of, § 1:4 Policy underlying grant of, § 1:4, § 12:10 Re-examination of. § 16:8 appeal from decision, § 16:14 Reissue of, § 15:16, § 15:17 Revocation of, § 20:16, § 20:18 Term, § 15:10, § 15:12 repealed provision re, § 26:33 PATENTABILITY, PATENTABLE INVENTION See also Invention, Selection patents, Double patenting Generally, § 2:12, § 2:28 Compound and composition, § 2:24, § 12:8, § 12:111 PATENT ACT History, policy, legislative jurisdiction, § 1:4 Interpretation of, § 1:5 PATENT AGENT Ethical obligations of, § 4:9, § 12:56 Misconduct of, § 7:3

PATENT AGENT—Cont'd Privileged communication, § 7:4 Registration of, § 7:1 PATENT APPEAL BOARD Generally, § 4:3, § 15:2, § 15:4 PATENT APPLICATION Generally, § 12:1 Abandonment of, § 12:123, § 12:369, § 13:6, § 21:1 Amendment of, § 14:7 Assignment of, see also Assignment, § 17:1, § 17:3, § 17:5 Atomic-energy related, § 11:1 Completion of, § 12:369 Confidentiality period for, § 4:15 Continuation-in-part, § 12:130 Defence-related, § 9:10 Delay in prosecution, consequences of. § 14:8 Divisional, § 13:9 Drawings, § 12:122 Drawings in, § 14:1 Duty of disclosure of prior art, in, § 13:8 Examination of, § 13:6, § 13:7 relaxed standard of claim construction during, § 13:8 Filing date of, § 2:1, § 2:2, § 12:125, § 12:126 Filing of, requirements for, § 12:1 Forfeiture, § 21:2 Fraudulent filing of, § 12:26 Informalities in filing of, § 12:1, § 12:27 Inspection of, in Patent Office, § 4:15, § 4:16 Joining, § 12:370 New matter in, § 14:8 Non-resident applicant, by, § 12:369 Prosecution of, § 4:6, § 13:8 court interference with or review of, § 8:3, § 15:2 delay in, consequences of, § 14:8 PATENT APPLICATION—Cont'd Reference to previously filed application, § 12:122 Refusal of, § 15:1, § 15:2, § 15:4 appeal from, § 15:3 repealed provisions re, § 26:30 Reinstatement of, § 12:123, § 12:369, § 13:6, § 21:1, § 21:2 Restoration, § 21:2 Search for pending, corresponding to foreign patent, § 4:17 Secrecy of, § 4:15, § 9:10 repealed provisions re, § 26:4 Withdrawal of, § 12:132

PATENT COOPERATION TREATY (PCT) Generally, § 5:3, § 5:4

Time limits for PCT cases, § 5:5, § 21:2

"PATENTED INVENTION" Generally, § 12:121 Licensed use for humanitarian purposes, § 10:7 Omission of essential element of, § 12:95, § 12:102

PATENTED MEDICINE PRICES REVIEW BOARD

Generally, § 23:1 Advisory panel to, § 23:20 Constitution and establishment of, § 23:19 Criminal remedy for breach of obligation to or order by, § 21:9 Guidelines published by, § 23:12 Interpretation of provisions re, § 23:1 Jurisdiction of, is not defeated by dedication of patent, § 23:9 Meeting with Minister, § 23:31 New medicine, § 23:7 Orders of, § 23:27, § 23:28 Powers of, § 23:24, § 23:30

PATENTED MEDICINE PRICES REVIEW BOARD—Cont'd

Pricing information re, § 23:3 Board order re, § 23:5 Pricing of new patented medicine, § 23:3 excessive price, § 23:8 Procedure before, § 23:26 Regulations re, § 23:30 Repealed provisions re, § 26:27 Report to Minister, § 23:17 Sales information, § 23:16

PATENTED MEDICINE(S)

See also Compulsory licence, Patented Medicines (Notice of Compliance) Regulations (PMNOC Regulations) Generally, § 23:1 Confidentiality of information re, § 23:15 Excessive price of, § 23:8 factors to be considered, § 23:11 hearing re, § 23:13 Information re, confidentiality of, § 23:15

PATENTED MEDICINES (NOTICE OF COMPLIANCE) REGULATIONS (PMNOC REGULATIONS)

Generally, § 19:57 Allegations, when to be made, § 19:104 bald allegations, § 19:108 contents of NOA, § 19:107 multiple and successive NOAs, § 19:106 NOAs vis-023901911/2-vis NDSs, timing of, § 19:105 sufficiency of NOA, § 19:109 Amendments to, § 19:75 1998 amendments, § 19:77 1999 amendments, § 19:78 2006 amendments, § 19:80 2008 amendments, § 19:82

PATENTED MEDICINES

(NOTICE OF COMPLIANCE) **REGULATIONS (PMNOC REGULATIONS)**—Cont'd Authority to adopt, § 19:60 regulate, § 19:59 Background and history of, § 19:74 Damages abuse of process, § 19:139 amendments, § 19:139 Apotex, § 19:138, § 19:139, § 19:141 appellate decisions, § 19:138 automatic injunction, § 19:138 clarity, § 19:138 commentary, § 19:138 constitutionality, § 19:138 counterclaim, § 19:138, § 19:139 declaration of invalidity, § 19:139 defence, § 19:138, § 19:140 discontinuance, § 19:138, § 19:139, § 19:141 discovery, § 19:138 to § 19:140 disgorgement, § 19:138, § 19:139 dismissal, § 19:138, § 19:139, § 19:141 effect of declaration of invalidity/ impeachment, § 19:139 embryonic state, § 19:138 English Court of Appeal, § 19:138 entitlement to damages, § 19:138, § 19:139 factors in determining quantum, § 19:140 Federal Court jurisdiction, § 19:138 Federal Court of Appeal, § 19:138, § 19:139, § 19:141 first person, § 19:138, § 19:139, § 19:141

PATENTED MEDICINES (NOTICE OF COMPLIANCE) **REGULATIONS (PMNOC REGULATIONS)**—Cont'd Damages-Cont'd five-step process to assessment of damages, § 19:138 future losses, § 19:138, § 19:139 generic market size, § 19:138 hypothetical marketplace. § 19:138 impeachment of patent, § 19:139 interlocutory injunction, § 19:138, § 19:139 interlocutory proceedings, § 19:138 intra vires the Patent Act. § 19:138 judicial treatment, § 19:138 lack of clarity, § 19:138 limitation period, § 19:138 losses, § 19:138, § 19:139 lost profits, § 19:138, § 19:139 lost volumes, § 19:138 lovastatin, § 19:138 market entry delay, § 19:138 Minister, § 19:138, § 19:139 moot appeals, § 19:141 NOC Regulations, § 19:138 notice of compliance, § 19:138 omeprazole, § 19:138 overall market size, § 19:138 patent infringement, § 19:138 period of liability, § 19:138 preventing infringement, § 19:138 procedure, § 19:138 proceedings, § 19:141 profits, § 19:139 prohibition, § 19:138 prohibition order, § 19:138, § 19:141 ramipril, § 19:138 regulatory impact analysis statement, § 19:139

PATENTED MEDICINES (NOTICE OF COMPLIANCE) **REGULATIONS (PMNOC REGULATIONS)**—Cont'd Damages—Cont'd reversal, § 19:138, § 19:139, § 19:141 right of recovery, § 19:138 second person, § 19:138, § 19:139 Supreme Court of Canada, § 19:138 Teva, § 19:138, § 19:139 theoretical infringement, § 19:138 third party claim, § 19:138 trial decisions, § 19:138 turpi causa defence, § 19:138 UK High Court of Justice, § 19:138 unjust enrichment, § 19:138, § 19:139 unsuccessful patentee liability, § 19:138 withdrawal, § 19:139 Data protection regulations, § 19:80 Drug approval review process, relationship to, **§ 19:61** conclusion of, § 19:70 confidentiality, § 19:71 drug submissions, § 19:63 NDS v. ANDS, § 19:66 notifiable change to, § 19:69 paper record, § 19:65 PMNOC Regulations, under, § 19:68 sponsor of NDS, § 19:72 supplemental, § 19:67 Food and Drug Regulations, § 19:62 purpose of review process, § 19:64 regulatory process primer, § 19:62 safety and efficacy, § 19:64

PATENTED MEDICINES (NOTICE OF COMPLIANCE) **REGULATIONS (PMNOC REGULATIONS)**—Cont'd History of s. 55.2 and PMNOC Regulations, § 19:57 Interplay with Act, miscellaneous, § 19:142 section 55.2(4), § 19:144 section 55.2(5), § 19:144 section 55.2(6), § 19:146 section 56, § 19:143 Interpretation of, § 19:84 approach to, § 19:84 interpretive aids, § 19:87 matters of. § 19:85 "patented invention," § 19:86 Jurisprudence re general scheme, § 19:88 purpose of s. 55.2 and related regulations, § 19:88 Legislative landscape, change in, § 19:58 Miscellany see interplay with Act, miscellaneous Notice of compliance, prohibition on issuance of, § 19:135 mootness appeals, § 19:137 withdrawal of NOA, § 19:136 Patent lists and patent listing, § 19:92 delisting patents, § 19:99 improper listing concern, timing of challenge, § 19:102 intermediates claims to, § 19:95 use of, § 19:96 pre-amendment listability requirements, § 19:100 process claims, § 19:94 proper listing, three-step analysis to question of, § 19:97 single claim may suffice, § 19:98

PATENTED MEDICINES (NOTICE OF COMPLIANCE) **REGULATIONS (PMNOC REGULATIONS)**—Cont'd Patent lists and patent listing, § 19:92—Cont'd submitting patent list, timing of, § 19:103 transitional provisions, § 19:93 Patent register, § 19:89 de-listing by Minister, see also patent lists, § 19:89 duty to audit, Minister's, § 19:89 judicial review of Minister's decision, § 1:7, § 19:90 standing to seek, § 19:91 maintenance of, by Minister, § 19:89 Prohibition, proceedings for order of, § 19:110 burden of proof, § 19:117 allegations of non-infringement, as to, **§ 19:119** allegations of validity, as to, § 19:120 "close calls," burden matters in. § 19:123 current view, § 19:122 historical overview. § 19:121 overriding principle, § 19:118 disclaimers, use of, § 19:133 infringement issues, § 19:132 interveners, § 19:113 legal standard: "justified," § 19:115 Minister's duties administrative, § 19:111 motion for production, § 19:130 motion to dismiss, § 19:124 abuse of process, § 19:127 comity, § 19:129 issue estoppel, § 19:128 section 6(5)(a), § 19:125 section 6(5)(b), § 19:126 parties, § 19:112

PATENTED MEDICINES (NOTICE OF COMPLIANCE) **REGULATIONS (PMNOC REGULATIONS)**—Cont'd Prohibition, proceedings for order of, § 19:110—Cont'd patent licences, effect of, § 19:134 presumptions, § 19:131 procedural considerations, **§ 19:114** standard of proof, § 19:116 Regulatory impact analysis statement to, § 19:76 Section 3 see patent register Section 4 see patent lists and patent listing Section 5 see allegations, when to be made Section 6 see prohibition order, proceedings for Section 7 see notice of compliance, prohibition on issuance of Section 8 see damages Steps set out in, § 19:73 Validity, attacks on, § 19:60 **"PATENTED PRODUCT," FOR** HUMANITARIAN USE PURPOSES Generally, § 10:3, § 10:4, § 10:6 **PATENT OFFICE** Days closed, § 21:13 Defined, **§ 4:1** Electronic filing, storage of documents in, § 4:10 to § 4:13 Employees not to traffic in patents, etc., § 4:7 Public inspection of documents in, § 4:15, § 4:16

PATENT OFFICE—Cont'd

Record, court order for variation of, § 17:7 Seal of, § 6:1

PATENT RULES

Act prevails over and governs interpretation, § **5:2** Power of Governor in Council to make, § **5:1**

РСТ

See Patent Cooperation Treaty, Treaties

PERPETUAL MOTION MACHINES Generally, § 14:4

PERSON INTERESTED

Impeachment action, in, § 20:3
Judicial review of Commissioner's
 decision, § 15:6
May apply for compulsory licence,
 § 20:17

PERSON SKILLED IN THE ART

Defined, § 1:5, § 12:41, § 12:183 Knowledge deemed to have, § 12:41 May be a composite, § 12:43

Obviousness tested relative to, § 12:169, § 12:177 Specification is directed to, § 12:1, § 12:36, § 12:37

PETITION

See also Filing Material allegation in, untrue, § 18:1, § 18:2

PHARMACEUTICAL INVENTION

See also Patented medicine Biological material, deposit of, § 12:88, § 14:5, § 14:6 PHARMACEUTICAL INVENTION—Cont'd Claiming of, repealed provisions re, § 26:26, § 26:27 effect on jurisprudence, § 2:25, § 12:9 Compulsory licensing of, repealed provisions re, § 26:26

PHARMACEUTICAL PRODUCT See Compulsory Licence, § 10:1

POLICY UNDERLYING PATENT SYSTEM AND PATENT ACT Generally, § 1:4

POSTAL SERVICES INTERRUPTION RELIEF ACT Generally, § 12:127

PREDICTABILITY

Sound see Sound Prediction, § 12:116, § 12:207

PRESCRIBED Defined, § 2:121

PRESUMPTION OF VALIDITY Generally, § 15:7

PRIOR ART

See also Re-examination of patent Generally, § 12:161, § 13:4 Admission of in patent, § 12:195 Inventor's evidence as to, § 12:107 Obligation of applicant to disclose, § 13:8

PRIOR CLAIMING Generally, § 12:13

PRIORITY

See also Convention, Paris Claim, does not constrain interpretation of patent, § 12:47, § 12:367 Claim date, Paris Convention,

§ 12:125, § 12:366

PRIORITY—Cont'd Domestic application, based on, § 12:367 Effect of, § 12:368 Improper claim to, § 18:3 Late claiming of, § 12:368 Repealed provisions re, § 26:16 Request for, § 2:1, § 2:2, § 12:366 Subject-matter added after priority date, availability of, § 12:367

PRIORITY DATE

Definition (repealed), § 2:122, § 26:2

PRIOR PUBLICATION, PRIOR USE

See Anticipation, Novelty

PRIOR USER'S RIGHT

Generally, **§ 19:148, § 19:149** Repealed provisions re, **§ 26:41**

PRIVILEGED COMMUNICATION

Generally, § 7:4 Exceptions, § 7:3, § 7:4 Individual acting on behalf of patent agent or client, § 7:3, § 7:4 Patent agents outside Canada, § 7:3, § 7:4 Waiver, § 7:3, § 7:4

PROFESSIONAL METHODS, PATENTABILITY OF

Generally, § 2:20

PROHIBITION, ORDER FOR AGAINST MINISTER RE NOTICE OF COMPLIANCE

See Patented Medicines (Notice of Compliance) Regulations (PMNOC Regulations)

PROMISE

Of the patent, § 2:52

PROOF OF PATENT IN COURT PROCEEDINGS Generally, § 6:2 **PROSECUTION (OF APPLICATION**) Amendment, § 14:7 new matter prohibited, § 14:7, § 14:8 Delay in, § 14:8 Duty of applicant to be precise, § 13:8, § 21:2 Examination, § 13:6 et seq. File history, use of for construing claims or attacking patent, § 12:102, § 15:6, § 15:9 Final action, § 13:8, § 15:4 Good faith by applicant required, § 21:1, § 21:2 Grant of patent overcomes defects in. § 15:6 Misstatements made during, consequences of, § 18:3 Prior art, duty to disclose, § 13:8 PROVINCES

Legislative jurisdiction over property in patents, § 1:4, § 17:2, § 17:6 Liability for patent infringement, § 3:1, § 3:2 Patent Act binding upon, § 3:1

Use of patent by government of, § 9:1, § 9:2

PROVINCIAL COURTS, JURISDICTION OF

See Action for infringement, Jurisdiction

PUBLICATION OF PATENTS AND APPLICATIONS

Generally, § 4:15 Prevention of atomic energy-related inventions, § 11:1 defence-related inventions, § 9:10

PUBLICATION OF PATENTS AND APPLICATIONS —Cont'd

Prior, as bar to patentability see Novelty

PUBLIC HEALTH

See Compulsory Licence

PUBLIC INSPECTION OF DOCUMENTS IN PATENT OFFICE

Generally, **§ 4:15, § 4:16** Prevention of, **§ 9:10, § 11:1**

PUBLIC SERVANTS

Inventions by, Generally, **§ 12:4** Inventions by, re defence, ownership of, **§ 9:10**

PURCHASER OF PATENTED ARTICLE, RIGHTS OF Generally, § 19:24

PURPOSIVE CONSTRUCTION See Claim, claims, Infringement of patent

"QUID PRO QUO" JUSTIFICATION FOR PATENT GRANT Generally, § 1:4, § 12:15

"REASONABLE COMPENSATION" FOR PRE-GRANT USE OF INVENTION Generally, § 19:48

RE-EXAMINATION OF PATENT Generally, § 16:8 Appeal from decision of Board, § 16:14 Certificate of Board upon conclusion of, § 16:13 Construction of claims in, § 12:78, § 16:11 Impeachment proceedings not foreclosed by, § 20:2 RE-EXAMINATION OF PATENT —Cont'd Proceedings, § 16:12 Re-examination Board, § 16:10

REFUSAL OF PATENT APPLICATION BY COMMISSIONER Generally, § 15:1, § 15:2, § 15:4 Appeal from, § 15:3

REGISTER, REGISTRATION See Assignment, Judgment, Patent agent

REGULATIONS

Act prevails over, § 5:2 Power of Governor in Council to make, § 5:1

REINSTATEMENT (OF ABANDONED APPLICATION) Generally, § 21:1, § 21:2

REISSUE (OF PATENT)

Generally, § 15:16, § 15:17 Application, amendment of, § 15:17 Commissioner may exercise discretion, § 15:17 Defective original patent, § 15:17 Delay in seeking, § 15:17 Double patenting, may cure, § 15:17 Impeachment of reissued patent, § 15:17 Inadvertence, accident, mistake, § 15:17 mistake of law, § 15:17 urgency a factor, § 15:17 Invalid patent, of, § 15:17 Inventor's intention, § 15:17 Patent agent's error, § 15:17 Pending action or cause of action, effect on, § 15:16, § 15:17 Same invention requirement, § 15:17 Strict construction of s. 47, § 15:17

REISSUE (OF PATENT)—Cont'd Third-party rights and interests, § 15:17 Two or more patents may issue from a reissue application, § 15:16, § 15:17 U.S. legislation and case law, authority of, § 15:17 **REPRESENTATIVE FOR** SERVICE Generally, § 12:369 **REQUEST FOR EXAMINATION** Generally, § 13:6 **REQUEST FOR PRIORITY** Generally, § 12:366, § 12:367 RESTORATION Generally, § 21:2 Repealed provision re, § 26:47 **REVOCATION OF PATENT** Generally, § 20:16, § 20:18 **RULES, POWER TO MAKE** Generally, § 5:1 **RULES OF CONSTRUCTION** See Specification SAFETY Generally, § 2:45 SALE OF PATENTED ARTICLE, **RESTRICTIONS ON**

Generally, § 19:24 SAME INVENTION

See also Double patenting Other contexts, § 12:14

SCHEDULES TO ACT (FOLLOWING S. 103) Generally, § 10:6 Amendment of, § 10:5

SCIENTIFIC PRINCIPLE Invention must not violate, § 14:4 Unpatentable per se, § 12:120 SEAL OF THE PATENT OFFICE Generally, § 6:1

SEARCH OF PENDING APPLICATIONS CORRESPONDING TO FOREIGN PATENT Generally, § 4:17

SECRECY OF PATENTS, APPLICATIONS, ETC.

Generally, § 4:15 Atomic energy-related inventions, for, § 11:1 Defence-related inventions, for, § 9:10

SELECTION PATENTS

Generally, § 2:25 Anticipation, § 12:166 Criteria to be satisfied, § 2:25 failure to meet is not a per se ground of invalidity, § 2:25 Disclosure requirements, § 12:69 Obviousness, § 12:177

SELF-PRIORITY Generally, § 12:366, § 12:367 Repealed provision re, § 26:13

SEMICONDUCTOR TECHNOLOGY, COMPULSORY LICENSING OF

Generally, § 9:3, § 9:4

SEPARATE CLAIMS, CLAIMED ALTERNATIVES ARE DEEMED Generally, § 12:1

SERVICE, REPRESENTATIVE FOR Generally, § 12:369

SHELL OIL Generally, § 12:10

SOUND PREDICTION

Generally, § 2:42 Claiming based on, § 2:31, § 12:110, § 12:115, § 12:116, § 12:207 Criteria for, § 2:42 Date for testing, § 2:51 Disclosure requirement for, § 2:46; § 12:70 Doctrine has no application to obviousness, § 2:49 Prima facie reasonable inference of utility required, § 2:48 Utility and, § 2:31, § 2:32

SPECIES

Genus in chemical cases, and, § 2:25 Inoperable, § 2:36

SPECIFICATION

See also Claim, claims, Disclosure Generally, § 12:56 to § 12:89 Advantages, whether need be described in, § 2:29, § 2:41, § 12:58, § 12:110 whether need be claimed in, § 12:115 Claims see Claim, claims Consistory clause in, § 12:118, § 26:20 Construction of, § 12:32 benevolent, § 12:41, § 12:51 date as of which construed, § 12:45 drawings as aid to construe, § 12:54, § 14:2 duty of court, § 12:32 experiments, testing required to practise invention, § 12:66 expert evidence for construing, § 12:36, § 12:37 historical, § 12:46 Interpretation Act, applicability of, § 12:52

SPECIFICATION—Cont'd Construction of, § 12:32—Cont'd "mind willing to understand," to be read with, § 12:41, § 12:50, § 12:95, § 12:99 person skilled in the art, addressed to, § 12:36, § 12:37 potential issues, selecting publication date, § 12:47 prosecution of application, irrelevant to, § 12:107 question of law or mixed fact and law, § 12:32 rules of, § 12:48 Contrived to permit varying interpretations, § 12:75 Disclosure, see also Disclosure historical evolution of, § 12:10 Evidence of inventor irrelevant, **§ 12:49** Foreign patent, comparison with, **§ 12:109** Material misstatement or omission in, § 12:31, § 12:61, § 18:3 New matter need not be distinguished from old in, § 12:58 Old or obvious matter need not be included in, § 12:58 Statutory basis and requirements of, § 12:1 Technical terms in, § 12:18 Utility, whether need be described in, § 2:41, § 12:59 Words and phrases used in, § 12:121 **SPECIMENS, TO BE FURNISHED IN SUPPORT OF PATENT** APPLICATION

Generally, § 14:3

STANDARD OF PROOF Generally, § 2:48

STAY OF EXECUTION Generally, § 19:47

SUBJECT-MATTER Generally, § 2:14, § 12:90 to § 12:118, § 12:129 Abstract theorem is not patentable, § 12:56 to § 12:89, § 12:120 Aggregations, § 2:16 Architectural plans, § 2:23 Biotechnological, § 2:20 Business methods, § 2:17 Combinations, § 2:16 Computer programs, § 2:18 Laws of nature, natural phenomena, § 12:120 Life forms, living matter, § 2:20 Medical treatment, methods of, **§ 2:19** Mental steps, § 2:22 Microorganisms, § 2:20 New use of something old. § 2:24 Printed matter, § 2:21 Professional methods, § 2:17 Scientific principle is not patentable, § 12:18, § 12:56 to § 12:89, § 12:120 Selections, § 2:25

SUFFICIENCY See Insufficiency

TERM OF PATENT Generally, § 15:10, § 15:12 Repealed provision re, § 26:32

THEOREM, ABSTRACT IS NOT PATENTABLE Generally, § 12:120

THREATS THAT A CUSTOMER INFRINGES, UNJUSTIFIED Generally, § 19:25

TIME PERIOD Extension, § 21:13

TITLE

See Ownership of patents, Assignment

TRANSITIONAL PROVISIONS

Applications for patent, old Act and new Act, § 12:2 Miscellaneous, § 22:1, § 22:2 Not included in Patent Act, § 22:9

TREATIES

Canadian law presumed to be compliant with treaties, § 1:5 GATT (General Agreement on Tariffs and Trade), § 1:5, § 9:4 Paris Convention, see also Priority, § 12:129, § 12:130, § 12:366, § 12:368 Patent Cooperation Treaty (PCT), § 5:4 TRIPS, World Trade Organization, § 10:1, § 10:2, § 10:6, § 19:42 Various, as aid to interpretation of legislation, § 1:5

TRIAL OF AN ISSUE Generally, § 19:39

USE, NEW, OF OLD ARTICLE OR PRODUCT Generally, § 2:24, § 12:165

Claim styles for, § 2:25

UTILITY

Generally, § 2:31 Burden of proving absence in pending application, § 2:36 Claim preamble limits scope to embodiments having, § 12:80, § 12:101 Claims, subject-matter of must be useful, § 12:80 § 12:112 Commercial success and technical improvement not needed to establish, § 2:39 Confining claims to useful embodiments, § 12:85 Control and reproducibility, factors in assessing, § 2:40 Date for assessing, § 2:37, § 2:38, § 2:51

UTILITY—Cont'd
Disclosure of, in specification, whether required, § 2:32, § 2:41
Element essential to, must be claimed, § 2:36
Lack of, in any member of claimed class, invalidates patent, § 2:52
Sound prediction and, § 2:42, § 12:60, § 12:69, § 12:110, § 12:116
VALIDITY
See also Invalidity
Evidence of, may include corre-

sponding patents elsewhere, § 15:9 Presumption of, § 15:7, § 15:8 prior art cited and other factors as affecting, § 15:9 WORDS AND PHRASES IN PATENTS Generally, § 12:116

WORKING, "WORK ON A COMMERCIAL SCALE," § 26:2, § 26:44, § 26:45

WORLD TRADE ORGANIZATION (WTO)

See also Treaties

TRIPS effect on patent infringement remedies, § 19:42

World Trade Organization Implementation Act, § 1:5, § 2:9, § 9:4

WTO decision waiving enforcement of pharmaceutical patents for developing countries, etc., § 10:1, § 10:2