

INDEX

References are given first to section number and then to page number in brackets.

ANTICIPATION

- anticipation analysis, general approach for, 3.1.6 (96)
- • construe claims first, 3.1.6.1 (96)
- • expressly pleaded, 3.1.6.3 (97)
- • person skilled in art, 3.1.6.5 (99)
- • question of fact, 3.1.6.2 (97)
- • single disclosure (no mosaicing), 3.1.6.4 (97)
- anticipation under new *Patent Act*, *see* ANTICIPATION AND “NEW” PATENT ACT
- anticipation under old *Patent Act*, *see* ANTICIPATION AND OLD PATENT ACT
- anticipation versus obviousness, 3.1.7 (99), 5.2 (202)
- generally, 3.1.1 (91)
- high threshold, 3.1.4 (92)
- invalidity defence, 3.1.3 (92)
- statutory defence, 3.1.5 (85)
- • first-to-file system (new *Patent Act*), 3.1.5.2 (95)
- • first to invent (old *Patent Act*), 3.1.5.1 (93)
- validity, presumption of, 3.1.2 (91)

ANTICIPATION AND “NEW” PATENT ACT, *see also* ANTICIPATION

- double patenting, 3.2.5 (127)
- enabling disclosure test, 3.2.1 (101)
- • disclosure requirement, 3.2.1.1 (103)
- • enabling requirements, 3.2.1.2 (107)
- • form of disclosure irrelevant, 3.2.1.3 (110)
- • prejudices of prior art, 3.2.1.5 (1013)
- • unrestricted access, 3.2.1.4 (110)

- prior oral disclosure, 3.2.3 (116)
- prior publication, 3.2.2 (114)
- • paper disclosures, 3.2.2.3 (115)
- • sufficiency and enablement, 3.2.2.2 (115)
- • unimaginative person skilled in art, 3.2.2.1 (114)
- prior use and prior sale, 3.2.4 (117)
- • enabling disclosure, 3.2.4.1 (117)
- • exemption for experimentation, 3.2.4.5 (126)
- • method invention, 3.2.4.3 (122)
- • removal of inherency, 3.2.4.4 (124)
- • reverse engineering, 3.2.4.2 (119)
- selection patents, 3.2.6 (128)

ANTICIPATION AND OLD PATENT ACT, *see also* ANTICIPATION

- double patenting or prior grant, 3.3.6 (138)
- enabling disclosure test, 3.3.1 (130)
- generally, 3.3 (129)
- prior corresponding patent (Section 27(2)), 3.3.5 (138)
- prior invention (Section 27(1)(a)), 3.3.2 (130)
- • date of invention, 3.3.2.1 (131)
- • making invention available to public, 3.3.2.3 (132)
- • prior use by any other person, 3.3.2.2 (132)
- • secret or fortuitous use, 3.3.2.4 (133)
- • sufficiency of prior use (Section 27 and 61), 3.3.2.5 (133)
- prior printed publication or patent (Section 27(1)(b)), 3.3.3 (135)
- • printed (Section 27), 3.3.3.2 (135)

ANTICIPATION AND OLD PATENT ACT (*cont'd*)

- prior art, date of interpretation 3.3.3.3 (135)
- publication defined, 3.3.3.1 (135)
- prior public use or sale in Canada (Section 27(1)(c), 3.3.4 (136)
- exemption for experimentation, 3.3.4.4 (137)
- on sale, 3.3.4.3 (137)
- prior use, 3.3.4.2 (136)
- unsuccessful experiments, 3.3.4.1 (136)

APPEALS, *see also* LITIGATION

- appeal book, 9.7.3 (784)
- appearance, 9.7.2 (784)
- authorities, book of, 9.7.6 (786)
- cross-appeal, 9.7.2 (784)
- hearing, requisition for, 9.7.5 (785)
- memorandum of, 9.7.4 (785)
- notice of appeal, 9.7.1 (783)

ASSIGNMENTS

- assignability, 11.1.1 (817)
- assignment by joint owners, 11.1.1.2 (819)
- partial assignment, 11.1.1.1 (818)
- devolution, 11.1.4 (824)
- bankruptcy, 11.1.4.2 (825)
- death or dissolution, 11.1.4.1 (824)
- equitable interests, 11.1.3 (821)
- by express agreement, 11.1.3.1 (821)
- employment, by virtue of, 11.1.3.2 (822)
- estoppel, 11.1.6 (828)
- legal requirements, 11.1.2 (819)
- form of assignment, 11.1.2.1 (819)
- notice of equitable interest, 11.1.2.3 (821)
- registration, 11.1.2.2 (820)
- past infringement, right to sue, 11.1.7 (829)

- public interest inventions, 11.1.8 (831)
- terms, 11.1.5 (827)
- implications of 11.1.5.2 (827)
- obligations attaching to patent, 11.1.5.1 (827)

BUSINESS ASSETS

- assignments, *see* ASSIGNMENTS
- *Competition Act*, applicability of, *see* COMPETITION ACT
- jurisdiction, 11.4 (872)
- licences, *see* LICENCES
- security interests, *see* SECURITY INTERESTS

CLAIM CONSTRUCTION

- *Catnic* case, 6.3.2 (436)
- claim defined, 6.1 (423)
- conclusions, 6.11
- court
- duty of, 6.4 (444)
- *Markman* hearings, 6.4.3.2 (458)
- patent as “regulation”, 6.4.3.1 (457)
- question of law, 6.4.2 (446)
- use of expert witnesses, 6.4.4 (459)
- developments since *Free World* and *Whirlpool* cases, 6.10 (571)
- *Actavis* (2017) decision, 6.10.2 (475)
- *Kirin-Amgen* (2004) decision, 6.10.1 (571)
- essentialness of claim element, *see* ESSENTIALNESS OF CLAIM ELEMENT
- evolution of, 6.3.4 (443)
- “form and substance” approach, rejection of, 6.6.1 (475)
- history of, 6.3 (429)
- *Catnic*, 6.3.2 (436)
- *Improver*, 6.3.3 (440)
- literal infringement, 6.3.1.1 (431)
- substantive infringement, 6.3.1.2 (433)
- two-part test, 6.3.1 (429)

CLAIM CONSTRUCTION —*(cont'd)*

- history of claiming, 6.2 (425)
- *Improver* case, 6.3.3 (440)
- inconsistency in *Free World*, 6.9 (554)
- back to *Catnic* and *Improver*, 6.9.2 (565)
- plain reading of *Whirlpool/Free World*, 6.9.1 (556)
- purposive construction of *Free World* 6.9.3 (569)
- introduction, 6.1 (423)
- onus on construction, 6.4.3 (456)
- principles (*Free World* and *Whirlpool* cases), 6.5 (469)
- purposive construction, 6.6 (472)
- “Swiss” types claims, 6.11 (580)
- words and phrases in claim, meaning of, *see* WORDS AND PHRASES

COMPETITION ACT, *see also* BUSINESS ASSETS

- abuse of dominant position, 11.5.1 (874)
- applicability of, 11.5 (874)
- impairment of competition, undue, 11.5.2 (874)
- price maintenance, 11.5.3 (875)
- specialization agreements, 11.5.4 (875)

COMPUTER IMPLEMENTED INVENTIONS, *see also* PATENTABLE SUBJECT MATTER

- Canada, 2.2.4.1 (76)
- United States, 2.2.4.2 (83)

CONTENTS OF PATENT APPLICATION, *see also* PATENT APPLICATION

- abstract, 1.2.3.1 (28)
- claims, 1.2.3.2 (28)

- description, 1.2.3.3 (29)
- drawings, 1.2.3.4 (30)
- generally, 1.2.3 (28)

DEDICATION TO PUBLIC, *see also* LATENT DEFECTS

- defined, 8.9.1 (684)
- enforceability of undedicated claims, 8.9.2 (685)
- pending actions, jurisdiction in, 8.9.4 (686)
- revocability, 8.9.3 (685)

DIRECT INFRINGEMENT, *see also* INFRINGEMENT

- generally, 7.2 (598)
- importation, 7.2.4 (607)
- making and constructing, *see* MAKING AND CONSTRUCTING
- selling, 7.2.3 (606)
- using, *see* USING

DISCLAIMER, *see also* LATENT DEFECTS

- accepting disclaimer, Patent Office role in, 8.8.3 (682)
- defined, 8.8.1 (680)
- pending actions, 8.8.3 (683)

DISCOVERY OF DOCUMENTS, *see also* LITIGATION

- affidavit of documents, 9.3.1.1 (721)
- confidentiality, 9.3.1.3 (722)
- deponent, examination of, 9.3.1.4 (722)
- examination for, 9.3.2 (723)
- generally, 9.3.1 (721)
- inspection of documents, 9.3.1.2 (722)
- privilege, 9.3.1.3 (722)

DOUBLE PATENTING

- anticipation, 3.2.5 (127)
- inventiveness, 5.19 (405)
- latent defects, 8.6 (672)

ESSENTIALNESS OF CLAIM ELEMENT, *see also* CLAIM CONSTRUCTION

- generally, 6.8 (528)
- inconsistency in *Free World*, 6.9 (554)
- intent of inventor, 6.8.3 (538)
- “about”, 6.8.3.6 (549)
- adherence of language of claims, 6.8.3.1 (541)
- essential elements in claims, 6.8.3.3 (544)
- inferred intent, 6.8.3.2 (543)
- numbers, 6.8.3.5 (549)
- “substantially”, 6.8.3.7 (551)
- words of precision and precision of words, 6.8.3.4 (548)
- “irrespective of its practical effect”, 6.9.1.2 (558)
- judicial readings of *Free World* and *Whirlpool*, 6.8.1 (530)
- problem/solution approach, 6.8.4 (551)
- substitutable claims, obviously, 6.8.2 (531)
- obvious substitutability, 6.8.2.3 (536)
- presence of variant, 6.8.2.1 (532)
- whether variant affects invention’s operation, 6.8.2.2 (533)

EXAMINATION FOR DISCOVERY, *see also* LITIGATION

- confidentiality orders, 9.3.2.7 (734)
- generally, 9.3.2 (723)
- implied undertaking of confidentiality, 9.3.2.1 (723)
- objections, 9.3.2.5 (732)
- person examined, 9.3.2.3 (727)
- scope of examination, 9.3.2.4 (729)
- timing issues, 9.3.2.2 (725)
- undertakings, 9.3.2.6 (733)

EXAMINATION OF PATENT APPLICATIONS, *see also* PATENT APPLICATION

- maintenance fees, *see* MAINTENANCE FEES
- prior art and protests, 1.4.3 (33)
- prosecution, 1.4.4 (34)
- amendments to patents, 1.4.4.4 (38)
- disclaimer, 1.4.4.5 (38)
- examiner, role of, 1.4.4.1 (34)
- office action, responding to, 1.4.4.2 (34)
- prosecution history estoppel, 1.4.4.6 (40)
- re-examination, 1.4.4.4 (38)
- refusal to grant patent, appealing, 1.4.4.3 (36)
- re-issue, 1.4.4.5 (38)
- requesting examination, 1.4.1 (32)
- special order examination, 1.4.2 (33)

INADEQUATE DISCLOSURE, *see also* LATENT DEFECTS

- ambiguity, 8.2.4 (658)
- “best mode” requirement, 8.2.3 (656)
- “selection patents”, 8.2.5 (659)
- sufficiency of disclosure, 8.2.1 (651), 8.2.2 (652)

INDIRECT INFRINGEMENT, *see also* INFRINGEMENT

- cause of action, characterization of, 7.3.1.2 (617)
- comparison with U.S. and U.K. tests, 7.3.1.1 (616)
- elements of, 7.3.2 (620)
- direct infringement, 7.3.2.1 (620)
- inducing conduct, 7.3.2.2 (621)
- knowingly, 7.3.2.3 (624)
- kits, 7.3.3 (627)
- overview, 7.3.1 (612)
- pleading, 7.3.4 (629)
- remedies, 7.3.5 (630)

INFRINGEMENT

- common design, 7.4 (630)
- defences, 7.5 (633)
- • *Gillette* defence, 7.5.1 (633)
- • limitation period, 7.5.2 (635)
- defined, 7.1.1 (589)
- direct infringement, *see* **DIRECT INFRINGEMENT**
- exemptions from infringement, *see* **EXEMPTIONS FROM INFRINGEMENT**
- introduction, 7.1 (589)
- question of fact, 7.1.1.1 (592)
- territorial limitations, 7.1.2 (593)
- • U.K. perspective, 7.1.2.2 (596)
- • U.S. perspective, 7.1.2.1 (595)
- who can be sued, 7.1.4 (598)
- • officers and directors, 7.1.5 (598)
- who can sue, 7.1.3 (597)
- • licensee, 7.1.3.2 (597)
- • patentee, 7.1.3.1 (597)

INFRINGEMENT — EXEMPTIONS, *see also* INFRINGEMENT

- compulsory licence regime, 7.6.2 (639)
- experimental use, 7.6.1 (635)
- • common law, 7.6.1.1 (635)
- • experimental (Section 55.3) 7.6.1.3 (638)
- • regulatory approval (Section 55.2), 7.6.1.2 (636)
- prior acquired goods, 7.6.4 (640)
- use in transit, 7.6.3 (639)

INOPERABILITY, *see also* INUTILITY

- claim includes inoperable embodiments, 4.8.9 (169)
- claim missing essential element, 4.8.5 (162)
- claim missing immaterial element, 4.8.4 (161)

- claim points to inoperable embodiments, 4.8.11 (170)
- control and reproducibility, 4.8.2 (159)
- generally, 4.8.1 (158)
- inutility of described embodiment, 4.8.6 (165)
- inutility within genus or within breadth of claim, 4.8.12 (172)
- obviously inoperable embodiments, 4.8.10 (169)
- partial utility, 4.8.7 (167)
- side effects, 4.8.3 (160)
- toxicity, 4.8.3 (160)
- use limited claims and sufficiency, 4.8.13 (174)
- utility in modified form, 4.8.8 (168)

INUTILITY, *see also* UTILITY

- grounds for, 4.8 (158)
- inoperability, *see* **INOPERABILITY**
- whole patent, 4.9 (176)

INVENTIVE CONCEPT, *see also* INVENTIVENESS

- Canadian law, 5.12.2 (299)
- • *Apotex v. Sanofi-Synthelabo*, 5.12.2.1 (300)
- • *Bristol-Myers Squibb v. Teva*, 5.12.2.2 (301)
- • *Ciba Specialty Chemicals v. SNF*, 5.12.2.3 (302)
- construe claim, 5.12 (297)
- differences between state of art and claim as construed, 5.13 (310)
- general principles, 5.12.3 (304)
- identify, 5.12 (297)
- patents governed by *Current Act*, step 2 5.12.5 (310)
- patents governed by *Old Act*, step 2 5.12.4 (309)
- identify, 5.12 (297)
- UK law, 5.12.1 (297)

INVENTIVENESS

- common general knowledge in art, 5.11 (287)
- generally, 5.11.2 (288)
- relevance, 5.11.1 (287)
- determination of obviousness, *see* OBVIOUSNESS, DETERMINATION OF
- double patenting, 5.19 (405)
- divisional applications, 5.19.1 (416)
- exception, Patent Office requires division, 5.19.2 (417)
- expert evidence, obviousness, 5.17 (392)
- inventive concept, *see* INVENTIVE CONCEPT
- non-obviousness requirements, development of,
 - introduction, 5.3.1 (203)
 - U.K., 5.3.2 (204)
 - U.S., 5.3.3 (209)
- obviousness requirement in Canada, development of, 5.3.4 (213)
 - *Apotex v. Sanofi-Synthelabo*, 5.3.4.5 (219)
 - *Beecham v. Procter & Gamble*, 5.3.4.2 (217)
 - *Beloit v. Valmet Oy*, 5.3.4.3 (217)
 - *Farbwerke Hoechst v. Halocarbon*, 5.3.4.1 (215)
 - Section 28.3, 5.3.4.4 (218)
- obviousness versus anticipation, 3.1.7 (99), 5.2 (202)
- overview, 5.1 (200)
- prior art, consideration of, *see* PRIOR ART
- relevance of prosecution history, 5.16 (391)
- relevant date for obviousness (current *Act*)
 - claim date, 5.8 (237)
- relevant date for obviousness (old *Act*), 5.7 (230)

- actual date of invention, proof of, 5.7.1 (231)
- constructive date (filing date or priority date), 5.7.2 (233)
- date of invention, 5.7 (230)
- statutory test for obviousness under current *Act*, 5.5 (226)
- subject matter defined by claim, 5.6 (228)
- test for obviousness or lack of invention (Old *Act*), 5.4 (223)
- test for obviousness, specific applications
 - combinations, 5.18.1 (394)
 - compositions, 5.18.7 (404)
 - idea, 5.18.9 (405)
 - new use for old product or process, 5.18.3 (398)
 - obviousness of member of claimed class, 5.18.2 (397)
 - process, 5.18.8 (405)
 - product for new use, 5.18.4 (400)
 - selection, 5.18.5 (400)
 - size, shape, and material, 5.18.6 (402)

LATENT DEFECTS

- dedication to public, *see* DEDICATION TO PUBLIC
- disclaimer, *see* DISCLAIMER
- disclosure requirement, 8.2 (648)
 - ambiguity, 8.2.4 (678)
 - “best mode” requirement, 8.2.3 (656)
 - “selection patents”, 8.2.5 (659)
- sufficiency of disclosure, 8.2.1 (651), 8.2.2 (652)
- double patenting, 8.6 (672)
- introduction, 8.1 (647)
- maintenance fees, *see* MAINTENANCE FEES
- misrepresentation in patent application, 8.3 (661)

LATENT DEFECTS — (*cont'd*)

- over-claiming, *see* **OVER-CLAIMING**
- reissue of patents, 8.10 (687)
- appeal, 8.10.6 (693)
- certificate of board, 8.10.5 (692)
- re-examination board, establishment of, 8.10.3 (691)
- re-examination proceeding, 8.10.4 (692)
- re-examination, 8.10.1 (690)
- request for re-examination, 8.10.2 (691)
- sound prediction, 8.5 (668)

LICENCES, *see also* **BUSINESS ASSETS**

- agreements to grant a licence, 11.2.3 (838)
- breach and enforcement, 11.2.9 (854)
- compulsory, 11.2.10 (857)
- abuse of exclusive rights, 11.2.10.1 (857)
- defence contracts, use of patents for, 11.2.10.4 (865)
- demand not being met, 11.2.10.1.4 (860)
- food and medicine, 11.2.10.2 (863)
- general requirements, 11.2.10.1.1 (857)
- humanitarian and public health use, 11.2.10.3 (865)
- initiation of application, 11.2.10.1.2 (858)
- prejudice to trade or industry, 11.2.10.1.5 (861)
- reasonable terms, 11.2.10.1.3 (859)
- remedies, 11.2.10.1.1 (857)
- terms of, 11.2.10.1.6 (862)
- determination, 11.2.5 (841)
- parties, rights of, 11.2.5.1 (841)
- revocation of patent, 11.2.5.2 (842)

- devolution, 11.2.6 (843)
- bankruptcy, 11.2.6.1 (843)
- licensor insolvent and restructuring, 11.2.6.3 (846)
- receivership, 11.2.6.2 (845)
- estoppel against licensee, 11.2.8 (850)
- agreement addresses validity, 11.2.8.2 (851)
- general principles, 11.2.8.1 (850)
- not acting under licence, 11.2.8.3 (852)
- other situations, 11.2.8.4 (853)
- grants by joint owners, 11.2.1.3 (837)
- implied licences, 11.2.4 (838)
- by conduct, 11.2.4.3 (840)
- by dissolution of partnership, 11.2.4.4 (841)
- by employment relationship, 11.2.4.2 (840)
- by sale, 11.2.4.1 (838)
- legal requirements, 11.2.2 (837)
- form of licence, 11.2.2.1 (837)
- notice of equitable interest, 11.2.2.3 (838)
- registration, 11.2.2.2 (837)
- nature of a licence, 11.2.1 (832)
- property, 11.2.1.1 (832)
- scope of, 11.2.1.2 (835)
- exclusive, 11.2.1.2.3 (836)
- general, 11.2.1.2.1 (835)
- limited, 11.2.1.2.2 (835)
- sole, 11.2.1.2.4 (836)
- tax issues, 11.2.11 (865)
- terms, 11.2.7 (847)
- assignment and sublicensing, 11.2.7.1 (847)
- conditions attaching to a licence, 11.2.7.5 (850)
- implication of other terms, 11.2.7.4 (849)

LICENCES (*cont'd*)

- • “most favoured licensee” clause, 11.2.7.2 (848)
- • reports, inspections, and audits, 11.2.7.3 (849)

LIFE FORMS, *see also* PATENTABLE SUBJECT MATTER

- Canada, 2.2.3.1 (70)
- United States, 2.2.3.2 (73)

LITIGATION

- discovery, 9.3 (721)
- • affidavit of documents, 9.3.1.1 (721)
- • confidentiality, 9.3.1.3 (722)
- • deponent, examination of, 9.3.1.4 (722)
- • discovery of documents, 9.3.1 (721)
- • examination for, 9.3.2 (723)
- • inspection of documents, 9.3.1.2 (722)
- • privilege, 9.3.1.3 (722)
- examinations for discovery, *see* EXAMINATION FOR DISCOVERY
- pleadings, 9.2 (699)
- • attack of, 9.2.5 (709)
- • close of, 9.2.6 (719)
- • counterclaim, 9.2.4 (708)
- • reply, 9.2.3 (708)
- • settlement, offers and discussions, 9.2.6.1 (719)
- • statement of claim, 9.2.1 (700)
- • statement of defence, 9.2.2 (706)
- • striking of pleadings (timing issues), 9.2.5.1 (709)
- pre-litigation matters, 9.1 (698)
- • demand letters, 9.1.1 (698)
- • gathering evidence, 9.1.2 (698)
- • motion to inspect, 9.1.3 (608)
- pre-trial matters, 9.4 (737)
- • bifurcation, 9.4.3 (744)
- • costs, security for, 9.4.1 (737)
- • expert evidence, 9.4.5 (745)

- • notice to admit, 9.4.4 (745)
- • pre-trial conference, 9.4.6 (750)
- • severance of issues, 9.4.3 (744)
- • summary judgment, 9.4.2 (738)
- • summary trial, 9.4.2 (738)
- trial, conduct of, 9.5 (651)
- • adducing evidence, 9.5.2 (651)
- • demonstrative evidence, 9.5.2.3 (760)
- • expert evidence, 9.5.2.2 (752)
- • expert evidence, admissibility, 9.5.2.2.1 (753)
- • “hot tubbing” and panel of experts, 9.5.2.2.2 (759)
- • opening statements, 9.5.1 (751)
- • use of discovery, 9.5.2.4 (761)
- • witnesses, 9.5.2.1 (752)

MAINTENANCE FEES, *see also* LATENT DEFECTS; PATENT DEFECTS

- *Dutch Industries* case, 8.7.2 (675)
- failure to pay, 1.5 (40), 8.7.4 (678)
- generally, 1.5 (40), 8.7.1 (674)
- section 78.6 of *Patent Act*, 8.7.3 (677)

MAKING AND CONSTRUCTING, *see also* INFRINGEMENT

- generally, 7.2.1 (599)
- patented process for obtaining new product, 7.2.1.1 (600)
- repairing vs remanufacturing, 7.2.1.2 (601)

METHODS OF MEDICAL TREATMENT, *see also* PATENTABLE SUBJECT MATTER

- Canada, 2.2.2.1 (49)
- U.S., 2.2.2.2 (62)

MISREPRESENTATION, *see also* LATENT DEFECTS

NEW USES FOR KNOWN COMPOUNDS AND PROCESSES, *see*

also PATENTABLE SUBJECT
MATTER

- Canada, 2.2.1.1 (47)
- U.S., 2.2.1.2 (49)

NOVELTY, *see also* ANTICIPATION

OBVIOUSNESS, *see also* INVENTIVENESS

OBVIOUSNESS, DETERMINATION OF, *see also* INVENTIVENESS

- directly and without difficulty, 5.14.5 (332)
- hindsight, caution concerning, 5.14.10 (340)
- invention required, 5.14.3 (318)
- mechanical skill, 5.14.8 (339)
- objective test, 5.14.2 (315)
- obvious to try test, 5.14.4 (320)
- other factors, relevance 5.14.11 (344)
- other statements, 5.14.6 (333)
- overview, 5.14.1 (312)
- question of fact, 5.14.7 (337)
- relevance of other facts, 5.15 (344)
- • climate in field, teaching away or prejudice, 5.15.9 (373)
- • commercial success, 5.15.10 (376)
- • combination of factors, 5.15.14 (389)
- • effort required to achieve invention, 5.15.2 (349)
- • industry praise, 5.15.12 (388)
- • manner of making invention, 5.15.4 (359)
- • motive to find solution addressed by patent, 5.15.3 (354)
- • patents, 5.15.13 (389)
- • reception of invention, 5.15.11 (385)
- • self-evidence, 5.15.1 (344)
- • simplicity, 5.15.5 (364)
- • technically or practically obvious, 5.15.6 (367)
- • utility, 5.15.7 (368)

- relevant date, 5.14.9 (340)

OVER-CLAIMING, *see also* LATENT DEFECTS

- claims broader than invention made, 8.4.1 (667)
- claims broader than invention disclosed, 8.4.2 (668)
- generally, 8.4 (665)

PATENT

- application, *see* PATENT APPLICATION
- defined, 1.1.1 (3)
- *Patent Act*
- • history and development of, 1.1.4 (11)
- patent system, purpose of, 1.1.2 (6)
- patentability, criteria for, *see* PATENTABILITY
- theory, 1.1.3 (7)
- • exploration control theory, 1.1.3.4 (10)
- • induce commercialization theory, 1.1.3.2 (9)
- • information disclosure theory, 1.1.3.3 (9)
- • invention motivation theory, 1.1.3.1 (8)
- U.S. patent system
- • comparison with, 1.1.5 (13)
- • key features, 1.1.5.1 (13)
- versus copyright, 1.1.1 (3)

PATENT ACT

- history and development of, 1.1.4 (11)
- Section 55.2, *see* PATENTED MEDICINES (NOTICE OF COMPLIANCE) REGULATIONS

PATENT ANTICIPATION, *see also* ANTICIPATION

PATENT APPLICATION

PATENT APPLICATION — (*cont'd*)

- applying outside Canada, 1.2.1.3 (17)
- claim date (priority date), 1.2.1.2 (16)
- contents of, *see* CONTENTS OF PATENT APPLICATION
- examination of, *see* EXAMINATION OF PATENT APPLICATIONS
- filing dates, 1.2.1.1 (15)
- generally, 1.2 (15)
- misrepresentation, 8.3 (661)
- patent prosecution highway, 1.2.1.4 (18)
- patentability, criteria for, *see* PATENTABILITY

PATENT CLAIMS, 1.2.3.2 (28) *see also* CONTENTS OF PATENT APPLICATION**PATENT PROCEDURE**

- filing application, 1.3 (31)
- filing date, 1.3.1 (31)
- public disclosure, 1.3.3 (31)
- serial number, 1.3.2 (30)

PATENT SYSTEM

- Canada, 1.1 (3)
- patent, defined, 1.1.1 (3)
- purpose of, 1.1.2 (6)
- patent theory, 1.1.3 (7)

PATENT THEORY

- exploration control theory, 1.1.3.4 (10)
- induce commercialization theory, 1.1.3.2 (9)
- information disclosure theory, 1.1.3.3 (9)
- invention motivation theory, 1.1.3.1 (8)

PATENTABILITY

- criteria for, 1.2.2 (19)

- inventiveness (non-obviousness), 1.2.2.4 (25)
- novelty, 1.2.2.2 (22)
- patentable subject matter, 1.2.2.1 (19)
- utility, 1.2.2.3 (23)

PATENTABLE SUBJECT MATTER

- “art”, 2.1.2 (45)
- “composition of matter”, 2.1.6 (46)
- computer implemented inventions, 2.2.4 (76)
- invention defined, 2.1.1 (44)
- known compounds and process, new uses for, 2.2.1 (47)
- life forms, 2.2.3 (70)
- “machine”, 2.1.4 (46)
- “manufacture”, 2.1.5 (46)
- methods of medical treatment, 2.2.2 (49)
- patentable, what is, 2.1 (44)
- statutory provisions, 2.2.1 (47)
- “process”, 2.1.3 (45)
- United States, 2.1.7 (46)

PATENTED MEDICINES (NOTICE OF COMPLIANCE) REGULATIONS

- appeals, 10.5 (809)
- conclusion, 10.9 (813)
- damages (Section 8), 10.8 (812)
- liability, 10.8.3 (812)
- parties, 10.8.2 (812)
- impeachment proceedings, 10.6.1 (810)
- infringement proceedings, patents not on Patent Register, 10.6.2 (810)
- issuance of (Section 7), 10.7 (811)
- overview, 10.1 (789)
- Patent List and s. 4 of Regulations, 10.2 (794)
- listing, timing requirements for, 10.2.1 (795)
- qualifying patents, 10.2.2 (795)

PATENTED MEDICINES (NOTICE OF COMPLIANCE) REGULATIONS — (*cont'd*)

- *Regulations*,
- • 2017 amendments, 10.1.3 (793)
- • background and purpose, 10.1.1 (789)
- • mechanics of, 10.1.2 (792)
- section 6 proceedings, 10.4 (802)
- • case management, 10.4.4 (807)
- • discovery/pre-trial steps, 10.4.6 (808)
- • initiation of an action, 10.4.3 (805)
- • motion to strike, 10.4.5 (808)
- • notice of allegation, 10.4.1 (802)
- • receipt and response to NOA, 10.4.2 (803)
- • trial of the action, 10.4.7 (809)
- submission for Notice of Compliance and s. 5 of *Regulations*, 10.3 (801)

PERSON SKILLED IN ART

- expert evidence, 5.10.4 (286)
- identifying, 5.10.1 (270)
- notional person, 5.10.2 (271)
- qualities and capabilities, 5.10.3 (276)
- • ordinary skill, 5.10.3.3 (278)
- • other, 5.10.3.8 (285)
- • practical interest, 5.10.3.2 (277)
- • reasonably diligent, 5.10.3.5 (284)
- • seeking success, 5.10.3.7 (285)
- • sufficient skill, 5.10.3.1 (276)
- • unimaginative, 5.10.3.4 (281)
- • willing to understand, 5.10.3.6 (285)

PLEADINGS, *see also* LITIGATION

- attack of, 9.2.5 (709)
- close of, 9.2.6 (719)
- counterclaim, 9.2.4 (708)
- reply, 9.2.3 (708)
- settlement, offers and discussions, 9.2.6.1 (719)

- statement of claim, 9.2.1 (700)
- statement of defence, 9.2.2 (706)
- striking of pleadings (timing issues), 9.2.5.1 (709)

PRE-TRIAL MATTERS, *see also* LITIGATION

- bifurcation, 9.4.3 (744)
- costs, security for, 9.4.1 (737)
- expert evidence, 9.4.5 (745)
- notice to admit, 9.4.4 (745)
- pre-trial conference, 9.4.6 (750)
- severance of issues, 9.4.3 (744)
- summary judgment, 9.4.2 (738)
- summary trial, 9.4.2 (738)

PRIOR ART, *see also* INVENTIVENESS

- age of prior art, 5.9.3.9 (265)
- all of relevant art, 5.9.3.2 (248)
- art after relevant date, 5.9.3.4 (252)
- art cited in patent, 5.9.3.3 (251)
- assessing obviousness, 5.9 (241)
- • current *Act*, 5.9.2 (242)
- • old *Act*, 5.9.1 (241)
- • other issues, 5.9.3 (247)
- disclosure to person skilled in the art, 5.9.3.1 (247)
- expert evidence as to, 5.9.4 (268)
- how art was located, 5.9.3.7 (262)
- information outside field of person skilled in art, 5.9.3.5 (253)
- mosaic, 5.9.3.12 (266)
- nature of disclosure, 5.9.3.8 (263)
- paper references, 5.9.3.11 (266)
- person skilled in art, *see* PERSON SKILLED IN ART
- recent art, 5.9.3.10 (265)
- relevance of diligent search, 5.9.3.6 (255)

PROSECUTION OF PATENT APPLICATIONS, *see also* EX-

AMINATION OF PATENT APPLICATIONS

- amendments to patents, 1.4.4.4 (38)
- disclaimer, 1.4.4.5 (38)
- examiner, role of, 1.4.4.1 (34)
- office action, responding to, 1.4.4.2 (34)
- prosecution history estoppel, 1.4.4.6 (40)
- re-examination, 1.4.4.4 (38)
- refusal to grant patent, appealing, 1.4.4.3 (36)
- re-issue, 1.4.4.5 (38)

REISSUE OF PATENTS, *see also* LATENT DEFECTS

- appeal, 8.10.6 (693)
- certificate of board, 8.10.5 (692)
- re-examination, 8.10.1 (690)
- re-examination board, establishment of, 8.10.3 (691)
- re-examination proceeding, 8.10.4 (692)
- request for re-examination, 8.10.2 (691)

REMEDIES, *see also* LITIGATION

- aggravated damages, 9.6.7 (779)
- appeals, 9.7 (782)
- appeal book, 9.7.3 (784)
- appearance, 9.7.2 (784)
- authorities, book of, 9.7.6 (786)
- cross-appeal, 9.7.2 (784)
- hearing, requisition for, 9.7.5 (785)
- memorandum of, 9.7.4 (785)
- notice of appeal, 9.7.1 (783)
- costs, 9.6.9 (779)
- damages, 9.6.3 (765)
- burden of proof, 9.6.3.3 (767)
- compensatory damages, 9.6.3.1 (765)
- entitlement, 9.6.3.6 (773)
- *Patent Act* damages, 9.6.3.2 (766)

- post-issuance activities, re, 9.6.3.5 (768)
- reasonable compensation, 9.6.3.4 (767)
- destruction of infringing goods, 9.6.2 (765)
- injunctive relief, 9.6.1 (763)
- Anton Piller orders, 9.6.1.3 (765)
- interim injunctions, 9.6.1.1 (763)
- interlocutory injunctions, 9.6.1.1 (763)
- permanent injunctions, 9.6.1.2 (764)
- interest, 9.6.8 (779)
- orders, 9.6.11 (781)
- profits, 9.6.4 (773)
- burden of proof, 9.6.4.1 (775)
- punitive damages, 9.6.5 (777)
- settlement, offers of, 9.6.10 (781)
- special damages, 9.6.6 (778)

SECURITY INTERESTS, *see also* BUSINESS ASSETS

- legal requirements, 11.3.1 (866)
- financing licence as security interest, 11.3.1.2 (867)
- licensing collateral, 11.3.1.3 (761)
- patent or licence as object of security interest, 11.3.1.1 (866)
- perfection and priorities, 11.3.1.4 (869)
- patent securitization, 11.3.2 (871)

SOUND PREDICTION, *see also* UTILITY

- after-the-fact validation, 4.11.2 (184)
- breadth of claim, and, 4.11.3 (186)
- demonstrated utility and proper disclosure, 4.11.4 (188)
- generally, 4.11 (178), 8.5 (668)
- obviousness, 4.11.5 (190)
- predicted utility (3-part test), 4.11.1 (180)

TRIALS, *see also* LITIGATION

TRIALS — (*cont'd*)

- adducing evidence, 9.5.2 (752)
- demonstrative evidence, 9.5.2.3 (760)
- expert evidence, 9.5.2.2 (752)
- expert evidence, admissibility, 9.5.2.2.1 (753)
- opening statements, 9.5.1 (751)
- use of discovery, 9.5.2.4 (761)
- witnesses, 9.5.2.1 (752)

USING, *see also* **INFRINGEMENT**

- *Monsanto* decision, 7.2.2.1 (603)
- product of patented process of machine, 7.2.2.3 (606)
- unintended manner, 7.2.2.2 (605)

UTILITY

- assessing,
 - relevant addressee, 4.4 (143)
 - relevant date, 4.3 (142)
- burden and standard of proof, 4.12 (178)
- commercial success as evidence of, 4.10 (176)
- degree of, required, 4.5 (145)
- disclosure and, 4.7 (150)
- element of invention, 4.2 (141)
- introduction, 4.1 (140)
- inutility, grounds for, *see* **IN-UTILITY**
- predicted utility (3-part test), 4.11.1 (180)
- relevant addressee for assessing, 4.4 (143)
- relevant date for assessing, 4.3 (142)
- sound prediction and, *see* **SOUND PREDICTION**
- subject matter, relation to, 4.6 (148)

WORDS AND PHRASES, *see also***CLAIM CONSTRUCTION**

- external material, use of, 6.7.3 (509)
- dictionaries, 6.7.3.1 (510)

- file wrapper estoppel, 6.7.3.2 (512)
- foreign decisions and issue estoppel, 6.7.3.7 (520)
- other Canadian decisions on same patent, 6.7.3.6 (519)
- other patents of same owner, 6.7.3.5 (518)
- prior art, 6.7.3.3 (517)
- testimony of inventor, 6.7.3.4 (517)
- generally, 6.7 (475)
- pre-construction set-up, 6.7.1 (476)
- defendant's product, 6.7.1.4 (484)
- objective attitude, 6.7.1.3 (482)
- relevant date, 6.7.1.1 (477)
- skilled reader, 6.7.1.2 (479)
- use of language: synecdoche or metonymy, 6.7.4 (522)
- examples of, 6.7.4.1 (525)
- use of patent specification, 6.7.2 (486)
- “comprising” or “consisting of”, 6.7.2.5 (490)
- dependent claims, 6.7.2.8 (502), 6.7.2.9 (508)
- disclosure and drawings, 6.7.2.6 (494)
- other independent claims, 6.7.2.10 (508)
- patentee as lexicographer, 6.7.2.2 (487)
- patent read as a whole, 6.7.2.1 (486)
- preamble to the claim, 6.7.2.4 (489)
- use of abstract, 6.7.2.3 (489)
- use of variants clause, 6.7.2.7 (501)