



Examiners' Bulletin

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Examiners' Bulletin No. 2016-P3-B

- **Subject: New Practice (National Practice) – TT54 - Amendment After Allowance**

Who is affected:

All examiners.

Action:

When submitting an Amendment After Allowance (AAA) applicants sometimes also submit payment of the final fee. When writing letters of refusal for unacceptable AAAs, examiners will now be asked to select specific PERM options depending on 1) whether or not the applicant has submitted a final fee payment with the AAA and, if they have submitted a final fee payment, 2) whether or not the submission includes conditional instructions regarding the final fee (e.g. instructions telling exam support to apply the final fee only if the AAA is accepted). Examiners will select the correct option based on the final fee payment information provided by Exam Support in the TT54 LOB notations.

The TT54 - Amendment After Allowance map and work instructions have been updated to reflect these changes.

Information:

When requesting an AAA, applicants sometimes also submit the final fee payment. If the final fee payment is submitted along with the AAA, the applicant may have provided

conditional instructions with regard to the application of the final fee (e.g. instructions telling exam support to apply the final fee only if the AAA is accepted).

AAA not acceptable:

Where an AAA is not accepted by the examiner, these conditional instructions (or lack thereof) will affect the text of the AAA refusal letter prepared by the examiner, and will also affect how exam support treats the file.

Where the applicant has submitted the final fee along with the AAA and the AAA is not accepted by the examiner, the following will now apply:

- If the applicant provides conditional instructions indicating that the final fee is only to be applied if the AAA is accepted, the final fee will not be applied. There may be opportunity to provide a subsequent AAA as long as it is received before the expiry of the original time to pay the final fee (i.e. six months from the date of the original notice of allowance). If no subsequent AAA is provided in the original time allotted, or if the original time allotted has already passed, the application will go abandoned.
- If the applicant submits the final fee with the AAA but does **not** provide conditional instructions stating that the final fee should be applied only if the AAA is acceptable, the final fee **will be applied** by Exam Support, and the application will proceed to grant on the basis of the application at allowance without taking into account the AAA.

In order to assist examiners in preparing the correct refusal letter, the TT54 LOB notation provided by Examination Support will now include the following information:

- 1) whether or not the AAA fee was paid or, alternatively, whether or not a Generalized Authorization Statement (GAS) was provided with the AAA submission (this information was previously provided in the description of the TT54 created by Examination Support, but will now be provided in the notations);
- 2) whether or not the final fee was submitted with the AAA; and
- 3) if the final fee was submitted with the AAA, whether or not conditional instructions regarding the final fee were provided.

NOTE that two different fees are now addressed in the notations – the AAA fee and the final fee.

The description field of the task will now read “See notations” as a reminder to examiners that the information required is available in the notation.

Examiners will continue to determine the basis for AAA acceptance or refusal in the same manner as was previously provided in the work instructions and training manual. If the AAA is not accepted, the examiner will select the appropriate letter ("Amendment After Allowance - refused because no fee paid" or "Amendment After Allowance -

refused because of content") from the Letters option found under the CIPO tab in Word. Following the examiner's selection of the appropriate letter, the following new PERM options will appear:

1. **Final fee** not submitted with AAA
2. **Final fee** with conditional instructions
3. **Final fee** no conditional instructions

Examiners will determine which PERM option to select by referencing the information provided by Exam Support in the TT54 notation; after choosing the appropriate PERM option the correct letter will then automatically be generated. As is currently the case, the examiner will then create a TT63 to signal Exam Support that the AAA is not accepted and a letter needs to be mailed.

AAA acceptable:

If an AAA is accepted the examiner creates a TT55 as before. There is no change for examiners.

Contact:

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Examiners' Bulletin No. 2016-P4-B

- **Subject: Further Guidelines for Setting out a Purposive Construction (PCon) Analysis**

Who is affected:

All examiners.

Action:

The following document provides additional guidance on setting out a purposive construction analysis when examining claims for non-statutory subject-matter.

Information:

It should be noted that non-statutory subject-matter defects, utility defects and sound prediction defects can all be cited under section 2 of the *Patent Act*. The following Examiners' Bulletin deals solely with non-statutory subject-matter defects (i.e. the claims are directed to subject-matter which does not fall into one of the patentable categories of invention as defined in s2.)

It should also be noted that subsection 13.05.03 of the MOPOP states that “examiners are not required to detail in reports parts of their analysis that are not in issue”. The intent of the following practice is to simplify examination where possible while still adhering to the teachings of subsection 13.05.03 of the MOPOP.

1) When one or more claims are defective for non-statutory subject-matter under section 2

Where an examiner suspects that one or more claims may be directed to non-statutory subject-matter, the examiner must carefully construe the claims using purposive construction. If it is determined that the claims are not directed to statutory subject-matter (and are therefore defective under section 2), the problem, solution and essential elements portions of the purposive construction analysis must be set out in the examiner's report. The person of ordinary skill in the art (POSITA) and that person's common general knowledge (CGK) may be omitted in initial reports if not required, but must be included if it is clear that the examiner and the applicant disagree on the POSITA and/or the CGK. In every case, the POSITA and CGK must be included in pre-final reports and Final Actions.

If the examiner's purposive construction analysis determines that the claims are directed to statutory subject-matter, the examiner should proceed as outlined in 2) or 3) below.

As stated above, where a statutory subject-matter defect under section 2 exists, the essential elements of the claims will be identified when the purposive construction analysis is set out in the report. The novelty analysis must then be conducted *on those same essential elements*. The obviousness analysis may be undertaken on the same essential elements or on the inventive concept in a *Sanofi* four-step analysis. Where an examiner is having difficulty reconciling the essential elements of the purposive construction analysis and the inventive concept, the examiner should contact their section head and the PM- Practice.

If the examiner wants to set out an alternative analysis to show that, even if the initial purposive construction analysis is incorrect, the claims would still be defective for lack of novelty or obviousness, the examiner should set out an *alternative analysis* taking into account all of the elements of the claims. The fact that such an analysis is an alternative analysis should be clearly indicated in the report. Language along the lines of “In the alternative, if the claims were to be considered to be directed to statutory subject-matter, the following analysis shows that the claims would still be defective for [novelty and/or obviousness].”

Example:

An application is directed to a computer-implemented method of doing banking. The examiner suspects a statutory subject-matter defect and undertakes to purposively construe the claims. The examiner determines that the computer is not an essential element of the claims and that the essential elements are

disembodied method steps (which, in this scenario, happen to be CGK). The examiner sets out the problem, solution and essential elements in the report. The examiner then goes on to cite prior art showing that the essential elements (the disembodied method steps) are also anticipated.

The examiner decides that an alternative analysis is warranted in case the purposive construction analysis is later found to be incorrect. The examiner therefore adds the following line to the report: “In the alternative, if the claims were to be considered to be directed to statutory subject-matter, the following analysis shows that the claims would still be defective for obviousness.” The examiner then sets out the obviousness analysis showing that even when taking into account all of the elements of the claims (using a traditional obviousness analysis) or the inventive concept of the claims (as per a *Sanofi* four-step analysis), the claims are obvious since, in this case, it is obvious to routinely automate the CGK method. (It should be noted that it is the examiner's choice in an initial report to use a traditional obviousness analysis or to use the inventive concept for the obviousness analysis – see more on this topic below).

Note that if the essential elements that were found to be disembodied had been found novel and non-obvious, the examiner would have simply set out the statutory subject-matter defect in the report and omitted the rest. No alternative analysis could be presented in this scenario, since in the absence of a statutory subject-matter defect, the claims are considered to be directed to statutory subject-matter (i.e. the computer is essential) and are novel and non-obvious (the method steps are new and non-obvious) and are therefore allowable (assuming all other requirements of the Act and Rules are met).

2) Where all claims are directed to statutory subject-matter

Where all of the claims are directed to statutory subject-matter, the examiner *need not set out a purposive construction analysis in the report*, even at the pre-final or *Final Action* stage. The examiner can examine the claims taking into account all of the elements of the claims. The examiner would then undertake a novelty analysis on a claim by claim basis, taking into account all of the elements of a claim. The obviousness analysis may be undertaken in a traditional manner, or using the inventive concept in a *Sanofi* four-step analysis. As always, an obviousness analysis in a pre-final report or *Final Action* must be set out using the *Sanofi* four-step analysis. Where an examiner has written one or more reports on obviousness using a traditional obviousness approach and then has trouble drafting an inventive concept statement when writing a pre-final report or *Final Action*, the examiner should consult their section head and the PM-Practice.

3) All claims directed to statutory subject-matter but one or more elements are clearly non-essential

Where all of the elements of the claims are directed to statutory subject-matter but the examiner determines that one or more of the elements of the claim are non-essential, the

examiner may set out the purposive construction analysis outlining which elements are essential. If the essential elements have been identified in the report, the examiner must then undertake the novelty analysis *only on the essential elements*. The obviousness analysis may be undertaken on the same essential elements or on the inventive concept in a *Sanofi* four-step analysis. If, when examining a particular case, the examiner is having difficulty reconciling the inventive concept of the obviousness analysis with the essential elements of the purposive construction analysis, the examiner's section head and the PM-Examination Practice should be consulted.

In the case where the prior art anticipates or makes obvious all of the elements of the claims regardless of whether they are essential or non-essential, the examiner may choose to omit setting out the purposive construction analysis and instead examine the claims taking into account all of the elements of the claims.

4) Using purposive construction to construe the meaning of a term

In all cases, examiners should continue to use purposive construction to construe the meaning of any terms in the claims that are ambiguous. In order to properly construe the meaning of a particular term, the examiner may have to determine the POSITA and that person's CGK. Where this is the case, the POSITA and the CGK should be set out in the report.

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Examiners' Bulletin No. 2016-P5-B

- **Subject: Further Guidelines for Setting out a Purposive Construction (PCon) Analysis For Diagnostic Method Claims**

Who is affected:

All examiners when examining diagnostic method claims.

Action:

The following document provides additional guidance on setting out a purposive construction analysis when examining diagnostic method claims. Examiners who have or may have applications containing diagnostic method claims should familiarize themselves with the following.

Information:

The following Examiners' Bulletin deals solely with prior art defects in the context of diagnostic method claims. This document is provided to help guide examiners when faced with various scenarios.

Diagnostic method claims – all data acquisition elements anticipated and/or obvious

Apply Office practice as per PN2015-02 and *EB 2015-P13-K Further Guidelines for Diagnostic Methods – Document 1*, setting out the PCon analysis from a data analysis viewpoint. **All** data analysis elements should be taken into account in any subsequent novelty and obviousness analysis.

A s2 defect should be identified since all data analysis elements are disembodied and do not fall into a category of invention. In cases where a novelty or obviousness analysis is also set out, it should focus **ONLY** on the data analysis elements. See EB 2015-P13-K for guidance as to when a novelty or obviousness analysis should be set out.

If the applicant insists that a data acquisition problem exists, the examiner should also undertake an alternative purposive construction from a data acquisition perspective. Set out the PCon analysis from the data acquisition viewpoint and identify the problem and solution from the data acquisition viewpoint.

Problem statement (example): The problem is a need for a means to acquire data about X.

Solution statement (example): The essential elements in the claims are those that solve the identified problem and, in this case, are represented by the data acquisition steps relating to the determination/measurement of the presence of X.

All of the data acquisition elements are taken into account in the novelty and obviousness analysis. The analysis should focus **ONLY** on the data acquisition elements. Where the data acquisition elements are all CGK, the claims will be defective for anticipation and/or obviousness.

Where an examiner has written one or more reports on obviousness taking into account all of the data acquisition elements, and then has trouble drafting an inventive concept statement (in a *Sanofi* four-step analysis) when writing a pre-final report or Final Action, the examiner should consult their section head and the PM-Practice.

Diagnostic method claims – all data acquisition elements novel and inventive and otherwise allowable

Though the examiner may have done their PCon analysis in order to separate the data acquisition elements from the data analysis elements, having found all the data

acquisition elements patentable they will not have to set out the PCon analysis and they will be allowing the application (assuming all other requirements of the Act and Rules are met).

Diagnostic method claims – all data acquisition elements novel and unobvious but other defects exist with respect to the data analysis elements

The examiner should identify the other defects related to the data acquisition aspects of the claims without identifying a s2 defect. Where there are defects relating to the data analysis elements that affect the whole of the claim (for example, if the data analysis portion of the claim is unclear, or lacks an antecedent), the examiner will also identify these defects.

Diagnostic method claims – at least one novel and unobvious data acquisition element is found in a dependent claim but the data acquisition elements in the independent claims are anticipated or obvious

The examiner will set out the PCon analysis and state that the data acquisition steps are essential. The examiner will then undertake a novelty/obviousness analysis taking into account all of the data acquisition elements in each claim. Where at least some of the data acquisition elements are found in the prior art, the examiner should identify the claims which are anticipated and/or obvious. The analysis should focus ONLY on the data acquisition elements.

As at least one dependent claim contains a novel and unobvious data acquisition step, at least one claim will be found to be allowable. If the applicant amends to include the novel element in the independent claim, the application will be allowed (assuming all other requirements of the Act and Rules are met).

Where an examiner has written one or more reports on obviousness taking into account all of the data acquisition elements, and then has trouble drafting an inventive concept statement (in a *Sanofi* four-step analysis) when writing a pre-final report or Final Action, the examiner should consult their section head and the PM-Practice.

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