Innovation, Science and Economic Development Canada
Canadian Intellectual Property Office

Innovation, Sciences et Développement économique Canada
Office de la propriété intellectuelle du Canada

Examiners' Bulletin

November 2016 (2016-L)

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Examiners' Bulletin No. 2016-I9-L

- **Subject: Reminder (International Practice)** - Requesting priority documents for international applications

ACTION:

Re-familiarize yourself as to when to request a priority document from the PCT – International section

INFORMATION:

As a general rule, the examiner, in preparing a written opinion or report, should not make any investigation as to the validity of a right to priority. However, the priority document assumes importance when a P-document or E-document has been cited which is relevant to the determination of novelty or inventive step of the claimed invention (e.g. (P,X), (P,Y), (E,X) or (E,Y) documents). Recall a "P" document is one that is published prior to the international filing date but later than the priority date claimed and an "E" document is an earlier application or patent but published on or after the international filing date. In such cases the examiner must satisfy themselves that the priority date(s) claimed may be accorded to the appropriate subject matters of the claims in the international application they are examining.

You may ask the CIPO PB PCT International section to attempt to locate the priority document if all the following conditions are met:

1) You have found a (P,X), (P,Y) (E,X)or an (E,Y) document;

2) There is no "PriorityDocs" tab found in InterApp that already contains the priority document; and,

3) The priority document is not a Canadian national patent application or a Canadian PCT international application (available to you in TechSource or InterApp).

If these conditions are not met you should not e-mail the PCT – International section requesting the priority document. For more details on this issue please refer to Examiners' Bulletin No. 2016-I2-A.

REFERENCES:

i) Examiners' Bulletin No. 2016-I2-A (January 2016)

ii) ISA & IPEA Training and Reference Manual, Subsection 2.3.2 "Requesting Priority Documents" and Subsection 6.3.3 "Filling out Box II – Priority"

iii) Chapter 5.11 of Annex A –InterApp Manual "Requesting Priority Documents"

iv) International Search and Preliminary Examination Guidelines, paragraphs 6.06 and 6.17.

CONTACT:

Program Manager - International (PCT-PPH) (Elaine A. Hellyer, P.Eng.)

Examiners' Bulletin No. 2016-I8-I

- **Subject: Reminder (International Practice) -** Content of Box VIII in the WO-ISA, WO-IPEA and IPRP

WHO IS AFFECTED:

All examiners and Section Heads.

ACTION:

Examiners and Section Heads are reminded that all important observations on clarity and descriptive support must be noted in Box VIII.

INFORMATION:

Box VIII observations are limited to substantive defects in the claims, description and drawings. In deciding whether or not to include observations on these matters, due account should be given to the significance and relevance of the observations in any further processing of the application.

Examples of observations to be included are:

i) substantive Article 6 and Rule 6 objections (dealing with the claims);

ii) substantive Article 5 and Rule 5 objections (dealing with the description);

iii) a substantive Article 7 objection (dealing with the drawings);

iv) objections to the "spirit of the invention" language (PERM AAM10 under Indefinite / Ambiguous menu); and

v) incorporation by reference where the document is crucial to the understanding of the invention (PERM AIE4 under Inoperative / Enablement menu).

Article 7 objections should be included when drawings are required because they are necessary for the understanding of the invention or when drawings do not adequately provide for the illustration of the invention. Other drawing objections in the PERMs address formality requirements under Rule 11 and should be placed in Box VII and not Box VIII.

A common error made by examiners is that observations that should be made in Box VII are being placed in Box VIII and vice versa. To assist examiners with the proper placement of observations the International PERMit! menu identifies which Box in the WO-ISA, WO-IPEA and IPRP each PERM paragraph should be placed.

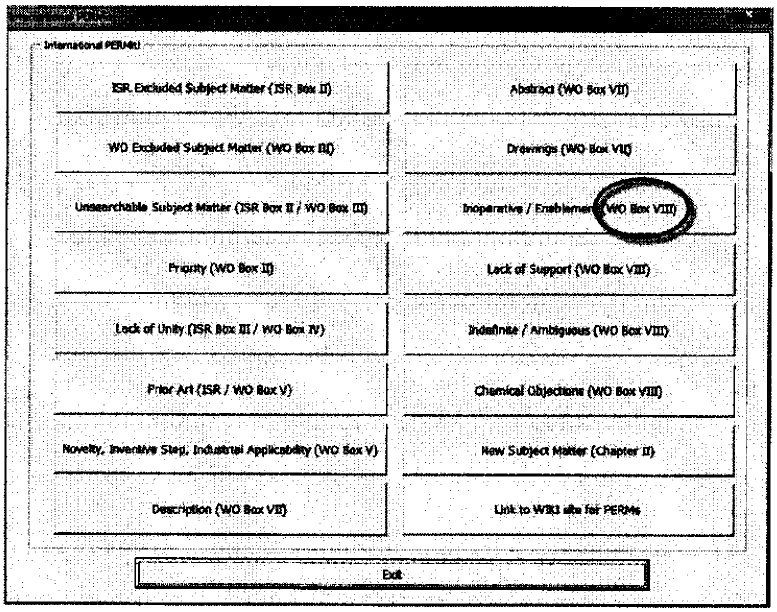

Figure 1 – PERMit! menu with identification of correct WO Box number

REFERENCES:

i) ISA & IPEA Training and Reference Manual, Subsection 6.3.9 "Filling Out Box VIII - Certain Observations;

ii) Patent Cooperation Treaty, Articles 5-7;

iii) PCT Regulations, Rules 5 and 6; and,

iv) PCT International Search and Preliminary Examination Guidelines, Chapters 4, 5 & 17

CONTACT:

Program Manager – International (PCT-PPH) (Elaine A. Hellyer, P.Eng.)

Examiners' Bulletin No. 2016-P25-L

- **Subject: Information (National Practice)** – New purposive construction perm for agent responses

WHO IS AFFECTED:

All examiners.

ACTION:

Examiners can use a new perm when responding to an agent's assertion that the Office has misinterpreted the jurisprudence regarding purposive construction analysis (denoted as Purposive Construction – Responses in the PERMit! menu).

INFORMATION:

The new Purposive Construction – Responses perm is employed when an agent argues, in a response to an examiner's Office Action, that the Office has misinterpreted the jurisprudence regarding purposive construction and thus a purposive construction analysis presented by the examiner is invalid.

The perm allows the examiner to tailor their response depending on the subject matter of the claims being examined. Two of the options refer to practice notices specific to medical diagnostic methods (PN 2015-02) and computer-implemented inventions (PN 2013-03), while a third option refers to a generic practice notice regarding purposive construction. It is noted that all three options refer to the generic practice notice regarding purposive construction (PN2013-02), as well as Chapter 13 of MOPOP.

As with all of the purposive construction perms, this new perm should be used in the introduction of the report - above the line "The examiner has identified the following defects in the application:". Furthermore, this perm

should always be used in conjunction with a detailed explanation of the specific purposive construction analysis in question. This explanation can be inputted in the text box provided in the perm and/or in one of the existing purposive construction analysis perms which can be launched directly from within the new perm.

Additional details of this new perm, including a screenshot and information regarding its use, can be found in the Perm Updates section of the Perm Wiki pages.

CONTACT:

PERM Coordinator (Stephen Decker)

Examiners' Bulletin No. 2016-P24-L

- **Subject: New Guidance (National Practice)** – Expressions Raising Uncertainty

WHO IS AFFECTED:

All examiners and section heads.

ACTION:

An examiner should always write a report identifying a lack of clarity defect when certain expressions raising uncertainty are present in a claim. When other expressions potentially raising uncertainty are present in a claim, the facts of the case will indicate whether a report should be written.

INFORMATION:

When examining a national application, certain expressions raising uncertainty in a claim are always defects (examples are "such as", "or the like", "for example", "e.g", "of the character described", "as herein described", "especially", "in particular", "more or less", "preferably"). Expressions containing a combination of indefinite terms, for example, "at least about" or "about at least" are inherently ambiguous, especially when used in a range, and would be objectionable (EB 2011-T9-J). These defects should be identified in any report, including reports where the expression would be the sole defect. Any report or allowance for an application will fail QC if these expressions are present in a claim and no defect relating to these expressions is identified in the report.

Other expressions potentially raising uncertainty *may* be defects (examples are "a major part", "about", "an active ingredient", "at least", "including", "approximately", "and/or", "i.e"[i], "if desired", "optionally", "when required", "not being", "not requiring", "substantially", "generally", "essentially", "thin", "strong", "containing as an active ingredient"[ii] and "therapeutically effective amount"[iii]). During QC, these expressions should be handled case-by-case relying on the examiner's judgement in conversation with the section head. QC relating to these latter expressions should reflect the contextual nature of the expressions, bearing in mind that terms should be construed with a mind willing to understand. Notwithstanding the above, expressions should generally be accorded their associated meanings within the arts in which they relate. For example, "thin" in

"thin film chromatography" or "strong" in "strong magnetic field" or "strong promoter" would be acceptable in certain arts. In all situations where there is doubt, MOPOP Chapter 11.03.02 should be consulted.

BACKGROUND:

Last summer, the QC Lean project conducted a survey of section heads (and actors) on how they assess expressions raising uncertainty. The results of the survey clearly illustrate that there is highly inconsistent practice and that examiners are given mixed messages through their QC results on the proper practice related to this defect.

To increase consistency of examination and QC within the Office, it is imperative to identify a first category of expressions raising uncertainty which would be objected to at all stages of prosecution and a second category which *may* be considered acceptable, these being dealt with on a case-by-case basis.

This practice stems from decisions made at the Patent Policy and Practice Committee meetings of June 21, September 28 and October 26, 2016.

CONTACT:

Program Manager - Practice (Jeremy McLean - Acting)

Notes:

1. When used correctly, the term "i.e." which means "that is" is acceptable, however, if its presence creates ambiguity, a defect should be identified.

2. The phrase "containing as an active ingredient" should, in some circumstances, be identified as defective for being indefinite because "an" implies the presence of other unspecified active ingredients in addition to the one specified in the claim. This phrase may be acceptable in a claim if "an" is changed to "the" and the other ingredients of the composition are specified.

3. The functional phrase "therapeutically effective amount" should only be permitted in a composition of matter claim when the utility of the composition of matter is indicated in the claim and provided that the actual amount taught and prescribed in the disclosure is not an important aspect of the invention.

Purposive Construction – Responses

5. Office's Interpretation

The applicant's response to the report of {date} has been carefully considered but the arguments presented by the applicant are not persuasive. The examiner has been guided by the Office's examination practice as set out in

{ ❍ PN2015-02 *Examination Practice Respecting Medical Diagnostic Methods*

❍ PN2013-03 *Examination Practice Respecting Computer-Implemented Inventions*, which takes into account the general guidance on purposive construction introduced in PN 2013-02 *Examination Practice Respecting Purposive Construction*

❍ PN 2013-02 *Examination Practice Respecting Purposive Construction* },

which is now incorporated into Chapter 13 of the Manual of Patent Office Practice (MOPOP). This(ese) practice notice(s) and the MOPOP detail the Canadian Intellectual Property Office's interpretation of the relevant jurisprudence.

As outlined in the previous report: {Explain and/or select one of the Further Purposive Construction Analysis options below

Note: *Selecting one of the following options will launch that macro for further analysis*

❍ Short	❍ Data Acquisition (Diagnostic Methods)
❍ Long	❍ Data Analysis (Diagnostic Methods) }

English follows French

Interprétation téléologique – réponses

5. L'interprétation de Bureau

La réponse du demandeur au rapport en date {date} a été examinée avec attention, mais les arguments présentés par le demandeur ne sont pas convaincants. L'examinateur s'est fondé sur la pratique d'examen du Bureau qui est énoncée dans l'avis

{ ❍ PN2015-02 *Pratique d'examen concernant les méthodes de diagnostic medical,*

❍ PN 2013-03 *Pratique d'examen au sujet de l'interprétation téléologique,*

lequel tient compte des directives générales sur l'interprétation téléologique présentées dans l'avis PN 2013-02 *Pratique d'examen au sujet de l'interprétation téléologique*,

❍ PN 2013-02 *Pratique d'examen au sujet de l'interprétation téléologique*,}

qui fait maintenant partie intégrante du chapitre 13 du Recueil des pratiques du Bureau des brevets (RPBB). Cet(s) avis de pratique et le RPBB énoncent en détail l'interprétation que fait l'Office de la propriété intellectuelle du Canada de la jurisprudence pertinente.

Tel qu'indiqué dans le rapport précédent: {Expliquer et/ou choisir l'une des options d'interprétation téléologique ci-bas pour poursuivre l'analyse

Remarque: *Lorsque les mêmes arguments sont maintenus, le paragraphe suivant devrait être utilisé*

❍ Court

❍ Long (avec l'identification de la PVA et des CGC)

❍ Acquisition de données (Méthodes de diagnostic)

❍ Analyse de données (Méthodes de diagnostic) }

Purposive Construction – Responses

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❍ Long
❍ Data Acquisition (Diagnostic Methods)
❍ Data Analysis (Diagnostic Methods) }