



## Canadian Patent Office Issues Guidance to “Cooperate” With Inventors of Computer-Based Inventions

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To be patentable, an invention must meet four main criteria: it must be new, it cannot be obvious, it must be useful and, crucially, it must fall within the definition of “invention” in the *Patent Act*. The last element can be a sticking point for some types of inventions, particularly those involving computer software (including AI) or business methods. For instance, the Patent Act specifically prohibits patents for “any mere scientific principle or abstract theorem,” and software and business method inventions often are alleged to fall within one of those categories. In 2013, following a decision involving the Amazon.com “1-Click” patent, the Canadian Intellectual Property Office (CIPO) developed guidance for evaluating whether the subject matter of patent applications meets the definition of “invention.” That guidance involved a so-called “problem-solution” approach described in more detail below. In the recent *Yves Choueifaty v. Attorney General of Canada* decision<sup>1</sup>, however, the [Federal Court has clarified](#) that the novel “problem-solution” approach to claim construction utilized by CIPO is incorrect in law. The decision emphasizes that “purposive construction,” as outlined by the Supreme Court of Canada in *Free World Trust*, is the correct method for construing claims by CIPO Examiners during patent prosecution.

In response, CIPO has now published a practice notice – a guidance document for patent examiners – to aid in correctly applying purposive construction. While *Choueifaty* did not specifically delve into what constitutes patentable subject matter, the practice notice does also provide guidance on this topic. Therefore, the notice undoubtedly will have significant implications for patentable subject matter, particularly in the fields of artificial intelligence and other computer-implemented inventions, [medical diagnostic methods and medical uses](#).

Under the previous “problem-solution” approach to claim construction, when applied to computer-implemented inventions, CIPO examiners often would characterize the problem in a narrow manner that rendered the computer and related hardware claim elements non-essential, and therefore disregarded. The remaining elements would then be classified as an abstract theorem or scientific principle, and thus excluded from patentability.

The practice notice outlines that CIPO examiners must apply the purposive construction test as set out in *Free World Trust*<sup>2</sup>. That is Examiners must consider the entirety of the specification and determine what a person skilled in the art would have determined the nature of the invention to be. All claim elements are to be presumed essential, until shown otherwise. Additionally, the practice notice categorically states that any claim construction that looks only at the so-called “substance of the invention” is incorrect. Despite this, the notice attempts to distinguish between elements deemed essential for establishing the boundaries of a patent monopoly, and those involved in the patentable subject matter analysis. In so doing, the practice notice goes on to describe an “actual invention” analysis in which even those elements deemed essential using purposive construction *would not form part of the actual invention because the fact that it has no material effect on the working of the invention means it does not cooperate with other elements of the claimed invention*” (emphasis added).

Citing the Federal Court of Appeal’s 1982 decision in *Schlumberger v Canada* (Commissioner of Patents), [1982] 1 F.C. 845 (FCA), the notice states that “[i]f a computer is merely used in a well-known manner, the use of the computer will not be sufficient to render the disembodied idea, scientific principle or abstract theorem patentable subject-matter.” Further, the practice notice asserts that an abstract idea “must cooperate with other elements of the claimed invention so as to become part of a combination of elements making up an actual invention.” This approach appears to resemble that used in the United States, where examiners are directed to consider whether an abstract idea is sufficiently “integrated into a practical



application” and where additional elements – such as a computer – must be meaningful limitations that provide more than “extra-solution activity.”

Taken at face value, the new guidance is a welcome development. For examiners, it provides a reasonably clear roadmap for assessing patentable subject matter. For applicants, the new guidance gives hope that computer-implemented inventions will be considered more holistically. Specifically, all computer elements of an invention should now be considered for the purposes of assessing subject matter, so long as they “cooperate with other elements” to form the “actual invention.” There remains a risk, however, that under the new guidance examiners will continue to disregard computer elements of claims that they deem insufficiently connected to the “actual invention.” It remains to be seen how the guidance will be implemented in the coming months.

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<sup>1</sup> *Yves ChouEIFaty v Attorney General of Canada*, 2020 FC 837 [*ChouEIFaty*]

<sup>2</sup> *Free World Trust v Électro Santé Inc*, 2000 SCC 66 [*Free World Trust*].

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