



# Federal Court Unwraps Foreign File Wrapper in Canadian Patent Litigation

October 7, 2019

By Amrita V. Singh and Shuo Xing

Historically, file wrappers – the back and forth with the Patent Office in a patent application file – were irrelevant and inadmissible in Canadian patent construction. This allowed the Court to focus when construing a patent on the actual language of the claims in the issued patent, while avoiding “opening the Pandora’s box of file wrapper estoppel.” This bar to file wrapper estoppel in Canadian claim construction distinguished Canada from the United States, where prosecution history estoppel was intended “to hold the inventor to the representations made during the application process... by amending, the inventor is deemed to concede the patent does not extend as far as the original claim.”

## Canada Introduces File Wrapper Estoppel

In late 2018, the Canadian Federal government amended the *Patent Act* to add section 53.1, which allows written communications between the patentee and Patent Office during patent prosecution to be admitted into evidence to rebut representations made by the patentee in litigation regarding claim construction.

On September 25, 2019, the Federal Court applied section 53.1 to for the first time in Canada<sup>3</sup>. In *Canmar Foods Ltd v TA Foods Ltd*, the patentee Canmar Foods brought a patent infringement action against TA Foods for alleged infringement of Canmar Foods’ patent, which claimed a method for roasting oil seed.

TA Foods argued that its roasting process differed from the patented method because it did not heat its flax seeds in a “stream of air” or maintain the seeds in an “insulated roasting chamber or tower”. TA Foods submitted because these two elements were added intentionally during the Canadian patent prosecution, they became essential elements of the claims. TA Foods claimed the American prosecution history was incorporated into the Canadian prosecution history by reference, because Canmar Foods acknowledged in correspondence to the Patent Office that the amendments in the U.S. had overcome novelty and obviousness rejections.

Specifically, during Canadian prosecution, Canmar Foods had acknowledged that the amended claims “correspond substantially to those submitted during prosecution of a related United States application<sup>4</sup>. Canmar Foods continued, explaining the newly submitted claims were “much narrower in scope than the previously examined claims in view of the introduction of significant limitations derived from the description and previous dependent claims” and “encompass[ed] both novel and non-obvious subject matter<sup>5</sup>”.

## File Wrapper Estoppel in Canadian Claim Construction

Justice Manson of the Federal Court held that with new section 53.1, claim construction in Canada now has three prongs: (1) the claims; (2) the disclosure; and (3) the [Canadian] prosecution history<sup>6</sup>. The Court observed that while ordinarily only Canadian prosecution history is admissible for claim construction (the language of section 53.1 makes no reference to prosecution histories from other jurisdictions<sup>7</sup>), under extraordinary circumstances, foreign prosecution histories may also be admissible. The Court held that the intended effect of the new provision is to allow the Court to consider “the substance behind intentional amendments to the claims<sup>8</sup>”.

## What is “extraordinary”?

In considering what constitutes extraordinary circumstances that would allow the Court to consider foreign prosecution



histories, Justice Manson held that where “the patentee acknowledges that the claims have been amended to be substantially the same as claims submitted in another jurisdiction, *and* the patentee admits that the amendments have limited the scope of the claims in order to make the claims novel and non-obvious” (emphasis in the original)<sup>9</sup>, the Court should be able to look to the other jurisdiction’s prosecution history for the limited purpose of purposively construing the Canadian claims.

The Court commented that if section 53.1 is interpreted to exclude foreign prosecution history where limitations are made to overcome novelty and obviousness objections, Canadian patentees would be incentivised to refrain from explaining amendments to the Canadian Patent Office, relying instead on corresponding co-pending foreign applications. In the Court’s view, this would be contrary to the intent of section 53.1.

After noting Canmar Foods had specifically referenced the corresponding US application and acknowledged its amendments to the Canadian claims were to overcome novelty and obviousness concerns in the US prosecution, the Court held the US prosecution history admissible. The amendments to add “stream of air” and “insulated roasting chamber or tower” to claim 1 of the patent were accordingly seen to be essential elements, and the Court refused to construe the patent to include variants without those essential elements.

#### Patent Prosecution post-Canmar

Patent applicants should keep the *Canmar* decision in mind when submitting claims from a corresponding foreign application during prosecution of their Canadian applications, including as part of a request for expedited examination under the Patent Prosecution Highway. There are many factors to be considered, such as balancing the advantages of potentially simplifying the examination of a Canadian patent application versus the risk of bringing foreign prosecution into any hypothetical future patent litigation.

---

<sup>1</sup> *Free World Trust v Électro-Santé Inc*, [2000] 2 SCR 1024 at para 66.

<sup>2</sup> *Festo Corp v Shoketsu Kinzoku Kogyo Kabushiki Co Ltd*, 535 US 722 (2002) at 737-738.

<sup>3</sup> *Canmar Foods Ltd v TA Foods Ltd*, 2019 FC 1233 [*Canmar*].

<sup>4</sup> Office Action Response to CIPO dated August 24, 2012 at page 2, for Canmar Foods’ Canadian Patent Application No. 2,582,376.

<sup>5</sup> *Canmar* at para 86.

<sup>6</sup> *Canmar* at para 68.

<sup>7</sup> *Canmar* at para 62.

<sup>8</sup> *Canmar* at para 71.

<sup>9</sup> *Canmar* at para 74

Content shared on Bereskin & Parr’s website is for information purposes only. It should not be taken as legal or professional advice. To obtain such advice, please contact a Bereskin & Parr LLP professional. We will be pleased to help you.