

NEWSLETTER



REFLEXIONS

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The Champs-Elysees, Paris at night.

AIPPI-The Upcoming 2010 Congress in Paris

In less than a month from now a significant contingent of Canadians will be heading to AIPPI's 42nd World Intellectual Property Congress in Paris, France.

There are a record number of Canadian members of AIPPI attending the Paris Congress. A special social meeting of the Canadian members in Paris will be held at the Café de l'Homme, on Sunday October 3 between 4:15 and 6:30 PM. Libations and nibbles will complement the spectacular view of the Eiffel Tower and the grounds of the Palais de Chaillot.

While there is some time set aside for cultural events with colleagues from around the globe, the meeting is at its heart a working meeting. The objective of AIPPI is improving and promoting intellectual property protection on a national and international basis. It does this by conducting studies of existing national laws with a view to finding ways to achieve international harmonisation of those laws.

This year the Congress will be addressing five issues in Paris:

- Q204P Liability for Contributory Infringement of IPRs – certain aspects of patent infringement

This study arises as a result of the Boston Resolution of AIPPI and will examine which acts can be established as contributory infringement and in what conditions and what happens when the acts contributing to the infringement happen in different countries. Bruce Morgan (who will be the representative in the Working Committee), Warren Sprigings, Alfred Macchione, Chris Bown and Hui Wu answered on behalf of AIPPI Canada.

- Q213 The role of the skilled person in the context of the inventive step requirement regarding validity and infringement in patent law.

This question focuses upon the role of the skilled person (person of skill in the art) in the process of granting or invalidating a patent. It will also address the central role the skilled person plays in claim construction and thus infringement of granted rights. Thomas Adams, Kazim Agha, Christian Bérubé, Isabelle Chabot, Keya Dasgupta, Bill Mayo (who will be the representative in the Working Committee), Bradley White prepared the report for the Canadian group.

- Q214 Protection against the dilution of a trade mark

Steven Garland and Tracy Corneau (who will both act as representatives in the Working Committee) prepared the Canadian report on this topic. The report looks at the provisions and remedies, including interlocutory remedies, available to protect a mark's inherent selling power against the lessening of the capacity of a mark to identify and distinguish goods and services whether or not there is a likelihood of confusion.

- Q215 Protection of Trade Secrets through IPR and Unfair Competition Law

Motivated by the increased movement of people and technology across international borders AIPPI is looking towards standards or guidelines for effective international protection of trade secrets. As a first step in that direction this study looks at the protections available for trade secrets, including non-compete and non-disclosure agreements, in each jurisdiction. The report on the Canadian jurisdiction was prepared by Fred Barbieri (who will be the representative in the Working Committee), Curtis B. Behmann and Ivan C. Fong.

- Q216 Exceptions to copyright protection and the permitted uses of copyright works in the hi-tech and digital sectors

Alfred A. Macchione (who will be the representative in the Working Committee), France Coté, Fraser D. Rowand and Curtis B. Behmann prepared a report for AIPPI Canada addressing issues of copyright exception or permitted uses particularly in the context of the Internet, databases, search engines, on-line social networking sites, file sharing and the digital music industry. The work on this topic will continue with a second set of issues to be addressed at the AIPPI Forum and Exco meeting in Hyderabad in 2011.

The work of AIPPI was recently recognised in a decision of the Federal Court of Canada. In that decision (*Merck & Co. v. Pharmascience Inc.*, 210 FC 510) the work of the Canadian group of AIPPI on question 213, “the role of the skilled person in the context of the inventive step requirement regarding validity and infringement in patent law” was used as a starting point by the Court from which the litigants could make their arguments in the particular context of the case.



Versailles orangerie, France

Canadian IP Law Update

Consistent Claim Construction Makes the Difference

Earlier this year, the Federal Court in *Janssen-Ortho Inc. et al. v. The Minister of Health & Novopharm Limited*, 2010 FC 42 issued reasons providing more guidance to litigants about claim construction in the face of contradictory expert evidence. The decision was in an Application pursuant to the PM(NOC) Regulations to prohibit the Minister of Health issuing a Notice of Compliance.

The fundamental dispute between the parties was described as the competition between two apparently opposing legal maxims that have been a part of patent law in Canada for more than one hundred years. On the one hand, there is the rule that a patent "must be read by a mind willing to understand, not by a mind desirous of misunderstanding:" *Lister v. Norton Brothers and Co.* (1886), 3 R.P.C. 199 (Ch. D.) at p. 203. On the other hand, there is the rule that a claim in a patent is not to be treated "like a nose of wax which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express:" *White v. Dunbar*, 119 U.S. 47 (1886) at pp. 51-52.

The parties disagreed on the proper approach to claim construction. The Applicants accused the Respondent of excessive literalism and alleged the Respondent had: (i) failed to approach the patent with a mind willing to understand; (ii) failed to consider the patent's inventive concept; and (iii) failed to consider the entire disclosure in arriving at its construction. The Respondent alleged the Applicants had ignored the clear language of the claims and had relied upon a "spirit of the invention" approach, and had picked words or phrases from the disclosure and imported them into the claims, when those words or phrases did not exist in the language of the claims. The Court in response set out the following principles and approach to claim construction:

- Construction by the person skilled in the art (PSIA) is limited to the four corners of the patent document based on his or her common general knowledge at the relevant date;
- As the role of the expert is not to interpret the claims but to put the trial judge in a position of being able to do so in a knowledgeable way, it is dubious that the direction on patent construction provided to an expert will result in an opinion that is to be preferred to the opinion of an equally qualified expert who has not been given such instruction;
- The phrase "mind willing to understand" simply means the claims must be construed in a manner that is fair to the inventor whose expertise is not language but the science that underlies the invention;
- The whole of the specification (including the disclosure and claims) may be examined to ascertain the nature of the invention. Where the words of the claims are plain and unambiguous and capable of only one interpretation by a PSIA, recourse to the disclosure is unnecessary;
- Recourse may be had to the disclosure for the purpose of confirming the interpretation arrived at from examining the claims alone or to disclose an ambiguity in the language of the claims that was not otherwise evident;
- When one looks beyond the language of the claims at issue one ought first to look at the dependent claims as an aid to interpreting the independent claims, before one resorts to the disclosure – there must be consistency between dependent and independent claims;
- If one considers the disclosure before considering the dependent claims, one runs a risk of forming an opinion as to the proper construction of the independent claims based on the content of the disclosure when that interpretation is not supported by or may, in fact, be contrary to the dependent claims.
- One should not reach a firm conclusion as to the meaning of the words in the claims being construed without having tested one's initial interpretation against the words of the disclosure. If the disclosure suggests another interpretation of the terms used in the claims, then resort to the meanings given in the disclosure is proper, subject to the proviso that the invention that is protected is what is expressed in the claims which cannot be added to by anything mentioned in the disclosure that has not found its way into the claims as drafted.
- Where two possible interpretations of a patent are available, but only one produces a

novel invention, that interpretation is to be preferred.

In this case the Court found that none of the experts took the proper approach to claim construction.

News from CIPO and the Canada Gazette

- As part of the Patent Branch's Quality Management System (QMS) implementation initiative, standards are defined for both international and national examination of patent applications. Quality standards for both International Search and Examination, and National Examination are now available on the [Patent Examination Quality Standards](#) page.
- The Minister of Industry proposes that a number of geographical indications be entered on the list of geographical indications kept pursuant to subsection 11.12(1) of the Trade-marks Act (<http://www.gazette.gc.ca/rp-pr/p1/2010/2010-09-04/html/notice-avis-eng.html#d101>)
- The rules committee of the Federal Court of Appeal and the Federal Court, pursuant to section 46 of the Federal Courts Act annexed Rules Amending the Federal Courts Rules in respect of Expert Witnesses. These Rules are now in force.

A Word from the Editor

Suggestions for content or notices are welcome and can be submitted electronically to the editor, Michael Crinson at mcrinson@dimock.com. When proposing content or notices please bear in mind the objective of AIPPI which is to improve and promote the protection of intellectual property on both an international and national basis. It pursues this objective by working for the development, expansion and improvement of international and regional treaties and agreements and also of national laws relating to intellectual property.

Future Events

October 3-6, 2010	AIPPI Congress	Paris, France
October 13-15, 2010	IPIC Annual Mtg	Quebec, Canada
October 21, 2010	AIPPI Annual Mtg	Washington, USA
November 10, 2010	AIPPI Canada AGM	University Club, Montreal
October 14-19, 2011	AIPPI Forum & ExCo	Hyderabad, India
October 20-24, 2012	AIPPI Congress	Incheon, Rep. of Korea
October 2013	AIPPI Forum & ExCo	Helsinki, Finland
October 2014	AIPPI Congress	Toronto, Canada