OSLER

Canadian patent office issues guidance on computer-implemented and medical inventions following Choueifaty decision

NOVEMBER 10, 2020 4 MIN READ

Related Expertise

- Intellectual Property
- Pharmaceuticals and Life Sciences

Authors: J. Bradley White, Nathaniel Lipkus, Geoffrey Langen

As we have previously reported, in the recent decision of the Federal Court in *Yves Choueifaty v Attorney General of Canada*, 2020 FC 837 (*Choueifaty*), the Court rejected the Commissioner of Patents' "problem-solution" approach to interpreting patent claims, re-emphasizing that patent claims must be interpreted using purposive construction for all purposes, including assessing subject-matter eligibility.

On November 3, 2020, as a result of *Choueifaty*, the Canadian Intellectual Property Office (CIPO) has issued new guidance entitled "Patentable Subject-Matter under the *Patent Act*" explaining how CIPO intends to apply *Choueifaty*.

CIPO's new guidance is meant to supersede current guidance present in the *Manual of Patent Office Practice* (MOPOP) when determining patentable subject-matter for computer-implemented inventions, medical diagnostic methods and medical uses. In particular, the sections of chapters 12, 17, 18, 22 and 23 of MOPOP that reference the contribution of a claim, a technological solution to a technological problem, and the problem and solution approach to the identification of essential elements should no longer be applied.

Approach to determining patentable subject-matter

CIPO's guidance document provides a substantially revised approach to determining whether a claim is patentable subject-matter:

1. Purposively construe the claims to determine the essential and non-essential elements of the claim. All elements set out in a claim are presumed to be essential unless it is established otherwise or is contrary to the language used in the claims.
2. Identify the "actual invention" of the claims.
3. The claims must be limited to or narrower than the "actual invention" that either has physical existence or manifests a discernible physical effect or change and that relates to the manual or productive arts, meaning those arts involving or concerned with applied and industrial sciences.

The "actual invention" of a claim in step two is not necessarily identical to the purposively construed claim in step one. Only those elements of a claim that provide a solution to a problem are a part of the "actual invention."

Computer-implemented inventions

According to CIPO's guidance document, a claim will not necessarily be patentable subject-matter if a computer is an essential element. To be patentable subject-matter, the computer must co-operate with other elements of the claimed invention, and the "actual invention" must have a "physical existence or [manifest] a discernible physical effect or change and [relate] to the manual or productive arts."

In a claim to a computer that runs an algorithm, the computer will be considered part of the "actual invention" that solves a problem related to the manual or productive arts if the algorithm improves the functioning of the computer. A computer that processes an algorithm in a well-known manner and does not solve a problem in computer functionality will not be considered patentable subject-matter. Furthermore, a business method does not become patentable subject-matter merely because it is implemented using a computer.

Medical diagnostic methods

Claims to medical diagnostic methods that include an abstract idea as an element may constitute patentable subject-matter if the abstract idea co-operates with the other elements of the claim making up a single actual invention that either has physical existence or manifests a discernible physical effect or change. According to CIPO's guidance document, one example of patentable subject-matter would be a claim to a diagnostic method where the elements of the claim co-operate together and includes physical means for testing the presence or quantity of an analyte.

Medical uses

A claim to a medical use would be patentable subject-matter if the actual invention has a physical existence or manifests a discernible effect or change, provided the actual invention does not include a medical treatment step or surgical step that restricts, prevents or interferes with the exercise of the professional skill and judgment of a medical professional.

Examples of the patentable subject-matter for each type of claim analysis are provided with CIPO's guidance document.

Key takeaways

The practical impact of CIPO's new guidance remains to be seen. The proper identification of essential elements by CIPO is likely to increase approvability of patents in general. However, the inclusion of problem-solution language and introduction of the concept of an "actual invention" may diminish the impact of *Choueifaty* for computer-implemented inventions. The authors sincerely hope that *Choueifaty* and CIPO's subsequent guidance will provide the increased predictability, clarity and fairness that the decision portends, as CIPO begins to apply the guidance in all three important subject-matter categories.

The authors, Nathaniel Lipkus and Geoff Langen, successfully represented the Appellant before the Federal Court in *Choueifaty* and recently discussed this decision in their article "Federal Court clarifies Canadian approach to subject-matter eligibility for computer patents."