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Federal Court of Appeal infuses greater certainty into the Canadian obviousness analysis

NOVEMBER 23, 2017 3 MIN READ

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What is "inventive" for the purpose of obtaining a patent? Since 2008, Canadian courts have applied the four-step analysis known as the *Windsurfing/Pozzoli* framework to determine the all-important question of obviousness. In a newly released decision, however, the Federal Court of Appeal suggests that trial courts may have strayed too far from the correct application of this obviousness framework. What impact the Court of Appeal's admonishments will have on future cases remains to be seen, but they will likely bring more certainty to the Canadian law of obviousness.

In *Ciba Specialty Chemicals Water Treatments Limited v SNF Inc.*, 2017 FCA 225 (*Ciba Specialty*), the Federal Court of Appeal held that the trial judge had erred in his application of the *Windsurfing/Pozzoli* framework, but that he had nonetheless come to the right conclusion about the obviousness of the patent at issue.

Key takeaways from the Federal Court of Appeal's decision include the following holdings:

1. The focus of the obviousness analysis should be on construing the claims of a patent, at least until such time as the Supreme Court develops a definition of inventive concept;
2. Obviousness should be assessed in light of *both* the common general knowledge *and* the prior art; and
3. A patent claim will be obvious if the difference between the construed claim and the prior art can be bridged by skilled persons using only their common general knowledge and any other information they could have found on a reasonably diligent search.

The Court of Appeal noted that there is much uncertainty about the definition of "inventive concept." If such uncertainty arises, however, it can be overcome by construing the claims of the patent rather than assessing the inventive concept from the patent specification more broadly. The focus on the claims will allow parties and the courts to avoid unnecessary satellite debates.

The majority of the Court of Appeal's panel also confirmed that the prior art should be considered when assessing obviousness (the third judge would have left this issue for another day). The prior art includes not only the common general knowledge – what is generally known and accepted by skilled persons – but also information which could have been found on a reasonably diligent search. To the extent that previous court decisions had suggested that only the common general knowledge was relevant to obviousness, such decisions were incorrect.

The Court of Appeal also held that assessing obviousness goes beyond determining whether the difference between the construed claims and the prior art is self-evident. The correct

analysis remains to ask whether the difference can be bridged by skilled persons using only their common general knowledge and other information that was available in the prior art. Thus, in this case where the patent claimed a certain amount of polymer for use in an industrial process, the Court of Appeal concluded that skilled persons would have been able to bridge the gap between the patent claims and the prior art using their common general knowledge and routine testing.

Ciba Specialty injects greater clarity into the Canadian law of obviousness. Disputes over the inventive concept often arise in patent cases; focusing the obviousness analysis on the claims of a patent should help resolve many of these disputes. In addition, the Court of Appeal's holding that obviousness is not limited to differences that are self-evident directs courts and lawyers to consider more closely how skilled persons could, or could not, have bridged the difference between the prior art and a patent claim using their entire knowledge and routine experimentation.