



Study Question

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Patentability of computer implemented inventions

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I. Current law and practice

1 Does your current law contain any statutory provisions which specifically apply only to CII?

No

Please Explain

2 Please briefly describe the general patentability requirements in the written statute based law of your jurisdiction which are specifically relevant for the examination of the patentability of CII.

Section 2 of Canada's *Patent Act* ("the *Patent Act*") provides the statutory basis for patent eligibility. Specifically, a patent eligible invention is defined as "any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter". The only statutory exclusion to patent eligibility is found in subdiv 27(8) of the *Patent Act*, which provides that no patent shall be granted for "any mere scientific principle or abstract theorem".

Subdiv 28.2(1) of the *Patent Act* provides the statutory basis for novelty in Canada. In general, the subject matter defined by a claim in a pending application must not have been publicly disclosed prior to the filing date or priority date (if available) or in an earlier Canadian patent application. A one year grace period excludes disclosures derived from the applicant from destroying novelty.

Section 28.3 of the *Patent Act* provides the statutory basis for obviousness in Canada. In general, the subject matter defined by a claim in a pending application must not have been obvious on the filing date or priority date (if available) to a person skilled in the art having regard to information disclosed to the public prior to this date. Applicant derived disclosures less than one year prior to the Canadian filing date are excluded from obviousness considerations.

3 Under the case law or judicial or administrative practice in your jurisdiction, are there rules which specifically apply only to CII? If yes, please explain.

Yes

Please Explain

The law set out by Canada's Federal Court of Appeal in *Amazon.com, Inc. v. Canada (A.G.)*, 2011 FCA 328 ("*Amazon.com*") applies to inventions in general, but in particular to CII. Since this decision, the Canadian Intellectual Property Office ("CIPO") has released guidelines which specifically apply to CII. Specifically, CIPO released Practice Notice 2013-03 titled "Examination Practice Respecting Computer-Implemented Inventions" ("PN2013-03").

4

Please briefly describe the general patentability requirements under the case law or judicial or administrative practice of your jurisdiction which are specifically relevant for the examination of the patentability of CII.

According to case law, patent eligibility is assessed with reference to the "essential elements" of the claimed invention. Specifically, the determination of patent eligibility must be based on a purposive construction of the patent claims. *Amazon.com* at paragraph 47.

By way of background, Canada's Supreme Court, in *Free World Trust v. Électro Santé Inc.*, [2000] 2 S.C.R. 1024 ("*Free World Trust*"), set out the following about purposive construction:

"Purposive construction" does away with a purely literal interpretation but disciplines the scope of the "substantive" claims construction in the interest of fairness to both the patentee and the public. Some elements of a claimed invention are essential while others are non-essential. These are identified, on the basis of the common knowledge of the worker skilled in the art to which the patent relates as of the date the patent is published (under the current provisions of the Patent Act the date of publication is the "laid open" date). There is no infringement if an essential element is different or omitted in the allegedly infringing device, but there may still be infringement if non-essential elements are substituted or omitted. For an element to be considered non-essential and thus substitutable, it must be shown either that on a purposive construction of the words of the claim it was clearly not intended to be essential, or that at the date of publication of the patent, the skilled addressee would have appreciated that a particular element could be substituted or omitted without affecting the working of the invention.

An otherwise abstract idea may be patentable if, on a purposive construction, it is combined with essential elements that are otherwise patent eligible, in a novel combination. *Amazon.com* at paragraph 63. A disembodied idea is not patentable.

According to CIPO, claim elements are essential if they are required to solve a practical problem addressed by the invention. The identification of a practical problem faced by the inventor is guided by the common general knowledge in the art and by the teachings of the disclosure.

After the claims are purposively construed, patent eligibility is assessed by determining if the essential elements define a patent eligible invention. Non-essential elements are simply read out of the claim.

In particular, as recited in PN2013-03, the following are excluded from patent eligibility:

inventions that fall within a defined exclusion from patentability;

- fine arts (*i.e.* things "that are inventive only in an artistic or aesthetic sense"); methods of medical treatment, etc.

disembodied inventions (including those lacking a method of practical application);

- inventions that lack physicality (*i.e.* are not "something with physical existence, or something that manifests a discernible effect or change");
- *e.g.* inventions where the claimed subject-matter is a mere idea, scheme, plan or set of rules.

It is implicit in the definition of "invention" that patent eligible subject matter must be something with physical existence, or something that manifests a discernible effect or change; *Amazon.com*.

Although PN2013-03 acknowledges that purposive construction must be used to construe the claims, CIPO does not follow purposive claim construction as articulated in *Free World Trust*. Rather, as outlined in Practice Notice 2013-02 titled "Examination Practice Respecting Purposive Construction" ("PN2013-02"), CIPO has adopted an approach in which identification of the problem and the solution provided by the invention informs the purposive construction of the claims.

Once the problem and solution is identified, the essential elements are determined. PN2013-02 suggests some elements of a claim merely define the context or the environment of a specific working embodiment, but do not actually change the nature of the solution to the problem. CIPO considers such elements to be non-essential to the claims and irrelevant to the determination of a claim's patent eligibility during examination.

CII that have computers or computer elements that are construed to be essential to the claim are generally considered patent eligible. According to PN2013-03, a good indicator that a claim is directed to patent eligible subject-matter is that it provides a technical solution to a technical problem.

PN2013-03 also notes that a key point may be determining whether or not the problem faced by the inventor was a "computer problem" (i.e. a problem with the operation of a computer) as opposed to not being a "computer problem" (i.e. a problem whose solution may be implemented using a computer). Where a "computer problem" has been identified, the essential elements of the claims are those that are directed to overcome the problem relating to the operation of the computer. Where the problem was not a "computer problem" *per se*, the examiner must carefully consider whether the computer is essential to the solution or if its use is simply a convenience or even an afterthought.

4) Please briefly describe the general patentability requirements under the case law or judicial or administrative practice of your jurisdiction which are specifically relevant for the examination of the patentability of CII.

According to case law, patent eligibility is assessed with reference to the "essential elements" of the claimed invention. Specifically, the determination of patent eligibility must be based on a purposive construction of the patent claims. *Amazon.com* at paragraph 47.

By way of background, Canada's Supreme Court, in *Free World Trust v. Électro Santé Inc.*, [2000] 2 S.C.R. 1024 ("*Free World Trust*"), set out the following about purposive construction:

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In particular, as recited in PN2013-03, the following are excluded from patent eligibility:

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5.a **Exclusion of non-patentable subject matter per se.**
Do the statutory provisions, case law or judicial or administrative practice (hereinafter collectively referred to as Law / Practice) in your jurisdiction exclude any particular subject matter relating to CII from patentability per se?
In this context, "per se" means that the non-patentable subject matter is identified without any implicit or explicit examination of the contribution to the state of the art the claimed CII makes.

If yes, please answer questions 5.b-5.e, if no, please go to question 6.a

Yes

Please Explain

The *Patent Act* provides an explicit definition of "invention" (and thus the categories of patentable subject matter) and also explicitly lists certain categories of non-patentable subject matter. The definition of "invention" in conjunction with the statutory exclusions have been interpreted to exclude certain forms of CII from patentability *per se*.

5.b **Please describe the subject matter excluded from patentability per se and explain in detail how it is identified in practice**

Canadian Courts and CIPO have applied the definition of "invention" in conjunction with the exclusion of mere scientific principles and abstract theorems to exclude from patent eligibility *per se* claims that are directed to computer programs (software), graphical user interfaces, databases, data structures, and electromagnetic or acoustic signals. See Chapter 16 of the Manual of Patent Office Practice (MOPOP).

5.c **If there is any subject matter identified in a patent claim relating to CII that is excluded from patentability per se, is it possible to overcome a rejection of the patent claim by adding other subject matter to the claim?**

If yes, please answer questions 5.d-5.e, if no, please go to question 6.a

Yes

Please Explain

For some CII it may be possible to overcome the rejection by adding other subject matter, such that the excluded subject matter in conjunction with the other subject matter is patent eligible.

5.d **Does the "other subject matter" need to have a certain quality, e.g. does it need to be inventive?**

No

Please Explain

The “other subject matter” does not need to have a certain quality. Rather, as long as the “other subject matter” is construed to be an essential element of the claim, then the claim as a whole will be considered for patent eligibility, novelty, and obviousness.

5.e Can you describe the areas of human endeavour the “other subject matter” needs to relate to?

Yes

If yes, please explain

The “other subject matter” simply needs to relate to subject matter that is conventionally considered to be patent eligible. In the context of CII, the “other subject matter” may, for example, relate to and incorporate a computing device, computing hardware elements, sensors, a communication network and the like. However, as noted the “other subject matter” must be found to be essential to the CII. If the “other subject matter” is not construed to be essential to the CII claim, it will not make an otherwise patent ineligible claim patent eligible.

6.a Requirement of a contribution in a field of technology.

Does the examination of the patentability of CII in your jurisdiction implicitly or explicitly involve an examination of the contribution the claimed CII makes to the state of the art (such examination may be part of a general “patentability” test or part of the novelty and inventive step/non-obviousness test)?

If yes, please answer questions 6.b-6.d, if no, please go to question 7

No

Please Explain

Canadian Courts have rejected the assessment of a “contribution” apart from the invention as a whole. Courts have also found that notions of the “actual contribution” (such as that term is used in the UK) have little applicability in Canadian law. More particularly, the Courts have rejected attempts by CIPO to apply tests incorporating such . See *Amazon.com Inc v Canada*, [2010 FC 1011](#) at paragraphs 44–47, aff’d [2011 FCA 328](#).

In practice, CIPO looks to common general knowledge when defining the problem in the problem and solution approach described in the response to Question 4. As a result, common general knowledge used to frame the problem will inevitably not be considered to be part of the solution. Elements that are part of the common general knowledge may be determined to merely define the context or the environment of a specific working embodiment without changing the solution to the problem – and may thus be identified as “inessential”. Thus, although CIPO does not explicitly consider the contribution the claimed CII makes to the state of the art, it may do so implicitly in framing the problem/solution and assessing which claim elements are essential.

The CII as a whole must be non-obvious in order to be patentable.

CII's that require computer or other conventionally patent eligible elements to solve the problem addressed by the CII will generally be considered patent eligible. Claims to such CII's when purposively construed will identify such elements as “essential” as described in response to Question 4.

6.b Does this test implicitly or explicitly involve excluding contributions from areas of human endeavour which are not deemed to be sources of patentable inventions? In other words, does patentability of CII implicitly or explicitly require a contribution from areas of human endeavour which are deemed to be sources of patentable inventions (e.g. engineering, natural sciences)? If yes, please explain.

6.c Does this test also implicitly or explicitly require that the relevant contribution the CII makes to the state of the art qualifies as inventive/non-obvious? This additional test may be integrated into the general inventive step / non-obviousness examination, or may be a stand-alone test. If yes, please explain.

6.d Is there an implicit or explicit consensus in your jurisdiction as to the areas of human endeavour which are accepted as sources of patentable CII? If yes, are these areas of human endeavour defined, and if so how?

7 Does the Law / Practice in your jurisdiction contain any specific claim drafting or other formal requirements which are applicable to CII, i.e. which deviate from the Law / Practice applicable to inventions which are not CII? If yes, please explain.

No

Please Explain

Neither the *Patent Act* nor the *Patent Rules* include specific claim drafting or formal requirements for applications directed to CII. In theory, CII are subject to the same procedural and substantive requirements as inventions in any other field. However, in practice, CIPO does consider CII to be different from other types of inventions, as is evidenced by the inclusion of an entire chapter (chapter 16 of MOPOP) directed to the evaluation and examination of Computer-Implemented Inventions. Chapter 17 of MOPOP, directed to Biotechnology and Medicinal Inventions is the only other invention-specific chapter in the manual.

CIPO has adopted the position that software, when claimed *per se*, is not patentable because it is considered to be an abstract scheme, plan or set of rules for operating a computer and is therefore outside the scope of patentable subject matter. Practically, this limitation can be overcome by drafting the claims to be directed to a physical memory storing the computer program as machine-executable code.

In practice, CII may be claimed as machines (hardware-based), systems, methods/process (considered an *art*) or a manufacture (e.g. a computer-readable medium), and are subject to the same definiteness, clarity and written support/enablement requirements applied to all patent applications.

However, the mere recitation of a computer or component is not sufficient to establish patent eligibility. A method that, on its own merits, would be considered non-statutory does not become statutory simply by virtue of some part of the method being carried out on or by a computer. While a disembodied idea such as a mere scientific principle or abstract theorem is not patentable, subject matter which has a physical existence or produces a discernible effect or change is patentable. (*Shell Oil* at page 554 and *Amazon.com* at paragraph 66). Unlike the mechanical arts, in which this “physicality requirement” is often inherent, claims directed to CII must ensure that steps recited in any method will result in a change or effect of sufficiently physicality and/or that effects a change on an object in the physical world.

If determined to be patent eligible, claims for CII are subject to the same substantive novelty and non-obviousness standards as applied to other categories of invention.

8 Does the Law / Practice in your jurisdiction contain any specific requirements as to sufficiency of disclosure and/or enablement which are applicable to CII, i.e. which deviate from the Law / Practice applicable to inventions which are not CII? If yes, please explain.

No

Please Explain

CII are subject to the same sufficiency of disclosure and enablement requirement as other types of invention.

Under Canadian law, the specification must correctly and fully describe the invention. The statutory requirements for the description (Patent Act (s27(3))) require that the specification of an invention must

- (a) correctly and fully describe the invention and its operation or use as contemplated by the inventor;
- (b) set out clearly the various steps in a process, or the method of constructing, making, compounding or using a machine, manufacture or composition of matter, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it pertains, or with which it is most closely connected, to make, construct, compound or use it;
- (c) in the case of a machine, explain the principle of the machine and the best mode in which the inventor has contemplated the application of that principle; and
- (d) in the case of a process, explain the necessary sequence, if any, of the various steps, so as to distinguish the invention from other inventions.

In practice, the Courts have interpreted these provisions to require that the specification must provide “adequate description of the invention with sufficiently complete and accurate details as will enable a workman, skilled in the art to which the invention relates, to construct or use

that invention when the period of the monopoly has expired". *Consolboard Inc. v. Mcmillan Bloedel (Saskatchewan) Ltd.* This same standard is applied to applications directed to CII's.

Source code or pseudocode may be provided as part of the description, but is not required nor is it by itself considered sufficient to provide a full and enabling description of an invention.

If the CII is described using a flow chart that illustrates an algorithm or logic tree, CIPO has taken the position that it is necessary for the person skilled in the art to be able to put each step in the flow chart into operation based on the teachings of the specification and without recourse to inventive ingenuity or undue experimentation.

Although there are no specific requirements as to sufficiency of disclosure and/or enablement which are applicable to CII, the level of description may play a role in determining the patent eligibility of the claims. Specifically, as noted in response to Question 4, a computer is considered essential to the solution if the problem faced by the inventor is a "computer problem". As indicated in PN 2013-03, one factor that may indicate the existence of a "computer problem" is that "a significant level of detail is devoted to describing technical details, such as the algorithm or logic performed by the computer."

9 Do courts and administrative bodies in your jurisdiction apply the Law / Practice for patentability of CII in your jurisdiction in a harmonized way? If not, please explain.

No

Please Explain

Jurisprudence in Canada has established that claims are to be construed using purposive construction to identify essential claim features, and that patent eligibility is to be determined based on the subject matter defined by the claims.

Purposive construction has historically been used as a doctrine to assist patentees in establishing infringement. As described in response to Question 4, if an essential element is different or omitted in an allegedly infringing device there is no infringement. However, if non-essential elements are substituted or omitted, there may still be infringement. In accordance with jurisprudence, the inventor's intent is a contributing factor when considering whether or not an element of a claim is essential. Furthermore, an element is considered to be essential if it materially affects the operation of the invention.

In contrast, CIPO emphasizes a problem/solution approach to identifying the essential elements of a claim. When defining the essential elements of the claim during construction, the inventor's intent is not considered. Rather, it is left to the examiner's judgment to determine if a person skilled in the art would consider an element to be essential. Furthermore, having an effect on the invention is not considered to be sufficient to determine that an element is essential. Instead, the element needs to be essential to solve the problem.

CIPO reads non-essential elements out of the claim during claim construction and disregards them when considering patent eligibility and patentability. If it is determined that the remaining essential elements of a construed claim are not patent eligible, the claim is not patent eligible. While purporting to be consistent with the Supreme Court's purposive construction process, this problem/solution approach may be contrary to the principles of purposive construction. In any event, the problem/solution approach should not be the only approach in identifying essential elements.

CIPO also attempts to identify and distinguish between a "computer problem" and *not* a "computer problem", where solutions directed to "computer problems" being more likely to be patentable. It is not clear that this distinction has any basis in law, or is consistent with general principles of purposive construction.

II. Policy considerations and proposals for improvements of your current Law/Practice

10 Is the current Law/Practice in your jurisdiction regarding the patentability of CII considered by users of the patent system and practitioners to be understandable and workable? If not, please explain.

No

Please Explain

The current law as enunciated by the Federal Court of Appeal of Canada in the *Amazon* decision is fairly well-understood by practitioners. The *Amazon* decision also clearly states that business methods are not *per se* patent ineligible.

However, in practice, the jurisprudence, including principles of claim constructions enunciated by the Supreme Court of Canada, are not being followed by CIPO. CIPO appears to be developing its own problem/solution approach, rather than following the proper essential/non-

essential framework.

Importantly, it is the Examiner, and not the Applicant, who defines the problem. Thus, Examiners are able to frame the problem in order to preclude the solution from relating to patentable subject matter. As a result, allowances and rejections by CIPO are often inconsistent.

11 Does the current Law/Practice in your jurisdiction regarding patentability of CII provide appropriate outcomes, in particular from an economic perspective? If not, please explain.

No

Please Explain

In general, the availability of patent protection for CII in Canada is economically desirable, since a great deal of modern innovation is implemented through software operating on computing resources. This does not make the inventions less meritorious or less deserving of potential patent protection. To the extent that patents are justified as a tool for promoting progress in the sciences and the useful arts, there is no principled reason to exclude progress that finds practical implementation in computing devices.

Nevertheless, CIPO's inconsistency in applying current law to CII in prosecution renders the available scope of protection ambiguous, which undermines economic certainty. Furthermore, as a result of this inconsistency, applications for CII are increasingly expensive to prosecute due to the significant back and forth with CIPO and the significant length of time before being able to appeal the Examiner's decision to the Patent Appeal Board.

12 In your jurisdiction, is copyright protection of CII regarded as sufficient from an economic standpoint? Please state why in either case.

No

Please Explain

Copyright alone is considered an insufficient form of IP protection for software as it only protects the copying of the expression of ideas. CII may be coded and therefore expressed in many languages and in many different ways, independently without copying, to achieve the same implementation and outcome.

13 Alternatively, is there an explicit or implicit consensus that patent protection of CII is required to ensure sufficient reward on investments made into the development of CII? If yes, please explain.

No

Please Explain

We have discord between policy makers, policy thinkers and industry about how best to proceed with protecting CII.

14 In your jurisdiction, is there an implicit or explicit consensus that availability of patent protection should be limited to contributions from certain areas of human endeavour, excluding contributions from all other areas of human endeavour, no matter how advanced these contributions?

No

Please Explain

In accordance with Canadian Patent practice, claims directed to methods of medical treatment are excluded from patent eligibility, no matter how advanced the contribution. Similarly, as noted in response to Question 5(b), claims directed to computer programs (software), graphical user interfaces, databases, data structures, and electromagnetic or acoustic signals, *per se*, are excluded from patent eligibility, no matter how advanced the contribution.

With regard to CII, the implicit consensus at CIPO appears to restrict patent protection to more “technological” innovation. Accordingly, if a claim can be said to have “technological” innovation, it will likely be considered to be patentable subject matter. However, the definition of “technological” is rather elusive.

III. Proposals for harmonisation

15 Do you consider that harmonisation regarding patentability of CII is desirable?
If yes, please respond to the following questions without regard to your Group's current Law/Practice. Even if no, please address the following questions to the extent your Group considers your Group's current Law/Practice could be improved.

Yes

Please Explain

There should consistency in terms of what can be patented across jurisdictions; however, we are cognizant of the significant difficulty that many countries are having in formulating a consistent and effective test for determining patentability of CII's in within their own jurisdictions, so it may be challenging to reach a detailed consensus on the precise test to be used. Nevertheless, it may be possible to harmonize at least some broad principles regarding patentability of CII's.

6.a **Exclusion of non-patentable subject matter per se.**
Should there be any exclusion from patentability per se of subject matter relating to CII?
In this context, “per se” means that the non-patentable subject matter has to be identified without any implicit or explicit examination of the contribution to the state of the art the claimed CII makes.
If yes, please answer questions 16.b-16.e, if no, please go to question 17.a

No

Please Explain

Provided the subject matter of the claim meets the statutory requirements of the jurisdiction, it should be considered proper subject matter for patenting. In Canada, that means the claim must be directed to an “art, process, machine, manufacture or composition of matter”, or any improvements thereto. There should be no explicit exclusion of “software” *per se* provided it is claimed such that it falls within one of the statutory categories.

6.b Please describe the subject matter that should be excluded from patentability per se and explain in detail how it should be identified in practice.

6.c If there is subject matter identified in a patent claim related to CII you consider should be excluded from patentability per se, should it possible to overcome a rejection of the patent claim by adding other subject matter to the claim?
If yes, please answer questions 16.d-16.e, if no, please go to question 17.a

6.d Should such “other subject matter” be required to have a certain quality, e.g. should it need to be inventive? Please state why in either case.

6.e If yes to question 16.d above, please describe the areas of human endeavour to which such “other subject matter” should relate.

7.a Requirement of a contribution in a field of technology.
Should the examination of subject matter eligibility of CII involve an examination of the contribution the claimed CII makes to the state of the art? If not, please explain.

If yes, please answer questions 17.b-17.e, if no, please go to question 18

No

Please Explain

Subject matter eligibility should be a coarse filter to exclude claims that are clearly patent ineligible, such as pure unapplied mathematical algorithms, artistic or professional skills, and the like. Importing an analysis of what is contributed relative to the state of the art and whether that contribution is to a recognized “field of technology” draws elements of novelty and obviousness analysis into the evaluation of patent eligibility. For example, if a claim is directed to a computer-implemented business or financial process, then it may meet the basic requirements for being patent eligible as being directed to an applied process or a machine. If the claim is the mere implementation by computer of known business or financial processes then the claim should fall for “obviousness” or “lack of inventiveness” and not based on being patent ineligible.

7.b Should such examination be made under a test specific to CII, or should it be part of the usual novelty and inventive step/non-obviousness test? Please state why in either case.

7.c Under this test, should patentability of CII require a contribution from areas of human endeavour which are deemed to be sources of patentable inventions (e.g. engineering, natural sciences)? In other words, should contributions from areas of human endeavour which are not deemed to be sources of patentable inventions be disregarded? If not, please explain.

If yes, please answer questions 17.d-17.e, if no, please go to question 18

7.d Should this test also require that the relevant contribution the CII makes to the state of the art qualifies as inventive/non-obvious? This additional test may be integrated into the general inventive step / non-obviousness examination, or may be a stand-alone test. Please state why in either case.

7.e Should there be a non-exhaustive list of areas of human endeavour which are accepted as sources of patentable CII, taking into account the ultimate purpose of patent law (protecting unforeseen, non-obvious subject matter)? If yes, please provide such a list. If not, why?

18 Should there be any specific claim drafting or other formal requirements which are applicable to CII, i.e. which deviate from the rules or practice applicable to inventions which are not CII? Please explain why in either case.

No

Please Explain

Insofar as patent eligibility is concerned, the only claim drafting requirements should be to formulate the claim so that it is directed to one of the statutory classes of subject matter. For example, a claim to "software instructions" requires an accompanying processor-readable medium (or similar), to make the claim patent eligible.

Other claim drafting requirements specific to software-implemented inventions may arise for reasons of clarity, but are not necessarily required for patent eligibility.

19 Should there be any specific requirements as to sufficiency of disclosure and/or enablement which are applicable to CII, i.e. which deviate from the rules or practice applicable to inventions which are not CII? Please explain why in either case.

No

Please Explain

In general, it is unwise to impose different standards for disclosure or enablement on different technologies. The same legal standards should apply across all fields of technology. Nevertheless, those standards may, in the context of a particular sector of the computing/software industry, mean that certain information should be in the specification to meet the sufficiency of disclosure and/or enablement tests in a particular case. However, whether a signal diagram, flowchart, or pseudocode is needed in a particular situation, will vary from case-to-case dependent on the nature of the invention.

20 Please comment on any additional issues concerning patent protection of CII your Group considers relevant to this Study Question.

As evident in the response to the previous questions, there is concern among patent practitioners that CIPO is not applying the test for patent eligible subject matter as enunciated by the Courts. Specifically, there does appear to be any basis for the problem/solution approach, especially as adopted by CIPO. This approach has also led to uncertainty as to what may or may not be patent eligible, especially given the limited number of CII inventions that have been brought before the Patent Appeal Board or the Court. Such uncertainty had resulted in increased prosecution costs for CII inventions.

There is also some concern that the test for patent eligibility is being conflated with the test for obviousness and anticipation.

Please indicate which industry sector views are included in part "III. Proposals of harmonization" on this form:

Please enter the name of your nominee for Study Committee representative for this Question (see Rule 12.8, Regulations of AIPPI). Study Committee leadership is chosen from amongst the nominated Study Committee representatives. Thus, persons not nominated as a Study Committee representative cannot be in the Study Committee leadership.

Jonathan Pollack