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THE WONDERFUL WORLD OF PATENTS: “THEY DO THINGS DIFFERENTLY THERE”

– David Vaver*

THE SCENE: The patent infringement trial of *Ewon v Fowler* held on Zoom in the Federal Court of Canada, after the decision of the Federal Court of Appeal in *CanMar Foods Ltd v TA Foods Ltd*, 2021 FCA 7. That decision affirmed a judgment of Manson J, 2019 FC 1233, finding no infringement of the patent in that case but holding, contrary to the judge, that a communication in a proceeding before the US Patent Office could not be used to help reach that conclusion. The Court of Appeal said that section 53.1 of the [Patent Act, R.S.C. 1985, c. P-4](#), which reversed *Free World Trust v. Électro Santé Inc.*, [2000 SCC 66](#), made only communications with the Canadian Patent Office admissible in evidence.

DRAMATIS PERSONAE: Justice R. Bitter, judge (J)
Sue N. Ewon, plaintiff (P)
Wigmore Cross, plaintiff’s counsel (PC)
Chick Fowler, defendant (D)
Ms Chiff Maker, defendant’s counsel (DC)

PARTIAL TRANSCRIPT OF CROSS-EXAMINATION OF PLAINTIFF SUE N. EWON:

DC: So, Ms Ewon, you say the defendant’s chicken-plucker infringes claim 1 of your patent?

P: Yes.

DC: Because it includes chicken-pluckers with a widget, and the defendant’s plucker has that widget?

P: Yes.

DC: Did you ever tell anyone that claim 1 doesn’t include chicken-pluckers with a widget?

PC: I object, what plaintiff thinks her claim means is irrelevant. That’s for the judge.

J: Yes, I think that’s right. Ms Maker, I decide questions of law.

DC: All right. (To P:) When you applied for your Canadian patent, did your patent agent write to the examiner to say that pluckers with widgets were excluded?

P: I’ve no idea.

DC: I show you Exhibit K. You recognize that letter from your patent agent to the examiner?

P: Yes, she sent me a copy.

DC: You see where it says “Enclosed is a new claim 1 that corresponds substantially to the claim submitted in prosecution of the related United States patent application”?

P: Yes.

DC: You did have such an application in the United States, didn’t you?

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PC (to J): With respect, Your Ladyship, I have no idea where this is all heading.

J: Nor do I, but I'll cut Ms Maker some slack for the moment.

DC: Thank you. (To P:) I repeat, you did have an application filed in the United States for the same invention as in this case, didn't you?

J: Yes.

DC: Are you aware that the attorney handling your American application wrote to the American examiner, saying that a new claim 1 he was submitting would overcome the examiner's objection that chicken-pluckers with widgets were known to the prior art?

PC (to J): I object most strenuously to that whole question. Even if my client personally wrote to the American examiner saying that, it is inadmissible here.

J: Why? Because it wasn't said in Canada to a Canadian examiner?

PC: Yes.

J: Would it have been admissible had your client written the same thing to the Canadian examiner?

PC: I don't believe anything said anywhere else than in a Canadian prosecution has anything to do with this case. May I draw Your Ladyship's attention to the Court of Appeal's reasons in *CanMar* at paragraph 70? The Court there said you should be "wary" about allowing anything other than Canadian prosecution history in. And then at paragraph 71 the Court went on to say you should "tread carefully" in admitting extrinsic evidence to interpret a patent claim. And once again in that paragraph, "Opening the door to allowing foreign patent prosecution history into the analysis might lead to overly contentious and expensive litigation."

J: Well, I am treading carefully and warily, and I haven't turned the door knob yet. Hasn't this litigation been contentious and expensive enough anyway? Aren't you making it more expensive and contentious by raising these sorts of objections? I can't see why a statement that would be admissible and relevant if made in Gatineau becomes inadmissible and irrelevant if made in Alexandria. What happens in Virginia doesn't have to stay in Virginia.

PC: With respect, it is not Your Ladyship's role to question the wisdom of Parliament. Both Justice Manson and the Court of Appeal said very clearly that section 53.1 applies only to communications to the Canadian Patent Office.

J: I am not questioning Parliament's wisdom, only the awkward statutory language used to translate it. Hasn't one of my colleagues just decided that even Canadian history isn't admissible if it's the licensor rather than the patentee who sues, even where the patentee is a defendant (*Allergan Inc v Sandoz Canada Inc*, 2020 FC 1189 at [126])? Why couldn't section 53.1 just have said that any prosecution history from wherever is admissible but its weight is for the court? Is section 53.1 based on any other country's legislation?

PC: Not that I know, Your Ladyship. It is homegrown, although I accept there may be a few weeds among the roses.

J: What I am saying, I guess, is much what Justice Manson said in *CanMar*. Here we have the extraordinary circumstance that the Canadian communication expressly refers to the corresponding

US application and the clear inference is that the Canadian claim is being replaced precisely to overcome the actual or anticipated citation of the same prior art against the Canadian application.

PC: With respect, that is exactly the same situation as in *CanMar*, and the Court of Appeal explicitly overruled Justice Manson's admission of the American file.

J: We have this anomaly then, haven't we? If the Canadian patent had been granted unchanged and without reference to the US application, your client could have asked for it to be reissued with the changed claim under section 47 of the *Patent Act* because of an inadvertent mistake. Foreign prosecution history has long been admitted on a reissue application to show there was a mistake and that the reissued patent would be for the same invention. Why allow the foreign file to be admitted to show the reissue was justified, but exclude it to show what the claims now mean?

PC: If that was the position before section 53.1 took effect, then I submit that such foreign history can no longer be admitted in reissue.

J: What do you say, Ms Maker?

DC: Section 53.1 states that it specifically applies to reissue and no intent to change current Patent Office practice appears. Nor is there any apparent attempt to overrule long-standing cases such as *Northern Electric Co v Photo Sound Corp*, [1936] SCR 649, where the whole case depended on foreign prosecution history. If foreign history is admissible in reissue to determine the scope of the invention, as I submit it was before and is after s. 53.1, then I cannot see why it is inadmissible where an ordinary patent is involved.

J: Well, it's a brave trial judge who says the Court of Appeal has decided something *per incuriam* and should not be followed.

DC: May I make one further point? The Court of Appeal in *CanMar* relied on a decision of the United States Federal Circuit Court of Appeals to say that the reference in the plaintiff's letter to the Canadian examiner to "a related United States patent application" wasn't specific enough to incorporate the corresponding US file. The point on how specific a cross-reference must be to allow another document to be read has not been decided by the US Supreme Court, and I would point out that the Federal Circuit Court of Appeals is a court with one of the highest reversal rates before the US Supreme Court, and especially so in patent cases.

What our Court of Appeal should have done was to apply the general law in Canada on when documents can be looked at together. Cases on the *Statute of Frauds* are the most obvious source. The *Statute* requires contracts such as guarantees or sales of land to be evidenced by a memorandum in writing, and ever since the 19th century it has been held that two or more documents can form a single memorandum. Supreme Court of Canada authority going back a century says, and I quote, "parol evidence may be given to connect two documents together which do not expressly refer to each other, but which connection and reference is a matter of fair and reasonable inference:" *Doran v McKinnon*, [1916 CanLII 627 \(SCC\)](#), 53 SCR 609 at 611. I can say that is also the law in most Commonwealth countries and state courts of the United States. Not to put too fine a point on it, the US Federal Circuit has gone rogue by making up its own rule of incorporation and ignoring the general law of the majority of state courts.

I submit that in our case the reference to the US application is plain enough in the letter to the Canadian examiner. It is also distinguishable from *CanMar* in two respects. First, our letter refers to

“the” US application, whereas the *Canmar* letter referred only to “a” related application. We are very specific. Second, the US application in *CanMar* was abandoned, whereas here the plaintiff’s application specifically claims priority from the corresponding US application which was granted. It is open to the Court to hold the US history admissible on either of these distinctions, since the Court of Appeal specifically refused to express any “firm view on the broader issue of whether foreign prosecution history can be considered under section 53.1.” I ask for Your Ladyship’s firm views now.

PC: I submit this case is covered exactly by the Court of Appeal in *CanMar* and the foreign history cannot be looked at.

D (intervening): You mean Sue can lie to a Canadian judge where she wouldn’t dare to an American one? [*Scuffle breaks out.*]

J: Ms Maker, could you kindly restrain your client? [*Order resumes.*]

Thank you, counsel.

I propose to admit the statement in the US patent file into evidence. I shall not at this stage indicate what weight it deserves or what use I may make of it. This case is not covered by *CanMar* because the Canadian patent here relies for its priority on a stated US patent. The plaintiff cannot blow hot and cold by then dismissing the very patent from which it claims priority and on which it may well depend for validity in Canada.

The Court of Appeal thought it “a stretch” to incorporate a US patent file on language as general as that which points to “a” related United States application. There is no “stretch” at all here since, as defendant’s counsel submitted, the letter to the Canadian examiner points to “the” related US application, not merely “a” related one. I nevertheless must say that, at a time when we are all urged not to subject patents to “the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge” (*Catnic Components Ltd v Hill & Smith Ltd*, [1982] RPC 183, 243 (HL)), I would be reluctant to have to read the documents leading to the grant of a patent more meticulously than I would read the patent itself.

I am also not sure that incorporation is the *mot juste* for the ability to follow a signpost and explore the destination to which it points. There is no difficulty in identifying that destination off the face of the Canadian file. Canadian patent law is no Alsatia where the general law stops, nor is it one where the US Federal Circuit’s writ runs. To adapt L.P. Hartley’s words in *The Go-Between*, patent law should not be a different country where they do things differently. Law under the *Statute of Frauds* lets two documents be read together where their “connection and reference is a matter of fair and reasonable inference.” *Doran v McKinnon*, [1916 CanLII 627 \(SCC\)](#), 53 S.C.R. 609, 611, which I note was recently applied to a series of emails in *Druet v Girouard*, 2012 NBCA 40 at [34]. Canadian patent law should let patent files be cross-referenced that way too. The location of the second file should not matter, any more than it does under the *Statute of Frauds*. If a multimillion dollar guarantee or land contract can be interpreted and enforced by means of such a connection, so should a patent.

None of the parade of horribles trotted out by the Court of Appeal (*CanMar* at [71]) is present here. There is no translation problem with the US file, and the Court of Appeal specifically said at [72] that “one should not underplay the public interest in keeping those who have previously disclaimed elements from their patent from re-claiming them in future infringement cases.” I do not expect that the plaintiff will ask me to take such a course, which Locke J (now JA) in *Pollard Banknote Ltd v BABN Technologies Corp*, 2016 FC 883 at [237] described as “breathtaking.”

I would only add in passing that, when the Court of Appeal comes to take a “firm view” on foreign prosecution history and section 53.1, it may well have to take account of the long-standing practice, sanctioned by consistent Supreme Court authority, of relying on evidence of such history to decide when the reissue of a defective or inoperative patent under section 47 of the *Patent Act* is warranted or valid.

Ruling accordingly