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Boehringer Sohn v. Bell-Craig Ltd., [1963] S.C.R. 410

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K. PATENTS

Boehringer Sohn v. Bell-Craig Ltd., [1963] S.C.R. 410.

The decision of the Supreme Court of Canada in *C. H. Boehringer Sohn v. Bell-Craig Limited,* [1963] S.C.R. 410, 25 Fox Pat. C. 36 is of considerable importance in determining the form of claims to be employed in applications for patent made under Section 41(1) of the *Patent Act.* That section provides as follows:

> In the case of inventions relating to substances prepared or produced by chemical processes and intended for food or medicine, the specification shall not include claims for the substance itself, except when prepared or produced by the methods or processes of manufacture particularly described and claimed or by their obvious chemical equivalents.

In other words, in patents of the type referred to there can only appear what are known as process-dependent claims.

The Supreme Court of Canada held that an applicant for a patent can not satisfy the requirements of Section 41(1) of the *Patent Act* for a claim for a substance by the filing of a broad process claim for the production of a whole genus of which a substance is one, if the claim, because of its generality, is found to be invalid. The Court pointed out that the subsection was intended to place a strict limitation upon claims for substances by chemical process and intended for food or medicine. As provided in the subsection such a substance can not be claimed by itself. It can only be claimed when produced by a particular process of manufacture. The applicant for patent must claim not only the substance but that process by which it is manufactured. Therefore, in order to comply with the subsection he must make two claims. He must make valid claims to both the process and the substance if he is to be entitled successfully to claim the latter. The Court further held that to interpret the subsection as meaning that all that is necessary is to file a claim for the process, valid or not, would be to defeat its purpose.

It will thus be seen that when a substance prepared or produced by a chemical process and intended for food or medicine is claimed, it must be claimed by reference to a claim for the process by which it is produced and that process claim must be valid. The applicant

must be under the necessity, if he wishes to claim the substance, of framing two claims each of which must be valid. It is apparent that a claim to such a substance can not be supported by a process claim which is invalid.

The Court discussed its previous decision in the *Commissioner of Patents v. Winthrop Chemical Company Inc.*, [1948] S.C.R. 46, 7 Fox Pat. C. 183. In that case it was held that a claim for a substance alone can not, under section 41(1) of the Patent Act, be entertained and the applicant's specification should describe the method or process by which the substance is prepared or produced and claim a patent therefor in the manner specified in the Act. The Court pointed out and held that the reasoning of the *Winthrop* case was authority not only for the precise point before the Court in that case, namely, that an applicant for a patent for a substance under section 41(1) must make a specific process claim, but was applicable also to the issue before the Court in the present case, namely, that there can not be a valid patent for a substance within that subsection if the process claim, which has been made for the process of its production, is found to be invalid.

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