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Quirks of practice: Protecting medical devices in Canada

Noel Courage and Adrienne Bieber McNeil, Bereskin & Parr, explain the elements of Canadian practice that need to be considered when drafting applications for medical device inventions.

Canadian patent practice has many similarities to foreign practice, but there are also many quirks that are unique to Canadian practice, and that should be considered when drafting a patent application that is to be filed in Canada.

Medical methods

The Canadian Intellectual Property Office does not allow claims that are directed to methods of medical treatment and methods of surgery¹. Invasive diagnostic methods will also fall within this prohibition. For example, the following claim would generally not be allowed in Canada: “A method for treating a patient using device X, the method comprising the steps of A, B, and C”. Nevertheless, medical *use* claims are generally permitted in Canada, as long as they do not include an active treatment or surgical step. Accordingly, in Canada, the above claim can be rewritten as follows: “The use of device X to treat a subject having disease Y, wherein the device X comprises elements Y and Z”. Such a claim would generally be patentable subject matter in Canada.

Some medical procedures, nevertheless, can be protected by method claims. Particularly, in order to be considered a method of medical treatment, the method must treat or prevent a *pathological* condition. For example, both

aging and pregnancy are *not* considered by the patent office to be *pathological* conditions², and therefore claims directed to methods of preventing aging or preventing pregnancy are considered permissible subject matter in Canada.

Furthermore, although claims to methods of medical *treatment* are not allowed in Canada, claims to both non-invasive *diagnostic* methods and *cosmetic* methods are allowed³. However, when drafting these claims, it is important to ensure that the claim language does not include steps that provide a secondary therapeutic benefit. If any steps do provide a secondary therapeutic benefit, the claim will be rejected.

Means-plus-function language

It is well known that means-plus-function claim language in the United States can be quite limiting, and according to 35 USC 112, restricts the claim to those embodiments that are disclosed in the specification. As a result, many US firms do not draft patent applications using “means” language at all. This is not the case in some other countries, where means language is still common practice.

When a patent application containing means-plus-function claim language is filed in Canada, it is construed according to “purposive construction” principles, which require that the claim language be interpreted according to what a skilled reader would have understood the claim language to mean⁴. As a result, means-plus-function claim language is generally interpreted quite broadly in Canada, and when drafting an application that is to be filed in Canada, one could consider using means-plus-function language in order to secure broad protection.

In general, alternate claim styles that are used in US practice instead of “means plus function” are suitable for Canada, and preferable when the originating application is going to be eventually filed in the US. For example, a US patent application may use the term “applicator for

Résumés

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applying” a drug instead of “means for applying” a drug. This should work as well in Canada as “means plus function” language.

Excess claims fees

Unlike many foreign patent offices, the Canadian Intellectual Property Office does not charge any excess claim fees. Accordingly, when drafting an application that is to be filed in Canada, it is advisable to include as many claims as is practical. In addition, multiple dependencies are permitted. If there is a unifying technical feature in the claims then they should all issue in the same patent, without restriction.

Incorporation by reference

Incorporation by reference is not permitted in Canada⁵. Accordingly, any disclosure that is important to the application (e.g. for enablement or support) must be explicitly included in the description at the time of filing.

Conclusion

The tips above should be considered when drafting a medical device-related patent application that is to be filed in Canada. There are other quirks of Canadian practice that will arise as prosecution progresses. A skilled Canadian Patent practitioner can guide you through this process, and ensure that your protection in Canada is as strong as possible.

“ The Canadian Intellectual Property Office does not allow claims that are directed to methods of medical treatment and methods of surgery. Invasive diagnostic methods will also fall within this prohibition. ”

¹ Manual of Patent Office Practice, Section 17.02.03

² *Re Application No. 559,960 of Senetek* (1997) C.D. 1213; *Re Application No. 532,566 of General Hospital Corporation* (1996) C.D. 1209

³ *Re Application No. 003,389 of N.V. Organon* [(1973) C.D. 144, 15 C.P.R. (2nd), 253 (P.A.B.)]; *Re Application for Patent of Goldenberg* [(1988) C.D. 1119, 22 C.P.R. (3rd), 159 (P.A.B.)]

⁴ *Free World Trust v Electro Santé Inc.*, 2000 SCC 66 at paragraph 50; and *Whirlpool Corp. v Camco Inc.*, 2000 SCC 67 at paragraph 48

⁵ Patent Rules, Section 81



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