

Canadian Patent Office Issues Revised Examination Guidelines Concerning Computer-based Inventions

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Authors: [Stephen Beney](#) and [Paul Horbal](#)

The Canadian Intellectual Property Office (CIPO) published on March 8, 2013, revised examination guidelines for its patent examiners in the wake of the 2011 Federal Court of Appeal decision in *Attorney General of Canada v. Amazon.com Inc.*

In that decision, the Federal Court of Appeal upheld portions of Amazon.com's appeal against the Commissioner of Patents' refusal of the patent application for its famous "1-Click" system. The application had been denied on several grounds relating to statutory subject matter.

The Court specifically rejected the Commissioner's "technological" requirement for patentable subject matter, holding it had no basis in Canadian law and that it was outside the Commissioner's jurisdiction to introduce a new test. The Court also rejected the Commissioner's "form and substance" approach to patentable subject matter as "confusing and unnecessary."

Following the Court of Appeal decision, CIPO released proposed examination guidelines for public comment. These guidelines included terminology and approaches that had been disapproved by the Federal Court of Appeal. Following a comment period in which numerous submissions were made noting this discrepancy, CIPO withdrew its earlier proposal.

CIPO have now released a new practice notice relating to "computer-implemented inventions." This practice notice expressly cautions Examiners not to look solely at the presumptive inventive "contribution" of a claim when assessing patentable subject matter. Nor are Examiners solely to consider whether claims involve a "technological solution to a technological problem." Rather, Examiners are directed to undertake a "purposive construction" of the claims, and consider the claims as construed in light of sections 2 and 27(8) of the *Patent Act*, which contain the statutory definition of "invention" and exclusions to patentable subject matter, respectively.

Examiners are also expressly advised that "where a computer is found to be an essential element of a construed claim, the claimed subject-matter will generally be statutory."

A complementary practice notice released concurrently details the "purposive construction" approach to be followed by Examiners when interpreting patent claims, called "purposive construction." Purposive construction has been endorsed as the correct approach by the Supreme Court of Canada.

Some curious language remains in the guidelines, such as references to a European-style "problem and solution" approach. It remains to be seen how Examiners will implement this approach in practice.

CIPO did not invite public comment before issuing the new guidelines, so it will be some time before practitioners have the ability to fully digest these directives. However, the guidelines appear to represent at least a partial step toward reconciling patent examination practice with legal precedent.