



Inconsistency remains the key to unlocking the file history. The Federal Court of Appeal cautions against an over broad interpretation of Section 53.1 in *Bauer Hockey Ltd. v. Sport Maska Inc.*

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To what extent is the extrinsic evidence found in the prosecution history of the patent relevant context for the purposive construction of a Canadian patent claim? In an *obiter* speech in *Bauer Hockey Ltd. v. Sport Maska Inc.*, 2021 FCA 166 (“*Bauer*”), the Federal Court of Appeal has once again cautioned (as it had in *Canmar Foods v. TA Foods*, 2021 FCA 7) against an expansive view of Section 53.1 of the *Patent Act*. In his *Bauer* trial judgment (2020 FC 624), Justice Grammond held that the enactment of Section 53.1 of the *Patent Act* meant that the prosecution history is always relevant context and can be considered by the Court in all cases in which claims construction is at issue. On appeal, the Court of Appeal has repeated that Section 53.1 should only allow for consideration of the prosecution history when there is evidence of inconsistent positions being taken by the patentee – one before the patent office and another before the Court. Otherwise, the rule from *Free World Trust* that extrinsic evidence such as the prosecution history should not be admitted should govern.

The *Bauer* case involved a patent claim for a one-piece quarter for a lasted skate boot, with a “foxing portion”. The “quarter” is the main component of the skate boot that wraps around the foot. It had traditionally been made in two pieces that were sewn together to form the “upper” of the skate boot. The inventive concept of the patent was held to be a quarter in one piece instead of two. The claims at issue were held to be obvious at trial, which finding was upheld on appeal. The construction of the claimed “foxing portion” of the quarter had been relevant at trial, at least in part, to the issue of whether certain prior art anticipated the claims.

In paragraphs [47]-[52] of his trial decision, Justice Grammond explained his view that *Free World Trust* and *Whirlpool* mandate that a purposive construction of patent claims should consider the text, context, and purpose of the claims while keeping in mind that the patent “bargain” requires that the interpretation of a patent claim must be fair to both the patentee and public and that patents are drafted in accordance with particular rules and conventions. The resulting goal of the purposive construction approach is to “search for a claim’s essential elements”, namely those elements that “cannot be substituted without affecting the working of the invention”.

In paragraphs [53]-[72], Justice Grammond explained his view of the law relating to four interpretive issues: (1) reliance on the disclosure and drawings; (2) reliance on extrinsic evidence (namely the prosecution history); (3) claims differentiation; and (4) the principle that claims are not limited to the preferred embodiments. The Federal Court of Appeal only addressed his statement of the law on point (2) relating to extrinsic evidence.

It was the 2018 enactment of Section 53.1 of the *Patent Act* that opened the door to consideration of the prosecution history when construing the claims. Section 53.1 of the *Patent Act* created an exception to the exclusionary rule against the consideration of extrinsic evidence affirmed by *Free World Trust*. Under Section 53.1, written communications during



prosecution between the patentee and a Canadian examiner may now be admitted into evidence “to rebut any representation made by the patentee in the action or proceeding as to the construction of a claim in the patent”.

For Justice Grammond, any time the parties offer competing constructions of the claims, Section 53.1 should be considered to be in play. The patentee’s position on claims construction is always being “rebutted” by the accused infringer. He did not feel that there should be a need to identify a particular representation and rebuttal in order to rely on the prosecution history. [66]

Justice Grammond noted that the “foxing portion” was added to the claim during prosecution to overcome an obviousness objection, making the “foxing portion” essential to patentability. In the litigation, Bauer did not dispute the fact that the “foxing portion” was an essential element of the claim. Rather, the dispute was over the scope to be given to the term. Further, apart from the example shown in the patent, Bauer had not made any explicit representation to the patent office as to the meaning of “foxing portion”. The Court relied on the prosecution history to support its finding that the “foxing portion” of the claim was limited to the “foxing portions” of the disclosure that provided an advantageous curved shape for the heel area. Justice Grammond felt that for Bauer’s expert to argue for a construction of “foxing portion” that would cover “any form of slits, notches or removal of material” that would eliminate “bumps, folds, creasing and/or kinking of the quarter material”, amounted to an attempt to reclaim ground conceded during prosecution. [104]-[105]

On appeal, although it was not necessary for the purposes of its decision to uphold the finding of obviousness, Justice Locke commented on Justice Grammond’s broad interpretation of Section 53.1 and when the Court can consider the prosecution history:

[36] I have difficulty accepting this interpretation because it makes it unnecessary to identify a particular representation before applying section 53.1. This interpretation seems to open the door to unrestricted reference to the prosecution history to assist with claim construction, and seems to be inconsistent with other decisions of the Federal Court: *Canmar Foods Ltd. v. TA Foods Ltd.*, 2019 FC 1233, aff’d 2021 FCA 7 (Canmar); *Eli Lilly Canada Inc. v. Apotex Inc.*, 2020 FC 814. This Court noted this apparent inconsistency also in its appeal decision in *Canmar (Canmar FCA)* at para. 66. Subsection 53.1(1) is a detailed provision that contemplates admitting into evidence certain portions of a patent’s prosecution history for a certain purpose: “to rebut any representation made by the patentee in the action or proceeding as to the construction of a claim in the patent.” If this provision had been intended simply to brush aside the general prohibition against reliance on a patent’s prosecution history for the purposes of claim construction, it could have been much shorter. This view is consistent with this Court’s comments in *Canmar FCA* at paras. 63 and 64.

[37] Based on the text of subsection 53.1(1), it would seem that its purpose is to provide a tool to use against patentees who take one position concerning the meaning of a claim during prosecution of a patent application and another during litigation on the resulting patent. Accordingly, the concern relates to inconsistent statements. Prior to the introduction of section 53.1, such inconsistent statements made during prosecution were not admissible for the purpose of claim construction: *Pollard Banknote Limited v. BABN Technologies Corp.*, 2016 FC 883 at paras. 79-81. Without identifying the representation made by the patentee in the action, it may be difficult to determine whether that representation is inconsistent with something said during prosecution. (emphasis added)

[38] It is not difficult to conceive why Parliament may have decided not to set aside entirely the prohibition against reliance on a prosecution history to construe claims. Among the reasons cited in *Free World Trust* for the prohibition was the following from paragraph 66:

[...] To allow such extrinsic evidence for the purpose of defining the monopoly would undermine the public notice function of the claims, and increase uncertainty as well as fuelling the already overheated engines of patent litigation. The current emphasis on purposive construction, which keeps the focus on the language of the claims, seems also to be inconsistent with opening the Pandora’s box of file wrapper estoppel [...]

[39] The concerns about the public notice function of patent claims and the potential for inappropriately complicating litigation are reasons to limit the lifting of the prohibition against reliance on a prosecution history. Some may question the wisdom of creating such a narrow exception to the prohibition, but it is not the role of the courts to participate in such a debate. Rather, we interpret and apply the legislation as written.



The issue of whether a feature or aspect of a claim is essential and cannot be substituted, or is inessential and can be substituted by a functionally equivalent variant (see *Free World Trust* at [55]), is often central to claims construction debates under the law of purposive construction. However, the possible variants that the patentee had in mind during prosecution may differ from those at issue in the litigation. It can be anticipated that there will be further debate and litigation over the scope of s.53.1 of the *Patent Act* and what reliance can and should be placed on any admissible statements made by the patentee during prosecution, by counsel in argument, or by the Court in arriving at a purposive construction.

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