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The Admissibility of Patent Prosecution History as Evidence in Canada

This past May, the Federal Court of Canada published two additional decisions (the *CCM* and the *Jempak* decisions)^{1,2} that provide additional guidance and clarity on the admissibility of “prosecution history”³ evidence in a patent proceeding under Section 53.1 of the *Patent Act*⁴ (the “Act”). This bulletin provides a summary of what we have learned about this relatively new Section thus far, and how the application of this Section by the courts may impact the manner in which Canadian patent applications are prosecuted. This bulletin will be of interest to inventors, patentees, and patent counsel.

Background

Up until December 2018, prosecution history was deemed inadmissible in a patent proceeding in Canada. As stated in paragraph 66 of the seminal decision of *Free World Trust*:⁵

“In my view, those references to the inventor’s intention refer to an objective manifestation of that intent in the patent claims, as interpreted by the person skilled in the art, and do not contemplate extrinsic evidence such as statements or admissions made in the course of patent prosecution. To allow such extrinsic evidence for the purpose of defining the monopoly

¹ *Bauer Hockey Ltd v Sport Maska Inc.*, 2020 FC 624 (“*CCM*”).

² *Gemak v Jempak*, 2020 FC 644 (“*Jempak*”).

³ The term “prosecution history”, as used in this article, refers to the negotiations between a patentee and a patent office over the wording of the claims leading up to issuance of a patent.

⁴ *Patent Act*, RSC 1985, c P-4.

⁵ *Free World Trust v Electro Sante Inc.*, 2000 SCC 66 (“*Free World Trust*”).

would undermine the public notice function of the claims, and increase uncertainty as well as fuelling the already overheated engines of patent litigation. [emphasis added]"

In December 2018, however, Section 53.1 of the Act came into force in Canada which, with regard to the admissibility of prosecution history evidence, may be paraphrased as follows:

"In any action or proceeding respecting a patent, a written communication, or any part of such a communication, may 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 if it is prepared in respect of the prosecution of the application for the patent and it is between the applicant for the patent and the Commissioner of Patents."

While Section 53.1 of the Act departs from the position set out in the *Free World Trust* decision, the Section does not necessarily run counter to certain realities of patent prosecution. As remarked by the court in the recent *CCM* decision:⁶

"Indeed, prosecution history is publicly available and its use is not unfair to the public. Under the new provision, communications between the patentee and the Patent Office "may 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." [emphasis added]"

Admissible for the Purpose of Claims Construction

Under Section 53.1 of the Act, prosecution history is admissible as evidence but only as it relates to the construction of a claim in a patent. The courts to date have not been shy to emphasize this point.^{7,8,9} As stated in the recent *Jempak* decision:¹⁰

⁶ *Supra* note 1, para. 63.

⁷ *ViiV Healthcare Company v Gilead Sciences Canada, Inc.*, 2019 FC 1579, para. 38 ("*Gilead*").

⁸ *Canmar Foods Ltd v TA Foods Ltd.*, 2019 FC 1233, para. 68 ("*Canmar*").

⁹ *Supra* note 2, para. 86.

¹⁰ *Ibid*, para.86.

Subsection 53.1(1) provides that the prosecution history may be admitted into evidence in an action to rebut any representation made by the patentee regarding claim construction, but only when specific conditions are met. In particular, subparagraph 53.1(1)(b)(ii) provides that the communication must be between the applicant and “the Commissioner, an officer or employee of the Patent Office or a member of a re-examination board.”
[emphasis added]

This point is further underscored in paragraph 65 of the recent *CCM* decision:

Although the use of prosecution history is described in terms of estoppel in the United States, section 53.1 squarely makes this a matter of claims construction. When an issue of claims construction arises, the patentee is always making representations to the Court as to the proper construction of the claims and the defendant is always attempting to rebut those representations. Therefore, in my view, as long as the issue is one of claims construction, section 53.1 applies and the prosecution history is admissible. In other words, there is no need to identify a particular representation and rebuttal every time a reference is made to the prosecution history. It is simply integrated in the interpretive process. [emphasis added]

United States patent practitioners will be well-versed in the prosecution history estoppel approach adopted in numerous U.S. decisions such as *Festo*,¹¹ which created a rebuttable presumption that an amendment narrowing the scope of a claim surrenders originally claimed subject matter,¹² and *Spectrum Pharmaceuticals*,¹³ which states that argument-based prosecution history estoppel arises when the applicant makes an argument evincing a “clear and unmistakable surrender” of subject matter. Under Section 53.1 of the Act however, prosecution history would simply be “integrated

¹¹ *Festo Corp. v Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 US 722 (2002).

¹² *Ibid*, page 738.

¹³ *Spectrum Pharmaceuticals, Inc. v Sandoz Inc.* (Fed. Cir. 10/02/15).

into the interpretive process” undertaken by the court as a part of its claims construction analysis.¹⁴

Claims Construction

While the mechanics of claims construction are outside the scope of this bulletin, suffice it to say that Canada has adopted a “purposive construction” approach to claims analysis which “does away with the first step of purely literal interpretation but disciplines the scope of ‘substantive’ claims construction in the interest of fairness to both the patentee and the public”.^{15,16}

In addition, claims construction in Canada is no longer necessarily limited to the “four corners of the specification”. Rather, with the introduction of section 53.1 of the Act, “purposive construction of patent claims in Canada now includes three prongs: (1) the claims themselves; (2) the disclosure [in the patent]; and (3) the prosecution history in Canada, when used to rebut a representation made by the patentee as to the construction of a claim in the patent”.¹⁷ Such expanded scope will likely affect how patent practitioners prosecute patent applications in Canada, including how and when to appropriately request accelerated examination under the patent prosecution highway program.

Admissibility of Foreign Prosecution History

Foreign prosecution history is generally inadmissible as evidence in a Canadian patent proceeding. The point is highlighted in the recent *Jempak* decision:¹⁸

“There is a further presumption against the legislature impliedly changing established law, particularly the common law. If Parliament had intended that communications prepared in respect of the prosecution of the application for a foreign patent could be admitted, clearer language would be required to effect

¹⁴ *Supra* note 1, para. 65.

¹⁵ *Supra* note 5, para. 50.

¹⁶ *Supra* note 2, para. 90.

¹⁷ *Supra* note 8, para. 68.

¹⁸ *Supra* note 2, para. 86.

that result. In the circumstances, I conclude that section 53.1 did not change the existing rule, as enunciated in *Free World Trust*, that foreign prosecution history is inadmissible.”

But like many general rules, there are exceptions. In this case for example, and as discussed in the *Canmar* decision, “[i]n the extraordinary circumstance that prosecution of the foreign application is made part of the prosecution history of the Canadian patent, that foreign prosecution history, where relevant to limitations made to Canadian claims, should be admissible to aid in a purposive construction of the claims of the Canadian patent” [emphasis added].¹⁹ The court in *Canmar* also noted the following:²⁰

Extraordinary circumstances arise where, as in this case, the patentee acknowledges that the claims have been amended to be substantially the same as claims submitted in another jurisdiction, and the patentee admits that the amendments have limited the scope of the claims in order to make the claims novel and non-obvious. In these circumstances, the Court should be able to refer to the foreign prosecution history for the limited purpose of purposively construing the Canadian claims. [emphasis added]

Thus, there are circumstances where Canadian courts may refer to statements made by the patentee in the course of prosecuting its non-Canadian counterpart patent applications.

Take-away Points

Over the past 18 months, and since the coming into force of Section 53.1 of the Act, Canadian courts have provided stakeholders with further clarity on the application and scope of this Section. Below are some key points to take away from this bulletin about this aspect of Canadian patent law:

- Prosecution history is potentially relevant as evidence in the context of claims construction.

¹⁹ *Supra* note **Error! Bookmark not defined.**, para. 77.

²⁰ *Supra* note **Error! Bookmark not defined.**, para. 74.

- There is a general rule against introducing foreign prosecution history as evidence in a Canadian patent proceeding. However, where prosecution of the foreign application is made a part of the prosecution history of the Canadian patent, then foreign prosecution history may be introduced as evidence in the proceeding for the purposes of claims construction.
- Claims construction is not limited to the four corners of a patent specification.

Canadian patent stakeholders are certainly advised to carefully consider the potential effects of their patent prosecution strategy (including how examinations of their Canadian patent applications are requested) on the enforcement of their patents.²¹

by Pablo Tseng

For more information on this topic, please contact:

Vancouver [Pablo Tseng](#) : 778.328.1631 pablo.tseng@mcmillan.ca

[a cautionary note](#)

The foregoing provides only an overview and does not constitute legal advice. Readers are cautioned against making any decisions based on this material alone. Rather, specific legal advice should be obtained.

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²¹ The author would like to thank his colleagues for their invaluable feedback.