KICKING THE HABIT: THE FEDERAL COURT OF CANADA NIXES THE "PROBLEM-SOLUTION" APPROACH – AGAIN

Posted on July 18, 2022

Categories: Insights, Publications

In *Benjamin Moore & Co. v The Attorney General of Canada*, 2022 FC 923 ("***Moore***"), the Federal Court of Canada (the "**Court**") once again reiterated that the "problem-solution" approach used by the Canadian Intellectual Property Office ("**CIPO**") is not the proper approach to claims construction or for determining patentable subject matter.

Background:

In 2020, the Court in *Choueifaty v Attorney General of Canada*, 2020 FC 837 ("***Choueifaty***") definitively held that the "problem-solution" approach used by CIPO to construe patent claims was inconsistent with the purposive construction approach set out by the Supreme Court of Canada ("**SCC**") in *Free World Trust v Électro Santé Inc.*, 2000 SCC 66 and *Whirlpool Corp v Campo Inc.*, 2000 SCC 67. Our discussion regarding the *Choueifaty* decision can be found here.

Following *Choueifaty*, CIPO issued an updated practice notice titled "Patentable Subject-Matter under the *Patent Act*". This notice explicitly states, "the 'problem and solution' approach in the identification of essential elements during purposive construction should no longer be applied".[1]

The Moore Applications:

Moore filed two patent applications (the "**Moore Applications**") related to Moore's "Color Selection System", which is described as "a computer implemented colour selection method that uses experimentally derived relationships for colour harmony and colour emotion".[2] Both applications were rejected by the patent examiner on the assertion that neither application qualified as an invention under §2 of the *Patent Act*.[3]

The Patent Appeal Board reviewed the applications and recommended that the Commissioner reject them. Despite the *Choueifaty* decision, the Board nevertheless relied on an approach set out in then current s. 13.05.01 (now s. 12.02.01) of CIPO's *Manual of Patent Office Practice*, which stated:

> Once the context is determined the examiner will:

> Identify the problem addressed by the application and its solution as contemplated by the inventor [see 13.05.02b]; and
>
> Determine the meaning of the terms used in the claim and identify the elements of the claim that are essential to solve the identified problem.[4]

The Patent Appeal Board's recommendation was based on this "problem-solution" approach. The Commissioner followed the recommendation and ultimately concluded that "since there was no computer problem to be solved, the computer and associated components were not part of the solution".[5]

Appeal to the Court

Moore appealed the Patent Appeal Board's decisions to the Court. The Intellectual Property Institute of Canada ("**IPIC**") was granted leave to intervene in these appeals. Ultimately, the Court once again ruled that the "problem-solution" approach is inconsistent with the purposive construction approach set out by the SCC in *Free World Trust* and *Whirlpool*.

The Court found that, while CIPO paid lip service to adopting a purposive construction approach consistent with the SCC decisions, CIPO nevertheless still used a "problem-solution" approach in denying the Moore Applications. Notably, the three parties involved – the appellant, the respondent, and the intervener – all agreed that the Commissioner erred by applying the "problem-solution" approach in her assessment of the Moore Applications. The Court agreed with the parties, and further reminded CIPO that claim construction should be made prior to conducting a novelty analysis, stating that:

> In this case, instead of using the purposive construction approach to determine whether the actual invention is patentable, the Commissioner construes the claims of both the 130 and 146 Applications by identifying only the novel aspects of the invention, and determines that those novel aspects are unpatentable as "mere scientific principles or abstract theorems". She also concludes that since there was no computer problem to be solved, the computer and associated components were not essential elements of the invention. First, Free World Trust and Whirlpool require that claim construction be made prior to conducting the novelty analysis. Second, that is not the test dictated by the Supreme Court of Canada to determine whether an element is essential or not to an invention.[6]

Moore and IPIC further argued that "CIPO regularly misconstrues the patentability of computer-implemented inventions, incorrectly excluding them under section 27(8) of the Patent Act",[7] and invited the Court to instruct CIPO to use the appropriate legal test (i.e. the test set out by the SCC). Ultimately, the Court decided that the framework provided by IPIC aligns with the SCC decisions, and instructed the Commissioner to reassess the Moore Applications accordingly and as follows:

a. purposively construe the claim;
b. ask whether the construed claim as a whole consists of only a mere scientific principle or abstract theorem, or whether it comprises a practical application that employs a scientific principle or abstract theorem; and
c. if the construed claim comprises a practical application, assess the construed claim for the remaining patentability criteria: statutory categories and judicial exclusions, as well as novelty, obviousness, and utility.[8]

Closing Remarks

The Moore decision hopefully puts the "problem solution" approach to bed: for good. Patent applicants should welcome the Court's decision as it provides much needed clarity on an issue that has dogged the Canadian patent system for the better part of the past decade and that has caused much avoidable friction between patent applicants and CIPO.

[1] [ps2id id='1' target='/]"Patentable Subject-Matter under the *Patent Act*", Canadian Intellectual Property Office (last modified November 3, 2020).
[2] [ps2id id='2' target='/]*Benjamin Moore & Co. v The Attorney General of Canada*, 2022 FC 923, at para 7.
[3] [ps2id id='3' target='/]*Ibid* at para 8.
[4] [ps2id id='4' target='/]*Ibid* at para 10, citing CIPO's *Manual of Patent Office Practice*, (Gatineau: CIPO, 16 April 2018), s 13.05.01.
[5] [ps2id id='5' target='/]*Ibid* at para 21.
[6] [ps2id id='6' target='/]*Ibid* at para 36.
[7] [ps2id id='7' target='/]*Ibid* at para 33.
[8] [ps2id id='8' target='/]*Ibid* at para 43.

by Pablo Tseng, Tilaye Terrefe, ZiJian Yang (Summer Law Student)

A Cautionary Note