THE PROMISE DOCTRINE: INVALIDATED FOR WANT OF UTILITY

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In *AstraZeneca Canada Inc. v Apotex Inc.*,[1] the Supreme Court of Canada revisited the requirement of utility in the definition of "invention" in s.2 of the *Patent Act*. The Federal Court and the Court of Appeal had held AstraZeneca's patent invalid because it failed to fully deliver on the promises made in the specification. The Supreme Court held that the application of the Promise Doctrine to an analysis of an invention's utility is ultimately the incorrect approach in law and thus AstraZeneca's patent was not invalid for want of utility.[2]

The Promise Doctrine

The Promise Doctrine finds its roots in the "False Promise Doctrine" from the United Kingdom in the early part of the 20th Century. At that time, patents in the UK were a grant from the Crown exercising its own discretionary power. It was presumed that the Crown granted patents on the entirety of the application being true. The courts would thus consider the patent on an invention which does not meet all its promises to be invalid, since they refused to second-guess the Crown's discretion by presuming the Crown would have granted the patent based on anything less than it did.[3]

The modern Promise Doctrine in Canada differs from this interpretation. As explained in *Eli Lilly Canada Inc. v Novopharm Ltd.*:"where the specification sets out an explicit "promise", utility will be measured against that promise.... The question is whether the invention does what the patent promises it will do".[4] Where multiple promises have been made, even if only one of them is unfulfilled, then the utility requirement of the definition of an "invention" in s. 2 *Patent Act* is not met and the entirety of the patent becomes invalid.[5]

Rowe J, writing for a unanimous court in *AstraZeneca*, declared that using this doctrine undermines the interpretation of utility under the *Patent Act* and it "is not good law".[6]

Court's Analysis in *AstraZeneca v Apotex*

In *AstraZeneca*, the Court found the use of the Promise Doctrine in the analysis of a patent's utility to be "excessively onerous" as it raises the bar for the utility necessary for patent validity to the promises expressed therein and it requires that all promises of utility expressed be valid for the patent to be valid.[7]

On the first point, the Court found that the Promise Doctrine does not respect the scheme set out in the

Patent Act as it conflates the requirement of utility in the definition of "invention" (s.2) and the requirement of an applicant to provide proper disclosure of the detailed specifications of the invention (ss.27(3)). These two parts of the *Act* serve different, albeit complementary, roles in the scheme of the *Patent Act* with the latter requiring inventors to share their knowledge with society and the former establishing the boundaries of the limited monopoly that inventors are granted over their knowledge. Effectively, using the Promise Doctrine in the assessment of utility under s.2 will require that any use disclosed under the specification requirement of ss.27(3) be "demonstrated or soundly predicted" at the time of filing, failing which a patent will be invalid.[8]

On the second point, the Court found that the Promise Doctrine is contrary to the *Patent Act* as its application requires that all promised uses be demonstrated or soundly predicted at the filing date. The *Act* only requires a single useful subject-matter though, meaning that the subject-matter is capable of an actual result, either demonstrably or through sound prediction. A mere "scintilla of utility" is sufficient to demonstrate utility under a s.2 analysis.[9] In one case utility was stated to require only that "the wheels must go round."[10] Invalidating patents for want of utility, on the basis of the Promise Doctrine could be unfair to inventors who would be giving up their knowledge without receiving the consideration of a limited monopoly.[11]

Commentary

An interesting observation in *AstraZeneca* is that the Court did not rely on any novel idea to invalidate the Promise Doctrine. In fact, the issue of conflation between s.2 and ss.27(3) had already been dealt with by Dickson J (as he then was) in *Consolboard Inc v MacMillan Bloedel (Sask) Ltd*, where the decision of the Court already differentiated between these two sections of the *Patent Act*. In *AstraZeneca* the Supreme Court found that the Promise Doctrine similarly conflated the section 2 requirement that an invention have utility with the disclosure requirements of ss. 27(3) as had been the case in *Consolboard* and thus the doctrine cannot stand.

The Supreme Court also criticised the "Promise Doctrine" for its focus on the description (disclosure) of the patent, and not the claims.[12]

Furthermore, the Court found that the ill effects of the Promise Doctrine do not outweigh its potential to dissuade inventors from overpromising, especially when overly broad claims or omissions "wilfully made for the purpose of misleading" are already grounds for invalidity under s.53 of the *Patent Act*.[13] The *Act* also contains a provision under s.58 in which only claims found invalid are to be given no effect under the patent, rather than establishing the outright invalidity of the patent. That section also prevents overly broad patent applications, without compromising the integrity of the Act's scheme. There is thus no need to keep using the Promise Doctrine to prevent overly broad or deceptive claims in patents.

When assessing the utility requirement of s.2, courts must only find a "scintilla of utility", demonstrated or soundly predicted, in order to "prevent the patenting of fanciful, speculative or inoperable inventions".[14] Given

the number of recent decisions in which the Federal Courts applied the Promise Doctrine in a s.2 analysis of utility, this decision will ultimately change the courts' approach to this analysis and bring it in line with the words and purposes of the *Patent Act*, leading to more predictable outcomes for inventors. Now that the "Promise Doctrine" has been declared to be dead, it will be interesting to see if the provisions of the *Patent Act* referred to by the Supreme Court actually prevent applicants from engaging in speculation as to utility.

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[1] 2017 SCC 36 [*AstraZeneca*].[ps2id id='1' target='/]
[2] *Ibid*, at para 24.[ps2id id='2' target='/]
[3] *Ibid*, at paras 34, 35.[ps2id id='3' target='/]
[4] 2010 FCA 197 at para 76.[ps2id id='4' target='/]
[5] *AstraZeneca*, supra note 1 at para 31.[ps2id id='5' target='/]
[6] *Ibid*, at para 51.[ps2id id='6' target='/]
[7] *Ibid*, at para 37.[ps2id id='7' target='/]
[8] *Ibid*, at para 44.[ps2id id='8' target='/]
[9] *Ibid*, at paras 53-55.[ps2id id='9' target='/]
[10] *The Mullard Radio Valve Company Limited v. Philco Radio and Television Corporation of Great Britain Limited*, (1935), 52 RPC 261 (CA).[ps2id id='10' target='/]
[11] *AstraZeneca*, *supra* note 1 at para 51.[ps2id id='11' target='/]
[12] *Ibid*, at paras 31 and 53[ps2id id='12' target='/]
[13] *Ibid*, at paras 44-46.[ps2id id='13' target='/]
[14] *Ibid*, at paras 55, 57.[ps2id id='14' target='/]

A Cautionary Note