

Federal Court



Cour fédérale

Date: 20191218

Docket: T-1812-18

Citation: 2019 FC 1641

Ottawa, Ontario, December 18, 2019

PRESENT: The Honourable Madam Justice McVeigh

BETWEEN:

WAYNE S. CUSITAR

Appellant

and

ATTORNEY GENERAL OF CANADA

Respondent

JUDGMENT AND REASONS

I. Introduction

[1] This is a statutory appeal under subsection 48.5(1) of the *Patent Act* (“the Act”) of a re-examination certificate which cancelled the claims in Canadian patent No. 2,876,770 (“the 770 Patent”) because they were found to be obvious and therefore unpatentable.

II. Background

A. *770 Patent*

[2] The Appellant is the owner of the 770 Patent which was filed on January 5, 2015 and issued on November 8, 2016. The Appellant has an engineering background and his patent set out a process for an “improved oil sand mining and haulage method” in northern Alberta. His patent says the method will lead to better performance, reduced greenhouse gas emissions, and an improved process flowsheet over the prior art.

[3] The Appellant’s process purports to have many benefits related to efficiency and flexibility compared to the conventional oil sand mining processes which have dominated the industry over the past three decades. He gives as examples, the industry typically uses “the same sequence of equipment” for each process train, whereas his method involves interchangeable parts and redundancy. As well, he states that his process involves crushing materials in the mine, using conveyance means at the mine face, and then using a haul truck to transport the materials, to be passed along for further processing.

[4] The 770 Patent’s simplified process in Claim 1 was described in a preliminary re-examination decision as follows:

- Mining oil sands with an excavator means;
- Receiving and storing said mined oil sands in a surge hopper means;
- Reclaiming said oil sands with a reclaiming conveyance means;

- Crushing said oil sands in a primary crusher means;
- Discharging said primary crushed oil sands onto a discharging conveyance means;
- Operating a tramp metal sensing and alarm means;
- Transporting said primary crushed oil sands using mine haulage trucks to a slurry preparation facility;
- Dumping said primary crushed oil sands into a remote surge bin at the slurry preparation facility;
- Reclaiming said oil sands from said surge bin using conveyance means to feed said oil sands to the adjacent slurry preparation facility.

B. *Prosecution of the 770 Patent*

[5] There were nearly two years of back-and-forth discussions between the Appellant and the examiner from the Patent Office before the issuance of the 770 Patent.

[6] On June 26, 2015, the examiner raised the issue of obviousness in the first requisition letter. Specifically, the examiner was concerned that the 770 Patent was obvious in light of Patent No. 2,567,644 (issued in 2007) which is referred to as “Reference D1” in both the first requisition and subsequent decisions. Other references like D2 and D3 are actually different documents from decision-to-decision, but D1 stays the same.

[7] Reference D1 describes an oil sands mining and haulage method using conveyor belts. The examiner suggested the Appellant’s patent overlapped with Reference D1 with the exception of conveyor belts being substituted for haulage trucks, noting that “haulage truck means are notoriously well known in the mining arts for use in all materials transporting capacities...

merely substituting a fleet of haulage trucks for the conveyor element of D1 cannot be considered as being inventive”. The examiner also considered three other pieces of prior art which included similar features. Finally, the examiner asked the Appellant to amend language that was indefinite.

[8] The Appellant submitted comments dated July 3, 2015 and received August 24, 2015 which distinguished his application from the four references that were considered by the examiner including D1. For the purposes of this appeal, the most important aspect of the comments is the way the Appellant dealt with the obviousness concerns in the final three pages.

[9] The Appellant’s response was that prior patents, such as D1, did not use trucks instead of conveyors for certain steps because they did not understand “the innovative contributory roles” of “de-coupling”, “redundancy”, “surge capacity”, and “flowsheet simplification”. He called these “compounding benefits”. He then explained that oil sands equipment frequently breaks down because of series-coupling, which means the systems are often unavailable. He presented that his method would mitigate the negative effect of a failure of one machine, and also allows for gains in redundancy and additional surge storage capacity. This is because his system would involve pairing any crusher with any excavator, and the crushers can then feed any crushed oil sand into any haulage truck to transport oil sands to any receiving plant. He says there were more changes than just the use of trucks: the patent also focused on surge capacity (the ability to hold oil sand at certain locations to avoid interruption in sand flow), saying his “surge bin” placement in a mechanically stabilized earth wall is different than the prior art and will improve system availability.

[10] The examiner seemed to be satisfied by these comments. On October 22, 2015 the examiner said he “agrees with the applicant’s arguments with respect to the redundancy and efficiency” of the system. Yet, he still had several concerns with indefinite language. On the final page, the examiner notes:

Regarding the prior art, the applicant has argued that there is a synergistic effect in providing redundancy to the oil sands mining trains which is made possible through the use of haulage trucks and for transporting primary crushed oil sands from the mobile primary crusher means to the oil sand receiving and oil sand preparation facility. The examiner agrees, however this inventive concept is not unambiguously articulated in the instant claims.... The subject matter recited by the claims must be clarified in order to accurately reflect the inventive concept for which protection is being sought and which overcomes the prior art.

[11] This passage is important to this appeal, because the Appellant submits that the examiner accepted his invention to be inventive and not obvious. The Appellant addressed the examiner’s concerns about ambiguity on November 19, 2015. Over the next year there were three additional reports, but these communications do not address the issue of obviousness.

[12] About two weeks before the 770 Patent was issued, Bennett Jones LLP submitted four prior art documents for the examiner’s consideration. These submissions argued the entire 770 Patent was obvious because it “has long been well known in the oil sands mining industry (and other mining industries) that conveyors and haul trucks can be used interchangeably to transport mined ore”. As the Appellant points out, any person may submit prior art to the examiner and the examiner need not respond to these submissions. As he was entitled to do, the examiner did not respond to these comments.

[13] On November 8, 2016, the 770 Patent was issued to the Appellant. He is still the owner of the 770 Patent.

C. *Re-examination process*

[14] On January 17, 2017, Bennett Jones requested a re-examination of the 770 Patent under section 48.1 of the Act. (see Annex A for relevant legislation) This request echoed the prior art submission that was made near the end of prosecution. Bennett Jones submitted four additional documents, along with the same four documents submitted to the original examiner, for a total of eight documents for the re-examiner to consider.

[15] Next, the Commissioner of Patents established a three-member re-examination board (“the Board”) to re-examine the Patent. First, the Board considered the threshold question of whether there was a substantial new question of patentability (“SNQP”) raised in the re-examination application. A SNQP must be raised to trigger a full re-examination under section 48.2 of the Act.

[16] The Board notified the Appellant on May 25, 2017 that Bennett Jones had raised a SNQP about obviousness. The Board cited the fact that Bennett Jones had brought nine prior art documents to its attention including D1, but this was in fact the same D1 that was before the original examiner. So, of these “nine” new prior art references, only eight were submitted by Bennett Jones. The 4 that were explicitly relied upon by the Board were Patent CA 2,567,644 (the same “D1” considered during prosecution), CA 2,733,640 (“D2”), CA 1,315,251 (“D3”) and

an application by Sandvik Mining (“D4”). These same four references were relied upon in the later decision to cancel the patent.

[17] After considering the prior art, the Board found there was no SNQP related to novelty but there was a SNQP related to obviousness. This finding that there was a SNQP triggered a full re-examination.

[18] The Appellant then provided further written submissions to the Board. He emphasized that his invention is not just about equipment, but rather it is a process flowsheet to increase reliability, availability, productivity and costs. More than just a use of equipment components found in the prior art, he says the focus should be on the process and the way the equipment is integrated. He refers to this throughout his written submissions as an “integrated process method patent” and he disputed the finding that there was a substantial question of obviousness. He told the Board that the initial SNQP decision overlooked the ideas about de-coupling, redundancies, surge capacity and equipment availability, which differentiated his patent from the prior art.

[19] The Appellant described that “de-coupling” is defined in his patent as “the breaking of series-connected one-on-one processing train equipment relationships”. “Redundancy” is defined as using “multiple units of identical or alternative technology equipment operating simultaneously in parallel independent relationships but performing the same process function with an incrementally cumulative effect”.

D. *Preliminary opinion*

[20] On January 18, 2018, the Board responded by saying their preliminary opinion was that the 770 Patent was obvious. The Board viewed the inventive concept as the integrated process flowsheet method, however it maintained that the inventive concept of claims 1-11 was just the use of conveyance and then a mine haul truck. The Board at page 4 noted that the term “de-coupling” did not add anything inventive to the concept. The Board went through the Appellant’s written submissions and found each of the steps was either already in the prior art, or would have been obvious to a POSITA. This preliminary opinion also indicated that bias or prejudice in the mining industry could weigh in favour of non-obviousness, however there had been no evidence of a bias or prejudice against his oil sands methods that made his patent non-obvious.

[21] The Appellant was given a chance to respond to this preliminary opinion. His response on March 24, 2018 disputed the way that the Board minimized the importance of the “battery limit” whereby mining and crushing are handled by two different entities. He says this battery limit problem is a systemic industry practice rather than just an industry bias. He claimed that moving the mobile configurations – as shown by his patent – would help to simplify the process. The Appellant also argued the D1 patent is unreliable and not practical. Furthermore, he revisited his arguments about de-coupling and redundancy, citing several potential breakdown scenarios in the existing art that his patent solves.

[22] He later appeared in person and gave a presentation to the Board on March 29, 2018. He once more stated the advantages of his invention.

E. *Re-examination decision*

[23] The re-examination decision dated July 13, 2018 cancelled all 15 claims of the 770 Patent. The Board found that the subject matter was obvious having regard to Reference D1 as well as the newly-raised Patent No. 2,733,640 (issued in 2010) which is referred to as “Reference D2”, and the common general knowledge of a POSITA.

[24] The decision observed close similarities between the patent marked D1 from 2007. The D1 reference involved, as one step of the oil sand process, “transporting said oil sands... to a surge bin... located at a slurry preparation facility”. Meanwhile, the 770 Patent involved “transporting said primary crushed oil sands using mine haulage trucks to a slurry preparation facility”. The other 7 to 8 steps in each oil mining process are generally similar. The Board points out that reference D1 mentions it is well-known to use haul trucks to transport materials.

[25] Meanwhile, reference D2 explicitly refers to haul trucks for transporting crushed material. References D3 and D4 consider how to increase efficiency, including D4’s consideration of both trucks and conveyors depending on environmental and other factors. Based on the *Sanofi* test (discussed below), the Board concluded that the patent was obvious in light of the prior art and the common general knowledge of a POSITA.

[26] The re-examination decision concludes with a certificate cancelling the 770 Patent. This cancellation is on hold pending this appeal, per 48.4(3) of the Act.

F. *Appeal of re-examination certificate*

[27] The Appellant is seeking:

- That the re-examination certificate be set aside;
- That claims 1-15 of the 770 Patent be confirmed as patentable; and
- Costs.

[28] In March 2019 Prothonotary Tabib rejected the Appellant's motion to present new evidence about battery limits on appeal. Prothonotary Tabib found that evidence could have been put before the Board with due diligence, as the Appellant had been told in the preliminary opinion that the Board was lacking evidence of a systemic industry practice as to battery limits. This decision of Prothonotary Tabib has not been appealed.

III. Issues

[29] The issues are:

A. *Was the decision to re-examine the 770 Patent unreasonable?*

- 1) Under a section 48.5 appeal, can this Court review the Board's initial finding that there was a SNQP?
- 2) If this Court can review the SNQP finding, was that finding unreasonable such that the full re-examination should never have occurred?

B. *Was the Board's conclusion that the 770 Patent was obvious unreasonable?*

IV. Standard of Review

[30] The standard of review is reasonableness (*Newco Tank Corp. v Canada (Attorney General)*, 2015 FCA 47 at para 13).

V. Analysis

A. *Was the decision to re-examine the 770 Patent unreasonable?*

- 1) Under a section 48.5 appeal, can this Court review the Board's initial finding that there was a SNQP?

[31] As the Appellant correctly argues, if there was no substantial new question affecting patentability, the re-examination would have ended there pursuant to subsection 48.2(3) of the Act.

[32] However that is immaterial in this case because the statutory right of appeal in subsection 48.5(1) is confined to the "certificate" (i.e. the final decision) rather than the threshold finding in the May 25, 2017 letter that there was a SNQP.

[33] A closer look at sections 48.1 to 48.5 of the Act reveals the flaws in the Appellant's attempt to appeal the result on the threshold question of whether there is a SNQP that triggers the next stage of the re-examination. Under subsection 48.2(2), the Board "shall within three months following its establishment, determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request for re-examination". If the Board finds there is no SNQP then the re-examination ends, that decision is final for all

purposes, and there is no right of appeal, according to subsection 48.2(3). If there is a SNQP, the Board must “notify the patentee of the determination and the reasons therefore” according to 48.2(4). It does not say that there is a right of appeal if there is a SNQP.

[34] Upon the conclusion of the re-examination proceeding, the Board issues a certificate under subsection 48.4(1) which cancels, confirms, or amends the patent. Then, subsection 48.5(1) says “[a]ny decision of a re-examination board set out in a certificate issued under subsection 48.4(1) is subject to appeal by the patentee to the Federal Court” [emphasis added].

[35] The problem for the Appellant is that the finding that there was a SNQP is not “[a]ny decision of a re-examination board set out in a certificate”. The Board had three options for its re-examination certificate: it could cancel, confirm, or amend the 770 Patent. The certificate says “claims 1-15...are unpatentable and are cancelled from the above noted patent”. This certificate decision to cancel the 770 Patent can be appealed under section 48.5(1), but not the letters sent in the early stages and the threshold question of the SNQP. Had Parliament intended to provide an appeal route for the threshold question, they would have done so, or they would have used broader language for section 48.5(1). Instead, section 48.5(1) only allows appeals of decisions set out in the “certificate”.

[36] Perhaps the reason that section 48 of the Act does not provide a right of appeal from SNQP determinations is the goal set out in section 23.02 of the Manual of Patent Office Practice for re-examination to be a “relatively summary and inexpensive alternative to an impeachment process by litigation”. If the Appellant was able to appeal the SNQP determination then that

would have further delayed the 18 month re-examination process as the parties awaited a court decision.

[37] Additionally, the patentee is not a party to the SNQP process and only becomes one after the SNQP determination at which time the requester ceases to be a party. So, it would make sense that the patentee would not have a right of appeal given they were not even a party.

[38] This position is consistent with the view in *Novozymes v Genencor International Inc.*, 2007 FCA 129 at para 7, which noted that re-examination is a “two-step process”. The Appellant is attempting to appeal the first step, over a year after it was dealt with. Similarly, in *Prenbec Equipment Inc. v Timberblade Inc.*, 2010 FC 23 at para 36, Justice de Montigny said “[i]f the patentee is dissatisfied with the Re-examination Board's final determination, he may appeal to this Court and, in the meantime, the effect of the board's decision will be suspended until final judgment of this Court: s. 48.5” [emphasis added]. The SNQP finding is not the final decision, it is a threshold one.

[39] In the alternative, even if the initial SNQP threshold decision was appealable, the three month window to do so under subsection 48.5(2) has passed.

[40] Based on my finding on the first issue, I do not have to consider whether the preliminary determination that there was a substantial new question of patentability was reasonable because this issue falls outside the section 48.5 appeal route.

B. *Was the Board's conclusion that the 770 Patent was obvious unreasonable?*

[41] The Appellant takes issue with the way steps 1(b) through 4 of the obviousness test were applied. He says the finding on the inventive concept of the 770 Patent was unreasonable, as his patent was not just using trucks but rather it involved redundancy, de-coupling, surge capacity, reduced costs, improved equipment availability, and greenhouse gas emissions reductions (collectively, these are the synergistic effects). He puts forward that the inventive concept is the way the equipment in his flowsheet *interacts* to yield benefits, noting that simplicity does not negate invention.

[42] Next, he says the difference between the 770 Patent and the prior art was determined unreasonably. As a result, the Appellant argues the conclusion on the fourth and final element of the test – whether the difference between the 770 Patent and the prior art was an obvious difference – was also unreasonable. The Appellant noted that during prosecution the examiner eventually accepted there were synergistic effects and that the patent was not obvious which supports his view that the re-examination decision was unreasonable. The Appellant says the obviousness issues are “substantially identical” to the issues raised in the SNQP decision in May 2017 as well as the examiner’s initial objections during prosecution in 2015. The further argument is that because the reasons do not acknowledge the examiner’s prior decision on the issue this makes the decision even more unreasonable.

(1) Test for obviousness

[43] Under section 28.3 of the Act, if the 770 Patent must “not have been obvious on the claim date to a person skilled in the art or science to which it pertains”, having considered the relevant

information. The parties agree on the four-part test for obviousness as set out in *Apotex Inc. v Sanofi-Synthelabo Canada Inc.*, 2008 SCC 61 at para 67 (*Sanofi*):

- (1) (a) Identify the notional “person skilled in the art”;
 - (b) Identify the relevant common general knowledge of that person;
- (2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
- (3) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;
- (4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

[44] Obviousness is a “very difficult test to satisfy” (*Beloit Canada Ltee/Ltd. v Valmet Oy* (1986), 8 CPR (3d) 289 at 294 (FCA)) however because the standard of review is reasonableness, deference is owed to the Board (*Newco Tank Corp. v Canada*, 2015 FCA 47).

(2) The application of the *Sanofi* test

Sanofi Step 1: The Board’s selections of the POSITA and common general knowledge of that person were reasonable

[45] No issues were raised by the parties about step 1(a). The POSITA was identified as being “mining experts, open pit engineers, and mine pit planning engineers”.

[46] Step 1(b) is to identify the relevant common general knowledge. In combination the common general knowledge becomes important for steps 3 and 4 of the *Sanofi* test.

[47] Common general knowledge may include information from the prior art and the two “are evidently not mutually exclusive categories” (*Corning Cable Systems LLC v Canada*, 2019 FC 1065 at para 69). In addition to some prior art, common general knowledge also includes “what the person may reasonably be expected to know and be able to find out” (*Janssen-Ortho Inc. v Novopharm Inc.*, 2007 FCA 217 at paras 25). Appropriately, on pages 4-5 of the decision, the Board canvassed the prior art and found the common general knowledge to include, among other things;

- “The use of mobile crushers to crush material at the mine face”
- “Combining the use of conveyors and haul trucks in mining methods” (D4)
- “The use of haul trucks to move material from the mine face to a slurry preparation facility” (based on D1)
- “Optimizing the loading capacity of a bulk material handling system to ensure efficient use of resources” (D3)
- “The use of surge bins...”

[48] The Board supported these findings about common general knowledge by referencing specific sections of the prior art. I accept that the Board’s description of the common general knowledge was reasonable.

[49] The Board found there was insufficient evidence to support the Appellant’s argument about a battery limit that prevented the industry from contemplating the use of in-pit crushing to create a more efficient process.

[50] I find this reasonable because the Appellant knew there was a lack of evidence about a battery limit that is holding the industry back but did not have that evidence before the Board and the further application to bring new evidence was rejected by the Prothonotary. As a result, the Appellant's arguments on the *Sanofi* test that assume there was a battery limit should be given no weight.

Sanofi Step 2: The Board's view of the inventive concept

[51] For step 2, the Appellant says the Board's view of the inventive concept was too narrow. The Appellant had submitted information about the overall process flowsheet and the interaction between the equipment which leads to redundancy, de-coupling, surge storage capacity, and other benefits. The Appellant says it was much more "than simply the use of haul trucks" and other equipment. The Appellant further argues that the process uses mobile excavators, mobile crushers, and a shared fleet of 25 to 35 mine haulage trucks feeding into 2 plants which together will avoid unproductivity when there are unscheduled delays or breakdowns.

[52] I cannot agree as the Board's reasons show that it considered the Appellant's submissions about his integrated process flowsheet, and they considered all 15 claims in the Patent to be the inventive concept. They did *not* view it as "simply the use of haul trucks", as the Appellant contends. Though the Board did not perform an in-depth examination of the inventive concept and there was no need to construct the patent, as the Appellant has consistently stated his patent is for the "integrated" oil sand mining "process flowsheet" as set out in the 15 claims.

Sanofi Step 3: The stated difference between state of the art & inventive concept

[53] The Appellant argued that when examining step 3, the difference between the 770 Patent and the prior art is that none of the cited prior art makes reference to de-coupling, redundancy, surge capacity or process simplification. He points out that for document D1, if one unit in the process fails, the entire equipment train becomes unavailable so the reality is that D1 is inoperable.

[54] When examined I find that the Board considered D1 and said it need not be a “commercially operable system”. The Board found the D1 patent “discloses an oil sands mining system with very similar characteristics as those of the ‘770 Patent and is classified in the same prior art field as the ‘770 Patent”. Then, the Board considered D1 and found the difference with the Appellant’s flowsheet was “that the oil sand material is first placed on a conveyance means at the mine face and then discharged into a haul truck to transport the material to a slurry preparation facility”. I do not think the failure to make reference to the benefits of redundancy, de-coupling, and surge capacity was an error that makes the decision unreasonable. I make that determination because the Board said that “claims 2-10 and 12-15 further defines the steps of the method of claims 1 and 11”, and these claims do get into the benefits of de-coupling and flexibility.

Sanofi Step 4: The Board reasonably found these differences would be obvious to a POSITA

[55] This fourth step is where the common general knowledge set out under step 1(b) enters the equation (*Ciba Speciality Chemicals Water Treatments Ltd. v SNF Inc.*, 2017 FCA 225 at

para 62). Some factors raised by the Supreme Court of Canada for this last step of the *Sanofi* test are (1) whether the patent is self-evident, (2) the extent, nature, and amount of effort required to achieve the invention, (3) a motive to find a solution, (4) the course of conduct that led to the invention, and (5) whether the invention was “obvious to try” (*Sanofi* at paras 84–92). A cumulative look at these factors, particularly factors 1 and 5, show that the Board’s decision was reasonable.

[56] As stated by Justice Pelletier, writing for the Court of Appeal in *Bristol-Myers Squibb Canada Co. v Teva Canada Limited*, 2017 FCA 76 at para 65:

It may be helpful to keep in mind that the obviousness analysis asks whether the distance between two points in the development of the art can be bridged by the Skilled Person using only the common general knowledge available to such a person. If so, it is obvious.

[57] Considering Justice Pelletier’s framing of the question as well as the Supreme Court’s analysis in *Sanofi*, I agree with the Board that the Appellant’s “efficient” process flowchart described in the 770 Patent was obvious.

[58] As noted at para 12 of the reasons, D1 in fact discloses that it is well-known to use haul trucks to transport materials. D2, meanwhile, discloses the use of trucks and/or conveyors with trucks accepting the material from in-pit crushers. Then, D3-D5 explain some factors to consider how to best transport the materials. For example, page 3 of D4 lists factors to consider for optimizing the placement of trucks and conveyors. It is common knowledge that equipment should be arranged in the most efficient way for a mining scenario. Furthermore, I agree with the Board that the “additional features” (which are secondary, based on the Appellant’s submissions)

like the mobile nature of the crusher and the surge bin's positioning are "well known in the art in light of the CGK".

[59] The Appellant points to the 8-year gap between publication of the D1 patent in 2007 and the filing of the 770 Patent in 2015. He admits it was a "simple to implement" idea but "nobody" thought of it before him.

[60] As the Respondent points out, the argument about an 8-year time gap was not before the Board. Furthermore, the test is *not* whether someone has thought of the claim but rather whether the differences between the claims and the state of the art "constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?" (*Sanofi* at para 67). I agree with the Respondent that it is not inventive if a POSITA could bridge the gap between the state of the art and the concept, without inventive ingenuity. This is exactly what the now-cancelled 770 Patent does.

[61] I agree with the Board that the Appellant has not articulated an inventive concept deserving of a patent, especially when the deference owed to the three-member expert Board is considered. Therefore, the decision that the 770 Patent was obvious fell within a range of reasonable outcomes.

- (1) The Board's lack of discussion about the prosecution did not make the re-examination certificate unreasonable

[62] As the Appellant points out, in the first requisition during prosecution on June 26, 2015, the examiner raised similar concerns about obviousness that the Board later raised. The

Appellant addressed them on August 22, 2015. Then, on November 19, 2015 in the second requisition the examiner did not issue much in the way of reasons other than to agree that there were synergistic effects and that the concept was in fact inventive.

[63] The failure to consider this exchange is not enough to make the decision on obviousness unreasonable. While the Board could have laid out the issues dealt with during the prosecution in more detail, this is often the case with the benefit of hindsight. There was not much in the examiner's reasons for the Board to grapple with in any event, and their lack of discussion on this point does not make the decision unreasonable.

[64] I agree with Justice Mosley's views in *Newco Tank Corp v Canada (Attorney General)*, 2014 FC 287 at para 36, aff'd in 2015 FCA 47:

As discussed by Gibson J, in *Genencor*, supra, at para 4, such proceedings are intended to be a "relatively summary and inexpensive alternative to a full-blown impeachment process". They are analogous to decisions made by the Commissioner to refuse to grant a patent under s 40 of the Act. It is inappropriate to impose the burdens that exist in adversarial judicial proceedings for impeachment actions on an administrative re-examination board: *Genencor*, supra, at para 70. The Board is not an adverse party in these proceedings as it has no interest in the outcome. The Board is owed a high degree of deference for its expertise, especially with respect to factual determinations such as its view of the relevant POSITA and their common knowledge.

[65] In this inexpensive, summary process, the Appellant made his submissions to the Board on obviousness. They were considered but the Board found the 770 Patent was obvious. The lack of discussion about the examiner's prior reasons did not render the decision unreasonable.

VI. Costs

[66] The parties post-hearing reached an agreement regarding costs. The parties agreed that lump sum costs inclusive of all disbursements and taxes will be awarded in the amount of \$4,000.00.

JUDGMENT in T-1812-18

THIS COURT'S JUDGMENT is that:

1. The appeal is dismissed; and
2. Costs are payable by the Appellant to the Respondent in the lump sum of \$4,000.00 inclusive of disbursements and taxes.

"Glennys McVeigh"

Judge

Annex A – Relevant legislation

Patent Act, RSC 1985 c P-4

Invention must not be obvious

28.3 The subject-matter defined by a claim in an application for a patent in Canada must be subject-matter that would not have been obvious on the claim date to a person skilled in the art or science to which it pertains, having regard to

(a) information disclosed more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant in such a manner that the information became available to the public in Canada or elsewhere; and

(b) information disclosed before the claim date by a person not mentioned in paragraph (a) in such a manner that the information became available to the public in Canada or elsewhere.

Filing of Prior Art Filing

34.1 (1) Any person may file with the Commissioner prior art, consisting of patents, applications for patents open to public inspection and printed publications, that the person believes has a bearing on the patentability of any claim in an application for a patent.

Pertinency

34.1(2) A person who files prior art with the Commissioner under subsection (1) shall explain the pertinency of the prior art.

Re-examination

Request for re-examination

48.1 (1) Any person may request a re-examination of any claim of a patent by filing with the Commissioner prior art, consisting of patents, applications for patents open to public inspection and printed publications, and by paying a prescribed fee.

Loi sur les brevets, LRC (1985), ch P-4

Objet non évident

28.3 L'objet que définit la revendication d'une demande de brevet ne doit pas, à la date de la revendication, être évident pour une personne versée dans l'art ou la science dont relève l'objet, eu égard à toute communication:

a) qui a été faite, plus d'un an avant la date de dépôt de la demande, par le demandeur ou un tiers ayant obtenu de lui l'information à cet égard de façon directe ou autrement, de manière telle qu'elle est devenue accessible au public au Canada ou ailleurs;

b) qui a été faite par toute autre personne avant la date de la revendication de manière telle qu'elle est devenue accessible au public au Canada ou ailleurs.

Dossier d'antériorité Dépôt

34.1 (1) Une personne peut déposer auprès du commissaire un dossier d'antériorité constitué de brevets, de demandes de brevet accessibles au public et d'imprimés qu'elle croit avoir effet sur la brevetabilité de toute revendication contenue dans une demande de brevet.

Pertinence

34.1(2) La personne qui dépose le dossier doit en exposer la pertinence.

Réexamen Demande

48.1 (1) Chacun peut demander le réexamen de toute revendication d'un brevet sur dépôt, auprès du commissaire, d'un dossier d'antériorité constitué de brevets, de demandes de brevet accessibles au public et d'imprimés et sur paiement des taxes

Pertinency of request

48.1(2) A request for re-examination under subsection (1) shall set forth the pertinency of the prior art and the manner of applying the prior art to the claim for which re-examination is requested.

Notice to patentee

48.1(3) Forthwith after receipt of a request for re-examination under subsection (1), the Commissioner shall send a copy of the request to the patentee of the patent in respect of which the request is made, unless the patentee is the person who made the request.

Establishment of re-examination board

48.2 (1) Forthwith after receipt of a request for re-examination under subsection 48.1(1), the Commissioner shall establish a re-examination board consisting of not fewer than three persons, at least two of whom shall be employees of the Patent Office, to which the request shall be referred for determination.

Determination to be made by board

48.2(2) A re-examination board shall, within three months following its establishment, determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request for re-examination.

Notice

48.2(3) Where a re-examination board has determined that a request for re-examination does not raise a substantial new question affecting the patentability of a claim of the patent concerned, the board shall so notify the person who filed the request and the decision of the board is final for all purposes and is not subject to appeal or to review by any court.

Idem

48.2(4) Where a re-examination board has determined that a request for re-examination raises

réglementaires.

Pertinence

48.1 (2) La demande énonce la pertinence du dossier et sa correspondance avec les revendications du brevet.

Avis

48.1(3) Sur réception de la demande, le commissaire en expédie un double au titulaire du brevet attaqué, sauf si celui-ci est également le demandeur.

Constitution d'un conseil de réexamen

48.2 (1) Sur dépôt de la demande, le commissaire constitue un conseil de réexamen formé d'au moins trois conseillers, dont deux au moins sont rattachés au Bureau des brevets, qui se saisissent de la demande.

Décision

48.2(2) Dans les trois mois suivant sa constitution, le conseil décide si la demande soulève un nouveau point de fond vis-à-vis de la brevetabilité des revendications du brevet en cause.

Avis

48.2(3) Le conseil avise le demandeur de toute décision négative, celle-ci étant finale et ne pouvant faire l'objet d'un appel ou d'une révision judiciaire.

Idem

48.2(4) En cas de décision positive, le conseil expédie un avis motivé de la décision au

a substantial new question affecting the patentability of a claim of the patent concerned, the board shall notify the patentee of the determination and the reasons therefor.

Filing of reply

48.2(5) A patentee who receives notice under subsection (4) may, within three months of the date of the notice, submit to the re-examination board a reply to the notice setting out submissions on the question of the patentability of the claim of the patent in respect of which the notice was given.

Re-examination proceeding

48.3(1) On receipt of a reply under subsection 48.2(5) or in the absence of any reply within three months after notice is given under subsection 48.2(4), a re-examination board shall forthwith cause a re-examination to be made of the claim of the patent in respect of which the request for re-examination was submitted.

Patentee may submit amendments

48.3(2) In any re-examination proceeding under subsection (1), the patentee may propose any amendment to the patent or any new claims in relation thereto but no proposed amendment or new claim enlarging the scope of a claim of the patent shall be permitted.

Time limitation

48.3(3) A re-examination proceeding in respect of a claim of a patent shall be completed within twelve months of the commencement of the proceedings under subsection (1).

Certificate of board

48.4(1) On conclusion of a re-examination proceeding in respect of a claim of a patent, the re-examination board shall issue a certificate

(a) cancelling any claim of the patent determined to be unpatentable;

(b) confirming any claim of the patent

titulaire du brevet.

Réponse

48.2(5) Dans les trois mois suivant la date de l'avis, le titulaire en cause peut expédier au conseil une réponse exposant ses observations sur la brevetabilité des revendications du brevet visé par l'avis.

Procédure de réexamen

48.3(1) Sur réception de la réponse ou au plus tard trois mois après l'avis mentionné au paragraphe 48.2(4), le conseil se saisit du réexamen des revendications du brevet en cause.

Dépôt de modifications

48.3(2) Le titulaire peut proposer des modifications au brevet ou toute nouvelle revendication à cet égard qui n'ont pas pour effet d'élargir la portée des revendications du brevet original.

Durée

48.3(3) Le réexamen doit être terminé dans les douze mois suivant le début de la procédure.

Constat

48.4(1) À l'issue du réexamen, le conseil délivre un constat portant rejet ou confirmation des revendications du brevet attaqué ou, le cas échéant, versant au brevet toute modification ou nouvelle revendication jugée brevetable.

determined to be patentable; or

(c) incorporating in the patent any proposed amended or new claim determined to be patentable.

Certificate attached to patent

48.4(2) A certificate issued in respect of a patent under subsection (1) shall be attached to the patent and made part thereof by reference, and a copy of the certificate shall be sent by registered mail to the patentee.

Effect of certificate

48.4(3) For the purposes of this Act, where a certificate issued in respect of a patent under subsection (1)

(a) cancels any claim but not all claims of the patent, the patent shall be deemed to have been issued, from the date of grant, in the corrected form;

(b) cancels all claims of the patent, the patent shall be deemed never to have been issued; or

(c) amends any claim of the patent or incorporates a new claim in the patent, the amended claim or new claim shall be effective, from the date of the certificate, for the unexpired term of the patent.

Appeals

48.4(4) Subsection (3) does not apply until the time for taking an appeal has expired under subsection 48.5(2) and, if an appeal is taken, subsection (3) applies only to the extent provided in the final judgment on the appeal.

Appeals

48.5(1) Any decision of a re-examination board set out in a certificate issued under subsection 48.4(1) is subject to appeal by the patentee to the Federal

Annexe

48.4(2) Le constat est annexé au brevet, dont il fait partie intégrante. Un double en est expédié, par courrier recommandé, au titulaire du brevet.

Effet du constat

48.4(3) Pour l'application de la présente loi, lorsqu'un constat:

a) rejette une revendication du brevet sans en rejeter la totalité, celui-ci est réputé, à compter de la date de sa délivrance, délivré en la forme modifiée;

b) rejette la totalité de ces revendications, le brevet est réputé n'avoir jamais été délivré;

c) modifie une telle revendication ou en inclut une nouvelle, l'une ou l'autre prend effet à compter de la date du constat jusqu'à l'expiration de la durée du brevet.

Appel

48.4(4) Le paragraphe (3) ne s'applique qu'à compter de l'expiration du délai visé au paragraphe 48.5(2). S'il y a appel, il ne s'applique que dans la mesure prévue par le jugement définitif rendu en l'espèce.

Appel

48.5(1) Le titulaire du brevet peut saisir la Cour fédérale d'un appel portant sur le constat de décision visé au paragraphe 48.4(1).

Court.

Limitation

48.5(2) No appeal may be taken under subsection (1) after three months from the date a copy of the certificate is sent by registered mail to the patentee.

Prescription

48.5(2) Il ne peut être formé d'appel plus de trois mois après l'expédition du double du constat au titulaire du brevet.

FEDERAL COURT
SOLICITORS OF RECORD

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