

DRAFT

CHAPTER 16

UTILITY AND NON-STATUTORY SUBJECT MATTER

16.01 SCOPE OF THIS CHAPTER

16.02 DEFINITION OF A STATUTORY INVENTION

16.02.01 An Invention Must Be Useful

16.03 PREREQUISITES OF A PATENTABLE INVENTION

16.04 EXAMPLES OF NON-STATUTORY SUBJECT MATTER

16.05 LIVING MATTER

16.06 JURISPRUDENCE

CHAPTER 16 UTILITY AND NON-STATUTORY SUBJECT MATTER

16.01 SCOPE OF THIS CHAPTER

This chapter indicates practice on the kinds of subject matter considered to be an invention under Section 2 of the *Patent Act*, divorced from considerations of novelty and unobviousness. Direction is given, in particular, as to the patentability of subject matter comprising: living matter, medical treatment, diagnostic methods, and intellectual matter, including computer related matter.

16.02 DEFINITION OF A STATUTORY INVENTION

Section 2 of the *Patent Act* defines the essential features of an invention. It reads in part:

"invention" means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter.

Art means a mode, or method, or manner of accomplishing a certain result as distinct from the result. An art must accomplish some change in the character or condition of material objects. Any art which belongs to the professional fields and which is a manual art or skill is not an art within the meaning of Section 2 of the *Patent Act*.

A process may be defined as a mode or method of operation by which a result or effect is produced by chemical action, by the operation or application of some element or power of nature or of one substance to another.

A machine is the embodiment in mechanism of any function or mode of operation designed to accomplish a particular effect.

Manufacture is defined as anything made by the art or industry of man and connotes the making of something which must be a vendible product of a process.

Composition of matter means chemical compounds, compositions and substances.

16.02.01

An Invention Must Be Useful

Section 2 of the *Patent Act* requires utility as an essential feature of invention. Utility, as related to inventions, means industrial value. If an invention lacks utility for its described purpose it will result in an invalid patent should it be granted. The use of the invention must be apparent from the description to one of skill in the art

16.03

PREREQUISITES OF A PATENTABLE INVENTION

In assessing whether subject matter falls within the meaning of the definition of a patentable invention under Section 2 of the *Patent Act*, the prerequisites established by Canadian jurisprudence and legislation that must be satisfied are, inter alia:

- (a) whether the subject matter relates to a useful art (as distinct from a fine art where the result produced is solely the exercise of personal skills, mental reasoning or judgment, or has only intellectual meaning or aesthetic appeal);
- (b) whether the subject matter is operable, controllable and reproducible by the means described by the inventor so that the desired result inevitably follows whenever it is worked;
- (c) whether the subject matter has practical application in industry, trade or commerce and
- (d) whether it is more than a mere scientific principle or abstract theorem (Subsection 27(8) of the *Patent Act*).

16.04

EXAMPLES OF NON-STATUTORY SUBJECT MATTER

- (a) Plants and animals are not patentable subject matter. Seeds are also non-patentable, however a coated seed may be patentable if the invention resides in the coating given to the seed provided that the life process of the seed has not

been altered and there is no new living matter.

Plant varieties that are distinct, uniform and stable may be protected under the Plant Breeders' Rights Act, administered by Agriculture Canada.

- (b) Subject matter related to a process of surgery or therapy on living humans or animals is not considered to be within the scope of "invention" as defined by section 2 of the *Patent Act*. The exclusion does not cover methods of treating animals to derive economic benefit. Claims which could encompass both medical and non-medical methods are not patentable. Methods of testing which do not relate to any step of surgery or therapy or vital function of the body may be patentable. Articles or apparatus designed for use in the treatment of humans or animals are patentable, provided they conform to all other conditions of the *Patent Act*.
- (c) Subject matter that accomplishes a result by means of a person's interpretive or judgmental reasoning cannot form the basis of a patent.
- (d) Subject matter that is a process or the product of a process, that depends entirely on artistic or personal skills, such as: procedures for exercising, teaching, cosmetological procedures, hair dressing, pedicure, flower arranging, painting pictures or playing musical instruments. However, materials and instruments used in these arts may be patentable.
- (e) Subject matter that is only a scheme or plan, a mere scheme for doing business, a method of accounting or providing statistics, a personality or I.Q. test and the like is not considered to be within the scope of "invention" as defined by section 2 of the *Patent Act*.
- (f) Subject matter comprising new rules for playing games or the like, printed or design matter having intellectual connotations only is unpatentable. However, structural features of printed matter and arrangements specially adapted to produce a new mechanical function or purpose may be patentable.

16.05

LIVING MATTER

Living matter is defined in terms of uni-cellular life forms, such as bacteria, many fungi (including yeasts), cells in culture, transformed cell lines and hybridomas, and multi-cellular life forms, such as plants, seeds and animals.

Uni-cellular life forms which are new, useful and inventive are patentable. A process to produce or a process which utilizes these organisms may also be patentable.

Multi-cellular life forms are not patentable subject matter. However, a process for producing a multicellular life form may be patentable provided the process requires significant technical intervention by man and is not essentially a natural biological process which occurs according to the laws of nature, for example, traditional plant cross-breeding.

16.06**JURISPRUDENCE AND REFERENCES**

The following decisions of the courts are of importance in considering the subject matter of this chapter:

Use/Utility

Mailman v Gillet	SCR 724	1932
Northern Electric v Photo	Ex CR 36	1940
	SCR 224	1941
Wandscheer v Sicard	SCR 1	1948
Metalliflex v Wienerberger	35 CPR 49	1961
	SCR 117	1961
Boehringer v Bell-Craig	39 CPR 201	1962
Rhone-Poulenc v Gilbert	55 CPR 207	1968
Burton Parsons v Hewlet	17 CPR (2d) 97	1976
	1 SCR 555	1976
Marzone v Eli Lilly	37 CPR (2d) 37	1978
Proctor & Gamble v Bristol	39 CPR (2d) 145	1978
	42 CPR (2d) 33	1979
Monsanto v Com of Patents	42 CPR (2d) 161	1979
	2 SCR 1108	1979
Consolboard v MacMillan	56 CPR (2d) 145	1981
Radio Corp v Hazeltine	56 CPR (3d) 170	1981
Shell Oil v Com of Patents	2 SCR 536	1982
	67 CPR (2d) 1	1982
Corning v Canada Wire & Cable	81 CPR (2d) 39	1984
Lubrizol v Imperial Oil	33 CPR (3d) 11	1990
	45 CPR (3d) 449	1992
TRW Inc v Walbar	39 CPR (3d) 176	1991
Welcome v Apotex	39 CPR (3d) 289	1991
Haul-All v Shanahan	50 CPR (3d) 368	1993
Unilever v Procter & Gamble	47 CPR (3d) 479	1993
	61 CPR (3d) 499	1995
Feherguard v Rocky's	53 CPR (3d) 417	1994
	60 CPR (3d) 512	1995

Novelty in utility

Wright v Brake Service	Ex CR 127	1925
Pope Appliance v Spanish River	Ex CR 28	1926
Canadian Gypsum v Gypsum Lime	Ex CR 180	1931
Mailman v Gillet	SCR 724	1932
Lanlois v Roy	Ex CR 197	1941
Northern Electric v Browns	SCR 224	1941
Shell Oil v Com of Patents	2 SCR 536	1982
	67 CPR (2d) 1	1982
Apotex v Hoffman-La Roche	15 CPR (3d) 217	1987
	24 CPR (3d) 289	1989
Re Application of Wayne State University	22 CPR (3d) 407	1988

Nonstatutory subject matter

Lawson v. Com of Patents	62 CPR 101	1970
Tennessee Eastman v Com of Patents	62 CPR 117	1970
	SCR 111	1974
Re Application for Patent containing claims that read on mental steps performed by a human operator in deciding to transmit a signal	23 CPR (2d) 93	1972
Re Application 3,389 of N.V. Organon	15 CPR (2d) 253	1973
Re Application 880,719	18 CPR (2d) 114	1973
Re Application of Polnauer	CPOR 40-xii	Oct 5, 1976
Re Dixon application 203	60 CPR (2d) 105	1978
Re Application of Pallos	1 CPR (3d) 334	1978
Re Application 079,973	54 CPR (2d) 124	1979
Schlumberger v Com of Patents	56 CPR (2d) 204	1981
	63 CPR (2d) 261	1982
Re Application of Abitibi Co.	62 CPR (2d) 81	1982
ICI v Com of Patents	9 CPR (3d) 289	1986
	3 FC 40	1986
Pioneer Hi-Bred v Com of Patents	14 CPR (3d) 491	1987
	25 CPR (3d) 257	1987
Re Application of Goldenberg	22 CPR (3d) 159	1988
Re Application of Clorox Co.	33 CPR (3d) 160	1990
Progressive Games v Com of Patents	3 CPR (4th) 517	1999
	9 CPR (4 th) 479	2000
President and Fellows of Harvard College v Com of Patents	2002 SCC 76	