



IPIC

Bonjour,
We have just received IPIC
comments on MOPOP Chapter 12 and 16.
Attached is a copy for your information.
For those of you involved in the working
group(s), Louis-Pierre will contact you
for further discussions. Merci
Agnès

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Concerned with

Patents,

November 19, 2004

Trade-marks,

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de commerce,

de droits d'auteur et

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Dear Ms. Lajoie:

Re: Proposed MOPOP Chapters 12 and 16

Thank you for consulting IPIC in your review process for the proposed new MOPOP amendments of October 8, 2004. We are pleased to see the advances that have been made in the proposed amendments since we first started working together.

You will find attached the Institute's comments on chapters 12 and 16. They were prepared by our IT Committee and the IPIC members of the JLC-Patents and were reviewed by Council.

In particular, we would like you to consider the following issues:

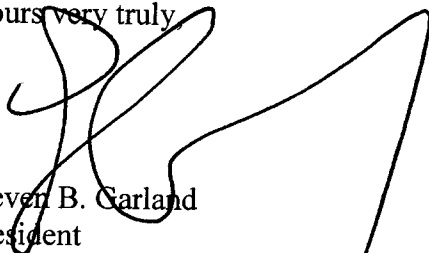
1. The definition of "art".
2. The requirement of an "economic result".
3. The use of the term "vendible product".

4. Statements made without citing supporting case law.
5. The requirement of a "physical" change in an object.
6. The alternative claim language statement made in section 12.03.

We would also like you to consider the overlap between Chapters 12 and 16. Removing overlap will aid in ensuring that a single source is provided for consistency. Our attached comments address this issue in greater detail.

Finally, we would like to suggest a meeting between IPIC and your editorial group to discuss our comments and to talk about the next steps in the revision of the MOPOP. If you agree, Michel Gérin will contact you to organize a meeting.

Yours very truly,

A large, stylized handwritten signature in black ink, appearing to read 'S. Garland', is written over the typed name and extends upwards into the 'Yours very truly,' line.

Steven B. Garland
President

cc: Louis-Pierre Riel, CIPO
Mark Schisler, IPIC IT Committee
Anthony Creber, JLC-Patents
Michel Gérin, IPIC



IPIC

**Comments from the
Intellectual Property Institute of Canada
on Proposed MOPOP Chapters 12 and 16
Issued by CIPO on October 8, 2004**

November 19, 2004

Introduction

The previous draft of 2003.06.17 had two chapters namely:

- Chapter 16 “Utility and Non-Statutory Subject Matter”; and
- Chapter 26 “Computer Implemented Inventions and Business Methods”

These have been replaced with new chapters:

- Chapter 12 “Utility and Subject Matter”; and
- Chapter 16 “Computer-Implemented Inventions”

Generally, many of the changes and points added to create Chapters 12 and 16 represent new and unique interpretations of the requirements for patentability. This is of some concern to IPIC, because many of these new interpretations do not appear to be supported by legislation or case law. Moreover, it seems that many of the changes demonstrate a policy shift by the Patent Office, which must be based on a sound application of the *Patent Act* and *Rules* together with the applicable jurisprudence.

Our specific concerns and recommendations are set out in detail below.

Chapter 12 Utility and Subject Matter

12.01

The definition of “business methods” looks out of place and probably should be included in section 12.04. Please consider also that by singling out “business methods” the Patent Office may be sending a biased message.

The definition itself leaves the reader with the impression that business methods in general are unpatentable subject matter, even though the Office states that there is no reason to “exclude” these types of inventions from patentability. We recommend that the language of this definition be revised.

12.02

Regarding point (1), the concept that a publication may “deem” an invention to lack novelty is problematic. A publication cannot “deem” an invention to lack novelty. We recommend that the reference to “deem” be removed.

Regarding point (3), we recommend changing “Statutory” to “Statutory Subject Matter”. Also, we recommend changing this section to refer to the wording of Section 2 of the Patent Act, such as:

Statutory subject matter. It must fit in a recognized category, i.e. art, process, machine manufacture or composition of matter or any improvement therein, for not all subject-matter is patentable.

Regarding point (4), we would submit that “degree” is part of a question of fact, and we recommend the proposed wording:

Inventive Ingenuity. There must be an inventive step. This is a question of fact, which includes an element of degree. More specifically, there must be an advance in the art, which is neither “obvious” nor merely a “workshop” improvement.

Further, the *Patent Act* makes no reference to “inventive ingenuity” as a requirement for patentability. We recommend referring to section 28.3 of the *Act* regarding obviousness.

Without a definition of “inventive ingenuity,” readers may assume that this sets a high standard. We believe that the standard was set by the Supreme Court of Canada in *Farbwerke Hoechst Aktiengesellschaft Vormals Mesiter Lucius & Bruning v. Halocarbon (Ontario) et al.* (June 21, 1979), 42 C.P.R. (2d) 145 (reversing 28 C.P.R. (2d) 63, reversing 15 C.P.R. (2d) 105), which reads:

On this point the Federal Court of Appeal reached a different conclusion, Jackett, C.J., saying (at p. 65 C.P.R., p. 471 F.C.):

“The learned trial Judge appears to have proceeded upon the assumption that the requirement of “inventive ingenuity” is satisfied unless the “state of the art” at the time of the alleged invention was such that it would have been obvious to any skilled chemist [15 C.P.R. (2d) 105 at p. 113, [1974] 2 F.C. 266]: “that he would successfully produce isohalothane (assuming the monomer used here and hydrogen bromide) in the “liquid phase”. (The italics are mine.) I do not think that the learned trial Judge's assumption is correct as a universal rule. I would not hazard a definition of what is involved in the requirement of “inventive ingenuity” but, as it seems to me, the requirement of “inventive ingenuity” is not met in the circumstances of the claim in question where the “state of the art” points to a process and all that the alleged inventor has done is ascertain whether or not the process will work successfully.”

In my view this statement of the requirement of inventive ingenuity puts it much too high. Very few inventions are unexpected discoveries. Practically all research work is done by looking in directions where the “state of the art” points.

In other words, even when a prior art reference teaches in the direction of the invention, the Supreme Court of Canada has held that “inventive ingenuity” must have been exercised to arrive at an invention which goes beyond the teaching in the art. We believe that this sets a very low bar. We recommend explaining this in more detail.

12.02.01

The modified definitions for “art” and “a process” confuse these two concepts. The new definition of “art” essentially repeats the definition of “process.” Specifically, the definition of “art” includes a process having an essentially economic result which is beneficial to the public. The qualification of a process in this definition seems to be out of place. Further, it appears that the statement “Art means a mode, or a method, or manner or accomplishing...” comes from Fox, Canadian Patent Law and Practice, Fourth Edition. Although Mr. Fox is well respected and rightfully so, MOPOP should refer only to law.

Clearly a great deal of thought has been given to the new definition of art. However, we question the inclusion of the last italicized sentence from *Lawson v. Commissioner of Patents* (1970), 62 C.P.R. 101. *Lawson* does indeed provide such a statement, but it was made in *obiter* and is obsolete since the Supreme Court of Canada decision in *Shell Oil*. The “physical agent” and “physical object” requirements are too restrictive, and have not been followed in subsequent decisions.

Specifically the Supreme Court in *Shell Oil* at page 554 [1982] 2 S.C.R. 536 stated, while referring to its *Tennessee Eastman* decision:

The Court affirmed that “art” was a word of very wide connotation and was not to be confined to new processes or products or manufacturing techniques but extended as well to new and innovative methods of applying skill or knowledge provided they produce effects or results commercially useful to the public.

With regard to “beneficial to the public” in *Re Application of Organon* (1974), 15 C.P.R. (2d) 255 at 257-258 the following is stated:

The other factor to be decided is whether the “art” in terms of the present process satisfies the prerequisites of being a “useful” art or process within the meaning of s. 2(d), which may be conveniently stated, inter alia, as to: whether the subject matter is useful in a “manual or productive art” Whether the subject matter is controllable and reproducible by the means disclosed so that the desired result inevitably follows whenever it is worked, and whether the subject matter has utility in practical affairs (as that in relation to trade, commerce or industry) which is beneficial to the public.

Read in its proper context, this quote refers to an aspect of utility and not a requirement of patentable subject matter.

The second paragraph of 12.02.01 is puzzling in the reference to “power of nature,” which has not traditionally been considered as a topic for patentable subject matter.

The definition of a process appears to be limiting, in that it addresses chemical or material processes only. A “process” is not limited to chemistry as is intimated in this section. Also, the phrase “of a process” appearing at the end of the definition of ‘manufacture’ is problematic, since a manufacture does not have to be the product of a process.

In paragraph 3, we recommend changing “A machine is a mechanical embodiment...” to “A machine is a physical embodiment...”, as some machines may not be mechanical.

We recommend that composition of matter specifically refer to genes and cells, which are clearly patentable subject matter in light of *Harvard College* and *Schmeiser*. For completeness, it should also refer to mixtures and new crystalline forms.

In paragraph 4, this language appears to be a rewrite of the following statement from *Lawson* (the same paragraph was also recited by the Supreme Court in *Tennessee Eastman*):

Manufacture connotes the making of something. Thus it is seldom that there can be a process of manufacture unless there is a vendible product of the process. It must accomplish some change in the character or condition of material objects.

Taken in its proper context, vendible product qualifies a “process of manufacture” and the language in this paragraph suggests that a vendible product is not an absolute requirement. However, the whole concept of a vendible product is cast into doubt by the following paragraph in *Lawson* (62 C.P.R. 101, at 109-110):

In the earlier development of patent law, it was considered that an invention must be a vendible substance and that unless a new mode of operation created a new substance the invention was not entitled to a patent, but if a new operation created a new substance the patentable invention was the substance and not the operation by which it was produced. This was the confusion of the idea of the end with that of means. However, it is now accepted that if the invention is the means and not the end, the inventor is entitled to a patent on the means.

In view of the foregoing, the paragraph would better be stated as:

Manufacture is anything made by the labour or industry of man.

Thus, we consider the definition of "art" to be too restrictive based upon current case law, and in particular in view of the meaning of "art" as interpreted by the Supreme Court of Canada. We recommend that the italicized sentence in the first paragraph be deleted.

12.03

This section is unclear and implies that *all* utility for a given invention must be specified in the specification. The jurisprudence is clear that all that is required is that the utility must be apparent, and (ignoring new use for old compound for the moment), a patent covers other uses even if not contemplated at the time of the application, so long as there was some utility at the time.

Further, it appears that the last two sentences of this section are contradictory. The penultimate sentence makes it clear that for claims that define subject matter in the alternative, each alternative will be interpreted as a separate claim. The last sentence of this section states

Therefore, if an embodiment in a claim lacks utility, the whole claim may be held invalid.

As each alternative is a separate claim under subsection 27(5) of the *Patent Act*, if one of the alternatives has utility that alternative is valid, even if other alternatives lack utility. Subsection 27(5) was intended to overcome the harsh result of an entire claim being invalidated where one embodiment lacked utility. If CIPO has a case law reference to the contrary (we believe you may be referring to *Minerals Separation North American Corp v. Noranda Mines*), adding a footnote here would be helpful.

12.03.01

Regarding the reference of the requirement to establish utility at the claim date, it is unclear whether you mean that an examiner may request such information during the prosecution process. We recommend that this be clarified.

This section states that the onus is on the applicant to establish utility at the claim date. This statement is contrary to the Supreme Court of Canada decision in *Monsanto v. Commission of Patents*. One aspect of the case was that the Commissioner can only reject an application for lack of utility where the Commissioner has proof that an embodiment within the scope of the claim lacks utility or if the prediction is not sound. A second aspect of this decision is that the Commissioner must allow the patent, unless the Commissioner is satisfied that the applicant is not entitled to a patent. Thus, where an applicant states that the claimed subject matter has utility, the Commissioner is not to refuse the application unless there is proof that the claimed subject matter lacks utility.

It appears that this section misinterprets the requirement for sound prediction as set out in *Apotex v. Wellcome*. In this decision, there is no mention of an “onus” upon the patentee to prove utility. In addition, in *Apotex* the Court made no finding as to what must go into an application, nor the onus in prosecution. Similarly, the reference to *Apotex v. Wellcome* appears to be incorrect because the new use was the invention, and the test for sound prediction applies when the new utility is the invention.

Likewise, this section appears to require an applicant who relies on sound prediction to satisfy the three requirements. It is unclear if the specification itself must identify the three requirements or if the applicant will be required to provide evidence of this upon being requested by the Examiner. Either way, such a requirement *in the application* is not supported by case law.

The comments on the *Monsanto* and *Burton Parsons* decisions appears to suggest that these decisions are not to be followed except in some narrow manner. This is incorrect. The Supreme Court of Canada in the *AZT* case actually approved these decisions.

12.03.02

Section 12.03.02 is new and deals with operability. The inclusion of the phrase “the desired result inevitably follows whenever it is put into practice” is confusing and is not supported by case law. We recommend that the word “inevitably” be removed from this section and that “whenever” be replaced by “when.”

In chemical cases, any chemist can cause a reaction to fail some of the time. This is not the test for lack of utility. When the reaction works, if the desired result follows then the patent has the requisite utility.

12.03.03

We recommend that the word “inevitably” be removed and “whenever” replaced by “when” for the reasons expressed above.

There is no legal authority for the proposition that an invention must be controllable. In fact, this was rejected in *Harvard College*.

Reproducibility appears to be linked to an accepted degree of success. It is unclear to what this phrase refers and raises the possibility that an application will be rejected based on an unknown standard. As such, we recommend that the reference to an accepted degree of success be removed. The jurisprudence is clear that an application is sufficient (not a utility issue) so long as a person skilled in the art can put the invention into practice, without undue experimentation. Thus it is recognized that some trial and error is acceptable, thus contradicting the concept of “inevitable result.”

The assumption that the use of “human-factors” leads to non-reproducible results does not appear to be correct. In some cases it may, but such a generalization is inaccurate. We recommend the wording

Subject matter that accomplishes a result solely by means of a person’s interpretative or judgmental reasoning cannot form the basis of a patent.

or alternatively

Subject matter that accomplishes a result by means of a person’s reasoning, in which the quality or character of the result may vary depending upon the individual skilled in the art performing the process or method, cannot form the basis of a patent.

There are many methods that require a person skilled in the art to determine a quality or quantity based on the interpretation of data. The comparison of two things can be equally determined by mechanical means such as sensors. Such interpretation may simply be one step in a sequence of steps. Its presence should not disqualify patentability.

As was suggested in regard to previous section 26.02(4)(I)

Human intervention is common during the steps of a process. When a human step is necessary, the examiner must determine whether the step has been fully integrated within the process and whether the mental step is predictable and precise. If this is the case, such an invention constitutes patentable subject matter.

Support for the above suggestion may be found in *Re: Application For Patent Containing Claims That Read On Mental Steps Performed by a Human Operator in Deciding to Transmit a Signal*. (23 C.P.R. (2d) 99 at p. 95):

A mental step which is judgmental or interpretive (purely mental) is definitive of a process the result of which depends on the intelligence and reasoning of the human mind. It seems settled that it is only this latter type of mental step, which renders a process unpatentable.

Further (at p.96):

Therefore, a process which includes a *mental* step involving the ascertaining and sensing facilities is patentable (provided all other attributes of patentability are present), since the effect of the mental step is precise and predictable no matter how skillfully it is performed. On the other hand, a process which includes a *mental* step, the nature of which is dependent upon the intelligence and reasoning of the human mind cannot satisfy the requirements of operability since the effect of the human feedback or response is neither predictable nor precise whenever the process is worked by its users.

It follows that the specific questions to be satisfied in this case are (assuming novelty and unobviousness):

- (1) Whether the steps involving human response are of the type that require subjective interpretive or judgmental considerations; or whether they are responses that are clearly defined and precise, and for example, can be performed otherwise by apparatus; and
- (2) Whether there is sufficient teaching of the human intervention so that the inventive process is operative when performed by its users.

12.04

This section deals with categories of non-recognized statutory subject matter. This section is analogous to the old section, however, a number of additions have been made that should be reviewed.

12.04.01

The phrase “multi-cellular life forms are not patentable subject matter” is incorrect. In *Harvard College* the Supreme Court of Canada used the term “higher life forms”, not “multi-cellular life forms”. Indeed, the Court did not distinguish between uni- and multi-cellular life forms in either *Harvard College* or *Schmeiser*. They distinguished between “higher life forms” and “lower life forms.” The Supreme Court accepted the definition in *Abitibi* which included some multicellular life forms.

Also, the exclusion of “tissues, organs, parts” etc. is incorrect. In *Harvard College*, the Court held that a “fertilized oocyte” was patentable subject matter. The limitation to cells in culture is in error because in *Schmeiser* and in both the majority and minority opinions in *Harvard College* it was held that cells and genes are patentable *per se*.

We recommend that the exclusion of “fungi colonies of differentiated cells” be removed because of an absence of supportive case law. Similarly, the exclusion of tissues (if excluded at all) should be limited to “non-homogeneous” tissues.

12.04.02

There are several references to “an essentially economic result.” The phrase “an essentially economic result relating to trade, industry or commerce” is not supported by legislation or case law and we recommend that it be removed. The citation of *Tennessee*

Eastman as support for the proposition that methods of medical treatment are unpatentable because they do not produce “essentially economic results” is in error. *Tennessee Eastman* was unpatentable due to the requirement that it involved professional skill, not that it did not produce an economic result. Treatment of patients is an economic result.

If “an essentially economic result” is indeed a key determining factor of patentability, perhaps it deserves a special section. Please see our comments on section 16.03.2a.

This section should also address medical use claims and in particular acknowledge that these types of claims are patentable.

12.04.03

This has always been a puzzling area and perhaps an explanation of what constitutes “mere” should be considered. The issue here is that by the use of “mere” there appears to be some threshold, which is not defined.

12.05

This section seems to overlap with 12.04. Perhaps a single section would be appropriate.

Subparagraph (a) is based on *Lawson*, but *Lawson* has been superseded by *Progressive Games* and *Shell Oil*. As such, this statement should be revised. Similarly, there seems to be no legal precedent for the position stated in subparagraphs (b) and (c).

It is unclear what “intermediate transitory product with no inherent commercial use per se or to internal convenience of a particular manufacturer” means and thus this should be clarified.

In 12.05(a) we recommend substituting “the subject matter” with “an art or process.”

Section 12.05(c) and the last bullet point may be in conflict, as the former seems to consider business method patents while the latter does not. Perhaps it would be better to make it clear that such inventions may be patentable if they meet the guidelines for computer related inventions. Please also see our comments throughout on the requirement of an “economic result.”

With regard to the procedures of the first bullet point being recognized as non-statutory subject matter, we recommend that references to case law be made or the examples be deleted. This comment applies to all examples mentioned throughout the chapter, as without a specific reference readers may be misled.

In the paragraph of examples of subject matter not recognized as being patentable, in particular the second last bullet point, we believe that “new rules for playing games or the like” is too broad. In particular, the *Progressive Games* decision and the subsequent

dismissal of appeal by the Federal Court of Appeal in which the court accepted that a method of playing poker with cards would qualify as “art” provided it was also new and innovative, given the test set out in *Shell Oil*. Accordingly, we recommend that the reference to new rules for playing games be deleted.

We recommend also that CIPO consider the TRIPS Agreement, Article 27 regarding what is considered to be patentable subject matter.

Chapter 16 Computer-Implemented Inventions

16.02

We question the need to make the test here any different from what has gone before. If a person skilled in the art can implement the invention, the disclosure is fine. We recommend that you reconsider placing restrictions on what constitutes a complete and valid disclosure for a specific type of invention.

The terminology used to describe various computer program related features is inconsistent. The section refers to “computer program,” “software,” “functional modules,” “modules in the system,” and “particular components.” Perhaps referring simply to a computer program having functional modules would make this more clear.

We recommend the following wording or something similar:

The invention should be described in sufficient detail for one skilled in the art to make and work the invention, this may comprise but is not restricted to: a description of hardware, a description of the modules of a computer program, and data structures.

In the “Computer program” section, “process algorithms” could be simply “processes.”

In the “data” section, we recommend changing “How is the data structured or stored in the memory?” to “What is the format of data when stored or transmitted?”. Further, the use of the term “data” may be overly restrictive, as some inventions may not utilize data but rather a simple hardware signal to instruct a circuit. If the signal is a hardware function than no data is required. There will be inventions where all three of hardware, “a computer program” and a data structure may not be required. Hardware and computer programs are quite often interchangeable, one may build a chip to function in the same manner as a software program based upon the signals it receives. Thus, requiring all three features is too restrictive. Perhaps a preamble indicating that typical features of an invention would utilize a combination of hardware, a computer program or “software” would be sufficient. Simply because an invention does not have one of the three features does not necessarily make the invention a “mere scheme.”

We recommend rephrasing in the hardware paragraph, “Are the important elements of the computer system...” as “Are the elements of the invention...” Otherwise this section requires possibly irrelevant elements be described in unnecessary detail.

16.03.01

Please see our comments on section 12.03.03 above.

The second paragraph does not seem to relate to the first and may be out of place.

We question the statement,

The outcome of the claimed method or system must be achievable from the teachings in the description without subjective judgment or interpretation by a person skilled in the art.

It is not the “outcome” that must be achievable without subjective judgment or interpretation. Rather, it is the claimed invention that must be reproducible. If the claimed apparatus or claimed process can be reproduced without subjective judgment or interpretation on the part of the person building the apparatus or carrying out the process, then it is not relevant whether the outcome of that process requires subjective judgment or interpretation to be useful. For example, an electronic tire pressure monitoring system would not cease to be patentable merely because the outcome, i.e. a low or high tire-pressure warning to the driver, requires subjective judgment or interpretation on the part of the driver. It is sufficient that the builder of the tire pressure monitoring system was able to build the system without subjective judgment or interpretation, based on the teachings of the specification.

16.03.02

Please see our comments on section 12.02.01 above with regard to the use of “physical object.”

We recommend in paragraph 2 changing “traditional” to “statutory.” Should there be other references to the term “traditional” we would suggest the same change be made.

In the last paragraph, the statement

In the absence of a full and correct description of the invention by means of hardware, software and data structure, the application may be considered as describing a mere scheme, for which no patent may issue.

does not appear to reflect the requirements for patentability under Canadian law. In particular, the term “scheme” is not found in the *Patent Act* or *Rules*. The European Patent Convention includes as Article 52(2) EPC a prohibition against the patentability of “schemes, rules and methods for performing mental acts, playing games or doing business ...”. The characterization of an invention as a “mere scheme” does not appear to us to have any connection with whether or not an invention qualifies as a new and useful art, process, machine, manufacture or composition of matter, or improvement therein, as required by the Canadian Patent Act.

This section includes a further reference to “an essentially economic result.” It may be best to consolidate such requirements with the applicable case law in a single section on patentable subject matter.

The last paragraph commencing with “In practice, even when claims...” is the only reference made to searching in this chapter. Perhaps it is not needed or is out of place.

16.03.2a

In general, there is overlap between this section and the contents of Chapter 12. We recommend that Chapter 16 focus on computer related inventions, and exclude the definition of “professional skill” and “economic results.”

We recommend deleting paragraph 3. Professional skill or method can certainly result in an “essentially economic result.” For example, think of the professional skills of those that can cap oil well fires, find treasure in the oceans or provide a method to transfer negotiable instruments between parties. Such skills and methods certainly provide an economic result. Further an invention may be developed now that is not economically feasible, but may be in the future, and an examiner cannot be expected to determine this. We recommend that this broad caveat be removed, and that such inventions be examined using the basic tests of utility, novelty and obviousness.

The argument of “financial success” to defend the validity of an invention is not well accepted by the Federal Court. There are many nuances to consider. Paragraph 3 appears to be too broad in light of existing case law.

In paragraph 4, some reference numbers to the cases in points (a) to (e) would be advantageous. Also, we are not aware of any case law to support the statement “...and is considered to have a broad meaning” and we recommend that this statement be removed.

We also recommend that paragraph 6 in point (b) be modified to include the language from the *Shell* decision, namely “new and innovative methods of applying skill or knowledge provided they produce effects or results commercially useful to the public.”

16.03.03

The principle that obviousness must be assessed with reference to the claim as a whole is consistent with s.28.3 of the *Patent Act*, which states that the subject matter of a claim shall not be obvious. Section 28.3 does not suggest that an examiner focus on obviousness of the subject matter of some elements but not others.

The term “non-analogous use” in the last sentence is unclear and we recommend that it be rephrased. Perhaps what is meant is “non-obvious.”

16.04.01

We recommend adding “and” to the penultimate phrases of each claim example, as was done in example claims 7 and 9. We also recommend changing “collecting samples of sampling a first signal” to “collecting samples of a signal.” Although we see nothing wrong with using “first,” we do not see reference to “second.”

16.04.02

Regarding Claim 2, the preamble does not match that of Claim 1, in that it uses “compressing” vs. “enrolling.” Since from the introduction this is providing an example of transforming a method claim to means plus function language, we recommend that it be consistent. Also, we recommend changing “b) filter” to “b) a filter,” or perhaps “means for filtering,” as the rest of the claim is in means-plus-function language.

16.04.03a

We recommend the insertion of “Example” before claim 5, and changing “However, a computer medium claim may not carry...” to “However, a proposed computer medium claim may not carry...”.

16.04.03b

In the example, we recommend deleting (c), as it is the same as (b), and changing (d) to (c).

16.05

We recommend changing “claim” to “claims.”

16.05.01

We recommend changing the text following claim 8 from “Formulae, equations...” to “Unapplied formulae, equations...”.

Examples shown as claim 8 and 9 illustrate unacceptable claims, while claims 10 and 11 show acceptable claims. Then claim 12 reverts to unacceptable. We recommend moving claim 12 to the ‘unacceptable’ section.

The discussion of claim 9 refers to a “physical agent,” however the claim appears to be a method claim that does not utilize a physical agent. We recommend including an explanation of why such a claim is “physical.”

16.05.04

In the paragraph beginning “Although Claim 13...”, it is our view that *Lawson* does not support the statement of “an essential economic result in relation...” and we recommend removing this sentence.

Appendix 16.1

It is not clear how the Patent Appeal Board references apply to the text of the chapter. In contrast, the endnotes provide specific references. If the intent is simply to provide additional information, we recommend that there be context provided to aid the reader in determining which references may be applicable in a given situation.

We also recommend adding *Re Application of Fujitsu Lts. (Now Patent No. 1,200,911)*, 9 C.P.R. (3d) 475, May 6, 1985.