

## Chapter 12

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## Chapter 12 Utility and subject matter

### 12.01 Scope of this chapter

This chapter outlines the Patent Office's practice concerning subject matter and utility requirements under section 2 of the *Patent Act*, divorced from considerations of novelty and obviousness <sup>1</sup>.

~~The expression "business methods" refers to a broad category of subject matter which often relates to financial, marketing and other commercial activities. These methods are not automatically excluded from patentability, since there is no authority in the *Patent Act* or *Rules* or in the Jurisprudence to sanction or preclude patentability based on their inclusion in this category. Patentability is established from criteria provided by the *Patent Act* and *Rules* and from Jurisprudence as for other inventions. Business methods are frequently implemented using computers. Guidelines regarding computer-implemented inventions are expanded on in more detail in Chapter 16 hereinof MQPOP.~~

### 12.02 Definition of a statutory invention

Section 2 of the *Patent Act* defines 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.

From this statutory definition and other sections of the *Patent Act*, the criteria for a patentable invention are <sup>2</sup>:

- 1) Novelty. The invention must not have been "anticipated" by another patent or a publication that would ~~deem it to lack~~ show it lacks novelty under that statute.
- 2) Utility. The invention must be operative, controllable and reproducible.

- 3) Statutory subject matter. It must fit in a recognized category, for not all subject-matter is patentable.
- 4) Non obviousness or inventive ingenuity. There must be an inventive step. *This is a question of fact and degree*<sup>3</sup>. The fact ~~concerns the~~ is that there must be an advance in the art whereas the degree entails that the advance it is neither "obvious" nor merely a "workshop improvement" (Section 15.01.02 herein).

Even when subject matter is novel and unobvious, it can still be non-patentable if it does not fit in a recognized category (sections 12.02.01 and 12.04 ~~of MOPOP~~ herein), or is not useful (section 12.03 ~~of MOPOP~~ herein).

### **12.02.01 Subject matter defined in section 2 of the Patent Act**

An "art" is an act or series of acts performed by some physical agent upon some physical object and producing in that object some change either of character or of condition<sup>4</sup>; "art" overlaps but does not eclipse "process"<sup>5</sup>; an "art" must be a manual or productive art (it must make a vendible product)<sup>6</sup> and/or be a new and innovative method of applying skill or knowledge that produces an essentially economic result relating to trade, commerce, or industry (it must be a method of operating or using an invention)<sup>7</sup>.

A "process" may be defined as a mode or method of operation by which a result or effect is produced by physical or chemical action, by the operation or application of some element or power of nature or one substance to another. It implies the application of a method to a material or materials<sup>8</sup>.

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

A "manufacture" is the process of making something on a large scale by the application of physical labour or mechanical power, or the thing made by such a process; excludes higher life forms<sup>9</sup>.

Composition of matter includes chemical compounds, compositions and substances  
~~Question 10/11/12~~

### **12.03 Utility**

Section 2 of the *Patent Act* requires an invention to have utility. The use of the invention is not necessarily stated in the claims <sup>10</sup>, but must be apparent from the description to one skilled in the art <sup>11</sup> (see also chapter 9 of ~~MOPOP~~ herein on Description and subsection 27(3) of the *Patent Act*). However, where the invention is a new use for an old product, the claims must indicate the new use <sup>12</sup>.

In practice, subject matter, for which ~~the~~ utility is not apparent from the specification to one skilled in the art <sup>5</sup>, that is inoperative <sup>13</sup>, ~~or~~ has results that cannot be reproduced, or that does not have results beneficial to the public <sup>14</sup> will be considered not to comply with the definition of invention under section 2 of the *Patent Act*. An invention must be useful for some purpose but not any particular purpose unless a certain utility is provided in the specification <sup>15</sup>. A claim defining subject matter that is, in view of the description, lacking some of the features or elements that are necessary or essential for the subject matter to be useful as taught will be considered to lack support for utility under section 84 of the *Patent Rules* (see Chapter 11 of ~~MOPOP~~ herein). ~~Also, subsection 27(5) of the Patent Act states that when a claim defines subject matter in the alternative, each alternative is interpreted as a separate claim. Therefore, if an alternative embodiment in a claim lacks utility, the whole claim may be held invalid for lack of utility. (Questionable, coming from Hughes & Woodley)~~

### 12.03.01 Predicted utility

If ~~the~~ no utility of the subject matter which forms the basis of a claim is ~~not~~ apparent or the promised utility of the subject matter is in doubt, then the ~~onus is on the~~ applicant ~~to~~ must have established utility, at the claim date, either by demonstration (i.e. testing the invention and conclusively proving utility) or by sound prediction <sup>16</sup>. Unless the inventor is in a position to establish utility as of the time the patent is applied for, on the basis of either demonstration or sound prediction, the Commissioner "by law" is required to refuse the patent <sup>17</sup>. It is not necessary for an inventor to provide a theory of why the invention works, but the "Doctrine of Sound Prediction" must not be diluted to include "a lucky guess or mere speculation" <sup>18</sup>.

An application that relies on sound prediction must satisfy three requirements:

- 1) *there must be a **factual basis** for the prediction;*
- 2) *the inventor must have at the date of the patent application an articulable and "**sound**" line of reasoning from which the desired result can be inferred from the factual basis; and*

- 3) *there must be proper disclosure by a full, clear and exact description of the nature of the invention and the manner in which it can be practised.*

The Doctrine of Sound Prediction applies not only to patent applications containing broad classes of chemical compounds, but also to new uses of known compounds and new uses of novel compounds. As long as the utility of the claimed subject matter relies on sound prediction, the requirements of the doctrine must be fulfilled.

For example, the Monsanto<sup>19a</sup> and Burton Parsons<sup>19b</sup> decisions dealt with novel compounds and novel electrocardiograph creams, respectively. The factual basis in these cases was supplied by tested compounds, but other factual underpinnings, depending on the nature of the invention may suffice. The line of reasoning was based on “structure-activity relationship” but other lines of reasoning, depending on the subject matter, may suffice.

#### **12.03.02 Operability**

The subject matter must be operable<sup>20</sup> by the means described by the inventor so that the desired result inevitably follows whenever it is put into practice<sup>21</sup>. The subject matter will be considered to lack utility if the invention does not work<sup>22</sup>, either in the sense that it will not operate at all or, more broadly, that it will not do what the specification promises that it will do<sup>23</sup>. The specification has to include the information, terminology, and means available at the time of the claim date, to provide sufficient description to enable the making of the invention, when read by a person skilled in the art.

#### **12.03.03 Reproducibility**

The invention must be controllable<sup>24</sup> and its result reproducible by the means described so that the desired result inevitably follows whenever the invention is put into practice<sup>25</sup>. However the expression “desired result inevitably follows” can refer to an accepted degree of success of a particular repetitive mass production method. For example, if a method is known and universally recognized in a particular art of having a success rate under a certain ratio or percentage of rejects, the desired result inevitably follows if this method is inside such parameters.

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.

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 having ordinary skill in the art performing the process or method, cannot form the basis of a patent. Human factors induce variation in the results due to different level of intuition, creativity, conjecture, and approximation, and therefore lead to ~~non-~~irreproducible results. A person's reasoning may include judgement <sup>26</sup> and interpretation.

#### **12.04      ~~Categories not recognized as statutory~~ Further guidance for certain subject matter**

Not all subject matter is patentable. Some subject matter is excluded by subsection 27(8) of the *Patent Act*, and under section 2 of the *Patent Act* based on clarifications of the definition of invention by Jurisprudence.

##### **12.04.01      Living matter**

Uni-cellular life forms which are new, useful and inventive are patentable <sup>27</sup>. In general, a process to produce, or which utilizes, these organisms is patentable. Uni-cellular life forms comprise:

- microscopic algae;
- fungi (including moulds and yeasts)<sup>28</sup>, ~~excluding fungi fungal colonies of differentiated cells~~
- bacteria;
- protozoa;
- viruses;
- cells in culture;
- transformed cell lines; and
- hybridomas.

~~Multi-cellular Higher~~ life forms are not patentable subject matter <sup>29</sup>. However, a process for producing a ~~multi-cellular higher~~ 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<sup>30</sup>. ~~Multi-cellular~~ Higher life forms comprise:

- animals<sup>31</sup>;
- plants<sup>32</sup>;
- seeds<sup>26</sup>;
- mushrooms<sup>33</sup> (differentiated fungal colonies);
- tissues, organs, embryos<sup>25</sup>, and parts of plants and animals; and
- colonies of differentiated cells.

Plant varieties that are distinct, uniform and stable may be protected under the Plant Breeders' Rights Act, administered by the Canadian Food Inspection Agency.

#### **12.04.02 Medical treatment**

A method or 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*, because such methods do not produce an essentially economic result in relation to trade, industry, or commerce<sup>34</sup>. Accordingly, The exclusion does not cover methods of treating animals to derive an economic benefit are not excluded<sup>35</sup>. If, when used for its leading purpose, a claimed method does not produce an essentially economic result, then that method is non statutory even if it could have other purposes<sup>36</sup>. Articles or apparatuses designed for use in the treatment of humans or animals are patentable, provided they conform to all other conditions of the *Patent Act*<sup>37</sup>.

Methods of diagnosing a ~~physical~~ disease or ~~physical~~ medical condition in a human being, provided that the methods do not contain any step of surgery or therapy, may be patentable<sup>38</sup>. The Patent Office practice regarding medical treatment is explained in more detail in Chapter 17 of ~~MOPOP~~ herein (currently under revision).

#### **12.04.03 Scientific principle or abstract theorem**

Subsection 27(8) of *Patent Act* specifically precludes "any mere scientific principle or abstract theorem" from patentability. Mathematical formulae<sup>39</sup> and algorithms are considered equivalent to mere scientific principles or abstract theorems (see also Section 16.05.01).

#### **12.04.04 Business methods**

The expression "business methods" refers to a broad category of subject matter which often relates to financial, marketing and other commercial activities. These methods are not automatically excluded from patentability, since there is no authority in the *Patent Act* or *Rules* or in the jurisprudence to sanction or preclude patentability based on their inclusion in this category. Patentability is established from criteria provided by the *Patent Act* and *Rules* and from Jurisprudence as for other inventions. Business methods are frequently implemented using computers. Guidelines regarding computer-implemented inventions are discussed in Section 12.04.05 and Chapter 16 herein.

#### **12.04.05 Computer-implemented invention**

Software expressed as lines of code or listings in a patent application or claims are not considered as patentable subject matter, but may be protected as literary works under the *Copyright Act*. Software in the form of an abstract theorem or algorithm is automatically excluded from patentability under subsection 27(8) of the *Patent Act*, but software that has been integrated with a traditionally patentable subject matter may be patentable. The Patent Office practice regarding computer implemented invention is explained in more detail in Chapter 16 of ~~MOPO~~herein.

#### **12.04.06 Games**

A method or set of rules for playing a game with a known gaming apparatus or article (e.g. a generic deck of cards) is not patentable<sup>40</sup>.

A method of playing with a conventional deck of cards in a new way is considered non-statutory subject matter because the deck of cards is being used for a known use. The cards lack novelty and inventiveness therefore indicating that the nature of the subject matter is the method or the rules for playing the game. The same principle applies to slot machines with bonus games.

A new arrangement of printed or design matter may form the subject matter of a patent if it performs a mechanical function or purpose in consequence of use<sup>41</sup>. The new arrangement of printed matter must import some functional limitation in a combination so as to produce a unitary result, which is useful in some practical way, as opposed to solely intellectual, literary or artistic connotations<sup>42</sup>. If the novelty lies solely in the meaning of the printed words or the aesthetic appeal of the printed or design matter, it is not considered patentable subject matter. Such matter is also referred to as non-functional descriptive matter.



A method of playing a board game or a game involving cards is considered to be patentable subject matter if the game board or cards are themselves novel and inventive. This can occur if they bear a new arrangement or design that provides some inventive functional use.

## **12.05 Examples of subject matter lacking utility or not recognized as statutory subject matter**

To summarize, in assessing whether subject matter falls within the definition of invention under section 2 of the *Patent Act* and by jurisprudence from Canadian Courts, the Patent Office will determine:

- (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<sup>43</sup> 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 an essentially economic result relating to trade industry or commerce<sup>44</sup>, ~~which is beneficial to the public~~, provided that the process is an innovative method of applying skill or knowledge, and
- (d) whether it is more than a mere scientific principle or abstract theorem (subsection 27(8) of the *Patent Act*).

Some examples of subject matter lacking utility or subject matter not recognized as statutory subject matter ~~are as follows~~ include the following:

- Process or the product of a process, that depends entirely on artistic, personal skills, performing purely mental acts, mental reasoning<sup>45</sup> or judgment, or has only intellectual meaning or aesthetic appeal<sup>46</sup>, ~~such as for example~~: procedures for exercising, teaching, cosmetological procedures, hair dressing, pedicure, flower arranging, painting pictures or playing musical instruments may not be patentable. However, materials and instruments used in these arts may be patentable. The subject matter must relate to a “useful art”, as distinct from a fine

art where the result produced is solely the exercise of the preceding inputs.

- Intermediate transitory product with no inherent commercial use per se <sup>47</sup>, or to the internal convenience of a particular manufacturer <sup>48</sup>.
- ~~New rules for playing games or the like~~<sup>49</sup>, Printed matter, design matter or presentation of information having intellectual connotations or aesthetic appeal. However, structural features of printed matter and arrangements specially adapted to produce a new mechanical function or purpose may be patentable.
- Mere schemes <sup>50</sup>, plans <sup>51</sup>, speculations <sup>52</sup> or ideas <sup>53</sup> such as a rule for doing business, a method of accounting or providing statistics, a personality or I.Q. test and the like.

**As an aside, do you believe that a method of operating a medical practise, which includes the step of carrying out a method of medical treatment on a human patient, would overcome the current Office reluctance? By casting the claim in such a fashion, it would provide an "essential economic result", and thereby provide some protection to the invention, to the extent that third parties could not carry out the method for compensation. It would still permit doctors to carry out the method on a pro bono basis with impunity.**

## Endnotes for Chapter 12

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- 1 Utility, novelty and unobviousness have to be present to constitute a patentable invention:  
Langlois v. Roy (1941) ExCR 197 at p. 203  
Northern Electric Co. v. Brown's Theatres Ltd. (1941) SCR 224  
Wright v. Brake Service Ltd. (1925) ExCR 127 at 131, aff'd (1926) SCR 434 at 444
- 2 Cochlear Corp. v. Cosen Neurostim Ltée [1995] F.C.J. No. 1433 at para 91, also indexed as [1995] 64 C.P.R. (3d) 10
- 3 Cochlear Corp. v. Cosen Neurostim Ltée [1995] F.C.J. No. 1433 at para 91(4), also indexed as [1995] 64 C.P.R. (3d) 10
- 4 Although the Supreme Court stated in *Shell* (67 C.P.R. (2d) 1 at 10-11) that "art" must be given its general connotations of being learning or knowledge as commonly used in expressions such as "the state of the art" or "the prior art", the Court emphasized (at 11, 14) that an "art" had to have a method of practical application. The Court also stated (at 15) that the Exchequer Court (in *Tennessee Eastman*) had affirmed that "art" was a word of very wide connotation and was not to be confined to processes or products or manufacturing techniques but extended as well to new and innovative methods of applying skill or knowledge provided they produced an economic result in relation to trade, commerce, or industry. Note that, with the exception of products, each of these terms refers to a type of method. The Supreme Court has subsequently shown in *Harvard* (21 C.P.R. (4<sup>th</sup>) 417 at 477) that it does not consider products (i.e. "compositions of matter" and articles of "manufacture") to be encompassed by "art". In *Shell*, the Supreme Court ultimately went on (at 15) to approvingly quote from the Exchequer Court in *Lawson* and *Tennessee Eastman* that an "art" is an act or series of acts performed by a physical agent upon some physical object and producing in that object some change either of character or condition.
- 5 Refrigerating Equipment Ltd. v. W.A. Drummond and Waltham System (1930) Ex. C.R. 154 at 166; *Harvard College v. Commissioner of Patents* (2002) 21 C.P.R. (4<sup>th</sup>) 417 (S.C.C.) at 479
- 6 *Lawson v. Commissioner of Patents* (1970) 62 C.P.R. 101 (Ex. Ct.) at 110-111; *Tennessee Eastman v. Commissioner of Patents* (1970) 62 C.P.R. 117 (Ex. Ct.) at 154-155, aff'd (1972) 8 C.P.R. (2d) 202 (S.C.C.)
- 7 *Shell Oil v. Commissioner of Patents* (1982) 67 C.P.R. (2d) 1 (S.C.C.) at 15, also indexed as (1982) 2 SCR 536
- 8 *Commissioner of Patents v. Ciba Ltd.* (1959) 30 C.P.R. 135 aff'd 27 C.P.R. 82
- 9 *Harvard College v. Commissioner of Patents* (2002) 21 C.P.R. (4<sup>th</sup>) 417 (S.C.C.) at 478-479
10. *Marzone Chemicals Ltd. v. Eli Lilly & Co.* (1978) 37 C.P.R. (2d) 37 at 38 & 39  
*Monsanto Canada Inc. v. Schmeiser* (2001) 12 C.P.R. (4<sup>th</sup>) 204 at 216 (see paragraph 26), aff'd (2002) 21 C.P.R. (4<sup>th</sup>) 1 at pp. 16-18 (see paragraphs 40 to 46)
11. *Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd.* (1981) 56 C.P.R. (2d) 145 at 153 to 160, also indexed as (1981) 1 SCR 504  
*Metalliflex Ltd. v. Rodi & Wienerberger AG* (1961) 35 C.P.R. 49 at p. 53, also indexed as (1961)

- SCR 117  
Feherguard Products Ltd. v. Rocky's of BC Leisure Ltd. (1995) 60 CPR (3d) 512 at p. 518  
Burton Parsons Chemical Inc. v. Hewlett-Packard (Canada) Ltd. (1976) 17 CPR (2d) 97 at p. 104,  
also indexed as 1 SCR 555  
Monsanto Co. v. Commissioner of Patents (1979) 42 CPR (2d) 161 at p. 165, also indexed as  
(1979) 2 SCR 1108
12. Apotex Inc. v. Wellcome Ltd. (2000) 10 C.P.R. (4<sup>th</sup>) 65 at para. 81-85, aff'd (2002) 21 C.P.R. (4<sup>th</sup>)  
499
13. Hoechst Pharmaceuticals of Canada Ltd. v. Gilbert & Co. (1966) S.C.R. 189 at p. 194,  
Lubrizol Corp. v. Imperial Oil Ltd. (1990) 33 C.P.R. (3d) 1 at pp. 27 & 28, varied (1992) 45 C.P.R.  
(3d) 449
14. Re Application No. 003,389 of N.V. Organon (1973) 15 C.P.R. (2d) 253 also indexed as  
Commissioner's Decision No. 144, Application 3,389, (Now patent 937,498)(1973)
15. Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd. [1981] 1 SCR 504 at 526, also  
indexed as (1981) 56 C.P.R. (2d) 145
16. Apotex Inc. Wellcome Foundation Ltd. (2002) 21 C.P.R. (4<sup>th</sup>) 499 at pp. 501-502
17. Apotex Inc. v. Wellcome Foundation Ltd. [2002] 4 S.C.R. 153 at para. 46, also index as 21 C.P.R.  
(4<sup>th</sup>) 499
18. Apotex Inc. Wellcome Foundation Ltd. (2002) 21 C.P.R. (4<sup>th</sup>) 499 at p. 501
19. a) Burton Parsons Chemical Inc. v. Hewlett-Packard (Canada) Ltd. (1976) 17 CPR (2d) 97, 1  
SCR 555  
b) Monsanto Co. v. Commissioner of Patents (1979) 42 CPR (2d) 161 at p. 165, (1979) 2 SCR  
1108  
These two preceding decisions were cited to support the definition of sound prediction in Apotex  
Inc. v. Wellcome Foundation Ltd. (2002) 22 C.P.R. (4<sup>th</sup>) 499
20. Commissioner's Decision No. 703, Application 312,909 (1980)
21. Northern Electric Co. v. Brown's Theaters Ltd. (1940) ExCR 36 at 56, aff'd (1941) SCR 224  
Wandscheer et al. V. Sicard Limitée (1944) 4 C.P.R. 5 at p.15-16, aff'd (1947) 6 C.P.R. 35  
Corning Glass Works v. Canada Wire & Cable Ltd. (1984) 81 C.P.R. (2d) 39 at p. 42  
Wellcome Foundation Ltd. v. Apotex Inc (1991) 39 C.P.R. (3d) 289 at 338, aff'd (1995) 60 C.P.R. (3d)  
135  
Feherguard Products Ltd. v. Rocky's of BC Leisure Ltd. (1994) 53 C.P.R. (3d) 417 at 424-425,  
aff'd (1995) 60 CPR (3d) 512  
Procter & Gamble Co. v. Bristol-Myers Canada Ltd. (1978) 39 C.P.R. (2d) 145 at pp. 159-160,  
aff'd (1979) 42 C.P.R. (2d) 33  
Commissioner's Decision No. 337, Application 114,647, (Now patent 1,013,190) (1976)  
Commissioner's Decision No. 1256, Application 2,145,007 (2003)  
Commissioner's Decision No. 1159, Application 474,156 (1990)  
Radio Corporation of America v. Hazeltine Corporation (1981) 56 C.P.R. (2d) 170

22. Noranda Mines Ltd. v. Minerals Separation North American Corp. (1947) 12 C.P.R. 102 at pp. 111-112, (1947) Ex. C.R. 306 aff'd (1950) 12 C.P.R. 99, (1950) S.C.R. 36  
Société des usines chimiques Rhone-Poulenc et al. v. Jules R. Gilbert et al. (1968) 55 C.P.R. 207 at pp. 207 & 208, affirming (1968) 55 C.P.R. 209  
Commissioner's Decision No. 509, Application 213,113 (1978)
23. Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd. (1981) 56 C.P.R. (2d) 145 at 160, also indexed as (1981) 1 SCR 504
24. Re Application No. 003,389 of N.V. Organon (1973) 15 C.P.R. (2d) 253 also indexed as Commissioner's Decision No. 144, Application 3,389, (Now patent 937,498)(1973)  
Harvard College v. Canada (Commissioner of Patents) 7 C.P.R. (4<sup>th</sup>) 1 at paragraphs 68 to 85, Reversed on other grounds 21 C.P.R. (4<sup>th</sup>) 417
25. Northern Electric Co. v. Brown's Theaters Ltd. (1940) ExCR 36 at 56, aff'd (1941) SCR 224  
Wandscheer et al. V. Sicard Limitée (1944) 4 C.P.R. 5 at p.15-16, aff'd (1947) 6 C.P.R. 35  
Corning Glass Works v. Canada Wire & Cable Ltd. (1984) 81 C.P.R. (2d) 39 at p. 42  
Wellcome Foundation Ltd. v. Apotex Inc (1991) 39 C.P.R. (3d) 289 at 338, aff'd (1995) 60 C.P.R. (3d) 135  
Feherguard Products Ltd. v. Rocky's of BC Leisure Ltd. (1994) 53 C.P.R. (3d) 417 at 424-425, aff'd (1995) 60 CPR (3d) 512  
Procter & Gamble Co. v. Bristol-Myers Canada Ltd. (1978) 39 C.P.R. (2d) 145 at pp. 159-160, aff'd (1979) 42 C.P.R. (2d) 33  
Commissioner's Decision No. 337, Application 114,647, (Now patent 1,013,190) (1976)  
Commissioner's Decision No. 1256, Application 2,145,007 (2003)  
Commissioner's Decision No. 1159, Application 474,156 (1990)  
Radio Corporation of America v. Hazeltine Corporation (1981) 56 C.P.R. (2d) 170
26. Re Application for Patent containing claims that read on mental steps performed by a human operator in deciding to transmit a signal (1972) 23 CPR (2d) 93
27. Re Application of Abitibi Co. (1982) 62 C.P.R. (2d) 81
28. Monsanto Canada Inc. v. Schmeiser [2004] SCC 34. at para 114. also indexed as (2004) 31 C.P.R. (4<sup>th</sup>) 161
29. President and Fellows of Harvard College v. Commissioner of Patents (2002) SCC 76, also indexed as (2002) 21 C.P.R. (4<sup>th</sup>) 417  
Pioneer Hi-Bred v. Commissioner of Patents (1987)14 C.P.R. (3d) 491, (1989) 25 C.P.R. (3d) 257
30. Pioneer Hi-Bred Ltd. v. Canada (Commissioner of Patents) (1989) 25 C.P.R. (3d) 257 at p. 264
31. President and Fellows of Harvard College v. Commissioner of Patents (2002) SCC 76, also indexed as (2002) 21 C.P.R. (4<sup>th</sup>) 417  
Pioneer Hi-Bred v. Commissioner of Patents (1987)14 C.P.R. (3d) 491, (1989) 25 C.P.R. (3d) 257
32. Monsanto Canada Inc. v. Schmeiser (2004) 31 C.P.R. (4<sup>th</sup>) 161 at para. 128

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33. President and Fellows of Harvard College v. Commissioner of Patents [2002] 4 S.C.R. 45 at para. 151 also indexed as [2002] 21 C.P.R. (4<sup>th</sup>) 417
34. Tennessee Eastman v. Commissioner of Patents [1972] 62 C.P.R. 117 (ExC) at 154-155, aff'd [1972] 8 C.P.R. (2d) 202 (S.C.C.); Imperial Chemical Industries Ltd. v. Commissioner of Patents [1986] 9 C.P.R. (3d) 289 (F.C.A.) at 295-296. *conf.*
35. Commissioner's Decision No. 33, Application 862,758 (now patent 882,618) (1970)  
Commissioner's Decision No. 63, Application 954,851 (now patent 890,188) (1994)
36. ICI v. Commissioner of Patents (1986) 9 C.P.R. (3d) 289, (1986) 3 FC 40
37. Commissioner's Decision No. 1191, Application 527,445 (now patent 1,332,440) (1994)
38. Re Application 3,389 of N.V. Organon (1973) 15 C.P.R. (2d) 253  
Re Application of Goldenberg (1988) 22 C.P.R. (3d) 159  
Re Application 880,719 (1973) 18 CPR (2d) 114  
C.D. 1125, Application 406,401 of Neuromed
39. Re: Mobil Oil 1,254,297(1988) 24 C.P.R. (3d) 571 at 576, "the applicant's system is useful and does not relate solely to calculations or algorithms"
40. Progressive Games v. Commissioner of Patents (2000) 9 C.P.R. (4<sup>th</sup>) 479 (F.C.A.) at 479, aff'd (1999) 3 C.P.R. (4<sup>th</sup>) 517 (F.C.T.D.); see also the F.C.T.D. case at 523-525
41. Commissioner's Decision No. 79, Application 40,799 for Game (1971); Commissioner's Decision No. 93, Application 55,210 for Golf Game (now patent 897,199) (1971)
42. Commissioner's Decision No. 93, Application 55,210 for Golf Game (now patent 897,199) (1971)
43. Re Application No. 003,389 of N.V. Organon (1973) 15 C.P.R. (2d) 253 also indexed as Commissioner's Decision No. 144, Application 3,389, (Now patent 937,498)(1973)  
Harvard College v. Canada (Commissioner of Patents) 7 C.P.R. (4<sup>th</sup>) 1 at paragraphs 68 to 85, reversed on other grounds 21 C.P.R. (4<sup>th</sup>) 417
44. Shell Oil v Comm. of Patents [1982] 2 SCR 536, also indexed as [1982] 67 C.P.R. (2d) 1 at 15
45. Commissioner's Decision No. 896, Application 269,230 (now patent 1121640) (1981)
46. Commissioner's Decision No. 605, Application 245,995 (1979)  
Commissioner's Decision No. 80, Application 44,282 (1971)
47. Commissioner's Decision No. 821, Application 298,822 (Now patent 1,116,380)

48. Mailman v. Gillette Safety Razor Co. of Canada, (1932) SCR 724 at pp. 731-732
49. Progressive Games, Inc. v. Canada (Commissioner of Patents) (2000) 9 C.P.R. (4<sup>th</sup>) 479 at paragraph 1: "*changes in the method of playing poker did not amount to a contribution or addition to the cumulative wisdom on the subject of the game*", affirming (1999) 3 C.P.R. (4<sup>th</sup>) 517 and (1997) 3 C.P.R. (4<sup>th</sup>) 526.
50. Commissioner's Decision No. 493, Application 159,204 (1978)
51. Lawson v. Com of Patents (1970) 62 C.P.R. 101 at p. 116  
Commissioner's Decision No. 878, Application 253,122 (1981)  
Commissioner's Decision No. 937, Application 310,519 (now patent 1,163,822) (1982)
52. Apotex Inc. v. Wellcome Foundation Ltd. 212 C.P.R. (2002) (4<sup>th</sup>) 499 at p. 501
53. Visx Inc. v. Nidek Co. (1999) 3 C.P.R. (4<sup>th</sup>) 417 at p.452 (para. 134), aff'd (2001) 16 C.P.R. (4<sup>th</sup>) 251