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January 25, 2021

Door Left Open for Use of Foreign Patent Prosecution History

Since its enactment in 2018, section 53.1 of the *Patent Act* has been the subject of much discussion. This provision allows courts tasked with construing the claims of a patent to consider communications previously made by the patentee to the Canadian Patent Office in the course of patent prosecution (known as the "prosecution history" or the "patent file wrapper"). Recently, the Federal Court has provided differing interpretations regarding the limitations of this section.

Last Wednesday, the Federal Court of Appeal ("FCA") released *Canmar Foods Ltd v TA Foods Ltd* ("*Canmar Appeal*"), an appeal from Justice Manson's decision ("*Canmar*"), granting the defendant's summary judgement motion to dismiss the patent infringement action. In reaching his decision, Justice Manson considered the US patent prosecution history for the corresponding US patent application (Justice Manson's decision was discussed in our previous commentary here).

The FCA ultimately dismissed the appeal and upheld Justice Manson's decision, but it found that he had erred in considering the US patent application. However, the FCA made that finding on the narrow basis that the US file history was not relevant for the specific patent at issue in *Canmar*, and the Court declined to express any firm view on whether foreign prosecution history is ever admissible pursuant to section 53.1.

Section 53.1(1) of the *Patent Act* states:

> **53.1 (1)** In any action or proceeding respecting a patent, a written communication […] may be admitted into evidence to rebut any representation made by the patentee in the action or proceeding as to the construction of a claim in the patent if
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> **(a)** it is prepared in respect of
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> **(i)** the prosecution of the application for the patent,
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> **[…]**; and
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> **(b)** it is between
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> **(i)** the applicant for the patent or

> the patentee; and
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> **(ii)** the Commissioner, an officer or employee of the Patent Office or a member of a re-examination board.

Prior to its enactment, prosecution history was inadmissible for the purposes of claim construction in any patent litigation. In practice, this meant that a patentee could frame its patent narrowly to overcome objections raised by an examiner, and then after the patent was issued, the patentee could then take the opposite position during an infringement proceeding in order to widen the monopoly granted by the patent. In *Pollard Banknote Limited v BABN Technologies Corp*, Justice Locke described this phenomenon as an attempt to "recapture ground conceded during the prosecution of the patent application".

Though section 53.1 plainly allows certain communications between the patentee and the Canadian Patent Office to be admitted as evidence, the Federal Court had issued differing interpretations on whether it allows consideration of foreign prosecution history. In *Gemak Trust v Jempak Corporation*, Justice Lafrenière held that foreign prosecution history is simply not admissible pursuant to section 53.1. However, in *Canmar*, Justice Manson held that foreign prosecution history is admissible in "extraordinary circumstances", such as where it has been incorporated by reference into the Canadian prosecution history.

In the *Canmar Appeal*, the FCA discussed the purpose and background of section 53.1, and the Court cautioned that courts should be wary of expanding the detailed language of section 53.1, which is specific to communications with the Canadian Patent Office. However, the Court declined to decide whether reference to a foreign prosecution history "should formally be treated as an exception to the general prohibition on foreign prosecution files."

Instead, the FCA found that, on the facts of *Canmar*, the statements from the foreign prosecution history had not been incorporated by reference into the Canadian patent at issue. The Canadian prosecution history contained only a general mention of "a related United States application". This statement, without even a citation to the specific application, was found to be insufficient to incorporate the US file wrapper into the Canadian prosecution history.

Accordingly, the FCA left the door open to arguments that exceptional circumstances may bring a foreign file history into

the ambit of section 53.1, and this issue remains to be conclusively determined.

For further information on the implications of this important case with regard to summary adjudication, read our companion post here.