



PATENTS

Appeal from Commissioner of Patents' decision refusing appellant's patent application no. 2635393 ('393 application) — Appellant founder of investment management firm — Claiming invention of computer implementation of new method for selecting, weighing investment portfolio assets that minimizes risk without impacting returns — Patent examiner rejecting '393 application on ground that subject matter of claims laying outside definition of "invention" provided in *Patent Act*, R.S.C., 1985, c. P-4 (Act), s. 2 — Panel of Board members agreeing with examiner's findings — Commissioner concurring with Panel's recommendation that claims on file not complying with Act, s. 2 as they did not disclose "invention" — Panel construing patent claims to determine essential elements using problem-solution approach set out in Canadian Intellectual Property Office's (CIPO) *Manual of Patent Office Practice* (June 2015) (MOPOP) — In this approach, set out in 2015 MOPOP, s. 13.05.02c (now s. 12.02.02e), essential elements of claim are those necessary to achieve disclosed solution to identified problem — Panel finding that essential elements of appellant's claims "directed to a scheme or rules involving mere calculations" for weighing securities — Finding no discernible physical effect to satisfy definition of "invention" — Appellant submitting, *inter alia*, that Commissioner erred in applying problem-solution approach when determining essential elements of claimed invention — Appellant also submitting that established test for determining essential elements set out by Supreme Court in *Free World Trust v. Électro Santé Inc.*, 2000 SCC 66, [2000] 2 SCR 1024 (*Free World Trust*) — Whether Commissioner applying wrong test when construing claims — Commissioner erring in determining essential elements of claimed invention by using problem-solution approach — Evident on reading of MOPOP that Commissioner, notwithstanding stating that patent claims are to be construed in purposive manner, not intending or directing patent examiners to follow teachings of *Free World Trust*, *Whirlpool Corp. v. Camco Inc.*, 2000 SCC 67, [2000] 2 SCR 1067 (*Whirlpool*) — MOPOP distinguishing purposive construction in *Whirlpool*, *Free World Trust* from that to be used by patent examiners — Commissioner relying on *Genencor International Inc. v. Canada (Commissioner of Patents)*, 2008 FC 608, [2009] 1 F.C.R. 361 (*Genencor*) for its holding that *Whirlpool* test not applicable to patent examiners — *Genencor* not binding on Court, no longer good law — Decided prior to *Canada (Attorney General) v Amazon.com, Inc.*, 2011 FCA 328, [2012] 2 F.C.R. 459 (*Amazon*) — Federal Court of Appeal therein finding that Commissioner required to employ purposive construction test set out in *Whirlpool*, *Free World Trust* — This, in part, because job of Commissioner, like judge at trial, is to determine validity — Using problem-solution approach to claims construction akin to using "substance of the invention" approach discredited by Supreme Court in *Free World Trust* — Problem-solution approach to claims construction failing to respond to issue of inventor's intention — Decision set aside — Appeal allowed.

CHOUEIFATY V. CANADA (ATTORNEY GENERAL) (T-1404-19, 2020 FC 837, Zinn J., reasons for judgment dated August 21, 2020, 17 pp.)