Section 53.1 of the Patent Act – An update on the Canadian version of file wrapper estoppel

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Prior to December 13, 2018, the law in Canada was that extrinsic evidence could not be used to interpret patent claims. The view articulated by the Supreme Court of Canada was that such use of extrinsic evidence undermines the public notice function of the claims, and increases uncertainty, thereby fueling patent litigation.[1]

However, the enactment of section 53.1, on that date, modified the approach to patent construction in Canada. This article will discuss some of the decisions interpreting section 53.1(1), and highlight some takeaways from these cases, as well as some conflicting interpretations that will likely lead to further guidance from the Court.

The text of section 53.1(1)

Section 53.1(1) states:

> **53.1 (1)** In any action or proceeding respecting a patent, a written communication, or any part of such a 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
>
> **(a)** it is prepared in respect of
>
> 1. the prosecution of the application for the patent,
> 2. a disclaimer made in respect of the patent, or
> 3. a request for re-examination, or a re-examination proceeding, in respect of the patent; and
>
> **(b)** it is between
>
> 1. the applicant for the patent or the patentee; and
> 2. the Commissioner, an officer or employee of the Patent Office or a member of a re-examination board.

The Federal Court of Appeal has confirmed that only written communications between the patentee and the Patent Office are admissible by virtue of section 53.1.[2]

When is it appropriate to admit and rely on the file history as evidence for claim construction?

In *Bauer*, the Court held that there is no need to identify a particular representation and rebuttal every time a reference is made to the prosecution history. The file history is simply integrated into the interpretive process of claims construction.[3]

However, in *Canmar Foods FC*, the Federal Court held that communications made in the course of prosecution are only admissible for the limited purpose of rebutting a representation made by the patentee as to the construction of a claim in that patent.[4] Similarly, in *Eli Lilly*, the Court stated that the patentee was not entitled to rely on the prosecution history to support its proposed construction, despite the prosecution history having been admitted as evidence to rebut the patentee's proposed construction on a different point.[5]

The Federal Court of Appeal in *Canmar Foods FCA* noted the discrepancy between these decisions. It stated that, at minimum, the approach in *Canmar Foods FC* was correct. It decided not to comment further on the extent and purpose for which the prosecution communications can be introduced.[6] As the *Bauer* and *Eli Lilly* decisions are both being appealed, we will have to wait for further guidance from the Federal Court of Appeal regarding when it is appropriate to admit and/or rely on these communications.

Can foreign prosecution histories be admitted and relied upon under s. 53.1?

In *Canmar Foods FC*, the Court relied on the American prosecution history of the related patent to interpret the Canadian claims.[7] On appeal, the Federal Court of Appeal stated that the language of s. 53.1 is specific about communications being limited to those with the Canadian Patent Office. It stated that on the facts of this case, it was inappropriate for the Federal Court to have relied on the American prosecution history. Admitting foreign patent prosecution histories as evidence may lead to overly contentious and expensive litigation. There may be different claims, laws, standards, and languages in other countries, and these differences support the exclusion of foreign prosecution histories.[8] Despite this, the Federal Court of Appeal did leave the door open for reliance on foreign prosecution histories if the situation so requires, including if the foreign history is incorporated by reference.[9]

Can the lack of representation by the patentee during prosecution confirm/rebut a construction put forward at trial?

In *Bauer*, the patentee put forward a construction of the term "foxing portion" of a hockey skate at trial. The Court found a lack of anything in the prosecution history that would have alerted the Patent Office to the interpretation put forward by patentee, and used this to confirm his rejection of the patentee's proposed construction. Therefore, the Court appears to have used this lack of representation by the patentee of what a term

would mean to confirm a narrower construction than that put forward by the patentee during the proceeding.[10]

Similarly, in *Janssen*, in the patentee's response to an office action with a method of medical treatment objection, the patentee reproduced some of the claim language, including the terms in question. The Court used this representation to the Patent Office to confirm its interpretation of these terms and reject the construction advanced by the patentee at trial. However, there was no meaning given to the terms in question in the representation to the patent office, merely a recitation of those terms. Therefore, again, the Court appears to have used a lack of representation by the patentee of what a term would mean to confirm a different construction than that put forward by the patentee during the proceeding.[11]

Takeaways

Although we await clarification from the Courts on certain issues related to s. 53.1(1), there are some takeaways and best practices that can be distilled from the case law.

Takeaway 1: Patentees should avoid incorporating foreign file histories by reference in their Canadian applications. Doing so may allow those foreign prosecution histories to be admitted in evidence, and relied upon to rebut a representation made by the patentee at trial as to construction. In fact, it may be prudent to disclaim foreign applications in correspondence with the Canadian patent office where the situation permits.

Takeaway 2: A strict reading of section 53.1(1) is, at minimum, the approach the Courts appear ready to enforce. Therefore, if there is a representation made by the patentee in an action or proceeding as to the construction of a claim in a patent, evidence from the Canadian prosecution history may be admissible, and used to rebut the patentees proposed construction.

There are at least two consequences of this. First, when a patentee is amending claims in a Canadian application or presenting arguments to overcome an objection of a patent examiner, it must give early and serious consideration to the potential consequences and the impact upon later enforcement and litigation strategy. Any limitation may essentially become an admission that what was previously claimed is now disclaimed. This could have the effect of narrowing the net within which infringers can be caught.

Second, for the same reason, patentees should pay close attention to the Canadian prosecution file history, including any foreign file histories incorporated by reference, prior to the commencement of a proceeding against a putative infringer. Amendments made during prosecution may make the construction of certain terms too narrow for an infringement finding.

Takeaway 3: Patentees should practice restraint when responding to office actions. Generally, responses to office actions should go no further than is reasonably necessary to overcome the examiner's objections. This approach would likely provide less ammunition for putative infringers in an attempt to rebut representations made by the patentee as to construction at an infringement proceeding. At the same time, it may be prudent to include disclaimers in responses to office actions to the effect that simply

because a claim or claim term was or was not discussed in the response, this does not constitute an admission, concession or interpretation of the claims.

[1] *Free World Trust c. Électro Santé Inc*., 2000 SCC 66 at para 66.

[2] *Canmar Foods Ltd. v. TA Foods Ltd*., 2021 FCA 7 at para 63 [*Canmar Foods FCA*].

[3] *Bauer Hockey Ltd. v. Sport Maska Inc*. (CCM Hockey), 2020 FC 624 at para 65 [*Bauer*].

[4] *Canmar Foods Ltd. v. TA Foods Ltd*. 2019 FC 1233 at para 63 [*Canmar Foods FC*].

[5] *Eli Lilly Canada Inc. v. Apotex Inc.*, 2020 FC 814 at para 175 [*Eli Lilly*].

[6] *Canmar Foods Ltd. v. TA Foods Ltd*., 2021 FCA 7 at paras 65-67 [*Canmar Foods FCA*].

[7] *Canmar Foods Ltd. v. TA Foods Ltd*. 2019 FC 1233 at paras 70, 74, 85, 92 [*Canmar Foods FC*].

[8] *Canmar Foods Ltd. v. TA Foods Ltd*., 2021 FCA 7 at paras 70, 71, 74, 77 [*Canmar Foods FCA*].

[9] *Canmar Foods Ltd. v. TA Foods Ltd*., 2021 FCA 7 at paras 74, 77 [*Canmar Foods FCA*].

[10] *Bauer Hockey Ltd. v. Sport Maska Inc*. *(CCM Hockey)*, 2020 FC 624 at para 105 [*Bauer*].

[11] *Janssen Inc. v. Teva Canada Ltd*., 2020 FC 593 at paras 124, 139-142 [*Janssen*].

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